

Jur. rel.
1736

Decisions

FEDERAL DECISIONS.

CASES ARGUED AND DETERMINED

IN THE

SUPREME, CIRCUIT AND DISTRICT COURTS

OF THE

UNITED STATES.

COMPRISING

THE OPINIONS OF THOSE COURTS FROM THE TIME OF THEIR ORGANIZATION TO
THE PRESENT DATE, TOGETHER WITH EXTRACTS FROM THE OPIN-
IONS OF THE COURT OF CLAIMS AND THE ATTORNEYS-
GENERAL, AND THE OPINIONS OF GENERAL
IMPORTANCE OF THE TERRI-
TORIAL COURTS.

ARRANGED BY

WILLIAM G. MYER,

*Author of an Index to the United States Supreme Court Reports;
also Indexes to the Reports of Illinois, Ohio, Iowa, Missouri
and Tennessee, a Digest of the Texas Reports, and
local works on Pleading and Practice.*

VOL. XXV.

PATENTS, COPYRIGHT AND TRADE-MARKS.

PATENTS:

EDITED BY

W. D. BALDWIN AND WOODBURY LOWERY.

SECOND EDITION.

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PREFACE.

This volume includes every known reported Federal Patent Case up to 1886, including the decisions therein contained relating to Contracts, Evidence, Pleading and Practice. The object has been to render it as completely as practicable an encyclopedia of patents and its connected subjects — for the benefit of the large class of patent solicitors who are not lawyers, as well as to facilitate the labors of the bar. The results of thirty years' experience have been embodied in an effort to present the matter in the shape practically most available. Imperfection is however keenly felt to be inseparable from such an attempt, but an earnest effort has been made to do the work properly.

The revising editor deems it due to his colleague to testify to the efficiency, thoroughness, and zeal of his work. This is a difficult branch in which to select leading cases for publication in full. Great care and discrimination have been exercised in this matter, however, and the selection made is believed to include every important topic. The plan pursued has been, as a rule, to take the latest controlling decisions of the Supreme Court, as they generally discuss the corresponding preceding cases, and those based upon the Revised Statutes which vary in some cases from preceding legislation. This digest includes some two thousand eight hundred cases; at least one thousand more than any other similar work. The arrangement adopted renders the work self-indexing; as it is arranged, as far as practicable, alphabetically, chronologically, logically, and by subject-matter, with copious cross-references. The aim has been to give the point decided in every case, leaving reversals or changes of doctrine to appear from the cases themselves. To have attempted this work ourselves would have involved the preparation of a treatise as well as a digest. (See Table 8.)

Thanks are due Mr. MacArthur for kind permission to use his notes.

B. & L.

EXPLANATORY.

1. The cases in this work are arranged by subjects, instead of chronologically. They are assigned to the various general heads of the law, and each subject is divided and subdivided, for convenience of arrangement and reference, with head-notes, or table of contents, at the head of each subject, the same as an ordinary digest.

2. At the head of each division of a subject will be found a digest or summary of the points of law in the cases assigned to such division. This SUMMARY is confined exclusively to the statement of the points of law applicable to the particular division under which the case is published, other points of law in the case, if any, being transferred to other subjects, or to other subdivisions of the same subject. Where points in a case are carried to another division of a subject, they are put into the foot-notes, or notes following the cases, and reference is made to the case by section numbers in parenthesis at the end of the section. (*a*)

3. The cases in full are arranged, generally, according to the order of the sections of the SUMMARY. Where the court states the facts of the case, it is so indicated by the use of the words STATEMENT OF FACTS at the beginning of the opinion. Where it is necessary to state the facts apart from the opinion, the statement is made as brief as possible, and is confined to the facts necessary to enable the reader to understand the points decided. The cases are also divided into convenient paragraphs, with a brief statement at the beginning of each paragraph of the point of law discussed or decided. Reference is here had to the *italic* sections scattered through the opinion. These take the place of the syllabus usually placed at the head of the opinion, and, besides bringing out every point of law actually decided, in some instances call attention to a review of authorities, as well as various points of law which would ordinarily be classed as *dicta*.

4. At the end of a series of cases is a digest of points applicable to the particular subdivision of the subject. This digest matter is obtained from four sources: 1st. Cases assigned originally to the general head, but digested and thrown out in the final arrangement, not to appear in full in any part of the work. 2d. Points taken from cases which will appear in full under some other division of the same subject. 3d. Points taken from cases which are assigned to some other general head. 4th. A digest of cases from state reports, law periodicals, and the opinions of the Court of Claims and the Attorneys-General.

5. Cases that will not appear in full in any part of the work are denoted by a *star* following the name of the case, thus, DOE *v.* ROE.* The tables of cases will also contain a similar designation of rejected cases, so that in consulting them the reader will readily see whether he is referred to a case in full or only a digest.

6. The *italic* matter at the head of the SUMMARY takes the place of the side-heads, or catch-words, usually prefixed to the sections, and is intended as an index to the contents of the SUMMARY. At the end of each section of the SUMMARY the name of the case of which the section is a digest is given, followed by the numbers of the sections into which the case is divided, so that after the reader has read the section of the SUMMARY, and found that it is what he wants, he can at once turn to the case in full.

(*a*) The editors of PATENTS have departed from the plan of the preceding volumes as to the arrangement of the digest matter at the head of the cases in full.

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Under Copyright & Trade-Marks, all the cases are included to 117 U. S., and 26 Fed. R.

ABBREVIATIONS.

Abbott's Admiralty	Abb. Adm.	Lowell	Low.
Abbott's U. S.	Abb.	McAllister	McAl.
Albany Law Journal	Alb. L. J.	McCahon	McCahon.
American Law Register ...	Am. L. Reg.	McCrary	McC.
Baldwin	Bald.	McLean	McL.
Bee	Bee.	MacArthur	MacArth.
Benedict	Ben.	Marshall	Marsh.
Bissell	Biss.	Martin	Martin (N. C.)
Black	Black.	Mason	Mason.
Blatchford	Blatch.	Montana Territory	Mont. T'y.
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Bond	Bond.	ter	N. B. R.
Brewster	Brewster.	Olcott	Olc.
Brockenbrough	Marsh.	Opinions of Attorneys-Gen-	
Brown	Brown.	eral	Opp. Att'y Genl
Call	Call (Va.).	Oregon	Oreg.
Central Law Journal	Cent. L. J.	Otto	Otto.
Chase's Decisions	Chase's Dec.	Overton	Overton (Tenn.).
Chicago Legal News	Ch. Leg. N.	Paine	Paine.
Clifford	Cliff.	Peters	Pet.
Colorado Territory	Colo. T'y.	Peters' Admiralty	Pet. Adm.
Connecticut Reports	Conn.	Peters' Circuit Court	Pet. C. C.
Cooke	Cooke (Tenn.).	Philadelphia Reports	Phil.
Court of Claims	Ct. Cl.	Pittsburgh Reports	Pittsb. R.
Crabbe	Crabbe.	Sawyer	Saw.
Cranch	Cr.	Smith	Smith (N. H.).
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Curtis	Curt.	Story	Story.
Dakota Territory	Dak. T'y.	Sumner	Sumn.
Dallas	Dal.	Taney	Taney.
Daveis	Dav.	Utah Territory	Utah T'y.
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Gilpin	Gilp.	Wheaton	Wheat.
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Hoffman	Hoff.	Woods	Woods.
Holmes	Holmes.	Woodbury & Minot	Woodb. & M.
Howard	How.	Woolworth	Woolw.
Hughes	Hughes.	Wyoming Territory	Wyom. T'y.
Law and Equity Reporter ..	Law & Eq. Rep.	Van Ness	Van Ness.
Legal Gazette Reports	Leg. Gaz. R.		

Additional Abbreviations in this Volume: *B. & A.*, or *Ban. & Arden*, Banning & Arden's Patent Reports. *Fish.*, Fisher's Patent Cases. *Fish. Pat. Rep.*, Fisher's Patent Reports. *Robb*, Robb's Patent Cases. *MacA. Pat. Cases*, MacArthur's Patent Cases. *Whit.*, Whitman's Patent Cases. *O. G.*, Official Gazette, U. S. Patent Office.

FEDERAL DECISIONS.

PATENTS.*

ABANDONMENT.

See APPLICATIONS, ABANDONED. CLAIMS, ABANDONED. EXPERIMENT, ABANDONED. EXPERIMENT, ABANDONED, PRESUMPTION AS TO. EXPERIMENT, ABANDONED, INFRINGEMENT. INVENTION, ABANDONED.

SUMMARY (PLANING-MACHINE CO. v. KEITH, §§ 1-13) — *History of case*, § 1.— *Act 1870*, §§ 2, 3.— *Patent office rule as to presumption of abandonment of rejected applications*, §§ 4-9.— *How ascertained*, § 4.— *May be after application*, § 6.— *Diligence in prosecuting application*, §§ 7, 8.— *The patent held wanting in novelty*, § 10.— *Mere enlargement is not invention*, § 11.— *Statutory notice of names of witnesses under section 4920, Revised Statutes*, § 12.— *Objections to witnesses*, § 13.

See COMMISSIONER, § 1069.

PLANING-MACHINE COMPANY v. KEITH.

(11 Otto, 479-494. 1879.)

APPEAL from U. S. Circuit Court, District of Massachusetts.

Opinion by MR. JUSTICE STRONG.

STATEMENT OF FACTS.— The bill of The Woodbury Patent Planing-Machine Company, the appellant, is founded upon letters patent granted to Joseph P. Woodbury on the 29th of April, 1873, for an alleged "new and useful improvement in planing-machines," numbered 138,462. The specification declares the object of the improvement to be presenting the material to the cutter in such a manner as both to counteract, as far as practicable, the fluttering or tremor caused by the successive blows of the knives, and the consequent wavy and uneven surface of the planed work, and at the same time to overcome more perfectly than theretofore the tendency in the knives of the rotary cutter to loosen and dislodge the knots and shakes, and to tear the fibres of the wood irregularly, instead of severing them smoothly along the exact surface desired. To accomplish this twofold object, the patentee proposed to make use of what he denominated "a yielding pressure-bar," made of such material, and of such mass, as to be rigid from end to end, with its under face flat, so that it may have an extended bearing upon the work longitudinally of the machine, and mounted upon springs, so as, within certain limits, to accommodate itself to the varying irregularities in the surface of the material operated upon. The specification then proceeds to state the patentee's supposed advantages of the alleged invention, and to describe, by reference to drawings, the patented device. The claims are four, all for combinations. They are as follows:

1. The combination of a rotary cutter and a yielding pressure-bar or bars, substantially as and for the purpose described.
2. The combination of a solid bed and a yielding pressure-bar or bars for the purpose of holding down

*Edited by WOODBURY LOWERY and W. D. BALDWIN, Esqs., of Washington, D. C.

the material while being acted on by the cutter, substantially as set forth. 3. The combination of a solid bed, a rotary cutter and a yielding pressure-bar or bars, substantially as described. 4. The combination of the two pressure-bars, one of which is supported upon arms and the other upon springs, substantially as and for the purpose set forth.

It is this use of yielding pressure-bars in the combination which constitutes principally, if not wholly, the novelty of the device described in the patent. Planing-machines with a solid bed, rotary cutter, and devices for receiving and transmitting the power had been known and in use long before Woodbury claimed to have made his invention. The Woodworth planing-machine, substantially the first of the class, had all these in combination, and in the same combination as they are found in the machine to which Woodbury applied his yielding bars, but instead of bars Woodworth used rollers to keep firmly in position the wood to be planed. Woodbury merely substituted bars for rollers. No doubt the substitution was an improvement. It enabled the pressure upon the wood to be brought nearer to the cutters than it could be in the Woodworth machine. It had a more extended bearing, and, therefore, held the material more steady under the action of the knives or cutters, and the bars, perhaps, were less likely to be clogged by the chips cut in the operation of the machine.

On the 2d of March, 1874, the patentee sold and assigned his letters patent to the complainant, and it brought this suit against the defendant for an alleged infringement.

The answer of the defendant denies any infringement, and attacks the validity of the Woodbury patent for several reasons, any one of which, if sustained, must bar the relief which the complainant seeks. It is denied that Woodbury was the first and original inventor of the improvement claimed, and it is averred that the invention described in his patent had been publicly known and used for more than two years before his application for a patent was made, and that before that time his invention had been abandoned to the public. The answer contains other averments which we think it unnecessary to set forth, because the controlling questions are whether the device of Woodbury was the first and original invention, and whether, if it was, it was abandoned to the public before he obtained his patent.

§ 1. *History of the invention and application.*

Before proceeding to the consideration of the several defenses set up, it will be convenient to refer briefly to the history of Woodbury's alleged invention. Though the patent was not granted until 1873, the earliest application for it was made on the 3d of June, 1848. The invention appears to have been completed in the latter part of the year 1846, a *caveat* for it having been forwarded to the commissioner of patents as early as the 28th of May of that year. The petition for the patent authorized and empowered J. James Greenough, as attorney for the petitioner, to alter or modify the specification as he might deem expedient; and also to receive back any moneys which the petitioner might be entitled to withdraw, and to receipt for the same. Greenough, however, was not empowered to withdraw the application.

On the 20th of February, 1849, the application for a patent was rejected in the patent office, and no serious attempt appears to have been made to procure a re-examination, or to renew it, for a period of more than twenty years, though, during more than sixteen years of that time, the improved device had been in common use. In October, 1852, Greenough, the applicant's attorney,

formally withdrew the application, and received back \$20, of which, however, Woodbury had no notice at the time. The attorney had no sufficient authority to withdraw the application, though he had to withdraw the fee. In 1854, five years after the application had been rejected in the office, Woodbury instructed Mr. Cooper, another patent solicitor, who was acting for him in another case, to call up and prosecute anew his rejected application. This, however, was not done. Mr. Cooper, it seems probable, was deterred from taking any action in regard to the matter, by a rule which, at that time, he thought was generally enforced in the patent office, viz., that an application rejected, or not prosecuted, within two years after its rejection or withdrawal, should be conclusively presumed to have been abandoned. This rule was not always enforced, and it was reversed by the commissioner in 1869, and in the revised patent act of 1870 congress enacted: "That when an application for a patent has been rejected or withdrawn, prior to the passage of this act, the applicant shall have six months, from the date of such passage, to renew his application, or to file a new one, and if he omit to do either, his application shall be held to be abandoned. Upon the hearing of such renewed applications, abandonment shall be considered as a question of fact." It was within six months after the passage of this act that Woodbury renewed his application, upon which the patent was granted.

In view of this history, and of the other facts appearing in the case, the question is a grave one, whether the invention, even if Woodbury was the first inventor, was not abandoned by him before his renewed application was made.

§ 2. *The action of the commissioner of patents in granting a patent, under section 35 of the act of 1870, is not conclusive on the question of abandonment.*

§ 3. *Section 35 of the act of 1870 declares abandonment to be a question of fact, and patents granted thereunder are just as impeachable as those granted under section 24, whereby the commissioner is authorized to deal with the question of abandonment as well as public use and sale and originality of invention.*

§ 4. *The rule of the patent office prior to the passage of the act of 1870, that an application rejected, or not prosecuted within two years after its rejection or withdrawal, should be conclusively presumed to have been abandoned, though not always adhered to, had held it to be a question of law in the cases to which it applied, and the effect of the statute was rather to change the rule than to make the decision of the commissioner granting a patent an unreviewable decision that the invention had not been abandoned.*

It is quite certain that the action of the commissioner, granting the patent in 1873, is not conclusive of the question whether there had not been an abandonment. Under the thirty-fifth section of the act of 1870, abandonment is declared to be a question of fact. The rule of the patent office, though not always adhered to, had held it be a question of law, in the cases to which it was applied, and the effect of the statute was rather to change the rule than to make the decision of the commissioner, granting a patent, an unreviewable decision that the invention had not been abandoned. In fact, the commissioner may not be called upon to pass upon that question. No evidence respecting it may be before him, except mere lapse of time, and he has not generally the means of ascertaining what the action of an applicant for a patent has been, outside of the patent office. It surely cannot be claimed that patents obtained under the provisions of the thirty-fifth section of the act are any

more unimpeachable than those referred to in the twenty-fourth section. By that section the commissioner is authorized to deal with the question whether the invention has been abandoned, as well as with the question whether it was in public use or on sale more than two years prior to the application. Yet, both these matters, as well as the originality of the invention, upon which the commissioner must pass, may be contested in suits brought for infringement of the patent. Such defenses are allowed by the statute. It must, then, be open to every person, charged with an infringement, to show in his defense that the patentee had abandoned his invention before he obtained his patent.

§ 5. *Abandonment, although a matter of intention on the part of the inventor, need not be expressed in words, but may be gathered from the acts of the inventor.*

§ 6. *Abandonment may occur as well after an application has been made and rejected or withdrawn as before, and evidenced in the same manner.*

It has sometimes been said that an invention cannot be held to have been abandoned, unless it was the intention of the inventor to abandon it. But this cannot be understood as meaning that such an intention must be expressed in words. In *Kendall v Winsor*, 21 How., 322, this court said, "it is the unquestionable right of every inventor to confer gratuitously the benefits of his ingenuity upon the public, and this he may do either by express declaration or by conduct equally significant with language; such, for instance, as an acquiescence with full knowledge in the use of his invention by others; or he may forfeit his rights as an inventor by a wilful or negligent postponement of his claims." To the same effect is *Shaw v. Cooper*, 7 Pet., 292. These were cases, it is true, where the alleged dedication to the public, or abandonment, was before any application for a patent, but it is obvious there may be an abandonment as well after such an application has been made and rejected, or withdrawn, as before, and evidenced in the same manner. In *Adams v. Jones*, 1 Fish. Pat. Cas., 527, Mr. Justice Grier said, "a man may justly be treated as having abandoned his application if it be not prosecuted with reasonable diligence. But involuntary delay, not caused by the laches of the applicant, should not work a forfeiture of his rights."

§ 7. *The law requires and favors diligence in prosecuting the claims to an exclusive right, and an inventor cannot, without cause, hold his application pending during a long period of years, leaving the public uncertain whether he intends ever to prosecute it, and keeping the field of his invention closed against other inventors.*

The patent law favors meritorious inventors by conditionally conferring upon them for a limited period exclusive rights to their inventions. But it requires them to be vigilant and active in complying with the statutory conditions. It is not unmindful of possibly intervening rights of the public. The invention must not have been in public use or on sale more than two years before the application for a patent is made, and all applications must be completed and prepared for examination within two years after the petition is filed, unless it be shown to the satisfaction of the commissioner that the delay was unavoidable. All this shows the intention of congress to require diligence in prosecuting the claims to an exclusive right. An inventor *cannot without cause* hold his application pending during a long period of years, leaving the public uncertain whether he intends ever to prosecute it, and keeping the field of his invention closed against other inventors. It is not unfair to him, after his application for a patent has been rejected, and after he has for many years taken no steps to reinstate it, to renew it, or to appeal, that it

should be concluded he has acquiesced in the rejection and abandoned any intention of prosecuting his claim further. Such a conclusion is in accordance with common observation. Especially is this so when, during those years of his inaction, he saw his invention go into common use, and neither uttered a word of complaint or remonstrance, nor was stimulated by it to a fresh attempt to obtain a patent. When in reliance upon his supine inaction the public has made use of the result of his ingenuity, and has accommodated its business and its machinery to the improvement, it is not unjust to him to hold that he shall be regarded as having assented to the appropriation, or, in other words, as having abandoned the invention.

§ 8. *Circumstances may arise which will excuse delay in prosecuting an application, such as extreme poverty or protracted sickness; but in the absence of any such excuse entire inaction on the part of the inventor, coupled with long continued public use without complaint or remonstrance on his part, constitute abandonment to the public.*

There may be, it is true, circumstances which will excuse delay in prosecuting an application for a patent, after it has been rejected, such as extreme poverty of the applicant or protracted sickness. Of such cases we are not now speaking. None of these ordinary and accepted reasons for Woodbury's inaction during the more than sixteen years that elapsed between 1854 and his presentation of the new petition upon which his patent was granted, are found in this case.

His first application, as we have seen, was rejected on the 20th of February, 1849, and he was then informed from the patent office that he could "withdraw or appeal." Nothing, however, was done until October 4, 1852, when his attorney withdrew the application and received back \$20. True, the attorney was not empowered to withdraw the application, and it does not appear that Woodbury was then informed it had been withdrawn, but he was informed that the application had been rejected, and he gave no instructions to do anything more in the case, though instructions were asked, and though he was frequently in communication with his attorney, who obtained for him another patent on the 20th of March, 1849. The rejected application was suffered to rest until February 27, 1854, when Woodbury wrote to Mr. Cooper, another attorney, informing him that he had a rejected application, filed in June, 1848, for an improvement in pressure with the rotary cutter, and asking him to call up the case and get a patent for the most he could. Mr. Cooper made application for copies of the drawings and specification and for the letter of rejection, after having been informed that the application for the patent had been withdrawn; but nothing further was done except that Cooper informed Woodbury the application had been withdrawn by his former attorney. Thus the matter rested. Cooper's connection with it ceased in September, 1854. No effort was made in the patent office to have the rejected application reinstated, though such an effort must have been successful had it been made, and apparently Woodbury acquiesced alike in the rejection and in the withdrawal, until December, 1870, when his new application was made. During all this time he was in frequent communication with the patent office, prosecuting, and successfully, other applications for patents. He was not pressed by poverty to such an extent as to hinder his renewal of his application. This is shown by direct evidence, and by the fact that he had means to sue for and obtain other patents. Nor was he unwarned of the danger of delay. Very soon after 1854, if not before, the use of planing-machines con-

taining pressure-bars in combination with rotary cutters and a solid bed was general. The defendant's answer asserts that before December 5, 1870, and since the withdrawal of Woodbury's rejected application, many thousand planing-machines, containing his invention, had been constructed, sold and used in the United States, and this assertion is accepted in the appellant's brief. This fact must have been known by him. Upon this subject the evidence is very full. As we have seen, the distinctive element of Woodbury's invention was the substitution of yielding pressure-bars for the rollers employed in the Woodworth patent. A machine patented to Joseph E. Andrews, in 1845, had those pressure-bars, and Woodbury was engaged for years in selling those machines. Between 1852 and 1854 three Cornell machines of the Woodworth patent, rotary cutter, yielding pressure bars combined with a solid bed were used by John F. Keating in his shop at Boston. Mr. Woodbury was repeatedly there while they were in use, and examined them, but he never suggested that he had any claim to the use of pressure-bars in planing-machines. There is ample evidence also that hundreds of other machines containing the same device were manufactured and sold in Boston between the years 1854 and 1870, and were frequently seen by Mr. Woodbury, calling forth no remark from him indicating that they were invasions of his rights. In view of all this, it is of little importance that from time to time he expressed a hope to his brother, and, perhaps, occasionally to some others, that he should some time, and in some way, obtain a patent. Such was not his language to the public. His inaction, his delay, his silence, under the circumstances, were most significant. Though not express avowals of abandonment, "to reason's ear they had a voice" not to be misunderstood. They spoke plainly of acquiescence in the rejection of his application for a patent. They encouraged the manufacture and sale of his invention.

§ 9. *The rule of the patent office that an application rejected, or not prosecuted within two years after its rejection or withdrawal, should be conclusively presumed to have been abandoned, was not a statutory rule, nor inflexible in its application, but was frequently departed from and abolished before the act of 1870, and was no bar to a movement on the applicant's part to have his application reinstated after withdrawal, or to have it re-examined, or take an appeal, or file a new one, and cannot be regarded as an adequate excuse for a long delay.*

And there is no sufficient explanation of Mr. Woodbury's conduct, nothing which can be regarded as an adequate excuse for it. The rule of the patent office was not a statutory rule. It was at most only a rule of practice in the office, and it was not inflexible. The action of the office exhibits many instances in which departures from it were made before the act of congress of 1870 was passed, and even before Mr. Fisher, the commissioner of patents, abolished it. Case of J. W. Cochran, Commissioner's Decisions, 1869. If Woodbury did not intend to acquiesce in the rejection of his application, the rule was no bar to a movement by him to have it reinstated after its withdrawal. So he might have applied for a re-examination, or might have appealed, or might have filed a new one. Thus he would have given notice that he did not intend to give up his invention to the public.

There is a wide difference between this case and *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S., 486. In the latter case it appeared that after three successive rejections, the last in 1856, the application was never withdrawn nor any portion of the fee claimed. Still the applicant did not remit his efforts. He was in ill-health and wretchedly poor. But he continued to assert

his expectations of ultimately obtaining a patent; made frequent applications to his friends for advances to enable him to prosecute his claim; attempted to appeal; until finally, in 1864, eight years after the third rejection, the patent was obtained. The patentee had never relaxed his vigilance. He had left nothing undone which he could. He had kept his flag constantly flying. Nobody had been encouraged by any act or inaction of his to appropriate his invention. His patent was, therefore, sustained, and sustained only because he had been guilty of no laches. The conduct of Woodbury was in striking contrast with that we have described, and which is described more fully on page 491 of the report. We are constrained, therefore, to hold that Woodbury's invention was abandoned by him before he obtained his patent.

§ 10. *Woodbury's invention, patented April 29, 1873, was anticipated by the machine made by Alfred Anson in 1843, and in constant use for thirty years.*

We also concur in opinion with the circuit court that the machine built by Alfred Anson, at Norwich, Connecticut, in 1843, anticipated Woodbury's invention. That machine was never patented, though an attempt was made to obtain a patent for it. On the 16th of August, 1843, Anson applied for a patent for what his specification denominated "a new and useful improvement in the construction of the stocks of rotating cutters for dressing and cutting window-sash stuff, etc." The specification was accompanied by a model and drawings in perspective and in detail. His application, however, was rejected; and on the 20th of August, 1844, he withdrew it, and received back \$20. We have before us the specification, drawings and model, and what is better we have the original machine, with the testimony of its builder to identify it. That testimony, as well as that of other witnesses, proved clearly that the machine had at first, as it has now, all the elements in combination which compose the combinations claimed in the Woodbury patent. It had a rotary cutter. It had a solid bed under the cutter on which the material to be operated upon was placed, and over which it was moved and fed to the cutters by an endless chain. It had two yielding pressure-bars instead of rollers, adjusted by means of weights, to keep the material down on the bed, and so arranged as to cause the pressure to be felt nearer to the cutter's edge than it could be brought to bear by pressure-rollers. The yielding pressure was effected by weights, and not by springs, as in the Woodbury machine, but these are plainly mechanical equivalents for each other.

Passing, for the present, consideration of the admissibility of the evidence respecting the Anson machine, which we will notice hereafter, we proceed to observe what it proves.

The machine was built and set up in the shop of Mr. Shepard, a sash and blind maker, at Norwich, in 1843. It has been in operation there ever since, until it was taken out to be made an exhibit in this case,—a period of more than thirty years. Some slight changes have been made in it, but none in the combination described. The evidence leaves no doubt in our minds that the pressure-bars were arranged so as to be yielding, in accommodation to the uneven surfaces of the material to be shaped or planed, and that they were intended to be so arranged for such uses. Anson himself testifies that he put in the pressure-bars because he could get these nearer the cut of the cutters than he could a roller; and in his specification filed in the patent office he stated: "the stuff is also kept steady by means of a bar passing from the stands *M* and *N*, which bar may be raised or depressed in the same manner and simultaneously with the shafts which hold the cutters by means of the

screws." He testifies, also, that he made the front bar with a rounded front, for the purpose of receiving the stuff, and that, driving the stuff under it, it would yield and the weights below would keep the stuff steady when it came to the cutters. Moreover, an inspection of the machine is sufficient to convince us that the bars are yielding, within certain limits, capable of adjustment to any varying thickness of the stuff to be operated upon.

The appellant contends that the Anson machine fails to be an anticipation of the Woodbury invention, because, as they say, it has no solid bed. It plainly has, however, a solid bed, adequate for the purposes for which the machine was intended and used,—for cutting and planing light material, sash and blinds, and the bed is sufficiently solid for such uses. It may be admitted it would be too weak for general planing work upon boards or plank. It is comparatively a small machine. It would not cease to be the same machine, in principle, if any one or all of its constituents were enlarged or strengthened, so that it might perform heavier work. True, the bed is divided by a slit running longitudinally from one end to the other; but the two parts are arranged so as to constitute one bed, and it is not perceived why, if enlarged, it would not answer all the purposes of the Woodbury machine. Mere enlargement is not invention. The simplest mechanic can make such a modification. Woodbury's patent claims no particular form of a bed. It does not require the bed to be of any specified thickness, or constructed in one piece. Its purpose is to furnish a firm and unyielding support to the material when passing under the cutter, and that may be done as well by constructing the bed of two parts as of one. An anvil composed of two pieces is not the less an anvil, a solid block to resist the blows of a hammer. A solid foundation of a house may be composed of more than one stone. We cannot but think this objection to the Anson machine as an anticipating device is entitled to no weight.

Secondly, the appellant contends that the machine has no such pressure-bars as are shown and described in the Woodbury patent. This objection we have already considered, perhaps as fully as need be. There is, it is true, a formal difference, but it is merely formal. The distinguishing feature of the patent is yielding pressure-bars in combination with two other elements. The Anson machine has those in the same combination. In both the machines they are substitutes for rollers, and intended to secure like advantages over the Woodworth patent; namely, while keeping down the stuff on the bed of the machine to bring the downward pressure nearer to the line of the cut. If, in the Woodbury machine, the bars enable that pressure to be brought nearer than it is in the Anson (which is not apparent), the difference is only in degree of approximation. Such a difference would be effected in the Woodworth machine by simply changing the diameter of the rollers.

§ 11. *Mere enlargement of a machine to strengthen or increase its capacity is the work of the mechanic and not invention, and is not sufficient to constitute novelty.*

The third principal objection urged by the appellant is that the Anson machine fails, as a whole, to perform the functions of the Woodbury machine. If by this is meant that heavy plank cannot be planed by it, the objection is well taken. For such a purpose it would need enlargement and strengthening; but that all the elements claimed for the patentee's combination are found in it, producing the same results, differing only in degree if at all, is to us very apparent.

Upon the whole, after having studied carefully the evidence and the ex-

hibits, we cannot doubt that every element found in the Woodbury machine, everything that was claimed by the patentee, existed in the same combination in the Anson machine, which was constructed and in full operation more than two years before Woodbury claims to have made his invention. Woodbury was not, therefore, the first and original inventor.

As the Anson machine has been in use, unchanged in the principles of its construction, from 1843 until it was taken from the shop to be made an exhibit in this case, it is not to be thrown aside as an abandoned experiment.

§ 12. *Under section 4920 of the Revised Statutes only the names and residences of those who had invented or used the anticipating machine or improvement, and not the names of those who are to testify of its invention or use, are required to be pleaded.*

We have considered the case thus far assuming that the Anson machine and all the testimony of witnesses respecting it is proper to be considered. The appellant objects, however, that most of the evidence is inadmissible, because the names of the witnesses called to sustain this defense of anticipation were not given in the answer. Section 4920 of the Revised Statutes declares that the proofs of previous invention, knowledge or use of the thing patented may be given upon notice in the answer of the defendant, stating the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used. The statute does not declare that the names of the witnesses, who may be called to testify to such prior invention or use, shall be stated in the answer. It is only the names and residences of the persons alleged to have invented or to have had prior knowledge of the thing patented that are required.

The defendant's answer in this case, as amended, set out "that said alleged invention, described and claimed as new in the letters-patent mentioned in the bill, or a substantial or material part thereof, was, before the alleged invention thereof by Woodbury, used by Alfred Anson, formerly of Norwich, and said use was known to Noah L. Cole, of said Norwich, said use being at said Norwich, in the state of Connecticut."

Anson and Cole were both examined and testified, without any objection to their competency because of want of notice. Hence it is too late to object to their testimony now. Had objection been taken at the time, the answer might have been amended. *Graham v. Mason*, 5 Fish. Pat. Cas., 6, per Mr. Justice Clifford; *Brown v. Hall*, 3 id., 531; *Phillips v. Page*, 24 How., 164; *Roemer v. Simon*, 95 U. S., 214-220.

§ 13. *An objection to the examination of a witness should state specifically the grounds of the objection, in order that the opposite party may have the opportunity of removing it, if possible.*

A number of other witnesses were examined relative to the history of the Anson machine and to show that no material change had been made in its organization from 1843 to 1876, or from the time when it was first put into operation. Their names were not given in the defendant's answer, and it is now insisted that their testimony should not be received. It is, however, doubtful, to say the least, whether any objection was made to their testifying because their names had not been given in the answer. None was made specifically for that reason. After notice had been given that the defendant would proceed to take depositions at Norwich, the solicitors of the complainant requested in writing to be informed of the names of witnesses proposed to be

examined, asserting a right to such information, not under the statute, but under the English chancery rules. Clearly they had no such right under our equity rule. The names were not given in answer to the request, and when the witnesses were called the counsel for the complainant objected to their examination "*for want of notice.*" Notice of what? The counsel of the defendant may well have understood the objection to be that the names had not been furnished in response to the application of the complainant's solicitors, rather than that they had not been set out in the answer. An objection to the examination of a witness should state specifically the ground of the objection, in order that the opposite party may have the opportunity of removing it, if possible. Had this been done in the present case the defendant might have postponed the examination and moved to amend his answer, if such amendment was needed.

But beyond this, it seems to be settled that the true construction of the act of congress is that only the names of those who had invented or used the anticipating machine or improvement, and not the names of those who are to testify of its invention or use, are required to be pleaded. It was so ruled by Mr. Justice Grier, in *Wilton v. The Railroads*, 1 Wall. Jr., 195, and by Mr. Justice Nelson, in *Many v. Jagger*, 1 Blatch., 376; *Roemer v. Simon*, 95 U. S., 214. This is all that is necessary to protect a patentee against surprise. If in regard to an invention claimed to have anticipated his own, he is informed by the defendant's answer of the names and residences of the alleged inventors, or who had prior knowledge of the thing patented, and when and by whom it had been used, it is sufficient to apprise him of the defense, and to enable him to make all needful inquiries respecting it. He need not know who are to testify in regard to the invention or use; much less does he need to know who are to testify respecting the history and use of the prior invention, after the complainant's patent has been granted.

We think, therefore, the testimony of the witnesses objected to "for want of notice" was admissible. And even without it the testimony of Anson and of Cole is sufficient to show the construction and use of the Anson machine in 1843, before Woodbury's invention was made.

Upon the whole, then, our conclusions are, that Woodbury was not the original and first inventor of the improvement for which the patent now owned by the complainant was granted to him, and that if he was, his invention had been abandoned to the public before his patent was granted.

It follows that the decree of the circuit court dismissing the bill must be affirmed, with costs; and it is so ordered.

Abandonment — *Delay in applying for patents does not necessarily constitute*, §§ 14-31.

§ 14. *Semble*, that an unreasonable delay in taking out patent may amount to an abandonment. *Treadwell v. Bladen*, 4 Wash., 703.

§ 15. Acts of 1836 and of 1839 did not prescribe the time within which a patent should be applied for after the invention was perfected. No lapse of time, however protracted, in the absence of abandonment or public use, barred an application for patent, nor affected its validity after it had been granted. *Wood v. Union Iron Works*, 4 Fish., 550.

§ 16. Mere delay in applying for patent, after invention made, works no forfeiture of right. *Kelleher v. Darling*, 4 Cliff., 424.

§ 17. Mere forbearance to apply for a patent during progress of experiments, and until the invention is perfected and its value tested by actual practice, is no ground for a presumption of abandonment. *Agawam Co. v. Gordon*, 7 Wall., 583.

§ 18. Mere lapse of time is not of itself a bar to a patent, but it is a circumstance from which, when taken in connection with others, abandonment may be presumed. *Russell & Erwin Manuf. Co. v. Mallory*, 10 Blatch., 140.

§ 19. Lapse of time does not, *per se*, constitute abandonment. It may be a circumstance to be considered. The circumstances of the case, other than mere lapse of time, almost always give complexion to delay, and either excuse it or give it conclusive effect. *Andrews v. Carman*, 13 Blatch., 307.

§ 20. Mere forbearance to apply for a patent while the inventor is experimenting upon his invention, and perfecting it and testing its value, affords no ground for presuming that he has abandoned it. *Jones v. Sewall*, 3 Cliff., 563.

§ 21. Mere forbearance to apply for a patent during the process of experiments, and until the party has perfected his invention and tested its value by actual practice, affords no just grounds for any presumption of abandonment or dedication to the public. *Henry v. Frances-town Soap-Stone Stove Co.*, 9 O. G., 408.

§ 22. After invention perfected, long delay in applying for patent will not defeat the inventor's rights, it being clear from the attendant circumstances that there was no intention to abandon and no abandonment in fact of the invention. *Sprague v. Adriance*, 14 O. G., 308.

§ 23. Nor is it material to the right of protection that in the interval of delay other inventors have devised and patented the same thing, this being wholly without the knowledge or acquiescence of the first inventor. *Ibid.*

§ 24. Even if it were otherwise, and his conduct operated as an estoppel, whether his assignees, without notice, could be likewise concluded, *quære?* *Ibid.*

§ 25. Delay in filing an application is no ground for charging the inventor with abandonment if he was residing in the insurrectionary states during the war. *Knox v. Loweree*, 6 O. G., 802.

§ 26. Unavoidable delay while an application for a patent is pending is no ground for imputing abandonment. *Jones v. Sewall*, 3 Cliff., 563.

§ 27. The statute does not limit any time within which an inventor must apply for a patent, nor does it declare a forfeiture by reason of any delay. The delay, therefore, seems unimportant, unless it amounts to evidence of abandonment of the claim. Delay is not one of the specified grounds upon which the commissioner is authorized by the seventh section of the act of 1836 to refuse a patent. *Heath v. Hildreth*, 1 MacA. Pat. Cases, 12.

§ 28. Before a patent is granted to any one for an invention, there is no law that requires the inventor to disclose his invention within any limited time. There is no limitation of his right to obtain a patent, unless the lapse of time be sufficient to show an abandonment of the invention. *Perry v. Cornell*, 1 MacA. Pat. Cases, 68.

§ 29. Merely withholding an invention from the public can never amount to abandonment, however it may, if too long continued, increase the difficulties in the way of proving priority of invention over another inventor. It may raise up an equity in favor of the junior discoverer which will call for the fullest measure of proof on the part of the first inventor to dispel the cloud of distrust with which he has thereby enveloped his case, but of itself it cannot defeat his right. *Babcock v. Degener*, 1 MacA. Pat. Cases, 607.

§ 30. The inventor is allowed a reasonable time within which to mature his invention, according to the circumstances of the case, and his right can be affected by no lapse of time short of that which will be sufficient to show an abandonment of his claims, during which time no subsequent inventor, however original or *bona fide*, can deprive him of his priority. *Stephens v. Salisbury*, 1 MacA. Pat. Cases, 379.

§ 31. No particular time is limited for filing the application for the patent by the statute; yet it is very clear, according to a fair construction of its spirit and meaning, that it ought to be done within a reasonable time; otherwise the right may be lost by the laches of the party. What is or is not a reasonable time depends on the circumstances of each case. *Ellithorp v. Robertson*, 1 MacA. Pat. Cases, 585. See *Defenses*, § 1855.

Abandonment—Presumption as to— *A question of intention*, §§ 32-34. *Presumption is against*, §§ 35-38. *Will be presumed, when*, §§ 39, 40. *When not presumed*, § 41. See *Claim*, §§ 848-853.

§ 32. The question of abandonment is not one of intention, but of legal inference from the inventor's conduct, and affecting the interests of the public. *Pennock v. Dialogue*, 4 Wash., 538.

§ 33. Abandonment of an invention must result from the intent of the patentee expressly declared, or clearly indicated. *McMillin v. Barclay*, 5 Fish., 189.

§ 34. To prove abandonment there must be evidence of a distinct character showing such intent. The natural presumption is against the abandonment of an invention. *Hovey v. Henry*, 3 West. L. J., 153.

§ 35. Abandonment by inventor is rarely presumed. *Sayles v. Chicago & Northwestern R. Co.*, 1 Biss., 468.

§ 36. Forfeitures and abandonments are not favored. *Singer v. Braunsdorf*, 7 Blatch., 521.

§ 37. Proof of inventor's knowledge and acquiescence in the public use of his invention, in order to constitute abandonment, must be beyond all reasonable doubt, as every presumption is the other way. *Andrews v. Carman*, 13 Blatch., 307.

§ 38. Abandonment to the public need not be two years before date of application for patent; it may be afterward, although the presumption is always against abandonment to the public by patentee after he has applied for his patent. *American Hide & Leather Splitting Co. v. Tool Co.*, 1 Holmes, 503.

§ 39. If an applicant withdraws his application after it has been rejected, and takes no further steps for eighteen years, when he renews his application, and a patent for the improvement has in the meanwhile been granted to another, it is to be presumed that he acquiesced in the decision of the office, and has abandoned his invention. *Marsh v. Sayles*, 2 O. G., 340.

§ 40. The presumption is the same, whether the decision of the office was right or wrong; if wrong, he should have appealed or brought his bill in equity to correct the error. *Ibid.*

§ 41. No inference of the abandonment of an individual element made the subject of a distinct claim can arise from the mere fact that the specification states the invention to consist of its combination with another feature. *Henderson v. The Cleveland Co-operative Stove Co.*, 12 O. G., 4.

See *Burden of Proof*, § 660.

Abandonment — Evidence of — *What is*, §§ 42-47. *What is not*, §§ 48-54.

§ 42. It is competent for a patentee to abandon his patent by overt acts, by express dedication; and acquiescence in known public use, without objection, is strong presumptive evidence of the same. *Wyeth v. Stone*, 1 Story, 273.

§ 43. Forfeiture or abandonment may be inferred from the acts of an inventor who, without substantial reason or excuse, neglects the use of his invention and sleeps upon his rights for a number of years, while others in the meantime produce the same thing and give the public the benefit thereof; and the same is true whether the device be patented or had gone into use without a patent. *United States Rifle & Cartridge Co. v. Whitney Arms Co.*, 14 Blatch., 94.

§ 44. Neglect of original model of an invention, considered *inter alia*, as evidence of abandonment. *Consolidated Fruit Jar Co. v. Wright*, 4 Otto, 92.

§ 45. Testimony of inventor that he did not intend to abandon his invention, held to be entitled to small consideration, in view of his undisputed acts. *Bevin v. East Hampton Bell Co.*, 9 Blatch., 50.

§ 46. Abandonment after the issue of letters patent must be shown to be positive, actual and intentional by some act or declaration of the patentee, or by such gross laches as indicate an intention to relinquish the invention to the public. *Johnsen v. Fassman*, 1 Woods, 138.

§ 47. Where a party has subsequently taken out a patent, evidence of abandonment prior thereto must be very clear and cogent to justify a court in adopting such a conclusion. *Wyeth v. Stone*, 1 Story, 273.

§ 48. The mere declaration of an intent to dedicate an invention to the public cannot be regarded as an equivalent to actual dedication, and the abandonment must be made out beyond all reasonable doubt. *Pitts v. Hall*, 2 Blatch., 229.

§ 49. Imperfect and crude descriptions of an invention imparted to others are no evidence of an intention to abandon it. *Locomotive Engine Safety Truck Co. v. The Pennsylvania R. Co.*, 6 O. G., 927.

§ 50. The putting of a device intended to perfect the working operation of a patented machine upon such machine, when sold, would not necessarily imply that the patentee intended to abandon the device to the public, or to put it in public use or on sale. *American Hide & Leather Splitting Co. v. Tool Co.*, 1 Holmes, 503.

§ 51. The filing of an application is conclusive evidence that at its date the inventor did not intend to give his invention to the public, but it is not conclusive evidence that he did not subsequently do so. *United States Rifle, etc., Co. v. Whitney Arms Co.*, 14 Blatch., 94.

§ 52. Issue of letters patent is *prima facie* evidence that there has been no abandonment either before or after application. *Johnsen v. Fassman*, 1 Woods, 138.

§ 53. The granting of a patent is *prima facie* but not conclusive evidence that the right to the invention has not been surrendered to the public, and the same is true in regard to abandonment upon renewed applications which were made under the thirty-fifth section of the act of 1870. *United States Rifle & Cartridge Co. v. Whitney Arms Co.*, 14 Blatch., 94.

§ 54. Held that where nine years intervened between application for patent and appeal, during four of which applicant was a citizen of a state in rebellion, it was not sufficient evidence of abandonment to invalidate the patent. *Johnsen v. Fassman*, 1 Woods, 138.

See *License*, § 4025.

Abandonment—Under the statute—*Act of 1839, §§ 55-60. Generally, §§ 61-65. See Use, §§ 6378-6606.*

§ 55. Under the seventh section of the act of 1839 the commissioner is authorized to reject an application upon proof that the invention has been abandoned to the public. *Wickersham v. Singer*, 1 MacA. Pat. Cases, 645.

§ 56. It seems that such conduct and the acquiescence in the sale of the machines is a bar also, upon the principles of patent law, upon the ground of abandonment. The case does not fall within the exception of section 7 of the act of 1839, since the sales were not made by the applicant nor by those claiming under him. *Carroll v. Gambrill*, 1 MacA. Pat. Cases, 581.

§ 57. The mere fact of making and selling or public use of his invention by the inventor, more than two years prior to application, do not constitute abandonment under act 1839, without acts on his part indicating an intention to abandon. *McCormick v. Seymour*, 2 Blatch., 240.

§ 58. Under act 1839 it is an abandonment of the invention if the patentee either sells or uses a machine, or puts one in public use, more than two years prior to his application. *Ibid.*

§ 59. Under act 1839, has no effect to invalidate a patent unless there be proof of the use of the invention more than two years prior to the application for patent, and that use with the knowledge and allowance of the inventor. *Andrews v. Carman*, 13 Blatch., 307.

§ 60. Under section 7 of the act of March 3, 1839 (5 U. S. Stats. at Large, 354), no patent is invalidated by abandonment or public use unless there is proof of actual abandonment or of a use of the invention with the knowledge and allowance of the inventor more than two years prior to his application for a patent. *Andrews v. Cross*, 19 Blatch., 294.

§ 61. Under the statute a single instance of sale or use by the patentee for more than two years prior to his application for patent may be fatal to the patent. *Consolidated Fruit Jar Co. v. Wright*, 4 Otto, 92.

§ 62. An inventor who makes no secret of his invention, but declares his purpose of obtaining a patent for it, and, being in no situation to engage in the manufacture, endeavors to sell it, and who, when he learns that another is making and selling it, asserts his right, and within a reasonable time applies for a patent, is not estopped from obtaining one and maintaining it because his application was not made for nearly two years. Neither is his prior right cut off because in the meanwhile another has obtained a knowledge of the invention, and has placed it on sale, although the latter believed himself to be the true and first inventor. *Russell & Erwin Manufacturing Co. v. Mallory*, 10 Blatch., 140.

§ 63. Public use for less than two years prior to application will not work an abandonment. *Heinrich v. Luther*, 6 McL., 345.

§ 64. A mere agreement to transfer an invention for the joint use of the inventor and of those who advance means for working it, which was entered into more than two years before the patent was applied for, but was not consummated till within that time, will not affect the validity of the patent. *Elm City Co. v. Wooster*, 4 O. G., 83.

§ 65. The question raised, but not decided, whether distinct and separable devices in use for more than two years prior to application for patent, not co-operating with the other devices, might not be forfeited, although the other devices were invented within the two years, and though all the devices were applicable to parts of the same machine, so that they were properly joined in a single patent. *Wade v. Metcalf*, 16 Fed. Rep., 130.

See *Acquiescence*, § 140. *Caveat*, § 671. *Estoppel*, § 2250. *License*, § 4006.

Abandonment—Pleading, §§ 66-68.

§ 66. The question of abandonment can only be brought before the court by amendment of the bill. *Wilson v. Stolley*, 4 McL., 275.

§ 67. When abandonment is relied upon by defendant he should raise the point in his answer; otherwise evidence concerning abandonment will be inadmissible. *Wyeth v. Stone*, 1 Story, 273.

§ 68. A naked averment in the bill that the complainant did not abandon his claim is not sufficient to rebut the presumption. *Marsh v. Sayles*, 2 O. G., 340.

See *Jury*, § 3973. *Plea*, §§ 4800, 4806. *Use*, § 6573.

Abandonment—Particular cases—Not abandoned, §§ 69-83. Held abandoned, §§ 84-92.

§ 69. While an inventor has an application for a patent pending in the patent office, and presses it from time to time, as his means allow, he cannot be charged with having abandoned his improvement, although nine years elapse before he succeeds. *Goodyear Dental Vulcanite Co. v. Smith*, 1 Holmes, 354.

§ 70. A single license granted by patentee, after filing his first application, to his brother and to complainant, on which he received royalty, but which was never exercised except to a very limited extent, held insufficient to support the defense of abandonment, although the first application was rejected and the patent only granted on a second application made nine years later. *Jones v. Sewall*, 3 Cliff., 563.

§ 71. Where an application filed in 1856 was only patented in 1867, but the patentee showed great diligence in prosecuting it by frequent actions in the patent office, it was held that the invention was not abandoned by delay. *McMillin v. Barclay*, 5 Fish., 189.

§ 72. A patent held valid, although granted upon an application rejected August 23, 1866, when no further steps were taken upon it till May 1, 1869, it not appearing that the invention had gone into market for two years previous to the last date, or that the patentee had any knowledge of its having gone into public use. *Clark v. Scott*, 9 Blatch., 301.

§ 73. Where the inventor of an improvement upon a patented machine could neither make an arrangement with the owners of the patent to adopt it, nor use it without infringing the patent, nor induce others to take it up, and was poor, he was held not to have lost his right in it, although he delayed applying for a patent until another person had made the improvement and obtained a patent for it. *Webster v. New Brunswick Carpet Co.*, 5 O. G., 522.

§ 74. A patent issued June 7, 1864, upon an application filed April 7, 1864, sustained upon evidence of the applicant's poverty and efforts, although he had filed a previous application for the same invention May 14, 1852, and it had been twice rejected in 1855, and by the commissioner in 1856, and a rehearing had been refused in 1859, and although the invention had gone into public use in 1860. *Goodyear Dental Vulcanite Co. v. Root*, 6 O. G., 154.

§ 75. A patentee cannot be charged with having abandoned his invention because his solicitors, without his knowledge, neglected to file his application in the patent office for more than two years after it had been sworn to, and was in all respects complete. *Birdsell v. McDonald*; *Birdsell v. The Ashland Machine Co.*, 6 C. G., 682.

§ 76. Where an application was filed in 1850, rejected, withdrawn, several times renewed, and finally allowed and patented in 1869, *held*, that patentee's date of invention was that of the filing of the original application, and that there was no abandonment in fact or in intent in the interval between the application and its allowance. *Howard v. Christy*, 10 O. G., 981.

§ 77. Where the inventor made application in 1848 for a patent, and it was rejected, and subsequently withdrawn by an attorney not empowered to do so; and, on seeking to press it, he was advised by counsel that it was impossible, and then waited until the action of congress allowed of its reconsideration, the patent being granted in 1873, and the general adoption of his invention having taken place when he had no means to enforce his rights, *held*, that it was not abandoned. *Woodbury Patent Planing Machine Co. v. Keith*, 4 B. & A., 100. See § 9.

§ 78. It not appearing that the complainant was guilty of laches in applying for a patent, or that *his improvement* ever went into public use or was on sale in this country before he applied for a patent, the patent was held to be valid. *Parks v. Booth*, 12 Otto, 96.

§ 79. In the absence of knowledge by the patentee of the infringement there was no abandonment of his patent. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 Fed. Rep., 638.

§ 80. Where, subsequent to an adverse decision on interference, and repeated rejections by the examiner, applicant divided his application, on one division of which a patent was granted, while he diligently prosecuted his appeal on the other division, *held*, that under such circumstances no intention to abandon the claims asserted in the bill on the pending divisional application could be inferred from his having meanwhile applied for and taken out the patent on the other division. *Butler v. Shaw*, 21 Fed. Rep., 321.

§ 81. Where the application for patent was on file when the prior patent to the same inventor was granted, *held*, that the description in the prior patent would not affect the validity of the subsequent patent. *Railway Register Mfg. Co. v. Broadway & 7th Ave. R. R. Co.*, 22 Fed. Rep., 665.

§ 82. Where four claims of an applicant had been rejected solely on the ground of their subject-matter being described, though not claimed in a patent granted to the same party prior to the filing of their application, and prior public use to bar the patent was denied on oath and was not shown, *held*, that applicant was entitled to his patent. *Vermont Farm Machine Co. v. Marble*, Commissioner, 27 O. G., 621.

§ 83. Continued poverty, sickness and mental alienation held sufficient excuses for delay in procuring a patent. Abandonment to public held not shown. *Celluloid Mfg. Co. v. Crofut*, 33 O. G., 235.

§ 84. When an applicant, in interference with a patent issued to an original and independent inventor, four years before his application was filed, based his claim to priority on a drawing made eleven years before, and it did not appear that he had in the meantime taken any steps to perfect his invention or bring it into notice, the only explanation offered for the delay being

that he had supposed — erroneously, as it appears — that his original drawing of the invention was lost. *held*, that by his laches he had lost his inchoate right to a patent. *Ellithorp v. Robertson*, 1 MacA. Pat. Cases, 585.

§ 85. Where the application for patent was made nine years after the perfecting of the invention, it was held such laches as was conclusive evidence of abandonment. *Rowley v. Mason*, 2 Am. L. T. R. (U. S.), 106.

§ 86. An invention allowed to lie unused for five years must be held abandoned. *Carleton v. Atwood*, 2 Am. L. T. R. (U. S.), 129.

§ 87. Where the subject-matter of the application was shown and described in a patent granted applicant less than two years prior to the date of his application, but not claimed therein, *held*, that it was against the spirit of the law to grant him a patent. *Marvin v. Lillie*, 27 O. G., 299.

§ 88. It would seem that where there was an interval of eight years between the application and grant of a patent and the invention went into public use, there was such want of diligence as to invalidate the patent. *Goodyear v. Hills*, 3 Fish., 134.

§ 89. An invention held to have been abandoned to the public when the author, after having reduced it to perfection and actual practice, took no further measures with it for nine years and suffered the molds to be lost, and meanwhile others, independently of him, reduced it to practice and introduced it extensively into market. *Consolidated Fruit Jar Co. v. Wright*, 12 Blatch., 149.

§ 90. It is not necessary that the latter should obtain a patent; it is enough if they have reduced the invention to practice, and it has gone into use. *Ibid.*

§ 91. The first inventor does not lose his right in such a case in consequence of the mere lapse of time, but because the circumstances indicate an intention of abandonment and because the rights of others have intervened. *Ibid.*

§ 92. Where the inventor made public the knowledge and use of his invention, and then for four years remained wholly silent and took no action for the procurement of a patent, *held*, that the causes which led to such silence were not as material as the facts themselves, and the invention was held abandoned. *Andrews v. Hovey*, 16 Fed. Rep., 387.

Abandonment — In general — Defined, § 93. *What constitutes*, §§ 94-97. *Description unaccompanied by claim is not*, §§ 98-100; *contra*, §§ 101, 102. *Disuse is not*, § 103. *Cannot be resumed*, §§ 104-108. *Is a question of fact*, § 109. *Grant of license as an estoppel*, § 110. *Act 1793*, § 111. *May be made in less than two years prior to application*, § 112. *Abandoned invention is not patentable*, § 113. *As evidence of a perfected invention*, § 114.

§ 93. The true meaning of the word abandonment, as used in the acts of congress relating to patents, is an abandonment of the invention to the public — a dedication of his discovery to the free use of his fellow-beings. It is, as said by Judge Story, “like the dedication of a public way or other easement, and is to be proved in the same manner by evidence of some acts inconsistent with the retention of the exclusive property himself; and in this regard his acts are to be construed liberally.” *Babcock v. Degener*, 1 MacA. Pat. Cases, 607.

§ 94. An inventor who makes his discovery public, and acquiesces in its public use, whether the article was made by a particular individual or not, has abandoned his inchoate right and is not entitled to a patent. *Pennock v. Dialogue*, 4 Wash., 538.

§ 95. An inventor may abandon his invention by acquiescence in its use, prior to the application for patent, but he is entitled to time necessary to experiment and test its completeness. *Kendall v. Winsor*, 21 How., 322.

§ 96. Where a party, having made an invention, allows the public to use it with his knowledge and consent, not for mere purposes of experiment, but for profit and gain, it is an abandonment. *American Hide & Leather Splitting Co. v. Tool Co.*, 1 Holmes, 503.

§ 97. If the invention was used by others, or even one person, with consent and allowance of inventor, publicly, and for more than two years prior to application for patent, or if it was publicly used for a long period by the inventor himself, not in the way of experiment, but for gain, in either case the patent is void. *Bell v. Daniels*, 1 Bond, 212.

§ 98. A description of a machine in the original patent, unaccompanied by a claim, is not a dedication to the public. *Battin v. Taggart*, 17 How., 74.

§ 99. *Semble*, that the mere fact that a new article is shown in the drawings of a patent for a machine would not of itself be an abandonment of the new article, which would properly be the subject of a different patent, until the statutory forfeiture of use for two years had been incurred. *Hatch v. Moffitt*, 15 Fed. Rep., 252.

§ 100. There is no warrant for the suggestion “that what is described and shown in the original specification and drawings is necessarily to be regarded as so dedicated to the public

that, if not claimed in the original, it cannot be claimed in the reissue." *Selden v. Stockwell Self-Lighting Gas Burner Co.*, 19 Blatch., 544.

§ 101. The omission by an inventor to claim a combination or device apparent upon the face of his patent amounts to a dedication of the neglected contrivance to the uses of the public. *Swift v. Jenks*, 19 Fed. Rep., 641.

§ 102. The claim of a specific device or combination in a patent, and the omission to claim other devices or combinations apparent on its face, are in law a dedication to the public of that which is not claimed. *Hill v. Commissioner of Patents*, 33 O. G., 757.

See *Claims*, §§ 848-853. *Combination*, § 966. *Patents*, §§ 4702-4712, 4726. *Reissues*, § 5326.

§ 103. Disuse of a patented invention is no abandonment. *Gray v. James*, Pet. C. C., 394.

§ 104. An inventor may abandon his invention to the public, and cannot then resume his inchoate right. Whether he has done so is generally a question of fact. *Pennock v. Dialogue*, 2 Pet., 1.

§ 105. If an inventor dedicates his invention to the public he cannot afterwards resume or claim an exclusive right in it. *Mellus v. Silsbee*, 4 Mason, 108.

§ 106. An abandonment of a perfected machine, no matter for what reason, cannot be recalled. *Rowley v. Mason*, 2 Am. L. T. R. (U. S.), 106.

§ 107. Where an invention has, through the acts of the inventor, gone into public use beyond his control, his right to it is forfeited beyond recall. *Jones v. Sewall*, 3 Cliff., 563.

§ 108. An inventor who, by his acts and consent, shows that he has made a dedication of his invention to the public, cannot afterwards disavow it and obtain a patent. This abandonment may be as well after as before the grant of the patent; but where the patent has been actually granted, it would require a strong case to prove it. *Bell v. Daniels*, 1 Bond, 212.

§ 109. Abandonment is a question of fact, to be liberally construed; acts consistent with the clear intent not to abandon will not work an abandonment. *Mellus v. Silsbee*, 4 Mason, 108.

§ 110. Inventor is not estopped from denying abandonment, on the ground of having licensed a few persons to try its utility. *Ibid.*

§ 111. Act 1793, "abandonment," considered. *Shaw v. Cooper*, 7 Pet., 292.

§ 112. There may be an abandonment by the inventor at any time, even within the two years before application for his patent (act 1839); but the mere use or sale of the invention within the time limited by the act, unaccompanied by declarations or acts to establish the intent, will not work one. *Pitts v. Hall*, 2 Blatch., 229.

§ 113. If the original inventor of a machine abandons the use of it and does not take out a patent for it, no other person can entitle himself to a patent for it, except in the case of a lost art. *Rich v. Lippincott*, 2 Fish., 1.

§ 114. Abandonment of an invention considered as evidence of its having been perfected or not. *Hayden v. Suffolk Mfg. Co.*, 4 Fish., 86.

See *Commissioner*, §§ 1092-1094. *Interference*, § 3466. *Invention, Joinder of*, § 3674.

2. ABOUT.

§ 115. "About" — meaning of in specification. *Davis v. Palmer*, 2 Brock., 298.

§ 116. The word "about," used in connection with a certain number of hours, held to indicate that the time is not to be considered as precisely specified. *Sewall v. Jones*, 1 Otto, 171.

3. ACCIDENT, INADVERTENCE OR MISTAKE, REISSUES FOR.

See REISSUES, ACCIDENT, INADVERTENCE OR MISTAKE, CONSTRUCTION OF STATUTES.

4. ACCOUNTING.

See DAMAGES AND PROFITS, §§ 1433-1707. JURISDICTION, §§ 3305-3313. MASTER'S REPORT, §§ 4164-4186.

Accounting — Apportionment of expenses, §§ 117-119.

§ 117. Where, in accounting for infringement, the profits of the several branches of business are to be separately stated, the general expenses of the business for the whole year held properly taken and apportioned among such several branches. *Brady v. Atlantic Works*, 15 O. G., 965.

§ 118. Apportionment of general expenses in account of profits for sale of an infringing article, how and in what proportions made. *Hitchcock v. Tremaine*, 9 Blatch., 385.

§ 119. In an account of profits derived by defendant dealing in the infringing article, *held*, that such a proportionate part of general expenses, such as clerk and store hire, should be assigned to the infringing article, as its sales bore to the sales of other articles in the shop. *Ibid*.

Accounting—Date to which it is brought down, §§ 120-124.

§ 120. On taking account of profits for infringement before a master, it should be brought down to the time of hearing before the master, if the infringement has been continued up to such date. *Tatham v. Lowber*, 4 Blatch., 86.

§ 121. Where, during pendency of suit, patentee has transferred all his interest, account of profits must terminate with such date of assignment. *Wheeler v. McCormick*, 11 Blatch., 334.

§ 122. The account should be extended to the time of the taking, including the profits resulting from the use of the invention, whether by means of the particular machine in use at the time of the commencement of the suit, or of others subsequently constructed and used. *Knox v. Great Western Q. M. Co.*, 6 Saw., 430.

§ 123. On statement of account to ascertain profits for infringement, *held* that the master had a right, in the absence of a statement by defendant, to assume that they manufactured during a period involved in the account, at the same rate as during the rest of the year. *Herring v. Gage*, 15 Blatch., 124.

§ 124. In taking an account of damages for an infringement of a patent, the master is not limited to the date of the decree, but may extend the account to the time of the hearing before him. *Rubber Co. v. Goodyear*, 9 Wall., 788.

See *Infringement*, § 2831.

Accounting—In general—Act 1870, § 125. Discretion of court of equity in granting, § 126. Right to, §§ 127-129. Practice, §§ 130-133. Question to be determined, §§ 134-137. Particular cases, §§ 138, 139.

§ 125. The act of 1870 (R. S., sec. 4921) provides for the accounting for damages as well as profits. *Andrews v. Creegan*, 19 Blatch., 113.

§ 126. Courts of equity will exercise a sound discretion in matters of account, when there are obstacles to a relief at law and when a discovery may be needed. *Blank v. Manufacturing Co.*, 3 Wall. Jr., 196.

§ 127. In order to maintain a suit in equity for an accounting of profits, there must be actual profits resulting to the infringer susceptible of computation or estimation, of which the patentee could be deprived, and with which the infringer can be charged as trustee. If from the character of the invention there can be nothing in the nature of profits of which the patentee can be deprived, there is no basis for charging the infringer with receiving profits for his benefit, and nothing for which he can be called upon to account. *Vaughn v. C. P. R. R. Co.*, 4 Saw., 280.

§ 128. Where a bill is brought for discovery in a case which is not the proper subject of an action or bill for account, the fact that the plaintiff is entitled to a discovery does not necessarily entitle him also to an account. *Magic Ruffle Co. v. Elm City Co.*, 14 Blatch., 109.

§ 129. The fact that plaintiff's device was used raises a presumption that there were, or might have been, some profits, and he is entitled to have the account taken. *Andrews v. Creegan*, 19 Blatch., 113.

See *Jurisdiction*, § 3876.

§ 130. Practice on taking account for infringement before a master. *Tatham v. Lowber*, 4 Blatch., 86.

§ 131. No general rule can be announced to govern the master in taking account of damages and profits. *La Baw v. Hawkins*, 2 B. & A., 561.

§ 132. The disclosure of gains and profits is an incident of an accounting under a decree in favor of the plaintiff in a suit in equity on a patent. *Gordon v. Anthony*, 16 Blatch., 234.

§ 133. Under an order to account for monthly manufactures and sales of safes *held*, it was not necessary to give names of purchasers, and it was sufficient to state the dimensions of the safes and not the prices at which they were sold. *Wilder v. Gayler*, 1 Blatch., 511.

See *Answer*, § 230. *Practice on Reference to Master*, §§ 4899-4904.

§ 134. In settling an account between a patentee and an infringer, the real inquiry is, What is the advantage which the infringer has derived from his use of the invention? If he has derived a profit attributable directly to the employment of the invention, that profit belongs to the patentee and is the measure of his recovery. *Herring v. Gage*, 15 Blatch., 124.

§ 135. In settling an account for infringement, the question is not what profits the infringer has made in his business, or from his manner of conducting it, but what advantage he has derived from the use of the infringed invention. *Cawood Patent*, 4 Otto, 695.

§ 136. Where only one of several claims has been infringed, the question for the master to settle is the advantage derived from the use of that particular part over what the infringer had in using other machines then open to the public. He may not infer that the advantage enjoyed on a simple claim is equal to that on the entire machine. *Fischer v. Hayes*, 22 Fed. Rep., 529.

§ 137. For the purposes of an account of profits, the comparison of the invention should be made with other machines in existence, or known, and open to public use at the time of the infringement complained of, and not with machines subsequently invented, or for the first time constructed or known, or machines not open to public use. *Knox v. Great Western Q. M. Co.*, 6 Saw., 430.

§ 138. An injunction having issued against the defendants because of their manufacture of rings, a motion for an attachment against them for the manufacture of *terrets, buckles and hooks* was denied; but the master, notwithstanding, was instructed to state a separate account of such trimmings, with a view to a reconsideration of the questions involved upon the hearing of the exceptions to the report. *Welling v. Rubber Coated Harness-Trimming Co.*, 7 O. G., 608.

See *Process*, §§ 5041-5045.

§ 139. Where defendant admitted the infringement, but pleaded lunacy at the time of the infringement, a perpetual injunction on account of the profit obtained by defendant, as also costs in favor of plaintiff, were decreed; and *held* that the past maintenance of the lunatic could not be considered in accounting for damages. *Avery v. Wilson*, 20 Fed. Rep., 856.

See *Appeal*, §§ 246, 247. *Costs*, §§ 1414-1416. *Injunction*, § 3313. *Practice*, §§ 4886, 4887.

5. ACQUIESCENCE.

As ground for Preliminary Injunction, see INJUNCTION, PRELIMINARY, ACQUIESCENCE, §§ 3025-3033.

In public use, an abandonment, § 140. *Presumption as to*, §§ 141-143. *Delay in bringing suit is not*, §§ 144, 145. *Must be proved affirmatively*, § 146. *Evidence of*, §§ 147-149.

§ 140. Acquiescence in the public use is an abandonment of the invention and the patent. *Whittemore v. Cutter*, 1 Gall., 478.

§ 141. A knowledge of, and acquiescence in, the public use and sale of the invention by another may be presumed from the circumstances of the case, as where the application of the subsequent inventor for a patent and his commercial use of that invention were matters of notoriety in the locality where the first inventor resided. *Savary v. Lauth*, 1 MacA. Pat. Cases, 691.

§ 142. It is to be presumed that when a party has used publicly and notoriously, for any considerable length of time, a patent, claiming exclusive right to it, the public have acquiesced in that claim; and against a man who comes to infringe it and to contest the rights of the plaintiff, there arises a presumption in consequence of that user, which is a very strong one; but previous user is not an absolute and indispensable element in granting an injunction. *American Middlings Purifier Co. v. Christian*, 4 Dill., 448.

§ 143. Where there is no adverse interest to the patent, no person who would be desirous of using it, whether patented or not, presumption of acquiescence will not arise from non-user, to strengthen the exclusive right thereto. *Grover & Baker Sewing Machine Co. v. Williams*, 2 Fish., 133.

§ 144. A plaintiff is not to be charged with acquiescence in defendant's infringement, because he proceeded first against the more palpable violation, or because he has not brought suit against all the infringing machines. *Van Hook v. Pendleton*, 1 Blatch., 187.

§ 145. The owner of a patent is not to be charged with acquiescence in an infringement because he withheld suit during the pendency of other suits to determine his rights under the patent. *Green v. French*, 16 O. G., 215.

§ 146. Where a party has several patents, he must prove affirmatively acquiescence in the particular patent sued on, and it is not sufficient to show an acquiescence which may have arisen under one, two or all. *Grover & Baker Sewing Machine Co. v. Williams*, 2 Fish., 133.

§ 147. Where the reissued patent is for matter not claimed in the original, acquiescence in the latter is no evidence of acquiescence in the former. *Ibid.*

§ 148. It is not evidence of general acquiescence in a patent right that others abstained from manufacturing the patented invention, where the parties owning the exclusive right neither licensed nor offered to grant licenses to others. *Ibid.*

§ 149. A decree adjudicating the validity of a patent, obtained in suits against infringers to which the defendant was not a party or privy, is not competent as evidence of acquiescence in his patent, on a trial on the merits. *Matthews v. Iron Clad Mfg. Co.*, 19 Fed. Rep., 321.

See *Defenses*, §§ 1831-1833. *Delay*, §§ 1861-1900. *Estoppel*, §§ 2251-2256. *Infringement*, § 2903.

6. ACTING COMMISSIONER.

See COMMISSIONER, ACTING.

7. ACTUAL DAMAGES.

See DAMAGES, ACTUAL.

8. ADDITION TO COMBINATION, INFRINGEMENT BY.

See COMBINATION, INFRINGEMENT OF, BY ADDITION TO.

9. ADDITIONAL IMPROVEMENT.

§ 150. Act 1837, § 8, "additional improvement," considered. *Carver v. Braintree Mfg. Co.*, 2 Story, 432.

§ 151. Issue of patents for additional improvements, on surrender and cancellation of original patents. *Taney's Opinion*, 2 Op., 455.

10. ADMINISTRATOR.

See ASSIGNMENT BY ADMINISTRATOR, DISCLAIMER, §§ 2005, 2063. EXTENSION, §§ 2454-2458. LEGAL REPRESENTATIVES, §§ 3979-3981. REISSUES, § 5383. TITLE, §§ 6311, 6312.

Administrator — In general, §§ 152, 153. Foreign, §§ 154, 155.

§ 152. An administrator to whom a patent has been granted for the invention of his intestate may bring suit for infringement in another state without taking out letters of administration in such state. *Goodyear v. Hullihen*, 2 Hughes, 492.

§ 153. Where an administrator undertook to sell certain patented articles in violation of the plaintiff's right, *held*, that he did not thereby bind the estate, and that no action could be maintained against him as administrator. *Thompson v. Canterbury*, 2 McC., 332.

See *Decree*, § 1796.

§ 154. A patent granted to the administrator of an inventor is held by him, *prima facie*, in trust for the heirs; and they must be made parties to a suit in equity on the patent so long as they retain such an interest. But if the inventor had sold his interest prior to his decease, the assignee must be made the party, and not the heirs. *N. W. Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 6 O. G., 34. (a)

§ 155. The grantee of a right under letters patent can sue in a circuit which forms part of a certain state, although he derives his title from a foreign administrator. *Smith v. Mercer*, 4 West. L. J., 49.

11. ADMISSIONS.

In Application, see CLAIMS. ESTOPPEL, §§ 2213-2217. DISCLAIMER, §§ 2020-2065. INTERFERENCE, § 3436. In Patent, Estoppel by, see ESTOPPEL BY ADMISSIONS IN PATENT.

Admissions — In pleading, §§ 156-161.

§ 156. The admissions of an answer as to infringements cannot be retracted. *Jones v. Morehead*, 1 Wall., 155.

§ 157. Where respondents in their answer admitted infringement, but claimed to be owners of the extended term, and by cross-bill sought to enjoin complainants; and subsequently obtained leave to withdraw the answer and cross-bill and to file an answer denying the original-

(a) See history of this case, *Ransome, Ex parte*, Commissioners' Decisions, 1870, p. 143, in which it appears that the question was that of a foreign administrator, although not apparent in the suit in equity.

ity and validity of the patent, *held*, that by answer and cross-bill under oath, as well as by their action, they had admitted the originality of the patent, in spite of the denial in the subsequent answer. *Livingston v. Jones*, 1 Fish., 521.

§ 158. Where plaintiff alleges in his bill that defendant uses a certain machine, which he describes, and defendant does not disprove or deny, it is an admission that he uses such a machine. *Ely v. Monson & Brimfield Mfg. Co.*, 4 Fish., 64.

§ 159. Where defendants in their answer failed to deny their alleged use of complainant's invention, which he had a right to treat as a confession of its use, but impliedly admitted it by their mode of answering, complainant was not required to make any further proof of infringement. *Jordan v. Wallace*, 5 Fish., 185.

§ 160. The defendants, having denied that they used the ingredients specified in the proportions or in the mode described in the patent, and having averred that the compositions made and sold by them were substantially and materially different from those claimed, were held not to have admitted the charge of infringement, although they admitted that they had used the same ingredients; and there being no evidence to contradict their denial, the complainants' bill was dismissed. *Francis & Loutrel v. Mellor*, 1 O. G., 48.

§ 161. The corporate character of a corporation complainant being averred under oath in the bill of complaint, and the same not being denied in the answer, but simply proof thereof being called for, *held*, that the fact of incorporation was in effect admitted by the pleadings. *Stover v. Halsted*, 13 Blatch., 95.

See *Demurrer*, §§ 1901-1909.

Admissions — Generally, §§ 162-169.

§ 162. Acts and admissions of parties to a deed subsequent to its execution are legitimate to show the meaning they then attached to terms used in the deed. *Goodyear v. Cary*, 4 Blatch., 271.

§ 163. A verbal admission of infringement, made against one's interest, makes a strong case for the grant of an injunction. *Morse Fountain Pen Co. v. Esterbrook Pen Mfg. Co.*, 3 Fish., 515.

§ 164. Declarations and admissions of a (patentee) assignor of a patent interest who had parted with it, held inadmissible to impeach the patent, although he held a reserved shop-right. *Many v. Jagger*, 1 Blatch., 372.

§ 165. In selling by license under another, there is a recognition, or admission of title in that other, not to be contravened lightly between the parties. *Wilder v. Adams*, 2 W. & M., 329.

§ 166. Where defendants, licensees of plaintiff, stamped their articles as made under plaintiff's patent, it was held a public acknowledgment that they were so made, although they had, at or after the agreement granting the license, protested that it should not be so construed. *Jones v. Vankirk*, 2 Fish., 586.

§ 167. Where the suit was in fact defended by one who had accepted a license under plaintiff's patent, *held*, that his admissions and conduct became important and convincing evidence of the novelty of the invention, and affidavits as to prior use, made by an employee of such licensee, were held disproved thereby. *Lockwood v. Hooper*, 25 Fed. Rep., 910.

§ 168. The admissions of a party to an interference, made before the controversy arose, to the effect that his opponent was the inventor, taken as conclusive evidence against his right to the patent. *Clarke v. Cramer*, 1 MacA. Pat. Cases, 473.

§ 169. In a case where admissions are made to induce others to act upon them, such admissions do not operate merely as presumptive evidence of the actual truth of the facts, which must give way to positive proof of the contrary, but precludes and, as it were, estops the party on grounds of policy. *Carroll v. Gambrill*, 1 MacA. Pat. Cases, 581.

See *Declaration of Inventor*, §§ 2273-2277.

12. AFFIDAVITS.

§ 170. Certifying of affidavits by a notary public under the act of congress. What is sufficient. *Goodyear v. Hullihen*, 2 Hughes, 492.

§ 171. In a suit for infringing a patent no weight will be given to an affidavit of the defendant that he is informed and believes that the patented article had been in use before the plaintiff invented it. *Young v. Lippman*, 9 Blatch., 277.

§ 172. Affidavits in support of a motion for a preliminary injunction will be received, although they were taken before the bill was filed, which constitutes the commencement of the suit; but they should not be entitled in the suit, it not being commenced when they were made. *Baldwin v. Bernard*, 9 Blatch., 509.

§ 173. An affidavit in support of a motion to open a case to admit other defenses, which sets forth no particular facts constituting the defenses desired to be brought forward, and no reason why they have not been brought forward in the usual manner, if they exist, except that the case was not attended to by either the defendants or their solicitor, is wholly insufficient. *Day v. Schwab*, 2 Fed. Rep., 544.

§ 174. Affidavits not entitled in the cause are merely extrajudicial oaths, and perjury could not be assigned on them; therefore they are not receivable in court. *Buerk v. Imhaeuser*, 14 Blatch., 19.

§ 175. *Ex parte* affidavits and sworn opinions of experts as to novelty and infringement, contradicted by evidence of equally low grade, are not sufficient to establish the extent or validity of complainants' patent or its infringement. *Pullman v. Baltimore & Ohio R. Co.*, 4 Hughes, 236.

§ 176. *Ex parte* affidavits taken without notice to the other side are not admissible in evidence. *Lilienthal v. Washburn*, 8 Fed. Rep., 707.

§ 177. An affidavit in support of a motion for a rehearing is not sufficient if it merely states that the party "made every effort to obtain the testimony (rebutting), but was not aware that he could do so," without stating what efforts were made, or that he visited any of the places mentioned, or saw any of the persons named in the testimony sought to be rebutted. *Barker v. Stowe*, 16 O. G., 807.

§ 178. Where an affidavit was filed by counsel on a collateral matter, showing an informality in taking the testimony in the case, and where the facts concerning the alleged informality were stated by the magistrate in his return and noticed by the commissioner, *held*, that it should be considered. *Nichols v. Harris*, 1 MacA. Pat. Cases, 302.

§ 179. An affidavit relating to the merits of a case not laid before the commissioner cannot be considered by the judge on appeal. *Ibid*.

§ 180. Affidavits not taken by the authority of the commissioner, nor acted upon by him in forming his decision, cannot be considered by the court upon appeal. *In re Jackson*, 1 MacA. Pat. Cases, 485.

13. AGENTS.

Generally, §§ 181-183. *Liability for infringement*, §§ 184-187. *Agent and principal*, §§ 188-190. *Pleading*, §§ 191-194.

§ 181. General rule as to agents in actions of tort. Distinctions taken and cases cited. *Lightner v. Kimball*, 1 Low., 211.

§ 182. Responsibility of a principal for a trespass committed by his agent. *Lightner v. Brooks*, 2 Cliff., 287.

§ 183. A servant or agent, being sued separately, is not bound by an adjudication in a former suit against his principal upon the question of the validity of the patent. *Hayes v. Bickelhaupt*, 32 O. G., 136.

See *Assignment*, § 466.

§ 184. A special agent of a corporation for the purpose of contracting for the delivery of a certain patented article is not liable for an infringing use of the article by the company. *Lightner v. Brooks*, 2 Cliff., 287.

§ 185. Where the general agent of a transportation company transported, under contract, rolling stock having the infringing device, but over the selection or equipment of which he had no control, *held*, that he was a mere stranger to the infringement, and not liable therefor. *Lightner v. Kimball*, 1 Low., 211.

§ 186. Where the assignee of a railroad corporation used a patent invention for the use of which the corporation held a license, *held*, that he was but the agent of the corporation and not liable for infringement. *Emigh v. Chamberlain*, 1 Biss., 367.

§ 187. *Quære*, whether or not an agent who sells the patented articles of another at the direction of his principal is liable for infringement. *Morse v. Davis*, 5 Blatch., 40.

§ 188. Where a contract was construed to empower agent to terminate a suit, *held*, that his settlement for an infringement was binding without the institution of any suit. *Burdell v. Denig*, 2 Fish., 588.

§ 189. Where it was expressly agreed between patentee and the head of a department that the latter had no authority to purchase or use the patented right, but that patentee was to allow its use so long as he saw fit, leaving the matter of remuneration exclusively to the will and action of congress, *held*, that the case was that of an agent who, at the request of the inventor, had tried and used the invention, subject to the ratification of his principal. In this case, congress not having ratified it, no action lay. *Shavor's Case*, 4 Ct. Cl., 440.

§ 190. Where an agent employed to sell a patent right for a certain territory purchased the right from his principal for a certain sum, on the ground that it was all it would bring, concealing the fact that he had already sold part of the territory at the price paid by him for the whole; and then sold several other county rights, and the principal filed a bill to set aside the sale and charge the agent as trustee for an account, *held*, that the principal was entitled to have the sale annulled, and the unsold part of the territory reconveyed; that he was entitled to an account for the entire amount sold, and was not bound to accept a reconveyance of the territory sold and then re-acquired by agent in anticipation of a decree against him, and that the agreement in the contract of agency did not control the commissions on the sales made by agent after acquiring his principal's right. *Jeffries v. Wiester*, 2 Saw., 135.

§ 191. The commission made by an agent on the sales of infringing articles being independent of the profits made by his employers, he cannot set up in bar to a suit for such commissions the existence of a like suit against his employers. *Steiger v. Heidelberger*, 18 Blatch., 426.

§ 192. Where an agency was pleaded as a ground of defense to an infringement, the plea was held bad for failure to disclose the name of the principal. *Morse v. Davis*, 5 Blatch., 40.

§ 193. In a suit for infringement and accounting, the fact that defendant is only an agent of parties also sued in another court for a like infringement, and that he obtains his commission merely for making sales, the profits going to his employers, is no answer to such suit, and a plea setting forth such facts must be overruled. *Steiger v. Heidelberger*, 18 Blatch., 426.

§ 194. A bill for the infringement of a patent, praying for an injunction and an accounting, will lie against a commission agent, although a suit under a similar bill is pending in another district against the parties for whom said commission agent is acting. *Ibid.*

See *Contracts*, § 1317. *Infringer*, § 2981.

14. AGGREGATION.

Mere aggregation is not patentable, §§ 195-206.

§ 195. The mere addition of an old device producing a specific result, to another old device producing its own result, in such wise that their combination produces those same two results, and no other, is not invention. *Hailes v. Van Wormer*, 7 Blatch., 443.

§ 196. A mere aggregation of old parts, without any new result issuing from their united action, is not patentable. *Hoffman v. Young*, 2 Fed. Rep., 74.

§ 197. A mere aggregation of parts, to none of which the patentee has an exclusive right, and where they have no new operation and produce no new result which is due to the combination, is not patentable. *Sarven v. Hall*, 9 Blatch., 524.

§ 198. In an aggregation as distinguished from patentable combination, the aggregate result may be the production of a better structure, as an aggregate, than was ever before produced, and yet, for the lack of novelty of device or new result, produced by the aggregation and due thereto, it may have no patentable quality. *Reckendorfer v. Faber*, 12 Blatch., 68.

§ 199. A mere aggregation of old things is not patentable, and in the sense of the patent law is not a combination. *Wood v. Packer*, 17 Fed. Rep., 650.

§ 200. A patent for a combination composed of a mere aggregation of parts which have no common function is void for want of invention. *Double Pointed Tack Co. v. Two Rivers Manufacturing Co.*, 9 Biss., 258.

§ 201. There is no patentable combination in an aggregation of devices which have no common purpose or effect, concurrent or successive. *Tower v. Bemis & Call Hardware & Tool Co.*, 19 Fed. Rep., 498.

§ 202. An aggregation of devices, each of which is old, so that each may work out its own effect, without the production of something novel arising from the co-operation of the devices, is not a new result. *Metropolitan Wringing Machine Co. v. Young*, 14 Blatch., 46.

§ 203. The several parts of a machine or device may combine in producing a result and yet not constitute a patentable combination, but only a mere aggregation. *Webster Loom Co. v. Higgins*, 15 Blatch., 447.

§ 204. The mere aggregation of two things is not a patentable combination. *Alcott v. Young*, 16 Blatch., 134.

§ 205. There is no patentable combination in a mere aggregation of old devices which produce no new effect or result due to their concurrent or successive joint and co-operating action; but it is by no means essential to a patentable combination, that the several devices or elements thereof should co-act upon each other. It is sufficient if all the devices co-operate with respect to the work to be done and in furtherance thereof, although each device may perform its own particular function only. *Stutz v. Armstrong*, 20 Fed. Rep., 843.

§ 206. The adoption and application of a ribbed fish-plate, with the bolt screwed to its place between the ribs, for joining the ends of railroad rails, *held*, in view of state of art, to be an aggregation of two old devices without attaining any new result. *Ex parte Fisher*, 20 O. G., 957.

See *Combination*, §§ 866-872, 881, 924, 934-935, 945, 963, 967. *Invention*, § 3625. *Patentability*, §§ 4558, 4620.

15. AGREEMENT, ESTOPPEL BY.

See ESTOPPEL BY AGREEMENT.

16. ALIEN PATENTEE.

§ 207. Acts 1793 and 1800, "rights of alien patentee," considered. *Shaw v. Cooper*, 7 Pet., 292.

§ 208. Act 1800, § 1, rights of alien to patent, reviewed. *Morris v. Huntington*, 1 Paine, 348.

§ 209. Act 1836, § 15, alien "patentee," assignees of, construed. *Tatham v. Lowber*, 2 Blatch., 47.

See *Assignee*, § 554. *Burden of Proof*, § 661. *Defenses*, § 1834.

17. ALTERNATIVE CLAIMS.

See CLAIMS, ALTERNATIVE.

18. ALTERNATIVE INJUNCTION.

See INJUNCTION, ALTERNATIVE.

19. AMBIGUITY.

See CLAIM, AMBIGUOUS. SPECIFICATION, AMBIGUOUS. CONSTRUCTION OF PATENTS, AMBIGUITY.

20. AMENDMENT.

To Application, see APPLICATION, AMENDMENT TO. To Answer, Motion for, see ANSWER, MOTION TO AMEND. To Bill, see BILL, MOTION TO AMEND. To Claim, see CLAIM, AMENDMENT TO. Generally, see PRACTICE, §§ 4832, 4883.

21. ANNULING PATENTS.

See REPEAL OF PATENTS.

22. ANSWER.

Answer — Generally, §§ 210-216.

§ 210. Where an answer had been put in, in the names of three defendants, as their joint and several answer, but was signed and sworn to by two only, defendants were allowed to take it from the files to erase the name of the one, and file it as their own answer. *Bailey Washing & Wringing Machine Co. v. Young*, 12 Blatch., 199.

§ 211. Where defendants, in their answer, made all the defenses usual in a patent suit, and also set out a copy of a release praying for the benefit of the same, as if pleaded in bar, held that, as a substantive defense not responsive to the bill, it was not subject to exception. *Adams v. Bridgewater Iron Co.*, 6 Fed. Rep., 179.

§ 212. In a suit upon a reissued patent it seems to be sufficient, in order to put in issue the lawfulness of the enlargement of claims and the scope of the original, to allege in the answer to the bill of complaint that the original patent was not surrendered because inoperative or invalid by reason of claiming too much, and that in the reissue the claims have been broadened, so as to cover more than the patentee had a right to claim as new. *Searles v. Bouton*, 12 Fed. Rep., 874.

§ 213. Where the bill alleged that defendants had used the process claimed, etc., and the answer expressly denied that they had practiced the invention claimed, an exception thereto on the ground of insufficiency was overruled. *Miller v. Buchanan*, 18 O. G., 1532.

§ 214. Where an answer under oath is not waived in the bill, the answer, so far as responsive to the bill, directly denying the matters alleged, not only makes an issue, but proves it, and must be overthrown by the testimony of two witnesses, or of one and circumstances equivalent to another. *Slessinger v. Buckingham*, 17 Fed. Rep., 454.

§ 215. An answer in equity is required for discovery and evidence, as well as for grounds of defense; and evidence cannot be given by attorney. Therefore an answer so made is wholly irregular. *Wooster v. Muser*, 20 Fed. Rep., 162.

§ 216. But as the orator did not move to have the answer taken off the file for the irregularity, nor to have the bill taken *pro confesso* for want of an answer, nor except to the answer for insufficiency, by replying to it he admitted it to be sufficient, however imperfect it might be. *Ibid.*

See *Abandonment*, § 67.

Answer — Motion to amend — *When allowed*, §§ 217-221. *When refused*, §§ 222-231. *Motion does not let in inadmissible testimony*, § 232; *and is addressed to the discretion of the court*, § 233.

§ 217. Where application was made during the term in which the bill was filed, to amend the answer by denying the validity of the patent, there being no laches, and the application being made as soon as the fact was discovered and before taking testimony, and being consistent with the answer as filed, it was allowed, on payment of costs. *Morehead v. Jones*, 3 Wall. Jr., 306.

§ 218. If it should appear that, as to prior use not set up in the answer, testimony clearly establishes the invalidity of the patent, the court might grant the respondents leave to amend. *Geier v. Goetinger*, 7 O. G., 563.

219. On motion made before final argument, leave was given to amend the answer so as to set up the new defense of public use and sale. Interlocutory decree entered in accordance with the findings of the court, with leave to take testimony relating strictly to the new defense in event the amended answer was filed within a time limited. *Snow v. Tapley*, 13 O. G., 548.

§ 220. Where the bill has been brought, answered, and tried upon the theory that a recovery upon certain assigned claims for damages was sought, the assignee of the patent, in an action against an infringer, was allowed on motion, prior to signing of an interlocutory decree, to amend his bill to include the subject of such claims due to mesne assignors. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 20 Fed. Rep., 505.

§ 221. Where the original bill set up only the first reissue of a patent that had been twice reissued, but the proofs, both for final hearing and before the master on the accounting, had reference to the second reissue, as also the proceedings upon the master's report, an order of court directing that the record be amended by inserting in the bill an averment of the second reissue was properly made, even after the final decree. *Tremolo Patent*, 23 Wall., 518.

§ 222. Where a new defense to a patent proposed to be set up as an amendment in the answer was of such nature that a search made before the hearing would have developed it, *held*, that it did not show reasonable diligence; and the new defense depending further wholly on parol evidence, the motion to amend was denied. *India Rubber Comb Co. v. Phelps*, 8 Blatch., 85.

§ 223. Where defendants in their answer admitted infringement, but justified under claim of ownership of patent, and decree was for plaintiff, and after reference and final report based on the admission of infringement — the litigation having been protracted for several years — and more than one year after decree, defendants moved to amend answer so as to contest the question of infringement, the motion was denied for want of due diligence. *Ruggles v. Eddy*, 11 Blatch., 524.

§ 224. Relevancy of new matter not established. Moreover with reasonable diligence it might have been set up in the original answer. *Richardson v. Croft*, 20 O. G., 372.

§ 225. Where, on motion to amend answer, it was not shown that the new matter could not, with reasonable diligence, have been set up in the answer, the motion was denied. *Ibid.*

§ 226. Where, on motion to amend answer, defendants failed to show satisfactorily that the new matter was relevant or material to the case on the question of novelty, the motion was denied. *Ibid.*

§ 227. In a proceeding in equity where the answer to the bill is filed and sworn to by defendants, and replication filed by complainants, and proofs taken and closed upon the issues raised, *held*, that a motion to amend answer by interposing one or more new defenses will be denied. *Webster Loom Co. v. Higgins*, 13 Blatch., 349.

§ 228. Motion for an amendment of answer and commission to take testimony abroad, to prove who is the original inventor of a patented invention, will not be allowed, where plaintiff's affidavit shows there is no prospect that such evidence can be had. *Hicks v. Otto*, 17 Fed. Rep., 539.

§ 229. A defendant was refused permission to amend his answer in order to deny the validity of the patent, where it had been sustained in a prior suit between the parties, and there was no surprise, and there was also a prior agreement admitting its validity. *Pentlarge v. Beeston*, 15 Blatch., 347.

§ 230. Where, after reference to master, a motion was made to amend the answer, on the ground that it contained no denial of the manufacture of the infringing article, it was refused, as defendant could have the benefit of such defense before the master. *Evory v. Candee*, 5 B. & A., 67.

§ 231. An amendment which changes the character of a bill ought not, generally, to be allowed after a case has been set for a hearing, and still less after it has been heard. The answer might become inapplicable if such an amendment were permitted. *Tremolo Patent*, 23 Wall., 518.

§ 232. Where evidence of anticipations not set up in the answer has been taken, and a motion afterward made to amend the answer, the granting of such motion would not make that evidence admissible which was taken under objection before the amendment. *Allis v. Buckstaff*, 22 O. G., 1705.

§ 233. But it is discretionary with the court in such a case, especially after the objecting party has fully cross-examined the witnesses and taken rebutting proofs, either to let the testimony stand in the case or to strike it out and permit the defense to take the testimony anew under the amended answer. *Ibid.*

23. ANTEDATING PATENTS.

§ 234. Antedating of one of two patents relating to the same machine, in order that both should correspond in date, held illegal. *Wirt's Opinion*, 5 Op., 722.

§ 235. Where the patent was issued under the act of 1861, and antedated under act of 1836, held that plaintiff could recover profits from the time of antedating of the patent. *Burdett v. Estey*, 19 Blatch., 1.

§ 236. Under the thirteenth section of the act of 1836, relating to the reissuing of invalid and defective patents, the commissioner has no power to alter the date of a previously granted antedated patent. *In re Cushman*, 1 MacA. Pat. Cases, 577.

See *Process*, § 5059. *Term*, § 6257.

24. APPEAL.

Appeal — Generally — *Bill of exceptions*, § 237. *Supersedeas*, §§ 238-241. *Court is limited to the record*, § 242. *Assignment of errors*, § 243. *Decree as to costs*, § 244.

§ 237. Motions to allow bills of exception, where the damages are less than \$2,000, should generally be allowed, subject to the sound discretion of the court, where the points in issue involve the construction of the patent law itself. *Allen v. Blunt*, 2 W. & M., 121.

§ 238. If an appeal from a circuit court to the supreme court does not operate as a *supersedeas*, security will usually be required of the appellant to only double the amount of costs that the appellee may recover. *American Nicholson Pavement Co. v. Elizabeth City*, 6 O. G., 764.

§ 239. If it operates as a *supersedeas*, further security will be required to twice the value of what is to be recovered. *Ibid.*

§ 240. Where the matter in controversy is secured by other means, the rule will be modified at the discretion of the court. *Ibid.*

§ 241. The appeal, and bond given in pursuance thereof, do not vacate or suspend the order of injunction; they affect only the collection of the amount adjudged as damages and costs. *Whitney v. Mowry*, 2 Bond, 45.

§ 242. Appellate court cannot go outside of the record for evidence. *O'Reilly v. Morse*, 15 How., 62.

§ 243. On appeal, questions not involved in the assignment of errors will be passed over without examination. *Roemer v. Simon*, 5 Otto, 214.

§ 244. No appeal lies from a mere decree respecting costs and expenses. *Elastic Fabrics Co. v. Smith*, 10 Otto, 110.

See *Estoppel*, § 2193.

Appeal — In patent cases, §§ 245-247.

§ 245. Act 1836, § 17, appeal in patent cases, reviewed and construed. *Hogg v. Emerson*, 6 How., 437; *Allen v. Blunt*, 2 W. & M., 121.

§ 246. An appeal will not lie in patent cases which provide for reference to a master to state an account, until the coming in of his report. *Potter v. Mack*, 3 Fish., 428.

§ 247. Where the injunction prayed for in the court below was made perpetual, but there was a reference to a master to ascertain damages by reason of infringement, and the bill was not dismissed, nor was there a decree for costs, *held*, that there was no final decree from which only an appeal could lie. *Barnard v. Gibson*, 7 How., 650.

Appeal — From examiner, § 248.

§ 248. The question whether an appeal from the decision of the primary examiner, requiring a division of an application, should be heard by the examiners-in-chief or by the commissioner, is a matter of administrative discrimination, and is not within the control or supervision of the court, but belongs to the administrative part of the government. *United States ex rel. Gorton v. Butterworth*, Commissioner of Patents, 27 O. G., 717.

See *Mandamus*, § 4121.

Appeal — From commissioner — Evidence admissible, §§ 249-251.

§ 249. The judge, upon appeal, can consider only such evidence as was properly before the commissioner. *Perry v. Cornell*, 1 MacA. Pat. Cases, 68.

§ 250. Section 11 of the act of 1839, read in connection with sections 7 and 8 of the law of 1836, upon which it is engrafted, gives to the applicant, on appeal to the judge, the right to support his claim by, and to be heard upon, the evidence or facts deemed by him essential to a just decision, although not produced before the commissioner at the hearing before him. *In re Fultz*, 1 MacA. Pat. Cases, 178.

§ 251. The restrictive part of the section, confining the judge in his decision to "the evidence adduced before the commissioner," applies to the merits of the case. *Ibid*.

Appeal — From commissioner — Limit of appeal, §§ 252-259. Reasons of appeal, §§ 260-272.

§ 252. The commissioner may, in his discretion, enlarge the limit of appeal from his decision; and his act in that regard is not reviewable by the judge upon appeal, although he so extended the time upon the suggestion or order of the secretary of the interior. If he should refuse to comply with such a request of the secretary, a question might then arise for the court to decide. *Justice v. Jones*, 1 MacA. Pat. Cases, 635.

§ 253. The power to enlarge the time for filing the reasons of appeal, and to rehear the case, remains with the commissioner not only until the patent issues, but until it is actually delivered, after which his power over the case is exhausted. *Greenough v. Clarke*, 1 MacA. Pat. Cases, 173.

§ 254. When the appeal in other respects had pursued its regular course, but it appeared that the "reasons of appeal" were filed a few days after the expiration of the limit of appeal, it was assumed by the judge that the commissioner, in the exercise of his discretion, had enlarged the limit of appeal. *Blackiston v. Douglas*, 1 MacA. Pat. Cases, 622.

§ 255. On receiving notice from the party of his intention to appeal, it becomes the duty of the commissioner, and his exclusively, to fix a reasonable time for filing the reasons, within which time all further action upon the application within the office is to be suspended, and within which time the reasons of appeal must be filed, unless for good cause shown the commissioner directs the time to be enlarged. *Greenough v. Clarke*, 1 MacA. Pat. Cases, 173.

§ 256. When the commissioner has fixed no time within which the party may appeal, an appeal may be taken at any time. *Carter v. Carter*, 1 MacA. Pat. Cases, 388.

§ 257. After the expiration of the time set by the commissioner, under authority of section 11, act of 1839, for filing the reasons of appeal, the right of appeal is gone; nor will the pendency of a motion to rehear the case of itself enlarge the time for filing the reasons of appeal without a special order by the commissioner to that effect. *Greenough v. Clarke*, 1 MacA. Pat. Cases, 173.

§ 258. No appeal from the decision of the commissioner can be considered unless the reasons of appeal were filed within the specified time. *Ibid*.

§ 259. *Semble*, that the applicant might still appeal from the decision of the former commissioner, there being in the act no limitation of time as to the appeal. *In re Janney*, 1 MacA. Pat. Cases, 86.

§ 260. The judge, in hearing and determining appeals from the commissioner of patents, under the eleventh section of the act of 1839, is authorized to revise the decisions of the com-

missioner only in respect to the points involved in the reasons of appeal. If the commissioner did not err in those points his decision must be affirmed, although the judge should be of opinion, upon the whole case, that the patent ought to have been granted. *Arnold v. Bishop*, 1 MacA. Pat. Cases, 36.

§ 261. No assignment of error can be regarded as sufficiently specific which does not point out the precise matter of alleged error with reasonable certainty. *Blackiston v. Douglas*, 1 MacA. Pat. Cases, 622.

§ 262. Where an application is rejected for lack of novelty, assignments of error that the "decision was in opposition to a clear apprehension of the merits of the case," and "inconsistent with the precedents," are too vague and indefinite. *In re Winslow*, 1 MacA. Pat. Cases, 123.

§ 263. A reason of appeal, "that the decision rejecting the application was against the evidence and the weight of evidence," is entirely too vague and indefinite to be considered within the provisions of the eleventh section of the act of 1839 as a substantive reason of appeal, "specifically set forth in writing." *Blackiston v. Douglas*, 1 MacA. Pat. Cases, 622.

§ 264. No reason of appeal can be regarded as valid which would not justify the commissioner in refusing the patent. *Matthews v. Wade*, 1 MacA. Pat. Cases, 143.

§ 265. The filing of the reasons of appeal is a proceeding in the office over which the judge has no control. If the commissioner has received and filed the reasons of appeal, the judge cannot order him to strike them out. They must be heard and decided; and when brought before him on appeal, if they are not valid, he will overrule them. *Ibid.*

§ 266. The refusal of the commissioner to receive as evidence certain certificates of manufacturers and others, not having been assigned as error in the reasons of appeal, cannot be considered as such by the judge upon appeal. *Jillson v. Winsor*, 1 MacA. Pat. Cases, 136.

§ 267. The reasons of appeal must show that the decision of the commissioner was wrong, and not merely that he was mistaken in his reasoning. *In re Crooker*, 1 MacA. Pat. Cases, 134.

§ 268. An objection to the opinion of the commissioner in regard to the sufficiency of a reference is not a good reason of appeal. Whatever may have been his opinion, his decision may have been correct. *Ibid.*

§ 269. The insufficiency of the commissioner's reasons is not of itself evidence that his decision was wrong, and is not, therefore, a good "reason of appeal." *In re Aiken*, 1 MacA. Pat. Cases, 130.

§ 270. It is immaterial what reasons the commissioner assigns for his decision. His reasons may be insufficient, and yet the decision may be correct. Such insufficient reasons are no ground for revising his decision. *In re Aiken*, 1 MacA. Pat. Cases, 126.

§ 271. The refusal by one commissioner to rehear a case decided by his predecessor is not a ground of appeal to the judge. The acts of 1836 and 1839 only give an appeal from the refusal of the commissioner to issue a patent. *In re Janney*, 1 MacA. Pat. Cases, 86.

§ 272. If the commissioner refuse to admit competent and material evidence offered by the applicant, the applicant may assign such refusal as a reason of appeal, and the commissioner, in stating the grounds of his decision, is bound fully to answer such reason and the judge to decide it, and the judge may then make an order directing the evidence to be admitted and the case to be reheard by the commissioner. *In re Fultz*, 1 MacA. Pat. Cases, 178.

Appeal—From commissioner—To secretary of interior, §§ 273-279.

§ 273. Where on an interference the commissioner, having finally adjudicated that one of the parties was entitled to a patent, refused to issue it on the sole ground of a pending appeal to the secretary of the interior, who subsequently reversed the commissioner's decision, *held*, that the appellate proceedings and reversal by the secretary in the case at hand were unauthorized, and therefore a nullity; and that consequently the commissioner of patents, having finally adjudicated that the relators are entitled to a patent, improperly refuses to issue the same and *ordered* that the writ of peremptory *mandamus* shall issue. *United States ex rel. Hoe & Co. v. Butterworth*, Comm'r of Patents, 27 O. G., 519.

§ 274. When the commissioner of patents stands in this court upon the ground that his decision in favor of an applicant's right to a patent is permanent, a legal duty to proceed to the next step consequent upon such permanent decision must arise, and a failure or refusal to so proceed presents the very evil which the writ of *mandamus* is designed to cure. *Ibid.*

§ 275. When it appears by the commissioner's return that he refused to prepare a patent out of deference to the action of the secretary of the interior in entertaining an appeal from and reversing his decision, that act of deference does not constitute an exercise by him of discretion as to his own executive functions, in such a sense as would cause the writ of *mandamus* to be an interference with executive discretion. *Ibid.*

§ 276. In this proceeding for *mandamus* the inquiry is, whether the title of the petitioner has been so adjudicated already that he is entitled to the fruit of that adjudication by the performance of a merely ministerial duty. The remedy provided by section 4915, R. S., is not an adequate remedy in such case. *Ibid.*

§ 277. The provisions of the statute giving the secretary power of directing is general, and the provisions relating to the duties and powers of the commissioner are specific. It is the latter which must control. When the sections of the statutes are considered together, it must be held that the commissioner must perform his duties under the direction of the secretary, except when he is already directed by the superior directory power of the legislature. *Ibid.*

§ 278. Applying the above rule of construction to the commissioner's decisions in cases of interference, *held*, that they are not subject to the directory power of the secretary, either by contemporaneous dictation or by appeal and reversal described as direction. *Ibid.*

§ 279. It appearing that what was intended to be a complete system of remedies by appeal from the decisions of the commissioner has been provided by the same statute which provides for the directory power of the secretary, *held* that, in the absence of any express provision for appeal to the secretary, an inferential right of appeal is excluded. *Ibid.*

See *Secretary of Interior*, §§ 5985-5994.

Appeal — From commissioner — To judge of circuit court of District of Columbia, in interferences, §§ 280-293.

§ 280. In an interference proceeding a patentee has no right of appeal from an adverse decision of the commissioner. *Bowen v. Herriet*, 1 MacA. Pat. Cases, 310.

§ 281. In an interference between an applicant and a patentee no appeal can be taken to the judge by the patentee from a decision of the commissioner favorable to the applicant. *Pomeroy v. Connison*, 1 MacA. Pat. Cases, 40.

§ 282. There is no section or clause of either of the acts relating to patents which gives a patentee a right of appeal from the decision of the commissioner granting a patent to another person, unless that right be given by the eighth section of the act of 1836 relating to interferences. *Ibid.*

§ 283. An appeal in an interference by a patentee from a decision of the commissioner, not referring or rejecting, but granting, the application, dismissed for want of jurisdiction or authority. *Whipple v. Benton*, 1 MacA. Pat. Cases, 332.

§ 284. The judge has no jurisdiction in case of an appeal taken by a patentee from a decision of the commissioner, not refusing or rejecting, but granting, the application for letters patent. *Hopkin v. Barnum*, 1 MacA. Pat. Cases, 334.

§ 285. In the case stated in the eighth section of the act of 1836 the judge is only to determine "which, or whether either, of the *applicants* is entitled to receive a patent as prayed for." These words qualify the general language of the first part of the section giving to either party the right to appeal, and restrict the right of appeal to the case where patents have been refused as prayed for. *Pomeroy v. Connison*, 1 MacA. Pat. Cases, 40.

§ 286. The judge can only act in a case when there are contending applicants for a patent, and those applicants must have prayed for a patent. A patentee has already obtained all he asked for, and he cannot appeal from a decision adverse to himself but favorable to the applicant contestant. *King v. Gedney*, 1 MacA. Pat. Cases, 443.

§ 287. The judge has no jurisdiction to hear and determine any appeal on behalf of a patentee from a decision of the commissioner in favor of an interfering applicant. *Drake v. Cunningham*, 1 MacA. Pat. Cases, 378.

§ 288. Where a patentee involved in interference filed a new application for merely substitute or equivalent means for carrying the invention disclosed in his patent into effect, and this application was also included in the interference, *held*, that he had no independent *status* as an applicant, and that an appeal by him from the adverse decision of the commissioner was virtually an appeal by a patentee. *Bowen v. Herriet*, 1 MacA. Pat. Cases, 310.

§ 289. An appeal will lie to the judge from the decision of the commissioner refusing a patent to all of the applicants involved in an interference although he did not award priority to either. The appeal is from the refusal to grant the patent. *Carter v. Carter*, 1 MacA. Pat. Cases, 388.

§ 290. Under the eighth section of the act of 1836 a patentee has equal right of appeal from a decision of the commissioner in favor of an applicant to one of the judges of the circuit court of the District of Columbia that an applicant for a patent has under the same section from an adverse decision in favor of a prior patentee. *Babcock v. Degener*, 1 MacA. Pat. Cases, 607.

§ 291. Both cases being applications for patents, or pending applications (sec. 4904, R. S.), the court declined to review the question of interference between the inventions of the parties. That rests in the judicial discretion of the commissioner, which having been exercised, no appeal lies under the statute. *Ex parte Gower*, 15 O. G., 828.

§ 292. From the decision of the commissioner of patents upon an interference, no appeal lies to the supreme court of the District of Columbia, and the only remedy is by bill in equity in a circuit court of the United States. *Butler v. Shaw*, 21 Fed. Rep., 321.

§ 293. The time for filing the reasons of appeal having expired, pending a motion before the commissioner to rehear the case, the motion having been denied and a patent issued to the successful party, the right of appeal is lost. *Greenough v. Clarke*, 1 MacA. Pat. Cases, 173.

See *Jurisdiction*, §§ 3818-3826.

Appeal — From commissioner — Generally, §§ 294-312.

§ 294. Review of statutes relating to appeals from the commissioner of patents to the judges of the courts of the District of Columbia. Hoar's Opinion, 13 Op., 79.

§ 295. Parties should be left to the provisions of the patent law, providing for appeal from the commissioner's decision. Hoar's Opinion, 13 Op., 28.

§ 296. The law providing an appeal to the appellate judge has reference to the contents of a patent, and not to a controversy between parties as to who owns it, where the patent has been granted. *Whitely v. Fisher*, 4 Fish., 248.

§ 297. Where the right of appeal from the commissioner to the chief judge of the circuit court of the District of Columbia was extended by a subsequent act to lie to either of the assistant judges also, *held*, that an order of the commissioner, requiring, on account of the infirmity of the chief judge, that appeals be admitted only to the assistant judges, is illegal and inoperative. Cushing's Opinion, 6 Op., 38.

§ 298. If an applicant considers a case important enough, he may refuse to take a limited patent, and, being then rejected, may apply to the supreme court of the District of Columbia, and, if still dissatisfied, he has his remedy in equity by section 4915, Revised Statutes. Here remedies are ample, and they are exclusive under the decisions. *New York Belting & Packing Co. v. Sibley*, 15 Fed. Rep., 386.

§ 299. In determining an appeal from the commissioner of patents, the supreme court of the District of Columbia will look only into the reasons of appeal, and into the records and proceedings in the case which are applicable to those reasons. (OLIN, Asst. J., dissenting.) *Conklin & Stafford*, 1 MacArth., 375.

§ 300. No reply to the grounds of the commissioner's decision can be admitted before the judge upon appeal, nor can such reply be filed in the patent office to be recorded with the proceedings. *In re Aiken*, 1 MacA. Pat. Cases, 130.

§ 301. Where a reissue has transpired to the party patentee, and an assignment from him to assignee, without its being recorded, assignee has no right to demand a patent to himself, and on such a demand the action of the commissioner in refusing is not the subject of an appeal to a judge. *Whitely v. Fisher*, 4 Fish., 248.

§ 302. Where appellants from the decision of the commissioner of patents assigned for reasons that the commissioner erred in holding that the invention had been abandoned, the court will not affirm the decision on the ground that the appellants have not shown that the omission which they are seeking to have corrected by a reissue arose through inadvertence, accident or mistake. (OLIN, J., dissenting.) *Conklin & Stafford*, 1 MacArth., 375.

§ 303. The general object of giving an appeal from the decision of the commissioner is to correct his errors in refusing to grant patents for which otherwise there would be no remedy. His error in granting a patent may be corrected by the ordinary tribunals of the country when it is made a subject of litigation, and there is no need of a special tribunal for that purpose. *Pomeroy v. Connison*, 1 MacA. Pat. Cases, 40.

§ 304. Features of novelty and utility not embraced in the claims, and brought out for the first time upon the argument before the judge, can have little influence in the determination of the questions before him. *In re Bishop*, 1 MacA. Pat. Cases, 519.

§ 305. In the decision of such a reason of appeal, the depositions and testimony may be considered to determine their relevancy, materiality and competency. *In re Fultz*, 1 MacA. Pat. Cases, 178.

§ 306. The practicability and usefulness of the invention, and the reducing of it to practice, are matters for the consideration and within the discretion of the commissioner, and cannot be made the subject of appeal. Nothing preliminary to the issuing of the patent is a valid ground of appeal, unless made so by the law. *Mathews v. Wade*, 1 MacA. Pat. Cases, 143.

§ 307. The filing of the reasons of appeal is essentially the appeal itself. The judge cannot take cognizance of a case until the aggrieved party presents to him his petition for a revision on appeal, which petition, according to the law, must be predicated upon the reasons of appeal filed with the commissioner in due form. *Greenough v. Clarke*, 1 MacA. Pat. Cases, 173.

§ 308. Under the eleventh section of the act of 1839, the commissioner is bound to furnish to the court upon appeal his answer to the reasons of appeal in *ex parte* as well as in contested cases. *In re Henry*, 1 MacA. Pat. Cases, 467.

§ 309. In such a case, therefore, an appeal will lie to the judge from a decision of the commissioner granting a patent to each of the applicants for the matter claimed by him although he has not in terms refused a patent. (His granting a patent to both parties substantially refuses a patent to one of them as prayed for?) *King v. Gedney*, 1 MacA. Pat. Cases, 443.

§ 310. After the commissioner has laid before the judge the papers and evidence in the case, together with the grounds of his decision, the case is no longer before the commissioner. Nothing further can be done in the case in the patent office until the decision of the judge and his proceedings shall be certified to the commissioner. *In re Aiken*, 1 MacA. Pat. Cases, 130.

§ 311. If, therefore, a party has been denied the privilege of submitting proper proofs of his invention, it is the duty of the judge, by reasonable regulations similar to those directed by section 12, to pursue such a course as to afford an opportunity to the party to produce and lay before him on the trial his proof to support his claim. *In re Fultz*, 1 MacA. Pat. Cases, 178.

§ 312. When the commissioner's answer virtually abandoned the reference originally referred to, and relied upon references then for the first time presented, the decision overruled and case remanded. *In re Jewett & Root*, 1 MacA. Pat. Cases, 259.

See *Jurisdiction*, §§ 3818-3826. *Secretary of Interior*, § 5988. Jurisdiction of Judge of Circuit Court of District of Columbia, see *Jurisdiction*.

25. APPEARANCE.

See PRACTICE, APPEARANCE

26. APPLICATIONS.

Diligence in Prosecuting, see DELAY. Interfering, see INTERFERENCE IN PATENT OFFICE.

Application — Abandoned — *Act of 1836*, § 313; *of 1861*, § 314; *of 1870*, §§ 315, 316. *Revised Statutes*, §§ 317, 318. *Proof of*, § 319. *Will not defeat subsequent patent*, §§ 320-322. *Particular cases*, 323-327.

§ 313. Under act 1836, section 7, an invention described in an application, afterwards withdrawn, is no bar to a further patent therefor; it bears only on the question of prior invention, and cannot of itself take the case out of the category of unsuccessful experiments. *Corn-planter Patents*, 23 Wall., 181.

§ 314. Under act of 1861 a delay of more than two years in completing an application is not conclusive as to the grant of the patent; the delay may be condoned by proof that it was unavoidable. *McMillin v. Barclay*, 5 Fish., 189.

§ 315. The second proviso of section 35 of the act of 1870 does not remove the objection to an application that the invention has been abandoned by neglect in prosecuting it. *Marsh v. Sayles*, 2 O. G., 340.

§ 316. The provisions of section 35 of the act of 1870, that, upon the hearing of the renewed applications therein referred to, abandonment should be considered as a question of fact, does not render delay of itself conclusive evidence of abandonment, but makes the decision of such cases depend upon the peculiar circumstances as a question of fact and not of law. *United States Rifle & Cartridge Co. v. Whitney Arms Co.*, 14 Blatch., 94.

§ 317. Section 4894, Revised Statutes, which provides that upon failure to prosecute an application within two years after action is had thereon by the patent office it shall be regarded as abandoned, refers to the application, not the invention, and does not prevent a subsequent application for the same invention. *Lindsay v. Stein*, 10 Fed. Rep., 907.

§ 318. But such second renewed application, when made, can derive no aid as to time from the prior abandoned application, and the applicant must stand as to defenses in suits on the patent as if the new application were the first application. *Ibid.*

§ 319. Proof of abandonment of an application depends upon intent and means to prosecute it. *Adams v. Edwards*, 1 Fish., 1.

§ 320. The abandonment of an application amounts to nothing unless it is in such wise as to become an abandonment of the invention to the public. *Clark v. Scott*, 9 Blatch., 301.

§ 321. An abandoned application held not admissible to show that patentee was not the original inventor of the thing patented. *Union Paper Bag Machine Co. v. Pultz & Walkley Co.*, 15 Blatch., 160.

§ 322. The doctrine announced in *The N. W. Fire Extinguisher Co. v. The Philadelphia Fire Extinguisher Co.*, 6 O. G., 34, and *The Lyman V. & R. Co. v. Lalor*, 12 Blatch., 303, that a withdrawn and abandoned application does not afford sufficient evidence of an invention to defeat a subsequent patent, reiterated and approved. *Lyman Ventilating & Refrigerating Co. v. Chamberlain*, 10 O. G., 588.

§ 323. Where an inventor withdrew his rejected application papers, leaving only a drawing and fee in the patent office, and ten years later applied for the same invention with new fee, etc., and without reference to the first application, and, on the rejection of the second application, he, four years later, again applied for a re-examination and got his patent, but in the intervening time had allowed his invention to go into public use without opposition on his part, *held*, that the first application was an abandoned application. *Bevin v. East Hampton Bell Co.*, 9 Blatch., 50.

§ 324. Cochran's application was filed January 11, 1859, withdrawn February 20, 1860, and not renewed until after a period of eight years had elapsed. He, in the meantime, made numerous other inventions of a kindred nature and obtained twenty-two patents thereon, constantly engaged in their development, and though poor, not thereby deterred from prosecuting his other inventions, and could have obtained a patent on this, or at least kept the application alive, had he so desired. Meanwhile the invention was patented by others, and finally introduced in 1867, a year before Cochran filed his second application. *Held*, that while the new petition did not of itself sever the second application from the first, his acts and conduct show that the proceeding had been abandoned, and there was no continuity in the two applications. *United States Rifle & Cartridge Co. v. Whitney Arms Co.*, 14 Blatch., 94.

§ 325. The case distinguished from *Smith v. Dental Vulcanite Company*, where the first application had never been withdrawn, and the inventor was unremitting in his endeavors to obtain a patent. *Ibid.*

§ 326. Where an application was made in 1861, which was improperly rejected, and which was not withdrawn until October, 1866, when it was withdrawn for the purpose of filing a new application for the same invention which was originally claimed, *held*, that no laches was attributable to applicant for this apparent delay after first rejection of his application, he being detained in England by a writ "*ne exeat*," and that he had neither abandoned his application nor his invention. *Weston v. White*, 13 Blatch., 448.

§ 327. Where an application was not amended until four years after its rejection, *held*, it was not abandoned, it appearing that applicant had been "generally incapacitated for business by mental disorder." *Ballard v. City of Pittsburgh*, 12 Fed. Rep., 783.

See *Continuing Application*. *Divisional Application*, § 350. *Delay*, §§ 1861-1873. *Invention*, §§ 3555, 3556.

Application — Amendment to — *Application is always open to amendment*, §§ 328, 329. *Scope of amendment*, § 330. *Permissible amendment*, § 331. *Invalid*, § 332.

§ 328. The specification of the application is always open to amendment of its description and claims and to the addition of new matters of description and new claims where the drawings and model exhibit the matters involved in the amendments and additions; and this privilege continues until the matter of the application is finally disposed of by grant of patent or otherwise. *Singer v. Braunsdorf*, 7 Blatch., 521.

§ 329. An inventor may amend or enlarge his claims from time to time before the issue of his patent in order to embrace everything which was specified at the start; and inventor's attorney is authorized to insert such amended claims without their being verified by the oath and signature of the patentee. *Railway Register Mfg. Co. v. North Hudson Railway Co.*, 33 O. G., 355.

See *Attorney*, § 574.

§ 330. The original application for a patent (with its accompanying drawings and model) filed by an inventor should possess great weight in showing what his invention really was, especially where it remains unchanged for a considerable period, and is afterward amended so as to have a broader scope. Amendments embracing any material variation from the original application — anything new not comprised in that — cannot be sustained on the original application, and should not be allowed; otherwise great injustice might be done to others who may have invented or used the same things in the meantime. *Railway Co. v. Sayles*, 7 Otto, 554.

§ 331. Where, in an application for patent, the entire specification before filed was erased, except the signatures, and in lieu thereof new specifications and claims inserted, not signed by the patentee nor attested by any witnesses, *held*, that there was no irregularity in the mode of procedure which would authorize that the patent be held void. *Railway Register Mfg. Co. v. North Hudson C. R. Co.*, 23 Fed. Rep., 593.

§ 332. An application made and sworn to June 26, 1868, by an inventor who died in February, 1870, amended November 7, 1871, by the introduction of the substantial part of the thing patented, by persons who had been his attorneys, unsupported by the oath of his personal representative, not a valid foundation for a patent. *Eagleton Manufacturing Co. v. West, Bradley & Cary Manufacturing Co.*, 18 Blatch., 218.

See *Construction of Patents*, § 1225. *Contracts*, § 1336.

Application — Continuing — *Act of 1839, § 333. Not affected by change in original, § 334. Is a question of fact, § 335. For the jury, § 336. Relates back to first application, §§ 337-341. Particular cases, §§ 342-349.*

§ 333. Under act 1839 the withdrawal of an application for patent, with the intention to file a new application, does not break the continuity of the claim. *Godfrey v. Eames*, 1 Wall., 317.

§ 334. A change in the specification as filed in the first instance, or the subsequent filing of a new one, whereby a patent is still sought for the substance of the invention as originally claimed, or part of it, cannot in any wise affect the continuity of the application under act 1836. *Ibid.*

§ 335. The continuity of the (first and subsequent) two applications is a question of fact to be determined in each case, upon an examination of its own circumstances. *Weston v. White*, 13 Blatch., 448.

§ 336. The question of the continuity of an application is for the jury. *Godfrey v. Eames*, 1 Wall., 317; *Howe v. Newton*, 2 Fish., 531.

§ 337. Where there is no abandonment of the first application, subsequent applications will relate back to it. *Adams v. Edwards*, 1 Fish., 1.

§ 338. The general rule is that the *first* in a series of applications for a patent is the one on which the patent, when granted, depends. *Pelton v. Waters*, 7 O. G., 425.

§ 339. If, between the first and a second application for a patent, the patentee has manifested an actual intention to abandon the first, his patent will have relation to the last one only. His actual intention severs the proceedings. *Ibid.*

§ 340. An invention will not be held forfeited in consequence of its having been on sale more than two years before the application was filed on which the patent issued, if within the two years the inventor had filed a previous application which described the invention, and was intended to cover it, although it was not specified in the claim in express terms. The second application will be considered a continuation of the first. *Smith v. O'Connor*, 2 Saw., 461.

§ 341. Where a second application is filed for a certain part of an invention disclosed in a prior application, the two applications will be regarded as a continuous proceeding, and public use of the invention, to defeat a patent granted upon such second application, must be shown to have occurred more than two years prior to the first application. *Graham v. McCormick*, 10 Biss., 39.

§ 342. Question of continuing application raised. *Rich v. Lippincott*, 2 Fish., 1.

§ 343. Where an application filed in 1856 was rejected and amended the same year, affidavits as to originality filed the following year, again rejected and appealed, the final application on which the patent was granted filed in 1858, the application not having been at any time withdrawn, or part of the fee refunded, it was held a continuing application; and held further, that patentees should not be held responsible for errors of the patent office which they could not prevent. *Blandy v. Griffeth*, 3 Fish., 609.

§ 344. Where an inventor made no new application until eight years after rejection, *held*, that it was a continuing application and no abandonment. *Goodyear Dental Vulcanite Co. v. Wetherbee*, 3 Cliff., 555.

§ 345. Cummings applied for a patent in April, 1855, and was rejected in 1856. He filed a new application in 1864, and the patent was then granted. The invention went into public use in 1859. *Held*, that where successive applications are made in the procurement of a patent, where there is no proof of actual abandonment, the subsequent application will be deemed a continuation of the first. *Goodyear Dental Vulcanite Co. v. Willis*, 1 Flip., 388.

§ 346. Where an application, drawing and model were filed in 1850, but not withdrawn on rejection, and in 1853 a second application identical with that of 1850, and so recognized by the patent office, was filed and a new fee paid, *held*, that the mere fact of making the second application could not be regarded as an abandonment of the first so as to work a constructive abandonment of the invention; that the patent issued on the 1853 application must be regarded as issued on that of 1850, and that a sale for more than two years prior to 1853 was not two years prior to the application, so as to work an abandonment. *Singer v. Braunsdorf*, 7 Blatch., 521.

§ 347. Simpson filed application papers for patent, but without model or the payment of the fee, in January and February, 1848, the invention involving the coating of a metallic wire with gutta-percha for electrical insulation. Thereafter another application for the invention was filed by him, in all respects complete (June, 1849), which was rejected by the examiner in October, 1849. January 21, 1851, Simpson, upon request made, received a refund of \$20, balance of fee, as allowed by law if a case be withdrawn after first rejection. In December, 1858, a new application was filed by Simpson, which was refused by the commissioner on appeal, February, 1859, and still another application, filed October 8, 1859, was finally rejected upon appeal to the circuit court for the District of Columbia, April 9, 1861. May 4, 1866, Simpson

filed the application upon which the patent issued. *Held*, upon the proofs, that, in spite of poverty and wrongful office action, Simpson had exercised exemplary diligence in seeking his patent; that in the long interval he had neither actually nor constructively abandoned the invention, and that as against adverse public use and priority claimants, he was entitled to be treated as a continuing applicant since January, 1848. *Colgate v. Western Union Tel. Co.*, 15 Blatch., 365.

§ 348. Howes and Throop filed their application January 27, 1855. It was rejected, and withdrawn by them June 11, 1856, for the purpose of filing a new application, which was prepared and sent to their attorney in April, 1857; but the latter failed to file it until February 26, 1858, and the patent was issued thereon March 16, 1858. *Held*, that there was, in judgment of law, a continuous application and no evidence of abandonment. *Howes v. McNeal*, 15 Blatch., 103.

§ 349. Where an application was withdrawn, but was instantly renewed in the same words, *held*, that there was a continuous application, and that the application would not be affected by a foreign patent taken out by a subsequent inventor intervening the first and second application. *Matthews v. Wade*, 1 MacA. Pat. Cases, 143.

See *Process and Product*, § 5110.

Application—Divisional, § 350.

§ 350. Where, after an adverse decision upon interference, applicant divided his application, on one division of which he secured a patent, while he diligently prosecuted his appeal on the other divisional application, which contained the claims that had been repeatedly rejected, *held*, that no intention to abandon such claims could be inferred from his having meanwhile applied for and taken out the patent on the divisional application. *Butler v. Shaw*, 21 Fed. Rep., 321.

See *Appeal*, § 248. *Commissioner*, § 1108.

Application — Date of — *Is that of original application*, §§ 351, 352. *That of subsequent application*, §§ 353, 354. *That of the patent*, § 355. *Filing of model does not establish date of application*, §§ 356, 357. *Evidence of*, § 358.

§ 351. Under act 1836, section 7, the date of application is that of the original, not the amended, application on which the patent issues. *Bell v. Daniels*, 1 Bond, 212.

§ 352. An application filed in 1857 was rejected, and a new application was filed January, 1859, renewing the first, whereupon a patent issued. *Held*, that the date of the application for the patent is to be the date of the first application, which was rejected, and not the date of the renewed application, on which letters patent issued. *Henry v. Francetown Soap-stone Stove Co.*, 9 O. G., 408.

§ 353. The doctrine, with relation to grants of the government, that a subsequent application may relate back to a prior application, so as to cut off intervening claims, will not be applied to a case which does not present the element of "due diligence in applying for and pursuing his application for a patent until he obtained the same." *Wickersham v. Singer*, 1 MacA. Pat. Cases, 645.

§ 354. The original application was filed in the United States patent office October 17, 1877, allowed December 22, 1877, forfeited for non-payment of the final fee, and renewed February 4, 1879. *Held*, that the application made by the patentee in February, 1879, must be considered as his first application, the former application going for naught, and leaving him to stand upon the application as made at the time he renewed it upon his old specifications and drawings. *Weir v. Morden*, 21 Fed. Rep., 243.

§ 355. In the absence of all other proof, the date of the patent will be taken as the date of application and the date of assignment. *Worley v. Loker Tobacco Co.*, 14 Otto, 340.

§ 356. The mere deposit of a model in the patent office gives rise to no inference that the application for patent was completed at such date. *Draper v. Wattles*, 16 O. G., 629.

§ 357. Neither filing the model nor writing the paper commonly called an "application" gives the date of the application from which the two years is to be reckoned. *Henry v. Francetown Soap-stone Co.*, 2 Fed. Rep., 78.

§ 358. Parol evidence held inadmissible to prove date of application. *Wayne v. Winter*, 6 McL., 344.

Application — Examination of — *In the patent office*, §§ 359-365.

§ 359. The seventh section of the act of 1836, authorizing the commissioner to reject the application in certain specified cases, must be taken in connection with the sixth section, which declares what persons may obtain a patent; and if the subject of the application is not a new

and useful art, etc., within the meaning of section 6, the commissioner is bound to refuse it, although it may not be liable to the particular objections specified in the seventh section. *In re Kempler*, 1 MacA. Pat. Cases, 1.

§ 360. An applicant is not required to file a new oath, after being finally rejected, to enable him to appeal. *In re Crooker*, 1 MacA. Pat. Cases, 134.

§ 361. The new oath referred to in the seventh section of the act of 1836 is to be taken only when the applicant persists in his application, after having been informed by the commissioner of the errors and defects of his specification. This happens before his claim is finally rejected. *Ibid.*

§ 362. When an application for a patent is rejected, the applicant is entitled to notice thereof, and to be furnished with such information and references as may be useful in judging of the propriety of renewing his application or altering his specification; and it would be a substantial denial of this right for the judge, upon appeal, to rest an adverse decision upon references for the first time presented in the commissioner's answer to the reasons of appeal. *In re Jewett & Root*, 1 MacA. Pat. Cases, 259.

§ 363. When application papers are filed without the due formalities required by law, it is the duty of the office (under the sixth section of the act of 1836) to decline to act upon them in their imperfect state; and this action on the part of the office does not amount to a rejection of the application. *Wickersham v. Singer*, 1 MacA. Pat. Cases, 645.

§ 364. The object of the last part of the seventh* section appears to be (on refusal to grant the patent) to direct a proceeding whereby the applicant will be allowed, under the particular circumstances stated, to withdraw or modify his specification; and if he persists in the latter, to give him the benefit of an appeal to a board of examiners. This construction is necessary in order to make one part of the section consistent with the other. *Hunt v. Howe*, 1 MacA. Pat. Cases, 366.

§ 365. As the manner in which the commissioner shall aid the inventor — by information and suitable references, so as to assist his judgment in determining whether he shall persist in or abandon his claim — is submitted to the discretion of the commissioner, no appeal lies from his action in this regard to the circuit court. *In re Chambers*, 1 MacA. Pat. Cases, 641.

Application — Rejected, §§ 366-372.

§ 366. A rejected application is not a publication within the meaning of the act of congress, and is in itself no bar to the grant of a patent. *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 6 O. G., 34.

§ 367. Assuming its similarity to the Deuchfield (the patentee) device, the rejected application does not make out that the thing described was ever used, nor is such a description a patent or publication within the statute. *Herring v. Nelson*, 14 Blatch., 293.

§ 368. An application for a patent which stands rejected will not, in such a case, avoid the subsequent patent. *Corn-planter Patent (Brown v. Guild)*, 23 Wall., 181.

§ 369. A rejected application for letters patent is no bar to a patent, there being no evidence to show that the alleged prior invention which it discloses was ever perfected or brought to practical use, or that it was not abandoned and never revived by the original inventor. *Rubber Step Manufacturing Co. v. Metropolitan R. Co.*, 13 O. G., 549.

§ 370. Rejected applications for patents are not of themselves evidence of the existence of perfected inventions at their dates of filing, in the absence of evidence of the construction and operation at such dates of the machines embodying the said inventions. *Howes v. McNeal*, 15 Blatch., 103.

§ 371. A rejected application may be received in evidence to establish prior invention in connection with evidence of the construction of a working machine embodying the invention, and successful experiments with it performed in public. *N. W. Fire Extinguisher Co. v. Phila. Fire Extinguisher Co.*, 6 O. G., 34.

§ 372. The plaintiff's patent was for a refrigerator, and the first claim — the only one adjudicated upon — embraced, in substance, a reservoir for holding the ice, and a flue or conduit descending from it and carrying down the cooled air and discharging it through apertures into the body of the apparatus, whence it rises and enters the ice box again through apertures in the top of it, thus creating a constant circulation. The patent was sustained, although another party had filed an application in the patent office describing a similar apparatus, but had been rejected, and had withdrawn his application long before that of the plaintiff was filed. It was sustained, also, although a third person had purchased of the rejected applicant his invention, and had obtained a patent for it, as his assignee, after the patent in suit was granted. *Lyman Ventilating and Refrigerator Co. v. Lalor*, 12 Blatch., 303.

See *Abandonment*, §§ 4, 9. *Construction of Patents*, § 1251. *Invention*, §§ 3555, 3556. *Patents*, § 1677.

Application — Renewed, §§ 373, 374.

§ 373. Act 1870, section 35, renewed, application construed, and held subject to the implied condition that applicant has not lost his right to make application by abandonment or surrender of his claim. *Marsh v. Commissioner of Patents*, 3 Biss., 321.

§ 374. When a renewed application is filed for the same invention, the time of the two years' prior use and sale is to be reckoned from the filing of the first application. *Henry v. Frances-town Soap-stone Stove Co.*, 9 O. G., 408.

See *Abandonment*, § 39.

Application — Withdrawal of, §§ 375-377.

§ 375. Right to withdrawal of application and return of fee. *Cushing's Opinion*, 7 Op., 390.

§ 376. The withdrawal of an application and the return of the fee is not of itself an abandonment or dedication of one's invention to the public, but is an equivocal act, to be interpreted by surrounding circumstances, and to be affected upon a second application for the same invention by the subsequent conduct of the party — his diligence or his neglect and delay — in the same manner as his conduct is to be weighed in regard to an original application. *Wickersham v. Singer*, 1 MacA. Pat. Cases, 645.

§ 377. The withdrawal of an application and the return of the fee, under the seventh section of the act of 1839, is a final abandonment of the application, and effects an entire extinction of all protection, saving and privilege thereunder. Such an application cannot be revived by filing a new application for the same invention. Such new application will not relate back to, or be considered as a revival of, the withdrawn application for the purpose of avoiding the objection of intervening public use. *Mowry v. Barber*, 1 MacA. Pat. Cases, 563.

See *Contracts*, § 1336.

Application — Generally — Pleading, act 1793, § 378. Act 1839, § 379. What it includes, § 380. Is a public record, § 381.

§ 378. Under the act of 1793, the allegations and suggestions in the petition for a patent should be recited in the patent, else it is void. *Evans v. Chambers*, 2 Wash., 125.

§ 379. Act 1839, section 3, refers to the original application, not to the reissue. *Stimpson v. Railroad Co.*, 4 How., 380.

§ 380. Application includes the paper, or some written paper, and its presentation to the commissioner. *Henry v. Frances-town Soap-stone Co.*, 2 Fed. Rep., 78.

§ 381. Application for patent is a public record, the contents of which the defendants and all others are presumed to know. *Webster Loom Co. v. Higgin*, 105 U. S., 580.

See *Abandonment*, § 51. *Date of Invention*, §§ 1714-1719. *Delay*, §§ 1861-1873. *Novelty*, §§ 4314, 4423. *Priority of Invention*, § 5001.

27. ART.

See STATE OF THE ART, EVIDENCE OF.

§ 382. A new and useful art may be patented. *Evans v. Eaton*, Pet. C. C., 322.

§ 383. Our law distinguishes between a patent for an art and a patent for a manufacture. *Merrill v. Yeomans*, 1 Holmes, 331.

§ 384. It is not an art in the abstract, but as explained in the specification and illustrated by a machine or model or drawing, when of a character to be, which alone the patent laws protect. *Smith v. Downing*, 1 Fish., 64.

See *Claim, Right to Broad*, § 680. *Construction of Patents*, §§ 1228, 1229. *Mode*, § 4195. *Process*, §§ 5028-5104.

Art — Lost.

SUMMARY — (*GAYLER v. WILDER*, §§ 385-396) — *Inventor's inchoate right*, § 385. — *When assigned patent inures to benefit of assignee*, § 386. — *Right of assignee of territorial interest to sue*, § 387. — *When patentee only can sue*, § 388. — *Agreement held to be a license*, § 389. — *Prior abandoned and forgotten experiment*, § 390. — *"Known or used," act 1836*, § 391. — *Lost art*, § 392. — *Experimental test is not invention*, § 393. — *"Original inventor," act 1836*, § 394. — *Prior knowledge of thing patented*, § 395. — *Motion to reopen judgment refused*, § 396.

GAYLER v. WILDER.

(10 Howard, 477-510. 1850.)

ERROR to U. S. Circuit Court, Southern District of New York.

Opinion by TANEY, C. J.

STATEMENT OF FACTS.—Three objections have been taken to the instructions given by the circuit court at the trial, and neither of them is, perhaps, entirely free from difficulty. The first question arises upon the assignment of Fitzgerald to Enos Wilder. The assignment was made and recorded in the patent office before the patent issued. It afterwards issued to Fitzgerald. And the plaintiffs in error insist that this assignment did not convey to Wilder the legal right to the monopoly subsequently conferred by the patent, and that the plaintiff, who claims under him, cannot therefore maintain this action.

§ 385. *The inventor cannot sue for infringement until the patent is issued to him, but he is vested with an inchoate right to the exclusive use of the invention, which may be completed and made absolute by his obtaining a patent therefor.*

§ 386. *And where he assigns it before a patent is issued, by assignment duly recorded, etc., the patent subsequently issued inures to the benefit of the assignee, under the patent act of 1836; and no other conveyance thereof is necessary.*

The inventor of a new and useful improvement certainly has no exclusive right to it until he obtains a patent. This right is created by the patent, and no suit can be maintained by the inventor against any one for using it before the patent is issued. But the discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect and make absolute by proceeding in the manner which the law requires. Fitzgerald possessed this inchoate right at the time of the assignment. The discovery had been made, and the specification prepared to obtain a patent. And it appears by the language of the assignment that it was intended to operate upon the perfect legal title which Fitzgerald then had a lawful right to obtain, as well as upon the imperfect and inchoate interest which he actually possessed. The assignment requests that the patent may issue to the assignee. And there would seem to be no sound reason for defeating the intention of the parties by restraining the assignment to the latter interest, and compelling them to execute another transfer, unless the act of congress makes it necessary. The court think it does not. The act of 1836 declares that every patent shall be assignable in law, and that the assignment must be in writing, and recorded within the time specified. But the thing to be assigned is not the mere parchment on which the grant is written. It is the monopoly which the grant confers; the right of property which it creates. And when the party has acquired an inchoate right to it, and the power to make that right perfect and absolute at his pleasure, the assignment of his whole interest, whether executed before or after the patent issued, is equally within the provisions of the act of congress.

And we are the less disposed to give it a different construction, because no purpose of justice would be answered by it, and the one we now give was the received construction of the act of 1793 (1 Stats. at Large, 318) in several of the circuits; and there is no material difference in this respect between the two acts. As long ago as 1825, it was held by Mr. Justice Story that in a case of this kind an action could not be maintained in the name of the patentee, but must be brought by the assignee. 4 Mason, 115. We understand

the same rule has prevailed in other circuits; and if it were now changed, it might produce much injustice to assignees who have relied on such assignments, and defeat pending suits brought upon the faith of long-established judicial practice and judicial decision. Fitzgerald sets up no claim against the assignment, and to require another to complete the transfer would be mere form. We do not think the act of congress requires it; but that, when the patent issued to him, the legal right to the monopoly and property it created was, by operation of the assignment then on record, vested in Enos Wilder.

§ 387. *To enable the assignee of a territorial interest in a patent to sue in his own name for an infringement, under section 14 of the patent act of 1836, he must have the entire and exclusive right in and for such territory.*

The next question is upon the agreement between the defendant in error and Herring. Is this instrument an assignment to Herring for the state or city of New York, upon which he might have sued in his own name? If it is, then this action cannot be maintained by the defendant in error. Now, the monopoly granted to the patentee is for one entire thing; it is the exclusive right of making, using, and vending to others to be used, the improvement he has invented, and for which the patent is granted. The monopoly did not exist at common law, and the rights, therefore, which may be exercised under it cannot be regulated by the rules of the common law. It is created by the act of congress; and no rights can be acquired in it unless authorized by statute, and in the manner the statute prescribes. By the eleventh section of the act of 1836, the patentee may assign his whole interest, or an undivided part of it. But if he assigns a part under this section, it must be an undivided portion of his entire interest under the patent, placing the assignee upon an equal footing with himself for the part assigned. Upon such an assignment, the patentee and his assignees become joint owners of the whole interest secured by the patent, according to the respective proportions which the assignment creates.

§ 388. *Where the transfer of a right is less than an assignment under section 14, act 1836, patentee can alone bring suit for infringement against third parties.*

By the fourteenth section the patentee may assign his exclusive right within and throughout a specified part of the United States, and upon such an assignment the assignee may sue in his own name for an infringement of his rights. But in order to enable him to sue, the assignment must undoubtedly convey to him the entire and unqualified monopoly which the patentee held in the territory specified, excluding the patentee himself, as well as others. And any assignment short of this is a mere license. For it was obviously not the intention of the legislature to permit several monopolies to be made out of one, and divided among different persons within the same limits. Such a division would inevitably lead to fraudulent impositions upon persons who desired to purchase the use of the improvement, and would subject a party who, under a mistake as to his rights, used the invention without authority, to be harassed by a multiplicity of suits instead of one, and to successive recoveries of damages by different persons holding different portions of the patent right in the same place. Unquestionably, a contract for the purchase of any portion of the patent right may be good as between the parties as a license, and enforced as such in the courts of justice. But the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it. This is the view taken of the subject in the

case of *Blanchard v. Eldridge*, 1 Wall. Jr., 337, and we think it the true one. Applying these principles to the case before us, the action was properly brought by the plaintiff below, and could not have been maintained by Herring.

§ 389. *An agreement granting an exclusive right to make and vend a safe in a certain city, county and state, grantee to pay monthly, for weight sold, grantor reserving right to manufacture at a given distance from the same city and to sell in the same state, paying grantee for weight sold, held to be a license and not an assignment.*

The agreement is singularly confused and complicated. It purports to grant to Herring the exclusive right to make and vend the Salamander safe in the city, county and state of New York; and Herring agrees to pay to the defendant in error a cent a pound for every pound the safes might weigh, to be paid monthly. But at the same time it reserves to Wilder the right to set up a manufactory or works for making these safes in the state of New York, provided it is not within fifty miles of the city, and to sell them in the state of New York, paying to Herring a cent a pound on each safe so sold within the state. It is evident that this agreement is not an assignment of an undivided interest in the whole patent, nor the assignment of an exclusive right to the entire monopoly in the state or city of New York. It is therefore to be regarded as a license only, and under the act of congress does not enable Herring to maintain an action for an infringement of the patent right. The defendant in error continues the legal owner of the monopoly created by the patent.

§ 390. *An isolated prior construction and use of an invention by a person, who never made it public, and afterwards forgot and abandoned it, so that the invention was virtually no more in existence when invented by the patentee, by his own skill and exertions, believing himself the first and original inventor thereof, does not render the patent invalid under the act of 1836.*

The remaining question is upon the validity of the patent on which the suit was brought. It appears that James Conner, who carried on the business of a stereotype founder in the city of New York, made a safe for his own use between the years 1829 and 1832, for the protection of his papers against fire; and continued to use it until 1838, when it passed into other hands. It was kept in his counting-room, and known to the persons engaged in the foundry; and after it passed out of his hands, he used others of a different construction. It does not appear what became of this safe afterwards. And there is nothing in the testimony from which it can be inferred that its mode of construction was known to the person into whose possession it fell, or that any value was attached to it as a place of security for papers against fire; or that it was ever used for that purpose.

Upon these facts, the court instructed the jury "that, if Conner had not made his discovery public, but had used it simply for his own private purpose, and it had been finally forgotten or abandoned, such a discovery and use would be no obstacle to the taking out of a patent by Fitzgerald, or those claiming under him, if he be an original, though not the first, inventor or discoverer." The instruction assumes that the jury might find from the evidence that Conner's safe was substantially the same with that of Fitzgerald, and also prior in time. And if the fact was so, the question then was, whether the patentee was "the original and first inventor or discoverer," within the meaning of the act of congress.

§ 391. "*Known or used*," section 6, act 1836, signifies knowledge and use existing in a manner accessible to the public.

The act of 1836, chapter 357, section 6, authorizes a patent where the party has discovered or invented a new and useful improvement, "not known or used by others before his discovery or invention." And the fifteenth section provides that, if it appears on the trial of an action brought for the infringement of a patent, that the patentee "was not the original and first inventor or discoverer of the thing patented," the verdict shall be for the defendant. Upon a literal construction of these particular words, the patentee in this case certainly was not the original and first inventor or discoverer, if the Conner safe was the same with his, and preceded his discovery.

But we do not think that this construction would carry into effect the intention of the legislature. It is not by detached words and phrases that a statute ought to be expounded. The whole act must be taken together, and a fair interpretation given to it, neither extending nor restricting it beyond the legitimate import of its language, and its obvious policy and object. And in the fifteenth section, after making the provision above mentioned, there is a further provision, that, if it shall appear that the patentee, at the time of his application for the patent, believed himself to be the first inventor, the patent shall not be void on account of the invention or discovery having been known or used in any foreign country, it not appearing that it had been before patented or described in any printed publication.

In the case thus provided for, the party who invents is not, strictly speaking, the first and original inventor. The law assumes that the improvement may have been known and used before his discovery. Yet his patent is valid if he discovered it by the efforts of his own genius, and believed himself to be the original inventor. The clause in question qualifies the words before used, and shows that, by knowledge and use, the legislature meant knowledge and use existing in a manner accessible to the public. If the foreign invention had been printed or patented, it was already given to the world, and open to the people of this country, as well as of others, upon reasonable inquiry. They would therefore derive no advantage from the invention here. It would confer no benefit upon the community, and the inventor therefore is not considered to be entitled to the reward. But if the foreign discovery is not patented, nor described in any printed publication, it might be known and used in remote places for ages, and the people of this country be unable to profit by it. The means of obtaining knowledge would not be within their reach; and, as far as their interest is concerned, it would be the same thing as if the improvement had never been discovered. It is the inventor here that brings it to them, and places it in their possession. And as he does this by the effort of his own genius, the law regards him as the first and original inventor, and protects his patent, although the improvement had in fact been invented before, and used by others.

§ 392. *Lost art considered.*

So, too, as to the lost arts. It is well known that centuries ago discoveries were made in certain arts, the fruits of which have come down to us, but the means by which the work was accomplished are at this day unknown. The knowledge has been lost for ages. Yet it would hardly be doubted, if any one now discovered an art thus lost, and it was a useful improvement, that, upon a fair construction of the act of congress, he would be entitled to a patent. Yet he would not literally be the first and original inventor. But he

would be the first to confer on the public the benefit of the invention. He would discover what is unknown, and communicate knowledge which the public had not the means of obtaining without his invention.

Upon the same principle, and upon the same rule of construction, we think that Fitzgerald must be regarded as the first and original inventor of the safe in question. The case as to this point admits that, although Conner's safe had been kept and used for years, yet no test had been applied to it, and its capacity for resisting heat was not known; there was no evidence to show that any particular value was attached to it after it passed from his possession, or that it was ever afterwards used as a place of security for papers; and it appeared that he himself did not attempt to make another like the one he is supposed to have invented, but used a different one. And upon this state of the evidence, the court put it to the jury to say, whether this safe had been finally forgotten or abandoned before Fitzgerald's invention, and whether he was the original inventor of the safe for which he obtained the patent; directing them, if they found these two facts, that their verdict must be for the plaintiff. We think there is no error in this instruction. For, if the Conner safe had passed away from the memory of Conner himself, and of those who had seen it, and the safe itself had disappeared, the knowledge of the improvement was as completely lost as if it had never been discovered. The public could derive no benefit from it until it was discovered by another inventor. And if Fitzgerald made his discovery by his own efforts, without any knowledge of Conner's, he invented an improvement that was then new, and at that time unknown; and it was not the less new and unknown because Conner's safe was recalled to his memory by the success of Fitzgerald's.

We do not understand the circuit court to have said that the omission of Conner to try the value of his safe by proper tests would deprive it of its priority; nor his omission to bring it into public use. He might have omitted both, and also abandoned its use, and been ignorant of the extent of its value; yet, if it was the same with Fitzgerald's, the latter would not upon such grounds be entitled to a patent, provided Conner's safe and its mode of construction were still in the memory of Conner before they were recalled by Fitzgerald's patent. The circumstances above mentioned, referred to in the opinion of the circuit court, appear to have been introduced as evidence tending to prove that the Conner safe might have been finally forgotten, and upon which this hypothetical instruction was given. Whether this evidence was sufficient for that purpose, or not, was a question for the jury, and the court left it to them. And if the jury found the fact to be so, and that Fitzgerald again discovered it, we regard him as standing upon the same ground with the discoverer of a lost art, or an unpatented and unpublished foreign invention, and like him entitled to a patent. For there was no existing and living knowledge of this improvement, or of its former use, at the time he made the discovery. And whatever benefit any individual may derive from it in the safety of his papers, he owes entirely to the genius and exertions of Fitzgerald.

Upon the whole, therefore, we think there is no error in the opinion of the circuit court, and the judgment is therefore affirmed.

Dissenting opinion by MR. JUSTICE McLEAN.

I dissent from the opinion of a majority of the judges in this case. The point of difference, I think, is essential to the maintenance of the rights of the public, and also of inventors.

It was proved by James Conner, as appears from the bill of exceptions, "that between 1829 and 1832 he was engaged in business as a stereotype founder, and, knowing that plaster of Paris was a non-conductor of heat, he constructed a safe with a double chest, and filled the space between the inner and outer one with plaster of Paris; the same, substantially, as testified to and claimed by Fitzgerald, except there was no plaster used on the top of the safe. It was made for his own private use in his establishment, and was used by him as a safe from the time it was made till 1838, when it passed into other hands. It was kept in the counting room while he used it, and was known to the persons working in the foundry." This evidence was confirmed by another witness.

By the sixth section of the patent act of 1836, it is provided "that any person or persons having discovered or invented any new or useful art, machine, manufacture, or composition of matter, or any new or usual improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof," may apply for a patent, etc. The applicant is required to "make oath or affirmation that he does verily believe that he is the original and first inventor," etc., "and that he does not know or believe that the same was ever before known or used."

The seventh section authorizes and requires the commissioner of patents "to make or cause to be made an examination of the alleged new invention or discovery; and if on such examination it shall not appear to the commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country," etc., the commissioner may grant a patent.

In the fifteenth section it is provided "that whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been before known or used in any foreign country, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication."

From the above extracts, it is seen that the patentee must be the inventor of the machine, or the improvement of it, or he can have no right. If the thing was known or used by others, he cannot claim a patent. Or if it was patented in a foreign country, or described in any publication at home or in any foreign country, he has no right to a patent. To this there is only the exception in the fifteenth section above cited. But this can have no influence in the present case.

Let these provisions of the statute be compared with the two last paragraphs of the charge of the court, as stated in the third exception: "And said court further instructed the jury, that if they found that the use made by James Conner of plaster of Paris was confined to a single iron chest, made for his own private use, after said Fitzgerald's discovery and experiments, then it was not in the way of Fitzgerald's patent, and the same was valid; but if the jury found that said James Conner made his said safe, as claimed, and tested it by experiments, before Fitzgerald's invention and improvement, and before he tested the same, then said Fitzgerald was not the first inventor as claimed, and was not entitled to said patent."

§ 393. *Experimental test is no part of the invention.*

This charge stands disconnected with any other facts in the case, except those named, and, in my judgment, it is erroneous. If Conner's safe were identical with Fitzgerald's, and though it was of prior invention, yet if it were not tested by experiments before Fitzgerald's improvement, and before he tested the same, the jury under the instruction were bound to find for Fitzgerald. And the case was thus made to turn, not on the priority of invention only, but upon that and the fact of its having been tested by experiments. This introduces a new principle into the patent law. The right under the law depends upon the time of the invention. An experimental test may show the value of the thing invented, but it is no part of the invention.

"The court further charged, that, independently of these considerations, there was another view of the case, as it respected the Conner safe; that it was a question whether the use of it by him had been such as would prevent another inventor from taking out a patent; that if Conner had not made his discovery public, but had used it simply for his own private purpose, and it had been finally forgotten or abandoned, such a discovery and use would be no obstacle to the taking out of a patent by Fitzgerald, or those claiming under him, if he be an original, though not the first, inventor or discoverer of the improvement."

§ 394. *In the patent act of 1836, the "original" means the first inventor, and where an invention patented was known to or used by any person before such invention was invented and patented by the patentee, the patent is invalid.*

If there be anything clear in the patent law, it is that the original inventor means the first inventor, subject only to the provision stated in the fifteenth section. This instruction presupposes that the safes are the same in principle. Now, if the invention was patented abroad, or was described in a foreign publication, both of which were unknown to the inventor in this country, still, his patent is void. So it is void if such invention has been known to any person in this country. The instruction says, if Conner's invention "had been forgotten or abandoned," it was no obstacle to Fitzgerald's right. Can a thing be forgotten or abandoned that was never known? If known before Fitzgerald's invention, it is fatal to it. By whom must it have been forgotten? By the inventor, or the public, or both? And how must it have been abandoned? When an invention is abandoned, it is said to be given up to the public, and this is the sense in which the term abandonment is used in the patent law. Such an abandonment would be fatal to the right of Fitzgerald.

Conner's safe, as appears from the bill of exceptions, was used in his counting-house, being accessible to every one, some six or eight years. In 1838 it passed into other hands; but into whose hands it does not appear. In 1843 Fitzgerald obtained his patent. How long before that he made experiments to test the invention is not proved. At most, the time must have been less than five years. This is a short period on which to found a presumption of forgetfulness. The law authorizes no such presumption. It can never become the law. It is not founded on probability or reason. The question is, Was Conner's invention prior to that of Fitzgerald? That it was of older date, by some ten or twelve years, is proved. And the instruction, it must be observed, was founded on the supposition that both inventions were similar.

§ 395. *Prior knowledge of the thing patented.*

The instruction seems to attach great importance to the fact that Conner's safe was used only for his private purpose. This is of no importance. The

invention is the question, and not the manner in which the inventor used it. The safe was constructed at the foundry and must have been known to the hands there employed. How can it be ascertained that Fitzgerald was not informed by some of these hands of the structure of Conner's safe, or by some one of the many hundreds who had seen it in his counting-house in the city of New York? It was to guard against this, which is rarely if ever susceptible of proof, that the act is express,—if the thing patented was known before, the patent is void. If the fact of this knowledge in any one be established, it is immaterial whether the patentee may have known it or not, it avoids his patent.

The law on this subject is not founded upon any supposed notions of equity. A foreign patent for the same thing, or a description of the thing in a foreign publication, is as effectual to avoid the patent as if the patentee had seen the prior invention. Notice to him is not important. The law is adopted on a settled public policy, which, while it is just to inventors, protects the rights of the public. Any other basis would open the door for endless frauds, by pretended inventors, without the probability of detection. And especially does this new doctrine of forgetfulness or abandonment, used in any other sense than as recognized in the patent law, leaving such matters to a jury, overturn what I consider to be the settled law on this subject. Of the same character is the fact that the invention was used for private purposes. A thing may be used in that way and at the same time be public, as was the case with the Conner safe, and yet the jury are necessarily misled by such an instruction.

Dissenting opinion by MR. JUSTICE DANIEL.

Differing from the majority in the decision just pronounced, I proceed to state the grounds on which my dissent from that decision is founded.

On two essential points in this cause, it seems to me that the learned justice who tried it at the circuit has erred, and that the decision here should therefore have been for a reversal of his judgment. Those points involve, first, the right of the plaintiff below to maintain his action upon the title or right of action deduced from Fitzgerald through Enos and Benjamin Wilder; and secondly, a right to or interest in the subject of the suit on the part of the plaintiff below, admitting that subject to have been originally invented and used by some other person than Fitzgerald; a right founded upon an assumption that this subject had been used in private only, or had, in the language of the learned justice, been "finally forgotten or abandoned" by such first inventor. These points are presented by the first and third exceptions of the plaintiffs in error to the rulings at the trial below. The plaintiff in the circuit court claimed by assignment from B. G. Wilder, assignee of Enos Wilder, assignee of Daniel Fitzgerald, alleged to have been the inventor of the Salamander safe. By the paper deduction of title, it appears that, on the 11th day of April, 1839, Fitzgerald, alleging that he had invented an improvement called the Salamander safe, for which he was about to apply for letters patent, for the consideration of \$5,000, sold the interest he then had, or might thereafter have, in this invention, to Enos Wilder; that Enos Wilder, on the 1st day of September, 1843, for the consideration of \$1, assigned and transferred to the plaintiff all the right, title and interest which he had derived from Fitzgerald, under the agreement of the 11th of April, 1839; that no patent issued for this Salamander safe until the year 1843, when a patent was granted

to Daniel Fitzgerald, as the original inventor; that no patent for this invention has ever been granted either to Enos or B. G. Wilder, either as inventor or assignee of this safe; that the title, whatever it may be, rests upon the agreement between Fitzgerald and Enos Wilder, of the 11th of April, 1839, before the patent to the former.

It must be recollected that this is an action at law; and in order to maintain it, the plaintiff was bound to set out and to prove a legal title. Has he done either? What was the character of the interest or title transferred from Fitzgerald to Enos Wilder? This could not transcend the interest or title possessed by Fitzgerald himself; and what was this? A title to any specific machine which he may have constructed, and of which no person could rightfully deprive him; and a claim upon the good will and gratitude of the community, if in truth he should have conferred upon them a benefit by the discovery and construction of his machine. I speak now in reference to rights derivable from the common law, and independently of the constitution or of statutory provisions. The mere circumstances of inventing and constructing a machine could no more inhibit its imitation than would the structure or interior arrangement of a house of peculiar ingenuity or convenience prevent the like imitation by any one who could possess himself of its plan. The mere mental process of devising an invention enters not into the nature of property according to the common law; it forms no class or division in any of its enumerations or definitions of estates or property, and is a matter quite too shadowy for the practical character of that sturdy system.

A doctrine contrary to this, though with some discrepancy amongst the judges as to its extent, seems at one time to have obtained in the king's bench, as propounded in the case of *Millar v. Taylor*, 4 Burr., 2305, in opposition to the profound and unanswerable reasoning of Mr. Justice Yates; but upon a review of the same question in the lords, in the case of *Donaldsons v. Becket* and others, the doctrine of the king's bench was repudiated, and that of the common law, as asserted by Yates, justice, vindicated and restored. And, indeed, if, according to the opinions of some of the judges in the case of *Millar v. Taylor*, the mere mental process of invention constituted an estate or property at the common law, and property vested *in perpetuo*, except so far as it should be transferred by the owner, it is difficult to perceive the necessity of a cautious and complicated system for the investment and security of interests already perfect, and surrounded with every guard and protection which is inseparable under the common law from every right it has created or recognized. But if the mere mental and invisible process of invention, apart from the specific, sensible and individual structure, can be classed at all as property at law, it must partake of the character of a *chose in action*, much more so than an obligation or contract, the terms and conditions of which are defined and assented to by the contracting parties. To *choses in action*, it can scarcely be necessary here to remark, assignability is imparted by statutory enactment only, or by commercial usage. To hold that the single circumstance of invention creates an estate or property at law, and an estate and legal title transmissible by assignment, appears to me a doctrine not merely subversive of the common law, but one which contravenes the origin and course of legislation in England in relation to patent rights, and renders useless and futile both the constitutional provision and all the careful enactments of congress for the security and transmissibility of the same rights. For why, as has been already remarked, should that provision and these enactments have been made for the

establishment and security of that which was established and safe independently of both? I hold it, then, to be true that the circumstance of invention invests no such perfect estate or right of property as can be claimed and enforced at law or in equity against the user of the same invention, either by subsequent inventors or imitators, and that any estate or property in the mere mental process of invention must be traced to and deducible from the constitution and the acts of congress alone. I cannot but regard as mischievous and alarming an attempt to introduce a *quasi* and indefinite, indefinable and invisible estate, independently of the constitution and acts of congress, and unknown to the rules and principles of the common law.

It is the patent alone which creates an estate or interest in the invention known to the law, and which can be enforced either at law or in equity, either by the inventor or by the person to whom, by virtue of the statute, he may assign his rights. Down to the act of congress of 1837 (5 Stats. at Large, 191), nothing but the estate, interest or property created or invested by the patent itself was made assignable. The language of the law is that "every patent," "the exclusive right under any patent," "the thing patented," may be assignable. The fact or existence of a patent is in every instance inseparable from the right given. It is this fact, and this only, which impresses the quality of assignability. Of course, under these provisions, there could be no transfer of the legal title previously to a patent.

By section 6 of the act of congress approved March 3, 1837, it is provided that thereafter any patent to be issued may be made to the assignee of the inventor or discoverer, upon the conditions set forth in that section. Yet still it is presumed that, until the issuing of a patent, so far is it from being true that a legal estate or title existed in such assignee, it is clear, on the contrary, that no legal title existed before the patent in the inventor himself, for it is the patent which constitutes his title. Of course, then, the assignee can at most hold nothing but an equity under such an assignment, which he may insist upon under this assignment against the inventor or against the government; but he has no legal title by force merely of such an assignment, and *a fortiori* he has no legal title, if the patent, notwithstanding such an assignment, is in fact issued to the inventor, but is thereby entirely excluded from all pretension to a legal title. Thus, in the case before us, the patent under which the plaintiff claims was, subsequently to the agreement between Fitzgerald and Enos Wilder, issued to Fitzgerald, the inventor, and, according to the proofs in the cause, has never been renewed to Enos Wilder, nor to any claimant under him, nor been assigned to any such claimant, but remains still in the alleged inventor, Fitzgerald. It seems to me, then, indisputable that the legal title indispensable for the maintenance of this suit at law never was in the plaintiff, and that he could not maintain the action.

The second instance in which I hold the learned justice who tried this cause to have erred is that in which he instructed the jury as follows: "That if Conner had not made his discovery public, but had used it simply for his own private purpose, and it had been finally forgotten or abandoned, such discovery and use would be no obstacle to the taking out of a patent by Fitzgerald, or those claiming under him, if he be an original, though not the first, inventor or discoverer of the improvement." In considering this instruction of the learned judge, the first vice with which it appears to be affected is its violation of a rule thought to be universally applicable to instructions to juries in trials at law; and that rule is this: that instructions should always arise out of,

and be limited to, the facts or the evidence in the cause, to which the questions of law propounded from the bench should be strictly applicable; and that instructions which are general, abstract, or not springing from, and pertinent to, the facts of the case, are calculated to mislead the jury, and are therefore improper. Tried by this rule, the instruction of the learned judge, so far as it relates to Conner's not having made his discovery public, or having finally forgotten or abandoned it, is certainly irrelevant to, and unsustained by, any evidence in the record. So far is the existence of such testimony from being shown, the converse is proved and is justly inferable throughout; for, although it does not appear that Conner advertised his invention in the public papers, or claimed a patent for it, it is admitted that he used this safe in an extensive business establishment, to which it is certain, from the nature of his business, the public had access; and it is not pretended that he made any effort at concealment of what he had invented, and the record is entirely destitute of evidence of an abandonment of his invention. As to the assumption of his having forgotten it, there is neither a fact, an inquiry nor conjecture in the testimony pointing to such a conclusion. The instruction appears to me to be wholly gratuitous and irrelevant.

But supposing this instruction to have been founded upon testimony introduced before the jury, let us consider for a moment its correctness as a rule of law applicable to this cause. This charge, it must be recollected, admits that Conner was, or might have been, the first inventor; and, notwithstanding, asserts that Fitzgerald, though posterior in time, might, upon the conditions and considerations assumed by the judge, become the owner of the right. Are these conditions warranted, either by the rules of public policy or by the terms and language of legislative provisions on such subjects? It is said that patent privileges are allowed as incitements to inventions and improvements by which the public may be benefited. This position, that may be conceded in general, should not be made a means of preventing the great and public purposes its legitimate enforcement is calculated to secure. The admission of this principle leaves entirely open the inquiries, whether he is more the benefactor of the public who makes a useful improvement which he generously shares with his fellow-citizens, or he who studies some device which he denies to all, and limits by every means in his power to a lucrative monopoly; and, still more, whether the latter shall be permitted to seize upon that which had already (as is here admitted) been given to the public, thereby to levy contributions, not only on the community at large, but upon him even who had been its generous benefactor. It was doubtless to prevent consequences like those here presented that the priority and originality of inventions are so uniformly and explicitly insisted upon in all the legislation of congress, as will presently be shown.

The tendency of the learned judge's charge to mislead the jury, from its want of precision, and its failure to define any certain predicament upon which the action of the jury should be founded, is of itself an insuperable objection to that charge. Thus it is said, if Conner "had not made his discovery public." In what mode? it may be asked. What form of publicity did the learned judge intend the jury should require? It is shown that Conner used his safe publicly; that is, he concealed it from no one; and if any mode or kind of publication or concealment was requisite, either to establish or conclude the right of Conner, or to conclude common right (a delinquency in the nature of a forfeiture), surely that mode, if found either in any statute, or in the rules of the

common law, ought to have been clearly laid down, so as to guard the rights of all. In the next place, it is said by the learned judge, that, if Conner had abandoned this improvement which the charge admits him to have invented, this would justify a patent to another who had not known of the improvement, although a subsequent inventor. I have always understood it to be indisputable law, that wherever an inventor abandons or surrenders an invention or improvement which he has certainly made, and neither claims an exclusive right in himself nor transfers it to another, the invention or improvement is given to the public; but by the charge in this case, such an abandonment transfers an exclusive right to one who, by the case supposed, is admitted not to be the first inventor. So, too, with respect to the hypothesis of the learned judge that the invention had or might have been forgotten. To this the same objections of vagueness and uncertainty, and the graver objection of injustice to the real inventor or to the public, are applicable. By whom and for what interval of time must this improvement have been forgotten, in order to transfer it from the originator thereof? For a term of years? And if so, for how long a term? But suppose he forgets it for his life-time, shall his executor or his posterity, upon the exhibition of indisputable proofs of the invention, yea, the very machine itself, perfect in all its parts and in its operation, be cut off? This surely cannot be; but, at any rate, the jury should have been furnished with some rule or measure of obliviousness, if this was to be made the substantive cause of deprivation as to the original inventor, or the foundation of right and of exclusive right in one confessedly not the first inventor.

An attempt has been made to compare the doctrine propounded by the court to what it might be thought is the law as applicable to the discovery, or rather recovery, of the processes employed in what have been called the lost arts. This illustration is in itself somewhat equivocal, and by no means satisfactory; for if that process could certainly be shown to be the same with one claimed by the modern inventor, his discovery could scarcely have the merit of originality, or be the foundation of exclusive right. But, in truth, the illustration attempted to be drawn from a revival of a lost art is not apposite to the present case. The term lost art is applicable peculiarly to certain monuments of antiquity still remaining in the world, the process of whose accomplishment has been lost for centuries, has been irretrievably swept from the earth, with every vestige of the archives or records of the nations with whom those arts existed, and the origin or even the identity of which process none can certainly establish. And if a means of producing the effect we see and have amongst us be discovered, and none can either by history or tradition refer to a similar or to the identical process, the inventor of that means may so far claim the merit of originality, though the work itself may have been produced possibly by the same means. But not one principle drawn from such a state of things can be applied to a recent proceeding, which counts from its origin scarcely a period of fifteen years. In fine, this ruling of the learned judge is regarded as being at war not less with the policy and objects, than it is with the express language, of all the legislation by congress upon the subject of patent-rights, which legislation has uniformly constituted priority of invention to be the foundation and the test of all such rights. Thus, in the act of April 10, 1790, the first patent law (1 Stats. at Large, 109), it is declared by the first section: "That upon the application of any person or persons, etc., setting forth that he, she or they hath or have invented or discovered any useful art, etc., not before known or used," etc.; and the second section of the same statute, re-

quiring a specification of any invention or discovery, declares that it shall be so described "as to distinguish it from all other things known or used."

The act of February 21, 1793 (1 Stats. at Large, 318), provides that when any citizen or citizens of the United States shall allege that he or they have invented any "new and useful art, etc., not known or used before the application," etc. By the act of April 17, 1800 (2 Stats. at Large, 37), which extends the privilege of patents to aliens, proof is required that the art, invention or discovery hath not been known or used in that or any foreign country. It is true that this requisition has been so far relaxed as to admit of the patenting in this country inventions which had been invented and used abroad, but with respect to this country the invention, etc., must still be original.

In the act of July 4, 1836 (5 Stats. at Large, 117), reorganizing the patent office, the language of the sixth section is as follows: "That any person or persons having discovered or invented any new and useful art, etc., not known or used by others before his or their discovery," etc. The language and import of the laws here cited are too plain to require comment, and I think that the production of a single instance from the statute book may safely be challenged by which the requisites above mentioned have been dispensed with. Every law, on the contrary, has emphatically demanded originality and priority as indispensable prerequisites to patent privileges, and every aspirant to such privileges is expressly required to swear to these prerequisites, as well as to establish them. These tests, ordained by the laws, are not only founded upon the true reason for the privileges conferred, but they are simple and comprehensible; whereas the innovations permitted by the ruling of the learned judge, not only conflict with the true reason and foundation of patent privileges, but tend to an uncertainty and confusion which cannot but invite litigation and mischief. I think that the judgment of the circuit court should be reversed, and the cause remanded for a *venire facias de novo*.

MR. JUSTICE GRIER dissented.

MOTION TO OPEN THE JUDGMENT.

On the following day a motion to open the judgment was made.

Opinion by TANNEY, C. J.

This case was argued early in the present term, and the judgment of the circuit court affirmed.

§ 396. *A judgment will not be opened by this court to enable a party to correct an error or mistake in the bill of exceptions.*

A motion is now made to open the judgment for the purpose of amending the bill of exceptions and rehearing the case, upon the ground that material evidence offered by the plaintiffs in error, which might have influenced the judgment of this court, has been omitted in the bill of exceptions contained in the record. If any error or mistake was committed in framing this exception, it might undoubtedly have been corrected by a *certiorari*, if the application had been made in due time and upon sufficient cause. But this application is too late, even if the evidence which the plaintiffs in error propose to introduce would have influenced the decision. We, by no means, intend to say that it would have done so. But they rested satisfied with the exception as it stood; made no objection to it here; and argued the case and awaited the judgment of the court upon the evidence as stated in the exception. After that judg-

ment has been pronounced, it is too late to say that the statement was imperfect or erroneous, and to make a new case by the introduction of new evidence, and a new exception.

The motion is therefore overruled.

§ 397. *Quære*, whether, when a patentee has made an original invention which is confessedly an improvement upon all old machines, he is conclusively presumed to have known every lost and forgotten machine in the line of his art, and therefore must prove invention over the best of them, as he undoubtedly must be presumed to know of any machine which fully embodied his invention. *Sinclair v. Backus*, 4 Fed. Rep., 539.

See *Abandonment*, § 113.

28. ARTICLE OF MANUFACTURE.

SUMMARY (*COLLAR COMPANY v. VAN DUSEN*, §§ 398-406) — *Purpose of a reissue*, § 398. — *Parol testimony to enlarge scope of reissue*, § 399. — *Identity of reissue and original*, § 400. — *Evans' reissue patent held invalid*, § 401. — *Invention held not for a new article of manufacture*, § 402. — *Patentability of article of manufacture*, § 403. — *Relation of employer and employee in view of inventorship*, §§ 404, 405. — *Gray's reissued patent wanting in novelty*, § 406.

COLLAR COMPANY v. VAN DUSEN.

(23 Wallace, 530-566. 1874.)

APPEAL from U. S. Circuit Court, Southern District of New York.

Opinion by MR. JUSTICE CLIFFORD.

STATEMENT OF FACTS.—Complainant filed a bill against defendant to enjoin him from making shirt collars of a certain material and in a certain way, to which it claimed an exclusive right under Reissued Patents No. 2309, granted A. Evans, July 10, 1866, and No. 1646, granted S. S. Gray, March 29, 1864, both patents being for shirt collars. Defendant admitted their use, but set up that the Evans reissue was void as not being for the same invention as the original patent and for want of novelty, and that the Gray reissue was also void for want of novelty.

The case presents two principal questions for decision: 1st. Whether the reissued patent granted to Evans for improvement in paper shirt collars is a valid patent. 2d. Whether the reissued patent originally granted to Gray for improvements in turn-over shirt collars is a valid patent.

Infringement is admitted. The defendants allege that the reissued patent of Evans is not for the same invention as the original. This, if true, is sufficient to show that the patent is invalid even if the patentee was the original and first inventor of the improvement described in the original patent.

§ 398. *The purpose of a reissue of letters patent is to cure defects and supply deficiencies, so as to render the patent operative and valid. The introduction of new features, ingredients or devices is not permitted in such reissues.*

Power to surrender patents for the purpose suggested in the act of congress implies that the specification may be corrected to the extent necessary to cure the defects and to supply the deficiencies to render the patent operative and valid, but the interpolation of new features, ingredients or devices which were neither described, suggested nor substantially indicated in the specification, drawings or patent office model were never allowed, and by a recent act of congress it is provided that no new matter shall be introduced into the specification, nor, in the case of a machine patent, shall the model or drawings be amended except each by the other. 16 Stat. at Large, 206.

§ 399. *Parol testimony is not admissible, in an application for a reissue patent, to enlarge the scope and effect of the invention, beyond what was described, suggested or substantially indicated in the original specifications, drawings or model.*

Repeated decisions also have established the rule that parol testimony is not admissible, in an application for a reissued patent, to enlarge the scope and effect of the invention beyond what was described, suggested, or substantially indicated in the original specification, drawings or patent office model, as the purpose of a surrender and reissue is not to introduce new features, ingredients or devices, but to render effectual the actual invention for which the original patent should have been granted.

Unless, however, it is apparent upon the face of the new patent that the commissioner has exceeded his authority, his decision is final and conclusive, as the jurisdiction to reissue patents is vested in him subject to a single exception, that if there is such repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the reissued patent is not for the same invention as that embraced and secured in the original patent, then the reissued patent is invalid.

§ 400. *Whether a reissued patent is for the same invention as the original depends upon whether the specifications and drawings are the same; and if not, whether the omissions or additions are or are not greater than the law allows to cure the defects of the original.*

Whether a reissued patent is for the same invention as the surrendered original or for a different one must very largely be determined by a comparison of the two instruments, as the decision must necessarily depend upon the question whether the specifications and drawings of the reissued patent are not substantially the same as those of the original; and if not, whether the omissions or additions are or are not greater than the law allows to cure the defects of the original specification.

§ 401. *The reissued patent of the Evans paper collar patent is for a different invention than the original patent was for, and hence is invalid.*

Instruments so widely different as are the original patent to Evans and the reissue of it can hardly be compared within the usual meaning and ordinary application of that word, as they really have substantially nothing in common, so far as respects the description of the invention which they respectively profess to secure. Examples where the difference between the original and reissued patents is as manifest as in this case may perhaps arise, but none such were referred to in the argument of such a striking character, nor are any such within the recollection of the court where the difference between the reissued and original patents is so pervading as in the case in decision.

Wide differences in that regard were exhibited in the case of *Gill v. Wells*, 22 Wall., 1, recently decided by this court, but they were by no means as striking and unmistakable as those disclosed in this record. Here the dissimilarity extends to every part of the description of the invention. There it had respect only to one of the elements of the patented combination. Attempt was made in that case to emasculate the combination described in the original patent by leaving out one of the material elements in order to give the exclusive right a more comprehensive effect in prosecuting suits for infringements, but in the case before the court the reissued patent is different throughout from the invention embodied in the original patent.

Proof of that proposition is found also in the respective claims of the pat-

ents as well as in the respective specifications. What I claim as new and desire to secure by letters patent, says the original patentee, is a shirt collar made of parchment-paper and coated with varnish of bleached shellac; but the patentee of the reissued patent claims as an article of new manufacture a collar made of long-fibre paper without referring to a coating of any kind; nor is the question affected in the least by the fact that the claim of the respective patents concludes with the phrase, "substantially as described," because the description of what is claimed, as given in the respective specifications, is even more widely different than the claims of the respective patents.

Instead of the phrase employed in the claim of the original patent, the specification to which it refers states that the nature of the invention consists, first, in making shirt collars of a fabric known to the trade as parchment-paper, or paper prepared with animal sizing, and second, in coating one or both sides of paper shirt collars with a thin varnish of bleached shellac, which, as there represented, not only adds smoothness, strength and stiffness to the fabric, but also, being a repellent of water, prevents perspiration or other moisture from entering the collar.

Nor will any attempt to construe the claim of the reissued patent by the specifications have any tendency to remove the difficulty in the way of the complainants, as the specification is to the same effect as the claim, and shows conclusively that the manufacture there described is a collar made of long-fibre paper manufactured in the manner and by the means therein minutely described; that the paper there described is not the parchment-paper described in the specification of the original patent, nor is it paper prepared with animal sizing, nor does the specification or claim of the reissued patent contemplate or require that either side of the collars shall be coated with varnish of bleached shellac for any purpose. Animal sizing, according to that patent, may be *used* or it may be *omitted*, and one or both sides of the paper may be covered with a thin varnish of bleached shellac, or such a coating may be *omitted* altogether, which shows that those two requirements of the original patent are not a material part of the invention embodied in the reissued patent.

Authorities to support the proposition that a reissued patent is invalid if not for the same invention as the surrendered original are scarcely necessary, as the rule is universally acknowledged. *Gill v. Wells*, 22 Wall., 1.

§ 402. *It appearing that the collars made by Evans, apart from the paper composing them, were identical in form, structure and arrangement with collars previously made of linen, paper of different quality, and of other fabrics, and that Evans did not invent the special paper used by him, nor the process by which it was obtained, held, that he was not entitled to a patent for the collars as a new manufacture.*

2. Suppose, however, the two may be so construed as to obviate that objection to the reissued patent, still the second defense of the respondents remains to be considered, that the patentee in the original patent is not the original and first inventor of the alleged improvement. Usually the patent when introduced is *prima facie* evidence to support the affirmative of that issue, but the representations of the specification may be such as to afford satisfactory proof that the alleged invention is neither new nor useful. Equivalent views were expressed by the circuit court in disposing of the question involved in the present issue, and in those views the court here entirely concurs. *Paper Collar Co. v. Van Deusen*, 10 Blatch., 119.

Nothing was known to the supposed inventor respecting paper made of

long fibre when he obtained his original patent, except that he previously found, as he states in his reissued patent, a sample of it ready made, suitable for such a purpose, and that he used it and filed it with his original application for a patent. Where he found it does not appear, nor does it appear for what purpose he used it, except that he filed it in the patent office. He does not even state that the original patentee knew who made it, nor that he had any knowledge of the process by which it was made. Viewed in any reasonable light the narration shows that the sample was made by another and not by the supposed inventor, and it affords a strong ground of presumption that he knew nothing respecting the process of manufacturing such paper, or of the constituents of the manufacture, except what is matter of common knowledge.

Hard stock, it is now said, must be used in larger proportions than is required for other descriptions of paper, and that the pulp must be subjected for a greater length of time to the long-beating process, so that the fibre shall be not only long but fine, in order that the paper may be strong, smooth and even, and that the fibre shall become bedded in the thickness of the paper so as not to mar the surface. Neither of such requirements or conditions was contained in the original specification, from which it may be inferred that the original invention did not include the discovery of the constituents of the paper to be used for the purpose, nor the process by which the paper was to be manufactured. Conclusive support to that proposition is found in the specification of the original patent, in which the patentee states that he takes the parchment-paper known to the trade, or paper prepared with animal sizing, and covers one or both sides of it with thin varnish of bleached shellac, and having allowed it to dry, the paper is then passed between polishing rollers, such as are in general use for polishing paper or cloth, which operation finishes the fabric ready to be made into collars.

Enough appears in these suggestions to show that the specification of the original patent does not describe the process of making paper possessing the qualities of long-fibre paper, but the making of collars out of parchment-paper, showing that the discovery that for a good paper collar the manufacturer must have paper which possesses the qualities of long-fibre paper is a subsequent discovery. Nor does the statement in the reissued specification, that he produced such a paper or caused it to be produced, strengthen the case for the complainants, because the same specification states in effect that he found a sample of such paper suitable for the purpose and that he used it and filed it with his original application, showing conclusively that the paper existed prior to his supposed invention.

Improvements in the manufacture of paper have often been made, and it may be that the discovery at that period of the constituents for making such paper, or of the process by which paper possessing the described properties could be produced, would have been the proper subject of a patent. Sufficient appears to show that the patentee learned from his experiments that he wanted paper of the qualities described in the reissued patent, and the evidence proves that he said so to the paper manufacturer, but it is clear that he did not communicate any information to the manufacturer respecting the process by which such paper could be produced, nor did he give the manufacturer any directions upon the subject. Information of the kind he could not communicate for the best possible reason, which is that he was utterly destitute of any knowledge as to the constituents of such paper or the process

by which it could be manufactured. Such paper was eventually produced by the manufacturer to whom the patentee applied to make the attempt, after many experiments as to the character of the materials suited to the end, and as to the mode of operation best adapted to effect the desired result, without any assistance whatever from the patentee.

Good paper collars may unquestionably be manufactured from that product, but it is nevertheless true that the patentee is not entitled to a patent for the collars as a new manufacture, for several reasons: (1) Because he did not invent either the product or the process by which the product is obtained. (2) Because the collars, apart from the paper of which they are made, are identical in form, structure and arrangement with collars previously made of linen, paper of different quality, and other fabrics. (3) Because it appears that the patentee is not the original and first inventor either of the paper or of the process by which the paper is made, or of the collar which is denominated a new manufacture.

§ 403. *New articles of commerce or manufacture are not patentable unless their production involve the exercise of invention or discovery beyond what was necessary to construct the apparatus for their manufacture or production.*

Articles of manufacture may be new in the commercial sense when they are not new in the sense of the patent law. New articles of commerce are not patentable as new manufactures, unless it appears in the given case that the production of the new article involved the exercise of invention or discovery beyond what was necessary to construct the apparatus for its manufacture or production. *Glue Company v. Upton*, 6 Off. Gaz., 840. Nothing short of invention or discovery will support a patent for a manufacture any more than for an art, machine or composition of matter, for which proposition there is abundant authority in the decisions of this court. *Hotchkiss v. Greenwood*, 11 How., 265; *Phillips v. Page*, 24 id., 167; *Jones v. Morehead*, 1 Wall., 162; *Stimpson v. Woodman*, 10 id., 121.

Suffice it to say that it is not pretended that the original patentee invented either the paper or the process, but the claim in argument is that he was the first person to conceive the idea that paper possessing the described qualities was desirable for the purpose of making such collars, and that inasmuch as he was not a paper manufacturer he had a right to employ trained skill to produce the desired product, and that he, under the circumstances, should be regarded as the actual inventor because he made known to the manufacturer that paper of such qualities would be useful, and because he employed the manufacturer to engage in the effort to produce the desired article; but the patentee communicated no information to the manufacturer as to the constituents or ingredients to be used, or as to the mode of operation by which they were to be compounded in order to produce the desired result.

§ 404. *Where one who has discovered a new and useful principle, machine, etc., employs another to assist him in perfecting it, and in the course of the experiments such employee makes discoveries ancillary thereto, they are generally regarded as the property of the employer, and may be embraced in his patent.*

Where a person has discovered a new and useful principle in a machine, manufacture or composition of matter, he may employ other persons to assist in carrying out that principle, and if they, in the course of experiments arising from that employment, make discoveries ancillary to the plan and preconceived design of the employer, such suggested improvements are in general to be regarded as the property of the party who discovered the original

principle, and they may be embodied in his patent as part of his invention.

§ 405. — *but where the suggestions of the employee communicated constitute the whole substance of the improvement, the rule is otherwise, because such employee is entitled to his own independent inventions.*

Doubt upon that subject cannot be entertained, but persons employed, as much as employers, are entitled to their own independent inventions; and if the suggestions communicated constitute the whole substance of the improvement the rule is otherwise, and the patent, if granted to the employer, is invalid, because the real invention or discovery belongs to the person who made the suggestions. *Agawam Company v. Jordan*, 7 Wall., 602.

Apply that rule to the present case and it is clear that the original patentee was not entitled to a patent either for the paper or the process, as he never made any invention or discovery upon the subject.

§ 406. *The reissued patent of Gray for the turning down of a paper or paper and cloth collar, on a curved instead of a straight line, is invalid for want of novelty.*

II. We come now to consider the reissued patent of Gray; one defense to which is that the patentee is not the original and first inventor of the improvement.

Three claims are contained in the reissued patent, substantially as follows: (1) The turning over of a paper or a paper and cloth collar by a defined line, whether pressed into the material by a die or pointed instrument, or by bending it over the edge of a pattern or block of the proper curve or line, substantially as described. (2) So turning the part B. of a paper or paper and cloth collar over towards the part A., in a curved or angular line, instead of a straight line, substantially as and for the purpose described. (3) So turning the part B. on to or towards the part A., in the manner described, as that a space shall be left between the two parts. This third claim it is admitted is substantially the same as the second claim, in consequence of which those two claims will be considered together.

1. Collars of paper or paper and cloth, if turned over on a defined line, are covered by the first claim, whether the line is curved, angular or straight, and whether the line is made or pressed into the fabric by a die or any pointed instrument, or marked or effected by bending the material over the edge of a pattern or block of the proper or preferred line or curve. Evidently, therefore, it is intended to cover collars turned over on a defined line effected in any possible manner or by any practicable means, if made of paper or paper and cloth. Shirt collars are turned over or down on a curved line in order to prevent the collars from puckering or wrinkling when bent in a circle, and in order to cause the part turned over or down to set out a little from the band portion of the same, so as to admit a necktie between the band and the part of the collar which is turned over.

Manifestly these objects are precisely the same whether the collar be all paper, paper and cloth, or all linen. Hence it is difficult to perceive upon what ground it can be held that any change in the manner of turning down a collar on a curved line, if made of any one of these fabrics, is patentable, if collars of either of the other fabrics have been turned down before in the same manner and precisely for the same purpose.

Evidence is exhibited which shows that many years before the patent was granted in this case paper envelopes and the tops and bottoms of paper boxes

were produced by shapers of steel pressed on the material so as to produce defined lines by which the material could be folded. Satisfactory proof is also exhibited that collars made of paper and cloth were, several years earlier than the date of this invention, folded over a piece of metal in a straight line, which is the same process as that described in the specification of this patent, as it appears that the material was bent over a pattern or block to give the proposed curve or line.

Plenary evidence is also exhibited showing that linen collars were ironed on blocks with a groove in the block by which the collar received a defined line for the folding, which accomplished the same purpose as the pattern or block.

Proofs were also exhibited showing that paper collars, long before the alleged invention under consideration, were folded by laying upon the unfinished side of the same a piece of tin having at one edge the required curve, which enabled the manipulator to accomplish the same object by pressing upward over such curve a part of the collar so as to mark the line of the curve and crease the paper preparatory to turning the collar over, which enabled the laundress to accomplish the same object as the means described in the specification of the patent.

Support to the answer is also derived from the proofs that linen collars had for years been turned over in a curved line and for the very purpose described, which is to prevent wrinkling and to afford space for the cravat. Taken as a whole, the proofs in this regard are conclusive, that the patentee is not the original and first inventor of the patented improvement described in either of the claims of his patent.

Decree affirmed.

Article of manufacture — *Patentability*, §§ 407-412. *A product is patentable as*, §§ 413, 414. *Novelty*, §§ 415-418.

§ 407. An article of manufacture, to be the subject of a patent, must be new as such in the sense of the patent laws, and must be the result of invention. *MacKay v. Jackman*, 12 Fed. Rep., 615.

§ 408. When a thing is produced new, in and of itself, it is patentable as a new manufacture. *Badische Anilin and Soda Fabrik v. Hamilton Manufacturing Co.*, 13 O. G., 273.

§ 409. In judging whether there is an improved result in an article of manufacture, the usual test is whether the production of the article is as good at a cheaper rate, or better in quality at the same rate, or with both of these consequences partially combined. *In re Smith*, 1 MacA. Pat. Cases, 255.

§ 410. In order to sustain a patent for a manufacture it is essential that invention or discovery must have been exercised in producing it. It is not enough that it is a new article of commerce. *Milligan & Higgins Glue Co. v. Upton*, 4 Cliff., 237.

§ 411. A patent for an article of manufacture cannot be sustained on the ground that it was fabricated by new and improved machinery; it must be a new and improved thing in itself, possessing novelty of its own independent of the devices, processes or arts by which it was produced. *Draper v. Hudson*, 1 Holmes, 208.

§ 412. No new manufacture is anything more than a new combination and arrangement of old materials; and whenever such new combination and arrangement produces a new and useful result, there being diversity of method and diversity of result, the invention is patentable. *Goodyear Dental Vulcanite Co. v. Smith*, 1 Holmes, 354.

§ 413. A new product of an old process is patentable as a new article of manufacture. *Merrill v. Yeomans*, 1 Holmes, 331.

§ 414. A new product or article of manufacture is patentable as a manufacture; and where the patent describes the product and the mode of making it, having certain characteristics which are defined, and stating that they were never produced before, it is a sufficient specification of a claim. *United Nickel Company v. Pendleton*, 15 Fed. Rep., 739.

§ 415. Where the patent was construed to be for an article of manufacture made by a par-

ticular process, it was held not anticipated by a similar article made by a different process. *Rogers v. Sargent*, 7 Blatch., 507.

§ 416. An old article made upon a new machine is not a new manufacture in the sense of the patent law. *Draper v. Hudson*, 1 Holmes, 208.

§ 417. Slight variations of form, or of superior smoothness, will not make such things new articles of manufacture, if they are used in the same way and for the same purpose, and effect a like result in the same application as the older forms. *Hatch v. Moffitt*, 15 Fed. Rep., 252.

§ 418. *Semble*, that if an article had been made by hand in such way that it might have been used separately from the larger thing to which it was joined, though there was no occasion so to use it, it cannot be patented as a new article of manufacture. *Ibid.*

See Art, § 383. *Claims, Construction of*, § 782. *Composition of Matter*, §§ 1117-1145. *Process and Product. Product, Reissues*, §§ 5562, 5563. *Substantially as Described*, § 6195.

29. ARTICLES, MARKING PATENTED.

See MARKING PATENTED ARTICLES.

30. ARTICLES "PATENTED," MARKING.

See MARKING ARTICLES "PATENTED."

31. ASSIGNMENT.

Assignment — Statutes, construction of — *Revised Statutes*, § 419. *Act of 1870*, § 420.

§ 419. Section 4898, Revised Statutes, requires that the assignment of a patent be by an instrument in writing. The ability to make the instrument, however, or the aids to a disability, must be found in the laws of the states, where all such rights are regulated. *Fetter v. Newhall*, 17 Fed. Rep., 841.

§ 420. The distinction between patentees, assignees, grantees of exclusive rights, and licensees, made by the law of 1836, and thereafter defined by the courts, has not been changed by the act of 1870. *Nelson v. McMann*, 16 Blatch., 139.

See *Assignees*, §§ 529-571. *Grant*, §§ 2631-2647. *Patents*, § 4756. *Statutes*, § 6175.

Assignments — Construed, §§ 421-434.

§ 421. Instrument construed to be an assignment of an exclusive right, with license to patentee under the assignment. *Washburn v. Gould*, 3 Story, 122.

§ 422. Where there was an assignment of a patent interest, conditioned on assignee defraying expenses of patenting, and subsequently, in accounting for breach of covenants, assignee was found to have charged patentee with expenses defrayed in obtaining the patent, *held*, that it was an acquiescence in his abandonment of claim to interest in patent under the assignment. *Kittle v. Frost*, 9 Blatch., 214.

§ 423. An instrument in which the patentee of a certain process grants to A. the exclusive right to manufacture and sell rolls for crushing grain or middlings, or other substances, held not to amount to such an assignment as to disable patentee from suing persons generally who infringe his patent. *Dillon, J. Held per contra* by Treat, J., that patentee was estopped as to all third parties by admission over his own name; and that A. was the only proper party in a suit brought to reform the contract. *Downton v. Yaeger Milling Co.*, 3 McC., 414.

§ 424. Where the right to make machines for the use expressly granted passed, *held*, that it included the right to procure them to be made, and covered the making them by one procured to make them. *Steam Stone Cutter Co. v. Shortsleeves*, 16 Blatch., 381.

§ 425. *Held*, that an assignment of the right to manufacture a particular form of mechanism by which a process could be practiced was not an assignment of the patent covering the process; neither would it be held such in the absence of satisfactory evidence that such was the intent of both parties. *Downton v. Allis*, 9 Fed. Rep., 766.

§ 426. Assignments of patents are not required to be under seal. The statute simply provides that "every patent or any interest therein shall be assignable in law by an instrument in writing." *Gottfried v. Miller*, 14 Otto, 521.

§ 427. An assignment therefor, purporting on its face to be the contract of the corporation therein named, declaring that the consideration has been received by the company, that it is executed in pursuance of a resolution passed by the company and purporting to be signed by

Smith, president of the company, who declares that he signs it as the act of the company, is transfer of said company and not the personal deed of Smith. *Ibid.*

§ 428. Execution of an assignment of a patent by the president of a corporation, executed by the signature of the corporation, and by S., president, held to carry not only the interest of the corporation but also the individual interest of the president. *Campbell v. James*, 17 Blatch., 42.

§ 429. Where a patent has been allowed and ordered to issue and an assignment has then been made, authorizing the commissioner to issue patent to assignee, and patent issue to inventor, the assignment not having been recorded until after the issue of the patent, *held*, that the legal right to the patent became vested in the assignee on the recording of the assignment. *United States Stamping Co. v. Jewett*, 18 Blatch., 469.

§ 430. *Bona fide* purchasers for value, without notice, under an instrument of assignment which was duly recorded, whereby interests are assigned in an unpatented invention, and wherein the commissioner is requested to issue the patent to such assignees, as was duly done, can convey a good title to such patent as against prior assignees of a prior patent which was issued to the same inventor, to whom such inventor at the same time assigned interests in new inventions which he had made, of which the invention above referred to was one, the prior instrument of assignment having been executed and recorded first, and the invention, the nature of which was definitely referred to in such prior instrument, having been made before any of such assignments. *Wright v. Randel*, 19 Blatch., 495.

§ 431. *Held*, that in an assignment the words "claim or demand whatsoever, in, to or under" the patent are not sufficient to cover claims for past infringement. *Dibble v. Augur*, 7 Blatch., 86.

§ 432. The bill charged infringement by defendant while the patent was owned by plaintiff's assignee, and set forth *in hæc verba* the assignment of the patent, together with "all the right, interest and claim for and to the past use of said invention and improvement under the said letters patent," and prayed for an injunction and for an increase of damages, "in addition to the profits and gains to be accounted for by the defendant," together with "such other and further relief as shall be agreeable in equity." *Held*, that the assignment which was proved by the instrument itself applied to infringement before as well as after assignment, and that the plaintiff was entitled to recover under such bill without doing violence to any of the well-settled rules of pleading. *Campbell v. James*, 18 Blatch., 92.

§ 433. Words "as mentioned in the patent of 1851," in an assignment, construed to simply refer to the machine without reference to any particular description. *Burdell v. Denig*, 2 Fish., 588.

§ 434. An assignment of a patent, "to be applied exclusively to the knitting or construction of harnesses for looms and for other purposes," means *harnesses* for other purposes. *Aiken v. Dolan*, 3 Fish., 197.

Assignment — Of invention — *Invention is assignable prior to patenting*, §§ 435-438. *Is conveyed by a full assignment*, §§ 439, 440. *Distinguished from assignment of patent*, § 441.

§ 435. Inventions may be assigned before they are patented. *Cammeyer v. Newton*, 4 Otto, 225.

§ 436. Patentable inventions may be assigned before the issuing of the patent. *Hendrie v. Sayles*, 8 Otto, 546.

§ 437. Under act 1837, section 6, and act 1839, section 10, an assignment of an invention by patentee subsequent to application and prior to grant of patent is valid, and assignee can sue in his own name. *Gay v. Cornell*, 1 Blatch., 506.

§ 438. A valid assignment of an invention can be made prior to the grant of the patent, and the patent will vest in assignee on the grant. (Act 1793.) *Herbert v. Adams*, 4 Mason, 15.

§ 439. A full assignment by the inventor gives assignee the whole benefit of the invention, including the original and any extended term. *Sayles v. Dubuque & Sioux City R. Co.*, 5 Dill., 561.

§ 440. A conveyance of the described invention without qualification or limitation carries with it its incidents — the inchoate right to the renewal as well as to the original term. *Hendrie v. Sayles*, 8 Otto, 546.

§ 441. A conveyance of letters patent distinguished from a conveyance of both the letters patent and the invention. **Gear v. Grosvenor*, 1 Holmes, 215.

See *Inchoate Right*, §§ 2814, 2815. *Invention*, § 3564.

Assignment — Mesne, §§ 442, 443.

§ 442. The inventors assigned the whole of their invention, before a patent therefor was granted, to B., who subsequently assigned it to C. C., in turn, assigned it to D. All of these

assignments were executed and duly recorded in the patent office more than two years before the patent was granted. The patent was granted to B., the immediate assignee of the inventors, who at the time the patent was issued had no interest of record in the invention. *Held*, that the patent so granted was valid. *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 33 O. G., 1597.

§ 443. Where A. transferred to B. by unrecorded assignment all his right, etc., and B. transferred by duly recorded assignment to C. his interest, and subsequently B., by duly recorded assignment, transferred the same to D.; whereupon, by assignment recorded the same day, C. reconveyed his interest to B., and D. did the same to E., whose executor plaintiff was, *held*, that plaintiff had no title. *Perry v. Corning*, 7 Blatch., 195.

See *Title*, § 6310.

Assignment — Of past damages, §§ 444-450.

§ 444. The profits recoverable in an action for the violation of an exclusive right under a patent are not regarded in the light of unliquidated damages, and an assignment which transfers to the complainant the right to sue for infringements of the patent is not void. *Jenkins v. Greenwald*, 1 Bond, 126.

§ 445. In assigning a right in action the person to be notified is he against whom the action is pending, so that he may not pay the wrong person. *Gear v. Fitch*, 16 O. G., 1231.

§ 446. An assignment of past profits and damages for the infringement of a patent, when made in connection with the transfer of the title of the patent itself, courts of equity will uphold; and if absolute and unconditional, and there is no remaining title or interest in the assignor to be affected by the decree, the assignor is not a necessary party. *Henry v. Frances-town Soap-stone Stove Co.*, 9 O. G., 408.

§ 447. Where plaintiffs, after bringing suit, parted with their exclusive interest, including state where suit was brought, except as to certain states, and reserved "their rights, so far as they are connected with said suit," with "the profits and damages therein," *held*, they were entitled to damages down to time of suit only, and not to an injunction. *Boomer v. United Power Press Co.*, 13 Blatch., 107.

§ 448. The profits or damages for infringement cannot be sued for except on a basis of a title as patentee, or as such assignee or grantee, to the whole or a part of the patent, and not on the basis merely of an assignment of a right to a claim for profits and damages severed from such title. *Gordon v. Anthony*, 16 Blatch., 234.

§ 449. A suit may be maintained to recover past damages for infringement, although the parties plaintiff have parted with their interest in the patent at the time suit is brought. *Spring v. Domestic Sewing Machine Co.*, 22 O. G., 1445.

§ 450. The claims for profits or damages arising from infringements prior to the plaintiff's purchase are choses in action, and the assignee takes the title subject to all the equities existing against the assignor. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 Fed. Rep., 638.

See *Answer*, § 220. *Assignment*, §§ 430, 511. *Jurisdiction*, §§ 3929, 3930. *Right of Action*, §§ 5871-5877.

Assignment — Under two patents, §§ 451-453.

§ 451. If one owns two patents of different dates to manufacture goods, and sells to A. his rights under one specifically, and to B. the right to manufacture the goods generally, the fair construction of the latter grant will be held to be a conveyance of the right to manufacture under both patents. *Day v. Stellman*, 1 Fish., 487.

§ 452. Under an assignment by the inventor of two patents, wherein the only new idea in common is carried out by a construction and mode of operation substantially different in each, of the earlier, together with the right to improvements to be subsequently invented or patented in, or of, or in aid of, the inventions or improvements of the same, the later patent granted to him would not be included. *Stebins Hydraulic Elevator Manufacturing Co. v. Stebins*, 4 Fed. Rep., 445.

§ 453. An assignment by A., owner, under two patents, of a patent right in a certain county to B., of the right to use and sell in said county, "S.'s patent sewing machines, as mentioned in the patent granted S., August 12, 1851," is a clear assignment of all B.'s right in the S. machines under both patents. *Burdell v. Denig*, 2 Fish., 588.

Assignment — Of territorial rights, construed, §§ 454-467.

§ 454. Under act 1836, section 11, exclusive right in patent, construed to mean an exclusive right to the patent in a particular section of country. *Washburn v. Gould*, 3 Story, 122.

§ 455. Act 1870, section 36, embodied in section 4898, Revised Statutes, the words "exclusive right," under a patent, to a specified part of the United States, means an exclusive right to do everything under the patent, in such specified part, which the patentee could do, and is the same thing as the "exclusive right," under the patent, "to make and use, and to grant to others to make and use, the thing patented, within and throughout" such specified part. *Nelson v. McMann*, 16 Blatch., 139.

§ 456. Held, that an unrestricted assignment of all right, title and interest in a particular territory conveys a right to vend the article in the territory to be used out of it. *McKay v. Wooster*, 2 Saw., 373.

§ 457. Where there was a prior conveyance to plaintiff of a right in two counties, but recorded in the patent office subsequent to a conveyance to defendants of all of patentee's right, title and interest in and to said letters patent in the following described territory, held, that the latter assignment did not necessarily include the two county rights, but only all the right which the assignor then had. *Turnbull v. Weir Plow Co.*, 9 Biss., 334 (§§ 479, 480).

§ 458. An assignment purporting to convey all the right, title and interest in letters patent "excepting thirty-two or thirty-three counties, heretofore sold and assigned," without designating the counties thus previously sold, is not so far ambiguous as that nothing passes thereby, the reservation being such as is capable of being made certain by competent evidence, showing what counties have been actually conveyed. *Washburn & Moen Manufacturing Co. v. Haish*, 10 Biss., 65.

§ 459. A grant by a patentee of "the sole and exclusive right to manufacture and sell machines" in a given city is an absolute assignment without restriction within the limits prescribed. *May v. Chaffee*, 2 Dill., 385.

§ 460. A conveyance of "all my right, title and interest in and to" a patent, though properly recorded, does not include the right for two counties covered by a prior conveyance, although the prior conveyance was not recorded in the patent office. *Turnbull v. Weir Plow Company*, 9 Biss., 334 (§§ 479, 480).

§ 461. Doubted whether an assignee of a territorial right under a patent could sell the patented article so as to authorize the use of it in a territory, the whole right in which had been sold to another before he purchased. *McKay v. Wooster*, 2 Saw., 373.

§ 462. Doubted what the effect would be of a clause in a deed of a territorial right expressly restricting the right to sell for use so that only sales for use in the territory shall be made under it. *Ibid.*

§ 463. It is not a fair construction of the assignment of a patent that the assignee shall first assign the entire right for a particular territory, and get its whole value from his vendee, and, after having thus received all the benefit he was entitled to under the transfer, sell single machines to be used in the same territory during the extended term. *Union Paper-Bag Machine Co. v. Nixon*, 1 Flip., 491.

§ 464. An assignment of an invention prior to patenting to A., B. and C., without giving their Christian names, held to be sufficiently certain as to the parties. *Fisk, Clark & Flagg v. Hollander Bros., MacArth. & Mack.*, 355.

§ 465. Where a patent was purchased and an assignment taken with knowledge of an existing agreement and license under it between the vendor and another, *held*, that the purchaser could be restrained from violating the terms of the agreement. *Hapgood v. Rosenstock*, 23 Fed. Rep., 86.

§ 466. Where two parties, having different patent rights individually, and having also joint patent rights, joined in an instrument giving a third party sole powers, with certain exceptions, to convey the rights, etc., etc., all under certain restrictions, in trust for the benefit of the owners, to continue for the unexpired term of the patent, *held*, that it made the assignee an agent joined with an interest to carry out the joint instruction of the makers; and that the statute prohibiting perpetuities had no application. *Ladd v. Mills*, 20 Fed. Rep., 792.

§ 467. Where plaintiff assigned a patent to defendants without informing them that a device claimed in combination therein was covered by a prior patent, against which prior patent plaintiff subsequently defended them, and had it declared void, and defendants had manufactured under the assignment and paid royalties, *held*, that they could not escape liability for royalties in arrear on the plea of fraud. *Shaw v. Soule*, 20 Fed. Rep., 790.

See *Assignment*, § 492. *Grantee*, §§ 2648-2653. *Infringement*, §§ 2906-2910. *Sale*, § 5921.

Assignments — By administrator, §§ 468-471.

§ 468. An assignment of a patent by an administrator is valid under the act of July 8, 1870. The decision in the case of *The Shaw Relief Valve Company v. The City of New Bedford* approved on this point. *Bradley v. Dull*, 19 Fed. Rep., 913.

§ 469. R. agreed with M. to apply for an extension of his patent, and to assign the same, when procured, to M. M. sold his interest in this contract to the U. P. B. Mach. Co. R. dying

before the extension was had, his wife was appointed executrix of his will, applied for and procured the extension, and assigned the same to the U. P. B. Mach. Co., but the assignment described herself as "administratrix," etc. The assignment was duly recorded. Subsequently the widow resigned her trust as executrix, and I. was appointed administrator with the will annexed. I. executed an assignment of the extended term of the patent to N., and N. brought suit for infringement. *Held*, that the recorded assignment to the U. P. B. Mach. Co., notwithstanding the erroneous description of the party executing it, was constructive notice to N. of the claim of an adverse title in the patent, the nature of which he should have ascertained by inquiry; and that this alone was sufficient to defeat complainant's title. *Held*, further, that, in fact, the assignment to the U. P. B. Mach. Co. was valid, notwithstanding the erroneous description of the representative character of the executrix. *Newell v. West*, 13 Blatch., 114.

§ 470. Where an inventor and patentee entered into a written contract with one of the part owners of the patent, to procure, if possible, an extension of the same, and, under such contract, received a valuable consideration, and after his death, his wife, as executrix, procured such extension, and conveyed, by assignment, duly recorded, such extended patent to the assignees of said part owner, who was a party to the original contract with the inventor and patentee, it was *held*, that, upon the resignation of the trust as executrix, and the appointment of an administrator with the will annexed, such administrator could not make a legal assignment of such extended patent so as to vest the same in another and different party than the assignee of the executrix. *Ibid*.

§ 471. An assignment of a patent by one of two administrators is good, and passes the entire interest. *Wintermute v. Redington*, 1 Fish., 239.

Assignment—In bankruptcy and insolvency, §§ 472-474.

§ 472. Assignment in bankruptcy under the bankrupt law (§ 5040, R. S.), vests all patent rights at once in assignee, and need not be recorded, and prevails over a recorded assignment made after the bankruptcy by the bankrupt's administrator. *Prime v. Brandon Mfg. Co.*, 16 Blatch., 453.

§ 473. Neither an assignee in insolvency nor a receiver can acquire or pass a title to a patent, except by a written instrument, signed by the owner of the patent and duly recorded. *Gordon v. Anthony*, 16 Blatch., 234.

§ 474. An assignment of a patent-right executed by a judge of probate in accordance with the insolvent law of a state transfers nothing to the assignee, although it is provided by the state law that it shall pass all the property of the debtor which he could have conveyed. *Ashcroft v. Walworth*, 1 Holmes, 152.

Assignment—Recording.

SUMMARY (*TURNBULL v. WEIR PLOW COMPANY*, §§ 475-478)—*Object of recording act*, § 475.—*Effect of second recorded assignment over a prior unrecorded*, §§ 476, 477.—*Construction of recording act of 1870*, § 478.

(*TURNBULL v. WEIR PLOW COMPANY*, §§ 479, 480)—*Effect of second recorded assignment over a prior unrecorded one*, § 479.—*Assignment to make and sell includes right to use*, § 480.

TURNBULL v. WEIR PLOW COMPANY.

(Circuit Court for Illinois: 6 Bissell, 225-232. 1874.)

Proceeding in equity for an injunction restraining defendant from infringing plaintiff's patent, and for an account.

Opinion by DRUMMOND, J.

STATEMENT OF FACTS.—The question in this case arises upon the plea of the defendant, from which, and from the bill of complaint, the following facts appear: A patent was issued to one McQuiston on the 18th of October, 1859, for an improvement in cultivators, and reissued on the 16th of May, 1871. Both parties claim under this patent. The defendant claims under a conveyance from William S. Weir, who purchased from the patentee on the 18th of November, 1870, and the assignment of purchase was recorded on the 5th of December, 1870. The terms of this assignment were that the patentee granted and conveyed to William S. Weir, through whom the defendant

claims, "all my right, title and interest in and to the said letters patent in the following described territory" (within which we may concede, for the purposes of the case, was included the state of Illinois), ". . . as fully and entirely as the same would have been held and enjoyed by me if this assignment had not been made."

On the 17th and 26th of April, 1860, the patentee assigned to the parties through whom the plaintiffs claim, the exclusive right to make and to sell all machines and rights under the patent, in the territory comprising the counties of Warren and Henderson, in Illinois. These assignments were not recorded in the patent office at the time that Weir's assignment was recorded, and the question presented by defendant's plea is as to the effect of the assignment to Weir, recorded in December, 1870, as against the assignments through which plaintiffs claim, and which were not then recorded.

§ 475. *The object of the recording act is to protect bona fide purchasers, without notice of prior assignment; as between the parties themselves to an assignment, it is valid without recording.*

I think there can be no question but that, under the eleventh section of the act of congress of 1836, as between the parties, the assignment by the patentee of the right under the patent would be valid without recording. In other words, the recording did not give it effect as between them. The only object of the law, I think, in requiring the assignment to be recorded, was to protect *bona fide* purchasers without notice of prior assignment of a right under the patent. It is contended, on the part of the defendant, that as it has been the practice for many years for rights under a patent to be conveyed by an assignment, the language of which is, "all the right, title, and interest" of the patentee in the patent, it substantially amounts to a warranty on the part of the patentee that he conveys by such language all the right which he ever had under the patent, and therefore, that when this language was used in the assignment to Weir in October, 1859, it meant all the interest which the patent originally conveyed to the patentee within the territory named.

§ 476. *Effect of a second assignment of patent-rights which is recorded, over a prior unrecorded assignment thereof.*

Of course the controversy turns upon what is the true construction of this assignment. Without deciding what might be the effect of an assignment of all the right, title and interest of the patentee in a particular county, where there was no residuary interest left in the patentee, I am of the opinion, notwithstanding this alleged uniform practice as to assignments, that the true construction of such an assignment is, that where there is a residuary interest left in the assignor under the patent, within the territory mentioned, it must be construed as only conveying that residuary interest. I mean, of course, where he has previously parted with some interest under the patent in a portion of the territory. For example, in this case, so far as we know from the history of the case and what is before us in the pleadings, the patentee had conveyed all his interest in the patent in Henderson and Warren counties in 1860, but he had left and had a right to convey all his remaining interest in the state of Illinois. And when he stated that he conveyed all the interest which he had under the patent in the state of Illinois, and that the assignment was to vest in the assignee all his right under the patent in the state of Illinois as fully and entirely as the same would have been held and enjoyed by him if the assignment had not been made, we must construe it as not indicating on his part an intention to convey what he had previously conveyed to other par-

ties, viz., his rights under the patent in the counties of Warren and Henderson. Otherwise we must infer that he was perpetrating a fraud on the assignee by the assignment of 1870.

The question is, what is the legal effect of the language used, or what did he mean? We have nothing to guide us except the language of the contract. Did he intend, and is it necessarily the legal construction of that contract from the language used, that he intended to convey, in November, 1870, what he had previously conveyed in April, 1860? If, as I have already intimated, there was nothing on which the conveyance of 1870 could operate, then a different question would arise. But the whole state of Illinois, except the counties of Henderson and Warren, was left, upon which the conveyance could take effect. And I think that, looking simply to the contract, notwithstanding the practice which is said to have grown up under the law as to the form of these assignments, we must hold that where there was anything upon which the assignment could be said fairly to operate, we cannot construe it as showing an intention on the part of the assignor to convey what he had previously conveyed. In other words, we will not infer from language such as this, and in the absence of any proof upon the subject, that the patentee intended a fraud upon his assignee.

§ 477. *Where there has been a conveyance of property which is unrecorded, and a conveyance afterwards of the grantor's right and title in the same property which is recorded, if there is anything upon which the second conveyance can operate, it does not cut off the prior unrecorded deed.*

This is the general rule as applicable to conveyances of real estate. The question always is, did the person intend to convey,—and is that the true meaning of the language used in the instrument,—the same property and the same rights that he had previously conveyed to other parties? If he did, and if that is the necessary construction of the language, then it may be fairly said that the recording law should operate upon it, as well in the case of the conveyance of lands as the assignment of rights under a patent. But I think the result of the authorities as to the conveyance of real estate is, that where there has been a conveyance of property which is unrecorded, and there is a conveyance afterwards of the property which is recorded, and there is anything upon which the second conveyance can operate, where it purports to transfer simply his right and title, it does not cut off the prior unrecorded deed. Perhaps the authorities go further and hold, in the case of real estate—at least such seems to be the intimation of the supreme court of the United States—that a mere quitclaim of the right and title of the grantor will not, *per se*, operate as against the prior unrecorded deed, which purports to convey the property.

§ 478. *Language of thirty-sixth section of act of 1870 not substantially different from that of the eleventh section of the act of 1836, as construed by the courts.*

The act of 1836 declared that a patent should be assignable, either as to the whole interest or any undivided part thereof, by any instrument in writing; and that the assignment should be recorded in the patent office within three months from the execution thereof. Now the language of the eleventh section of the act of 1836, as construed by the courts, is not essentially different from the language of the thirty-sixth section of the act of 1870. The courts have construed the assignment, where it was not recorded, to be void as against parties who held by the subsequent assignment purporting to transfer,

when recorded and taken in good faith, and without notice of the prior assignment or conveyance. The language of the thirty-sixth section of the act of 1870 is, that "said assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration without notice, unless it is recorded in the patent office within three months from the date thereof." I do not understand that this language is substantially different from that of the eleventh section of the act of 1836, as construed by the courts, so that I hold that we cannot construe the language of the assignment made in November, 1870, to Weir, under whom the defendant claims, as intending to convey the right and title under the patent within the counties of Warren and Henderson, which the patentee in 1860 had conveyed to another party, through whom the plaintiffs claim. The result, therefore, is, that the assignment in 1860 is operative. The plea of defendant is therefore overruled.

TURNBULL *v.* WEIR PLOW COMPANY.

(Circuit Court for Illinois: 9 Bissell, 334-337. 1880.)

Opinion by DRUMMOND, J.

STATEMENT OF FACTS.—I think the plaintiffs in this case were entitled to a decree. Some of the questions involved are of importance, and have been re-argued in this case. The bill charges an infringement by the defendants of two claims in the patent issued originally October 18, 1859, and reissued in 1871, for some improvements in a plow or cultivator. One of the principal, and the most important, question in the case arises under the law of congress upon the subject of patents. The patent was issued originally to Thomas McQuiston, and the plaintiffs claim through him the right in two counties, Warren and Henderson, in this state, to use the improvement patented. The conveyance by McQuiston, through which the plaintiffs claim, was not recorded in the patent office at the time the conveyance through which the defendants claim was made by McQuiston and recorded. In other words, the conveyance through which the defendants claim from the patentee was first recorded in the patent office before that through which the plaintiffs claim was recorded.

§ 479. *Where there was a residuary interest left in the assignor under a patent within the territory mentioned, the words "all the right, title and interest" of the patentee, in the conveying clause of an assignment, construed as only conveying such residuary interest, though the prior deed of assignment, by which the patentee had alienated a part of his original interest in the territory specified, had not been recorded when the later assignment was made.*

I stated at the time I decided this question before (*Turnbull v. Weir Plow Co.*, 6 Biss., 225; §§ 475-478, *supra*), that it was one of great difficulty, and about which I had some doubt, because the decision seemed to be contrary to the practice adopted in the patent office as to the construction which was there placed upon assignments of patents. After the patentee had made an assignment of the right to these two counties in Illinois, he made an assignment through which the defendants claim, which assignment, it is insisted, according to the general scope of the language, would include the two counties which had been previously assigned by the patentee, and under which the plaintiffs claim. The language of the assignment to the defendants is as follows: "Do hereby grant and convey to the said William S. Weir all my right, title and interest in and to said letters patent in the following described

territory.” The construction which the court formerly placed upon that assignment was, that it did not necessarily include the right which had been previously conveyed by the patentee in the counties of Warren and Henderson, but only included all the right which the assignor then had. The language of the statute authorizing assignments in writing to be made of rights secured by letters patent is somewhat different from that contained in this assignment, and also in the form which was given by Mr. Fisher at the time he was commissioner of patents. The language in the statute in substance is this: All the right which was secured to the patentee by letters patent. U. S. Rev. Stat., § 4898. The language used in the form prescribed by Mr. Fisher is substantially like that used in the assignment through which the defendants claim; “all the right, title and interest in and to said letters patent.” It is quite clear to my mind that Mr. Fisher, at the time he prescribed this form, was not thinking of the case where a patentee had disposed of a portion of his interest in the letters patent, as, for example, in such a case as this, where he had assigned the right in a particular territory, reserving his right to other portions of the territory covered by the patent; and, therefore, I cannot hold that the form prescribed by Mr. Fisher has the same efficacy as that prescribed by the statute itself. Where a man assigns all the right which was conveyed to him by letters patent, the meaning is that the assignment takes with it everything that the letters patent conveyed. It is certainly different from an assignment which declares merely that he assigns all the interest which he, at the time he makes the assignment, has in the letters patent, provided, as in this case, he had previously assigned a part of the interest which he had to another person. So, that, admitting that the question is one of difficulty and doubt, I must still adhere to the view which I originally took of this case, and hold that it was not the intention of the assignment which was made to Weir, and through which the defendants claim, to convey to him the interest, which had been previously conveyed by the patentee, in the counties of Warren and Henderson in this state.

§ 480. *An assignment to make and sell includes the right to use.*

Another objection made to the right of the plaintiffs to recover is, that the conveyance to them did not include the right to use as well as to make and sell the improvement patented within those counties. I think that the assignment to make and sell includes necessarily the right to use the thing patented, because, without the right to use, the right to make and sell would be a barren right. It must be construed as having been the intention of the parties that the right to manufacture and sell included the right in the vendee to use the thing sold.

There is nothing in the case to estop the plaintiffs from setting up a claim under this patent in consequence of any supposed laches that they may have committed; and I think it must be considered that the defendants, under all the circumstances in the case, have infringed upon the right of the plaintiffs. I have not the models of the machines here, without which a statement of the particular points constituting the claim of infringement by the defendants would be unintelligible. It is sufficient to say that I have heretofore fully considered those questions, and have reconsidered them on the argument which has been made, and have reached the conclusion which I then formed, although perhaps I did not particularly state it at the time.

It may be said the case is not one of very great importance in some respects;

that is, it includes only two counties in this state; but, as I have said, some of the questions involved are quite important, and particularly as to the construction, under the patent law, of the assignments in this case.

Assignment — Recording — *Act 1836*, §§ 481-484. *Act 1837*, § 485. *Revised Statutes*, section 4898, §§ 486, 487. *Revised Statutes*, section 4895, § 488. *Unrecorded*, §§ 489-491. *Territorial right, and recordable under act of 1836*, § 492.

§ 481. *Act 1836*, section 11, recording assignments, reviewed. *Brooks v. Byam*, 2 Story, 525; *Boyd v. McAlpin*, 3 McL., 427.

§ 482. Recording assignments, under act 1836, is directory only. *Brooks v. Byam*, 2 Story, 525.

§ 483. *Act 1836*, section 11, directing the recording of assignments in the patent office within three months, construed to be merely directory, for the protection of *bona fide* purchasers without notice, and the recording of an assignment is not a prerequisite to its validity. *Pitts v. Whitman*, 2 Story, 609.

§ 484. *Act 1836*, section 11, requiring deeds or assignments to be recorded within three months, is merely directory, and, except as to intermediate *bona fide* purchasers without notice, any subsequent recording of such papers will pass title to assignee. *Olcott v. Hawkins*, 2 Am. L. J., 317.

§ 485. It is enough, within the terms of act 1837, section 6, if an assignment of an invention prior to patenting be recorded at any time before the issuing of the patent. *Gay v. Cornell*, 1 Blatch., 506.

§ 486. A conveyance or assignment of the right to maintain suits under a patent after the grant has expired — mere choses in action — is not required to be recorded under section 4898, *Revised Statutes*. *Gear v. Fitch*, 16 O. G., 1231.

§ 487. Section 4898 of the *Revised Statutes* does not provide for the recording of assignments, grants, and conveyances of interests in patents not yet issued. *Wright v. Randell*, 19 Blatch., 495.

§ 488. Section 4895 of the *Revised Statutes* makes no provision for the recording of an assignment of an unpatented invention on which the patent is not to be issued to the assignee; therefore its record is not constructive notice of its contents to one who subsequently deals with a party to it in respect to its subject-matter. *Ibid.*

§ 489. An unrecorded assignment is valid against a wrong-doer; the provision requiring the recording is merely directory for the protection of *bona fide* purchasers without notice. *Hall v. Speer*, 6 Pitts. L. J., 403.

§ 490. An agreement which operates as a transfer of a patent is good as against the patentee, and those who purchase with notice, though not recorded. *Continental Wind Mill Co. v. Empire Wind Mill Co.*, 8 Blatch., 295.

§ 491. As against a purchaser in good faith, for value, without notice of any prior assignment, an assignment not recorded within the time limited in the act is not valid and will not affect his rights acquired from the patentee before such record is made, but is valid and effectual according to its purport against the assignor and all others except third persons, who in good faith, for value, without notice, became purchasers or acquired rights or interests in or under the patent. *Perry v. Corning*, 7 Blatch., 195.

§ 492. Under act 1836, section 11, the assignment or grant of an exclusive right in the patent within a given territory must not only be in writing, but recorded within three months, to defeat a subsequent purchaser without notice and for a valuable consideration; within that period an unrecorded prior assignment would prevail. *Gibson v. Cook*, 2 Blatch., 144.

See *Assignment*, § 469. *Burden of Proof*, § 663. *Purchase*, § 5181. *Title*, §§ 6308, 6309.

Assignment — Of extended term, construed, §§ 493-512.

§ 493. An assignment made prior to 1836, conveying an "alteration or renewal" of the patent, construed to pass an extended term granted under act of 1836. *Wilson v. Turner*, Taney, 278.

§ 494. An assignment "to the utmost and fullest extent as to duration of one's right under said letters patent," held to convey the extended term. *Chase v. Walker*, 3 Fish., 120.

§ 495. An assignment of "the said invention as secured to me by letters patent," "to the full end of the term for which said letters patent are or may be granted," construed to convey the extended term. *Ruggles v. Eddy*, 10 Blatch., 52.

§ 496. An assignment during pendency of application of "all the right, title and interest whatsoever which we now have, or by letters patent would be entitled to have and possess, in the aforesaid invention," held to confine the grant to the right which would have been com-

pleted and secured by the patent then applied for, and not to include the extended term. *Mowry v. Grand St. & Newton R. Co.*, 10 Blatch., 89.

§ 497. An assignment by patentee of an "undivided fourth part of all right, title and interest which I have in the said invention, as secured to me by said letters patent," *held*, in view of *Railroad Co. v. Trimble*, 10 Wall., 378, to convey the extended term. *Thayer v. Wales*, 5 Fish., 448.

§ 498. A conveyance previously executed of an interest in the extension of a patent becomes operative upon the extension being granted, and the title passes thereupon to the purchaser. *Gear v. Grosvenor*, 1 Holmes, 215.

§ 499. A conveyance of all the grantor's "right, title and interest in letters patent for the full term for which they are or may be granted," without any reference to the extended term, conveys no interest in it. *Ibid*.

§ 500. Although the *habendum* clause contains the words "to the full end of the term for which said letters patent are or may be granted," the extended term will not pass. *Ibid*.

§ 501. *Held*, that in a conveyance of "all of the aforesaid inventions and letters patent. And, whereas, I also agree to assign and convey any further patents," etc., the words "further patents" cover an extension. *Prime v. Brandon Mfg. Co.*, 16 Blatch., 453.

§ 502. An assignment by a patentee of "all the right, title and interest" which he has "in the said invention," to be held by the grantee "to the full end of the term for which the said letters patent are or may be granted," conveys the property in the extended term. *Nicholson Pavement Co. v. Jenkins*, 14 Wall., 452.

§ 503. An assignment "to the full end of term or terms for which letters patent are or may be granted," *held* to convey extended term. *Phelps v. Comstock*, 4 McL., 353.

§§ 504-5. Assignment by administrator of patentee construed to convey the improvement and the extended term of the patent. *Case v. Redfield*, 4 McL., 526.

§ 506. Where patentees covenanted to execute all necessary papers for securing an extension "for said H.'s benefit," who was also assignee of the original term, *held*, that it was a covenant to stand seized, and in equity certainly equivalent to a grant of the extension. *Prime v. Brandon Mfg. Co.*, 16 Blatch., 453.

§ 507. *Held* that an assignment conveying "all right, etc., which I have in said invention," "to the full end of the term for which said letters patent are or may be granted," is limited to the original, and does not convey the extended term. *Jenkins v. Nicholson Pavement Co.*, 1 Abb. 567.

§ 508. A grant of all the patents which the grantor "now has, or has in contemplation to obtain," does not embrace the extended terms of those patents. *Wetherill v. Passaic Zinc Company*, 2 O. G., 471.

§ 509. An assignment of the invention, after a patent has been issued, without any other language to indicate the intent of the parties, does not import a conveyance of the right to an extended term. *Waterman v. Wallace*, 13 Blatch., 129.

§ 510. An assignment of an interest in an invention, and letters patent therefor, before the expiration of the original term, carries with it no interest in a subsequent extended term, unless it contains a specific provision to that effect. *Jenkins v. Nicholson Pavement Co.*, 1 Abb., 577.

§ 511. A patent after it has expired is a mere "chase in action," and a paper purporting to convey the same is a conveyance of patentee's right to collect the damages accrued during its life-time. Such right is not assignable, and a paper purporting to be an assignment thereof *held* void, although it might be good as a power of attorney authorizing assignee to collect for infringements. *Bell v. McCullough*, 1 Bond, 194.

§ 512. It is no objection to a suit brought upon an extended patent that the exclusive right under the original term for the territory where the infringements were perpetrated had been assigned to third parties, unless it appears that the extended term was embraced in the assignment. *Aultman v. Holley*, 11 Blatch., 317.

Assignment — Generally — Defined, § 513. *A patent is assignable*, §§ 514, 515. *What is a sufficient assignment*, § 516. *What is not*, §§ 517, 518. *What will amount to notice of an assignment*, § 519. *Rule for construing assignments*, §§ 520, 521. *Of patent granted by special act*, §§ 522-524. *Duration of, prior to act of 1836*, § 525. *Execution of, under New York statute*, § 526. *Conveyance pendente lite*, § 527. *Equity*, § 528.

§ 513. An assignment is a grant in writing of the whole or a part of the exclusive right vested in patentee by the letters patent, and it makes no difference whether such part be designated as an undivided part of the whole patent, or as the grant of the exclusive right of the patentee within a particular district; in either case it is a conveyance of an interest in the patent, must be in writing and recorded, and cannot be proved by parol evidence. *Baldwin v. Sebley*, 1 Cliff., 150.

See *Grant*, § 2633.

§ 514. An owner of a patent can make an assignment in regard to it the same as he may make in regard to any other species of personal property. *May v. Chaffee*, 2 Dill., 385.

§ 515. All interests in patents are assignable by an instrument in writing. No particular form is required, but still there must be some operative words expressing at least an intention to assign in order to constitute an assignment. *Campbell v. James*, 18 Blatch., 92.

§ 516. A deed conveying "all the grantor's property and estate of every kind and description" is a sufficient assignment of a patent-right. *Railroad Co. v. Trimble*, 10 Wall., 367.

§ 517. An assignment of all property, except such property as is exempt by law from levy and sale under execution, cannot transfer a patent-right. *Campbell v. James*, 18 Blatch., 92.

§ 518. An instrument which makes no allusion to a patent further than to mention a claim for the use of the invention embraced therein cannot act to carry the patent. The fact that it was recorded in the patent office cannot make it an instrument of title, but could only complete its effect if it was one. *Ibid.*

§ 519. The expression "right, title and interest," contained in an assignment from a person holding under the patentee, is enough to put the assignee on inquiry and to charge him with notice of what such inquiry, if made of the first grantor, would have disclosed. *Hamilton v. Kingsbury*, 17 Blatch., 460.

§ 520. Courts of equity look to the intent, not the form of the instrument, and construe the acts of the parties in view of such intent, as far as consistent with general principles. *Hall v. Speer*, 6 Pitts. L. J., 403.

§ 521. Where an assignment will admit of it, it is in the interest of fair dealing that it should be so construed in a court of equity in favor of those who are prior in time and have acted in good faith. *Wright v. Randel*, 19 Blatch., 495.

§ 522. Dr. William A. Graham filed his application for a patent in November, 1837, which was rejected a second time December 13, 1837. December 29, 1837, he filed an amended specification, which was not acted upon by the patent office. December 13, 1851, he attempted to revive the application, but was not permitted to do so. January 13, 1852, he conveyed an undivided one-fourth interest in the invention to one A. W. Burton. The patent office refused to consider an application January 19, 1852, and nothing more was done. Graham died in 1857. By a special act of congress approved June 11, 1878, the heirs of Graham were permitted, through his administrator, to revive the application, and a patent was issued July 9, 1878, to A. Graham, administrator. January 27, 1879, Julia L. Burton, as administratrix of A. W. Burton, sold and assigned to the Fire Extinguisher Manufacturing Company an undivided one-fourth interest in said patent. *Held*, that the title in the Graham heirs was not affected by this assignment. *Fire Extinguisher Manufacturing Co. v. Graham*, 16 Fed. Rep., 543.

§ 523. The difference between the right to use machines properly obtained and the right to use by reason of the ownership of an interest or share of the monopoly is distinct and well recognized; and the failure of a special act to mention the assignees, in view of the express reference to the users of machines, must be regarded as intentional — *expressio unius exclusio alterius*. The right by assignment is not a mere equitable right such as ordinarily has to be prosecuted in the name and often at the pleasure of the assignor, but the assignor was as much bound to prosecute the application with diligence, and was as effectually concluded by the fact of his rights under the general patent laws of the country and the rules of practice in the patent office at Washington, as the inventor himself. *Ibid.*

§ 524. Under the circumstances named a special act was as necessary to the revival of the assignor's rights as of the inventor. Whatever right might be conferred by such act could only inure to the persons in whose favor it should be granted. *Ibid.*

§ 525. Prior to act 1836 every license or assignment expired with the limitation of the original patent, unless granted in express terms to cover a renewal. *Washburn v. Gould*, 3 Story, 122.

§ 526. Under the statutes of New York assignments of patents duly acknowledged before a notary are sufficiently proved, and it is not incumbent upon the complainant to prove the signatures of the assignors. *New York Pharmica Association v. Tilden*, 14 Fed. Rep., 740.

§ 527. Conveyances *pendente lite* do not at all affect the litigation as between the parties to the original controversy unless there are special statutes or circumstances to control; but courts of justice, even courts of law, and especially courts of equity, often protect the rights of the real owners to the fruits of a recovery as against those who are nominal but not real owners whenever their rights may have been acquired. *Campbell v. James*, 18 Blatch., 92.

§ 528. Between equal equities the law will prevail. *Wright v. Randel*, 19 Blatch., 495.

See *Attorney*, § 577. *Evidence*, §§ 2320-2322. *Injunction, Provisional*, § 3201. *Jurisdiction*, §§ 3849, 3859. *Receiver*, § 5206.

33. ASSIGNEES.

See ASSIGNMENT.

SUMMARY (LITTLEFIELD v. PERRY, §§ 529-547) — *Assignee's right to sue*, § 529. — *What is an assignment*, § 530. — *Particular assignment construed*, §§ 531-533. — *Jurisdiction of circuit court in infringement cases*, § 534. — *Patentee and licensee, right to sue*, § 535. — *Equitable interest by assignment*, § 536. — *Reissue without consent of assignee*, § 537. — *Recorded assignment of invention*, § 538. — *Estoppel*, § 539. — *What constitutes an improvement*, § 540. — *Assignment of imperfect invention*, § 541. — *Equitable and legal assignment, effect in equity*, § 542. — *Patentee as trustee of an assignee's interest is liable for infringement*, § 543. — *Complainant held to be assignee of patentee*, § 544. — *Accountability of infringer*, § 545. — *Apportionment of profits in infringement of an improvement*, § 546. — *Improper allowance of interest on profits*, § 547.

LITTLEFIELD v. PERRY.

(21 Wallace, 206-230. 1874.)

APPEAL from U. S. Circuit Court, Northern District of New York.

The facts sufficiently appear in the opinion.

§ 529. *The assignee of the entire interest of a patentee in a patent, within and throughout a specific portion of the United States, may prosecute in the circuit court any action necessary for the protection of his rights.*

Opinion by WAITE, C. J.

We are met at the outset of this case with a question of jurisdiction. All the parties, plaintiff as well as defendant, are citizens of the state of New York. The power of the circuit court, therefore, to entertain the cause, if it exists at all, must be found in the jurisdiction conferred by the patent laws. The suit is in equity against a patentee by one who claims to be his assignee, to restrain him from infringing upon rights under his patent, which are alleged to have been assigned. The circuit court has jurisdiction of all suits arising under the patent laws, and has power, upon a bill in equity filed by a party aggrieved, to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of any right secured by patent. Every patent, or any interest therein, is by statute made assignable by an instrument in writing, and the patentee or his assignee may, in like manner, grant and convey an exclusive right under his patent throughout any specified part of the United States. All such assignments must be recorded in the patent office within three months from the time of their execution.

§ 530. *The power of assignment under the statute has been so construed by the courts as to confine it to the transfer of an entire patent, an undivided part thereof, or the entire interest of the patentee, or undivided part thereof, within and throughout a certain specified portion of the United States.*

This power of assignment has been so construed by the courts as to confine it to the transfer of an entire patent, an undivided part thereof, or the entire interest of the patentee or undivided part thereof, within and throughout a certain specified portion of the United States. One holding such an assignment is an assignee within the meaning of the statute, and may prosecute in the circuit court any action that may be necessary for the protection of his rights under the patent.

§ 531. *A certain grant and supplementary agreement stated, and held, that the assignee might sue the patentee in the circuit court to prevent an infringement.*

The title of the complainant in this case grows out of what is termed in the

answers "a grant and supplementary agreement," executed in "two parts," between Littlefield, the patentee, and Treadwell & Perry. The "grant" is one of the parts, and the "supplementary agreement" the other. The grant, taken by itself, contains, in most unmistakable language, an absolute conveyance by the patentee of his patent and inventions described, and all improvements thereon, within and throughout the states of New York and Connecticut, and an agreement by the assignees to pay a royalty on all patented articles sold, with a clause of forfeiture in case of non-payment or neglect, after due notice, to make and sell the patented articles to the extent of a reasonable demand therefor. This grant was duly recorded in the patent office six days after its execution.

The supplementary agreement was never recorded. It contained, among other things, a stipulation to the effect that nothing in the assignment should give to Treadwell & Perry the right to use or apply the principle of the patent to furnaces erected in cellars or basements of houses for the purpose of heating several rooms, it being the intention of the patentee to reserve that to himself. It also contained certain other stipulations between the parties, intended for the protection of their respective rights and the regulation of their conduct under the assignment. The defendants now contend that by reason of this reservation, and these several stipulations, the title of Treadwell & Perry, under the grant, has been reduced from that of assignees to mere licensees.

Undoubtedly, for the purpose of ascertaining the intention of the parties in making their contract, the two instruments, executed as they were at the same time, and each referring to the other, are to be construed together. If, when so construed, they shall be found to convey to the assignees the title to the patent and inventions and grant a license back from the assignees to the patentee of the right to use the patent and its principle in the manufacture of the designated furnaces, the circuit court had jurisdiction of the cause.

§ 532. *An agreement to account and pay a specified royalty, contained in an instrument of assignment, forms part of the consideration of the assignment, and does not reduce the grantee to the position of a licensee.*

§ 533. *Neither does a clause of forfeiture for non-performance, contained in an assignment, reduce the grantee to the position of a licensee. For the non-payment or other non-performance a forfeiture may be enforced as for condition broken; but until it is enforced the title granted remains in the assignee.*

When the "grant" was placed on record, Treadwell & Perry became the apparent owners of the entire patent and inventions throughout the specified territory. Neither the agreement to account and pay the royalty nor the clause of forfeiture for non-performance contained in that instrument reduced them to the position of licensees. The agreement to account and pay formed part of the consideration of the assignment, and was in effect an agreement to pay at a future time a sum to be determined by the number of articles made and sold. For the non-payment or other non-performance a forfeiture might be enforced as for condition broken, but until it was enforced the title granted remained in the assignees.

The supplementary agreement contained a provision that Littlefield should sue infringers "in his own name or otherwise," and also defend all suits against Treadwell & Perry for alleged infringements of other patents by the use of his, and this it is alleged is evidence of the intention of the parties to make the grant effective only as a license. It needs only a slight examination

of that clause in the contract, however, to become satisfied that it was intended only as a provision for placing on Littlefield the costs and expenses of all such litigation, as well as all damages for infringements growing out of the use of the inventions by the assignees. The suits were to be prosecuted in his name, or otherwise, as circumstances should require, and he was to be at all the costs and expense of maintaining his patents. That is the extent of the provision.

Upon the argument, the reservation of the right to use the principle of the patent and inventions in the manufacture of furnaces seemed to be relied upon with more confidence as establishing this claim on the part of the defendants. All agree that the intention of the parties, when ascertained by an examination of both the instruments, must govern in this action where only the parties themselves are interested. There are no intervening innocent third persons. Jagger, the partner of Littlefield, who is co-defendant with him, is charged with full notice of the rights of Treadwell & Perry, and others claiming under them.

It is a significant fact that the agreement was executed in two parts. Ordinarily the whole of such a contract is embodied in a single instrument. Another important fact is, that only one of the parts is recorded, and that the one which, taken by itself, places the title in Treadwell & Perry. The record is intended for the benefit of the public. *Bona fide* purchasers look to it for their protection. The record of the grant alone, therefore, furnishes the strongest evidence of the intention of the parties to give effect to the two instruments as an assignment. It is true, that in the recorded part reference is made to the other, but the manner of the reference is not such as to indicate that the unrecorded part contained anything to defeat the title granted by that which was recorded. The language is, "in consideration of one dollar, and of the agreements herein contained on the part of the parties of the second part, and of the agreements contained in a certain agreement this day executed between the parties hereto, and bearing even date herewith, hath, and by these presents doth, assign," etc. And again: "It is expressly understood and agreed between the said parties, that in case said party of the first part shall well and faithfully keep and perform all the agreements herein, and in the aforesaid agreement bearing even date herewith contained, and said parties of the second part shall, etc., neglect, etc., that this assignment and transfer shall thereafter be void and of no effect," etc. This is undoubtedly sufficient to charge purchasers with notice of the execution of the supplementary agreement, and possibly of its provisions, but it falls far short of indicating an intention of the parties, by anything contained in the unrecorded instrument, to limit or defeat the assignment made in consideration of it. The most that can be inferred from such language is, that the parties had stipulated between themselves, not as to the legal effect of the recorded instrument, but as to their obligations or equitable rights under it. We think, therefore, that Treadwell & Perry were the assignees of Littlefield within the meaning of the patent laws, and that they, and those claiming under them, may sue in the circuit courts to prevent an infringement upon their rights.

§ 534. *The circuit court of the United States has jurisdiction in all suits for the infringement of patents.*

But even if they are not technically assignees, we think this action is, nevertheless, maintainable. They certainly had the exclusive right to the use of the patent for certain purposes within their territory. They thus held a right under the patent. The claim is that this right has been infringed. To deter-

mine the suit, therefore, it is necessary to inquire whether there has been an infringement, and that involves a construction of the patents. The act of congress provides "that all actions, suits, controversies and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable, as well in equity as at law, in the circuit courts," etc. An action which raises a question of infringement is an action arising "under the law," and one who has the right to sue for the infringement may sue in the circuit court. Such a suit may involve the construction of a contract as well as the patent, but that will not oust the court of its jurisdiction. If the patent is involved it carries with it the whole case.

§ 535. *A patentee may be sued for an infringement by his licensee in a court of equity. The licensee may sue in his own name.*

A mere licensee cannot sue strangers who infringe. In such case redress is obtained through or in the name of the patentee or his assignee. Here, however, the patentee is the infringer, and as he cannot sue himself, the licensee is powerless, so far as the courts of the United States are concerned, unless he can sue in his own name. A court of equity looks to substance rather than form. When it has jurisdiction of parties it grants the appropriate relief without regard to whether they come as plaintiff or defendant. In this case the person who should have protected the plaintiff against all infringements has become himself the infringer. He held the legal title to his patent in trust for his licensees. He has been faithless to his trust, and courts of equity are always open for the redress of such a wrong. This wrong is an infringement. Its redress involves a suit, therefore, arising under the patent laws, and of that suit the circuit court has jurisdiction.

§ 536. *Certain assignments and reassignments stated, and the question of title considered.*

It is next asserted that the complainant has not by his proof shown himself to be the assignee of Treadwell & Perry. They, on the 25th of March, 1862, assigned all their interest to George W. Sterling. He became dissatisfied with his purchase, and by agreement of parties the sale was canceled, he giving effect to the cancellation by executing a reassignment to Treadwell & Perry, bearing date June 2, 1862. Under date of April 7, 1862, Treadwell & Perry executed another assignment to one Dickey. Both the reassignment from Sterling and the assignment to Dickey were left at the patent office for record on the 26th June, 1862, and on the 2d July Dickey assigned to Mary J. Perry, in whose name the suit was commenced.

It is now claimed that this proof shows title in Treadwell & Perry, inasmuch as Sterling reassigned to them after they had assigned to Dickey. Mrs. Perry was the wife of John S. Perry, one of the firm, and he is now a party to the suit, having upon her death succeeded to all her rights as trustee under her will. Treadwell, the other member of the firm, has been several times in the progress of the cause examined as a witness, and has testified that Dickey became the owner of the patents under a transfer to which he consented. It is clear, therefore, that Mrs. Perry at the commencement of the action was in equity, if not in law, the owner of whatever had been assigned by Littlefield, and that if Treadwell & Perry had the legal title, they held it in trust for her, and will be estopped by a decree in her favor from setting up as against Littlefield any beneficial interest under it. At an earlier stage of the proceedings it might have been proper to make Treadwell a party, but upon the

case as it now stands no possible harm can result to the defendants from a decree against them in his absence.

STATEMENT OF FACTS.—This brings us to a consideration of the merits of the case.

On the 15th April, 1851, a patent was issued to Littlefield for a certain improvement in cooking-stoves, and on the 30th December, 1852, he filed in the patent office his application for another improvement in stoves, devised “for the purpose of economizing and burning the gases generated by the combustion of anthracite coals.” On the 5th April, 1853, he executed the grant and supplementary agreement already referred to. In the grant, after reciting that he held a patent bearing date April 15, 1851, “for a coal-burner so constructed as to produce combustion of the inflammable gases of anthracite coals,” and that he had “made application to the patent office at Washington for letters patent securing to him a certain improvement in the invention so as aforesaid patented to him,” and that such application was then pending, he proceeded to assign all the right, title and interest which he then had, or might thereafter have, “in or to the aforesaid inventions, improvement and patent, or the patent or patents that may be granted for said inventions or any improvement therein, and on any extension or extensions thereof within and throughout the district, etc., for and during the term for which the aforesaid letters patent were granted, and the terms for which any patent for the aforesaid improvement or any improvement or improvements thereof may be granted,” etc. The application of December 30, 1852, was rejected at the patent office, and finally withdrawn by Littlefield on the 22d day of July, 1853, he at the same time filing another application for “a new and useful improvement in stoves,” so devised as “to burn the gaseous or more inflammable elements of the coal in contact with its more refractory portions, and thus secure a complete combustion of them both.” Upon this application a patent was issued January 20, 1854. All the patents outstanding, and the subject of this controversy, are admitted to be reissues of this, or improvements upon it. Littlefield and his co-defendant do not deny that they have used the patents issued after January, 1854, and, if the title to them passed under the assignment of April, 1853, it is admitted that such use is an infringement, and that the complainant is entitled to a decree. The simple question, then, presented for our consideration is as to the effect to be given to this assignment.

§ 537. *Where a reissue is obtained without assignee's consent, he has his election to accept or reject it.*

§ 538. *The recorded assignment of a perfected invention carries with it the patent when issued.*

It is well settled that a recorded assignment of a perfected invention, made before a patent has issued, carries with it the patent when issued (*Gayler v. Wilder*, 10 How., 477; §§ 385-96, *supra*); and that reissues are not patents for new inventions, but amendments of old patents. If a reissue is obtained with the consent of an assignee, it inures at once to his benefit; if without, he has his election to accept or reject it.

§ 539. *Where an inventor agrees with an assignee of an interest in a patent that a certain invention is an improvement on the one patented, and induces the assignee to purchase by reason of the agreement, he is estopped to deny that such invention is an improvement on the one in which an interest is assigned.*

The parties have themselves agreed that the invention of 1852 is an improvement upon the patent of 1851. In the grant the patent is described as being

“for a coal-burner, so constructed as to produce combustion of the inflammable gases of anthracite coal,” and the application as being for an improvement upon the patent. It is true that the application is not referred to by its date, but there can be no doubt as to its identity, because the language adopted to describe the patent is not that of the claim in the patent itself, but of the application of 1852. Besides, the application is said to be then pending, and it is not pretended that Littlefield had any other on file in the patent office at that date. This relieves us from an examination of the specifications in the patent and application, for the purpose of ascertaining whether, in point of fact, the one was an improvement upon the other. Littlefield having agreed that it was, and having induced Treadwell & Perry to purchase by reason of this agreement, cannot now deny it.

§ 540. *A stove doing the same thing which another was intended to do, but doing it better, is an improvement upon the latter.*

It is clear, also, that the idea which Littlefield had in mind, and which he was endeavoring by his devices to make practically useful, was greater economy in the use of the inflammable gases of coal to produce combustion. It is not important in this suit that the patent, which had then been obtained, was not in fact suited for that purpose. It is sufficient that it was intended to be so. The subsequent devices, better adapted to the end to be accomplished, may therefore properly be regarded as improvements upon the original invention. They produce a stove doing the same thing which the first was intended to do, but doing it better. This is the proper office of an improvement.

§ 541. *An assignment of an imperfect invention, with all the improvements upon it that the inventor may make, is equivalent to an assignment of the perfected result.*

The assignment in this case, by its express terms, covers all improvements in the original patent or the invention described in the application of 1852. It carried with it the legal title to the existing patent. If one had been issued upon the application, that too would have inured to the benefit of the assignee, because, in that case, it would have been the assignment of a perfected invention. Without considering whether the invention upon which the patent of 1854 issued was not in fact the same, to all intents and purposes, as that of 1852, it is sufficient for the purposes of this case that it was an improvement upon it, or perhaps, more properly, that invention perfected. An assignment of an imperfect invention, with all improvements upon it that the inventor may make, is equivalent in equity to an assignment of the perfected results. The assignment in this case being such a one, the assignees became in equity the owners of the patent granted upon the perfected invention; that is to say, of the patent of 1854. Littlefield took the legal title in trust for them, and should convey. Courts of equity, in proper cases, consider that as done which should be. If there exists an obligation to convey at once, such courts will oftentimes proceed as if it had actually been made.

§ 542. *A court of equity will give the same effect to an equitable assignment that it would to a legal one.*

There is here no attempt to obtain the specific performance of a contract, but to restrain this patentee from infringing upon rights which, in a court of equity, he is deemed to have assigned. In other words, this complainant is in equity an assignee, and entitled to protection as such. If the assignment in precisely its present form had been executed after the last reissue was granted, we think it would hardly be claimed that the legal title to all the present out-

standing patents did not pass with it. What such an assignment could do in respect to legal titles this has done in respect to such as are equitable. The contest is now between an assignor in equity and his assignee. A court of equity will in such a case give the same effect to an equitable title that it would to one that was legal.

It is next contended that the assignment in this case was forfeited before the commencement of this action, because of the failure of Treadwell & Perry to perform its conditions. There is no proof that the royalty on the stoves made and sold before the action was commenced was sufficient to discharge that part of the debt due from Littlefield to Treadwell & Perry, which was first to be paid out of it before anything was payable to him, and there could be no forfeiture for a neglect to make and sell until after reasonable notice of the default. No such notice is proven or even claimed.

§ 543. *Where a patentee holds an interest in his patent in trust for an assignee, and infringes the latter's rights thereunder, he is bound to account to him for the unlawful use of the trust property.*

It is next insisted that if the plaintiff claims the benefit of the last reissues, he puts it out of his power to have damages for infringements previous to their date. The original bill in this cause was filed August 27, 1862. Everything since that time has been done *pendente lite*. The first reissue was granted November 19, 1861, and the first patent for an improvement on the patent of 1854 was issued on the 27th June previous. All in the way of reissues or improvements except these has been done pending the suit. The litigation gathers to its harvest the fruits of the labors of Littlefield and his associates during its pendency. His infringement and that of his co-defendant Jagger, claiming under him, commenced in 1862, only a short time before the action was commenced. The question presented by this objection is, therefore, comparatively unimportant; but if it were not, the result would be the same. For as Littlefield held his patents all the time in trust for these assignees to the extent of the territory they owned, he must account to them for the profits he has made by the unlawful use of the trust property.

§ 544. *Complainant held assignee of the patentee.*

We are, therefore, clearly of the opinion that the complainant is in equity the assignee of Littlefield, and that he is entitled to recover of the defendants the profits they have made out of these infringements upon his rights. So far there is no error in the court below.

§ 545. *An infringer of a patent is only bound to account to the patentee for profits derived from using the patented invention, over and above what he would have made in using other processes open to the public.*

We now come to the decree itself. The plaintiff is entitled, as has been seen, to recover of the defendants the profits they have made from the use of the several inventions within the assigned territory; but the decree directed an account of "all the profits, gains and advantages which the said defendants, or either of them, have received, or which have arisen or accrued to them, or either of them, from the manufacture, use or sale of stoves within the states of New York and Connecticut, embracing the improvements described in and covered by the said letters patent, and the reissues thereof, or any of them." An account stated upon these principles has been approved by the court in the decree appealed from.

The decree is, as we think, too broad. After the interlocutory decree below settling the principle of the accounting, the case of *Mowry v. Whitney*, 14

Wall., 620 (§§ 5036-45, *infra*), was decided in this court. It was there held that the question to be determined in such a case as this was, "what advantage did the defendant derive from using the complainant's invention over what he had in using other processes then open to the public, and adequate to enable him to obtain an equally beneficial result? The fruits of that advantage are his profits." For such profits he is compelled to account as damages.

§ 546. *Where the patented improvement formed a part only of the infringing stoves made by the defendants, the inquiry in the accounting before the master should have been confined to an account of the profits received by the defendants as the direct result of the improper use of the improvements, and could not include all the profits received from the manufacture of the stoves embracing such improvements.*

Here the order is to account for all profits received from the manufacture, etc., of stoves, embracing the improvements covered by any of the patents. This would cover all the profits made upon a stove having in it any one of the improvements patented. The true inquiry is as to the profits which the defendants have realized as the consequence of the improper use of these improvements. Such profits belong to the plaintiff, and should be accounted for to him. The account of the master may not charge the defendants with more than the complainant is entitled to recover. The conduct of the defendants in withholding statements which it would seem they ought to be able to make, and their evident unwillingness to account, would induce us to sustain the report had the order of reference been less broad. As it is, we think the decree, so far as it settles the principles of the accounting for profits, must be reversed, and that the inquiry before the master must be confined to an account of the profits received by the defendants as the direct result of the use within the assigned territory of the several inventions involved in the case. This reverses the decree.

§ 547. *An allowance of interest on the amount found due upon the account for profits, held improper under the facts of the case.*

Many exceptions were taken to the master's report. Some were as to the matters of form, and others were directed to the principles of the accounting as settled by the decree. It is unnecessary to consider these further. Another account may dispose of them all. The circuit court, however, in rendering its final decree, added interest to the amount found by the master to be due upon the account for profits. In *Mowry v. Whitney*, it was held that interest is not allowable in such cases, except under peculiar circumstances. The testimony thus far presented in this case does not, in our opinion, justify such an allowance. It will be for the court to determine, upon the coming in of the new report, accompanied by other evidence, whether the conduct of the defendants has been such as to subject them to liability in this particular. Profits actually realized are usually, in a case like this, the measure of unliquidated damages. Circumstances may, however, arise which would justify the addition of interest in order to give complete indemnity for losses sustained by wilful infringements.

Decree reversed to the extent hereinbefore indicated, and the cause remanded, with instructions to take a new account of profits and proceed in accordance with this opinion.

Assignees — Generally — Defined, §§ 548-551. *Takes no greater rights than assignor,* §§ 552-554. *Builders have rights of an assignee,* § 555. *Patent may issue to assignee,* § 556. *Reissue in relation to,* §§ 557, 558. *Generally,* §§ 559-561.

§ 548. Assignee, act 1836, section 14, defined. *Blanchard v. Eldridge*, 1 Wall. Jr., 337; *Potter v. Holland*, 4 Blatch., 206.

§ 549. An assignee, under the patent act of 1836, is one who has transferred to him in writing the whole interest of the patent, or an undivided part of such whole interest, in every portion of the United States. *Meyer v. Bailey*, 8 O. G., 437.

§ 550. Section 4895, Revised Statutes, words "assignee of the inventor or discoverer," construed. *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 33 O. G., 1597.

§ 551. Act 1836, sections 11 and 14, "interest of assignee and grantee," reviewed and construed. *Wilson v. Rousseau*, 4 How., 646.

§ 552. When, through several assignments, an individual becomes the owner of several distinct patents, he can have no greater rights than his assignors respectively. *Washburn & Moen Mfg. Co. v. Fuchs*, 16 Fed. Rep., 669.

§ 553. Assignees of inventors take by assignment the right of the inventors and no more. *Tatham v. Loring*, 5 N. Y. Leg. Obs., 207.

§ 554. Where plaintiffs were assignees of alien patentees, who had failed to work their invention as required by act 1836, section 9, it was held that as assignees they took no more than the rights of the inventors, and the failure was held fatal to the suit. *Ibid.*

§ 555. Builders of machines who construct under the authority of patentee or his assignees have the same rights as grantees or assignees. *Bloomer v. Millinger*, 1 Wall., 340.

§ 556. Patents cannot issue to inventors and assignees of a partial interest jointly, but may issue to assignees of the whole interest. *Mason's Opinion*, 4 Op., 399; *Black's Opinion*, 9 Op., 403.

§ 557. Patentee cannot affect assignee's right by an unauthorized reissue. *Woodworth v. Stone*, 3 Story, 749.

§ 558. Where the assignees of the inventor filed and completed their application for a reissue before July 20, 1870, it was held that their oath to it was sufficient without that of the inventor. *National Spring Co. v. The Union Car-Spring Manufacturing Co.*, 12 Blatch., 80.

See *Reissues*, §§ 5384-5393.

§ 559. An assignee of a patent, by granting and transferring the exclusive right to manufacture or use an invention within a state, exhausts his whole power of disposition under and by virtue of the assignment to him; and such assignee has no right to flood the country with machines to be used after the expiration of the term of the original patent, thus defeating the interest of the patentee in the extension. *Union Paper-Bag Machine Co. v. Nixon*, 1 Flip., 491.

§ 560. Where the patentees do not explicitly transfer to complainants the right to vend to others the right to make the patented article, and do not reserve that right to themselves in the instrument; and the complainants are vested with the exclusive right to make the article, as well as to use and vend it, the patentees have nothing left to transfer, and therefore the complainants are assignees and not licensees. *Pickhardt v. Packard*, 22 Fed. Rep., 530.

§ 561. An assignee or licensee has an interest in the issuance of a patent to his assignor or licensor as against a rival claimant. *Screw Co. v. Sloan*, 1 MacA. Pat. Cases, 210.

See *Alien Patentee*, § 209. *Assignments*. *Disclaimer*, § 2051.

Assignees — Right of action, §§ 562-571.

§ 562. Under act of 1793, an assignee of a part of a patent cannot maintain an action on the case for the violation of the patent. *Tyler v. Tuel*, 6 Cr., 324. (*Aliter* under act of 1836.)

§ 563. Under act 1793, section 4, assignee of patent is the proper party to bring suit for infringement. *Herbert v. Adams*, 4 Mason, 15.

§ 564. Under act 1793, section 4, assignee of a patent cannot maintain a suit for infringement unless the assignment to him has been put of record. *Wyeth v. Stone*, 1 Story, 273.

§ 565. An assignee can sue in his own name for infringement of his exclusive right. *Chambers v. Smith*, 5 Fish., 12.

§ 566. Assignees of undivided interest in a patent may sue jointly for an injury to that interest. *Stein v. Goddard*, 1 McAl., 82.

§ 567. Assignee of a part interest may maintain suit to enjoin third party from infringing and for an account. *Ogle v. Edge*, 4 Wash., 584.

§ 568. Where assignor reserved to himself the exclusive right to prosecute for piracies, which right by mesne assignments vested in assignee, *held*, that the latter could sue for infringement. *Picknell v. Todd*, 5 McL., 236.

§ 569. An assignee of the exclusive right to manufacture and sell a patented invention throughout the United States is the proper party to maintain a suit for the violation of this right. The right to manufacture and sell carries with it the right to use the devices sold, and nothing short of an express qualification will change this result. *Nellis v. Pennock Manufacturing Co.*, 22 O. G., 1131.

§ 570. An assignee of a chose in action — as a patent-right — cannot proceed by bill in equity to enforce for his own use the legal right of his assignor merely because he cannot sue at law in his own name. *Hayward v. Andrews*, 106 U. S., 672.

§ 571. The meaning of the passage in *Root v. Railroad Company*, that the bill in equity may be maintained “where the title of the complainant is equitable merely,” is to limit the exception to cases where the purpose and necessity of the resort to a court of chancery are to enforce the peculiar equity personal to the complainant, and not merely the legal right of which he is a beneficial owner. *Ibid.*

See *Art, Lost*, § 387. *Jurisdiction*, §§ 3929, 3930. *Right of Action*, §§ 5869, 5870.

34. ATTACHMENT FOR CONTEMPT FOR VIOLATION OF INJUNCTION

See INJUNCTION, VIOLATION OF, MOTION FOR ATTACHMENT FOR CONTEMPT FOR

35. ATTORNEYS.

Attorney, §§ 572-576. *Power of attorney*, 577-579.

§ 572. As to what evidence will be deemed sufficient to authorize one to act as attorney for another, it is the subject of a rule to be fixed by the department. *Taney's Opinion*, 2 Op., 571.

§ 573. In legal effect the action of an applicant or his attorney is the same. *In re Hatchman*, 26 O. G., 738.

§ 574. Where a patent covers vessels having both a shoulder and wire, and the inventor did not invent the wire, the act of the solicitor inserting it would seem to be unauthorized, and the patent, as to the public, void. *Milligan v. Lalanc & Grosjean Manufacturing Co.*, 21 Fed. Rep., 570.

§ 575. Neither upon principle nor authority is it just or reasonable that the evidence taken in a contested proceeding in the patent office should be taken before a magistrate who is of counsel for one of the parties; and depositions so taken held to be legally incompetent and inadmissible evidence in the case. *Nichols v. Harris*, 1 MacA. Pat. Cases, 302.

§ 576. Where plaintiff had assigned his patent for certain purposes to attorneys engaged by defendant to reissue defendant's patent, *held*, that they were attorneys for a specific purpose only and not in all matters relating to the patent, and that the assignment to them did not inure to defendant's benefit, and that having properly reissued his patent, they were not guilty of fraud. *Hoffheims v. Brandt*, 3 Fish., 218.

See *Answer*, § 215. *Application*, § 329. *Bill of Review*, § 617. *Contract*, § 1303. *Disclaimer*, § 2040. *Reissues*, §§ 5375, 5376.

§ 577. Where, in consideration of B. sustaining the charges in procuring an extended patent in the interest of licensees thereunder, and other considerations, A. appointed B. his trustee and attorney irrevocable, to hold such extended patent; that it might be so placed as to inure to the benefit of such licensees unaffected by A.'s death, and B. had paid such charges, *held*, that it was a power of attorney coupled with an interest, and irrevocable, and in equity equivalent to a formal assignment, and that A. had no power subsequent to revoke the same. *Day v. Candee*, 3 Fish., 9.

§ 578. Where A., in consideration of an annuity and indemnity for the expense of extending a patent, appointed B. his “trustee and attorney irrevocable to hold said patent and have control thereof” so that it might inure to the benefit of a certain part owner and his licensees, reserving the right to use it in his own business, *held*, that the entire interest and ownership in the patent passed to B. for the benefit of C. and his licensees. *Held*, further, that the right to the annuity rested in covenant of an agreement of prior date, and that on a failure to regularly pay it, the power of attorney could not be revoked. *Hartshorn v. Day*, 19 How., 211.

§ 579. The presumption of law is, that the resale of a right under a patent, where it reinvests in the patentee vendor, puts an end to a power of attorney relating to the patent executed to vendee by patentee; but if not recalled, and under the impression that it is still in force, innocent parties deal with the attorney, they will be protected against the owner of the patent, as maker of the power of attorney. *Larabee v. Peoria, Pekin & Jacksonville R. Co.*, 3 B. & A., 180.

See *Contracts*, § 1326.

36. AUCTION SALE.

See SALE, AUCTION.

37. BANKRUPTCY.

See ASSIGNMENTS, IN BANKRUPTCY. INJUNCTIONS, § 3273

§ 580. A claim for an account of profits for infringement held not provable against infringer's estate in bankruptcy under section 5067, Revised Statutes. *In re Boston & Fairhaven Iron Works*, 23 Fed. Rep., 880.

§ 581. Where a plaintiff in an action at law pending when he became bankrupt has bought the right of action from his assignee in bankruptcy, before any plea was interposed, it is too late for the defendant to plead in abatement, and the case should proceed as if he never had been bankrupt. In equity the bankruptcy of the complainant and appointment of an assignee would not abate the suit, but only require a supplemental bill to be filed; and the reconveyance to the complainant pending the suit renders such proceeding unnecessary. *Gear v. Fitch*, 16 O. G., 1231.

38. BILL.

See MULTIFARIOUSNESS.

Bill — Allegations — *Generally*, §§ 582-586; *of infringement, sufficient and insufficient*, §§ 587-594.

§ 582. An allegation in the bill that a patent was extended by the commissioner is sustained by proof of its extension by the acting commissioner. *Dorsey Revolving Harvester Rake Co. v. Marsh*, 6 Fish., 387.

§ 583. A bill for an injunction in which the allegations are of a patent of one term will not be sustained by evidence of a patent for another term. *Woodworth v. Hall*, 1 W. & M., 248.

§ 584. It is not necessary to aver in a bill brought under a reissued patent, that the grantee of a territorial right acted with the patentee in the surrender of the original patent or concurred in the reissue thereof. *Meyer v. Bailey*, 8 O. G., 437.

§ 585. What are sufficient allegations in a bill for revocation of a license to entitle plaintiff to relief. *Adams v. Meyrose*, 10 Fed. Rep., 671.

§ 586. Where the averments of the bill are in general terms as to the invention, reciting the title of the patent merely, and making profert of the letters patent, the bill is not demurrable for defective description of the patent. *McMillin v. St. Louis & Miss. Valley Transp. Co.*, 18 Fed. Rep., 260.

§ 587. Defendant A. in a prior suit recovered a decree against defendant B. for profits by reason of infringement. In this suit plaintiff alleged that he and not A. is owner of the patent, and prayed to reform an assignment to A., if by mistake, and contrary to intent, it had conveyed the patent to A., and that B. be restrained from paying A. the profits decreed in the prior suit, but alleged no infringement by B. B. demurred to the bill, and the demurrer was sustained. *Secombe v. Campbell*, 5 B. & A., 632.

§ 588. A statement of the complainant's patent and a general allegation of infringement, without any specification of the claims alleged to have been infringed, will suffice to put the defendant upon his answer. At the final hearing the complainant will be permitted to specify the claims on which he will ask for a decree. *Thatcher Heating Company v. The Carbon Stove Co.*, 15 O. G., 1051.

§ 589. Where the bill stated an assignment to plaintiff, July 2, 1862, and alleged infringement after the making of a contract "entered into" between January 1, 1861, and January 1, 1863, suggested, that it did not contain sufficient averment of infringement after the time when the right accrued. *Perry v. Corning*, 7 Blatch., 195.

§ 590. Averment in bill as to "making and using" infringing article is proved to all intents and purposes by proof of using alone. *Locomotive Engine Safety Truck Co. v. Erie R'y Co.*, 10 Blatch., 292.

§ 591. The allegation in the bill, in which profert of the patent is made and the title merely recited, that defendant has used "some parts" of plaintiff's patent, is a sufficient allegation of infringement. *McMillin v. St. Louis & Miss. Valley Transp. Co.*, 18 Fed. Rep., 260.

§ 592. An allegation of infringement of a patent for a product construed to be that the product which had been made and sold was made by the patented method. *Cone v. Powers*, 4 B. & A., 107.

§ 593. The general allegation of the bill that the defendant has infringed the letters patent is sufficient to put him upon his answer. It is not necessary to set out at length in the bill the details of his invention and of defendant's manufacture. *Turrell v. Cammerer*, 3 Fish., 462.

§ 594. Where the bill merely declared that the patent was for an improvement in bed-fastenings, and in the same general terms alleged infringement of the reissue by defendant without describing the nature of the improvement nor the claims infringed, a demurrer thereto for failure to specify the claims infringed was overruled on authority. *Haven v. Brown*, 6 Fish., 413.

Bill — For account, §§ 595, 596.

§ 595. Where plaintiff sought to charge defendants as infringers of the patent, despite the contract of license, in consequence of non-compliance with its terms, *held*, that in view of *Hartell v. Tilghman*, 99 U. S., 547, bill for account would not lie. *Adams v. Meyrose*, 2 McC., 360.

§ 596. As a general rule a bill in equity will not lie to settle an account on one side only, except when a discovery is prayed, or when the nature of the account is such it cannot be readily investigated in a court of law. *Vaughn v. East Tenn., Virginia & Georgia R. Co.*, 1 Flip., 621.

Bill — Cross-bill, §§ 597-602.

§ 597. A cross-bill is not permissible in a common law action. *Castle v. Hutchinson*, 25 Fed. Rep., 394.

§ 598. A cross-bill is properly filed to establish an equitable title to a patent, the legal title to which is in the plaintiff in the original bill filed for infringement of the patent, and the equitable title in the orator in the cross-bill. *Brandon Mfg. Co. v. Perine*, 14 Blatch., 371.

§ 599. Cross-bills cannot be filed except by leave of the court upon due notice. *Webster Loom Co. v. Short*, 10 O. G., 1019.

§ 600. Where an interlocutory decree is rendered for infringement, and, pending the accounting before the master, a bill is filed by defendants to set off a judgment held by them against complainant, it is to be regarded as an original bill, and cannot be sustained as a cross-bill, because when filed no decree for payment of damages had passed in the original suit. *Rubber Co. v. Goodyear*, 9 Wall., 807.

§ 601. Where defendant in a suit for infringement, sought by cross-bill, which set up no color of title in himself, a discovery from the plaintiff in the original suit, as to the source and validity of his title to the patent, and further prayed for relief founded on the discovery, *held*, that it was not the proper office of a cross-bill, neither could it be sustained as a bill for relief, and a demurrer thereto was sustained. *Young v. Colt*, 2 Blatch., 373.

§ 602. Where the bill of complaint alleged infringement of a patent, and set up a license to some of the defendants as a measure of damages, and the licensed defendants filed a cross-bill asking for the surrender of the license, *held*, that upon such a bill there was no authority for notice by publication. *Webster Loom Co. v. Short*, 10 O. G., 1019.

See *Interfering Patents*, § 3492.

Bill — Of discovery, §§ 603-609.

§ 603. A court of equity should not refuse to entertain a bill for discovery, although, by the enlargement of the jurisdiction and remedies exercised by courts of law, similar relief could be obtained by the complainant in his action at law. *Colgate v. Compagnie Française du Télégraphe de Paris à New York*, 23 Fed. Rep., 82.

§ 604. Where a bill for infringement was filed praying discovery under oath, and did not state where the corporation complainant was located or resided, neither was the bill sworn to, a demurrer thereto, on both of these grounds, was overruled. *National Hay Rake Co. v. Harbert*, 2 Weekly Notes, 100.

§ 605. Where a bill for infringement contained no special allegation that a discovery was necessary, and contained no special interrogatories, but prayed for answer on oath and account for profits, *held*, that, under equity rule 31, it was a bill for discovery and account, and a demurrer thereto for want of jurisdiction, on the ground that it did not pray for injunction or discovery, was overruled. *Perry v. Corning*, 6 Blatch., 134.

§ 606. Where a bill is brought for a discovery and for other equitable relief within the appropriate jurisdiction of a court of equity, and the ultimate object of the plaintiff is to obtain damages, in such case the court, having granted a discovery, will proceed and give the proper relief in damages. *Magic Ruffle Co. v. Elm City Co.*, 14 Blatch., 109.

§ 607. A bill in equity stating an approximate amount as the defendants' gains and profits from the manufacture and sale of the invention, in infringement of the plaintiff's rights, and

praying that the defendants may be required to make a disclosure of all such gains and profits, is in no proper sense a bill of discovery or a bill praying a discovery. *Gordon v. Anthony*, 16 Blatch., 234.

§ 608. A bill in equity maintained in a United States circuit court to compel a discovery in aid of an action at law brought to recover damages for infringement of a patent, although such necessary evidence could be obtained in the suit at law. *Colgate v. Compagnie Française du Telegraphe de Paris à New York*, 23 Fed. Rep., 82.

§ 609. Courts of equity in patent causes sometimes exercise the power of granting to a complainant an inspection of alleged infringing devices as incidental to ordinary discovery. *Ibid.* See *Accounting*, § 128.

Bill — Of exceptions, §§ 610, 611.

§ 610. A bill of exceptions cannot be taken on the trial of a feigned issue directed by a court of equity, or if taken can only be used on a motion for a new trial. *Watt v. Starke*, 17 O. G., 1092.

§ 611. A bill of exceptions is not the proper mode of reviewing the trial of an issue out of chancery. *Ibid.*

See *Appeals*, § 237.

Bill — Of review, §§ 612-617.

§ 612. Bill of review; failure of complainant to appear in the original suit. *Irwin v. Meyrose*, 2 McC., 244.

§ 613. Where motion was made for leave to file a bill of review grounded on newly discovered matter, *held*, that the matter being already sufficiently shown in the exhibits in the case, appellants were estopped from denying knowledge of their contents, and their laches of more than seven years was held fatal to their motion. *Providence Rubber Co. v. Goodyear*, 9 Wall., 805.

§ 614. Where an application was made to file supplemental bill to set aside a decree entered by consent, it was held to be in substance for leave to file a bill of review, and denied on the ground that the latter will not be allowed to set aside such a decree, except on the ground of fraud. *Pentlarge v. Beetson*, 17 Blatch., 306.

§ 615. Where on bill of review filed to set aside a decree, it not appearing, first, that the original decree showed upon its face that it was contrary to law; second, neither *prima facie* proof of material facts, which, if known, would have hindered the decree, and which could not have been known at former trial nor discovered with reasonable diligence, a rule to show cause was not granted. *Yerrington v. Putnam*, 2 B. & A., 601.

§ 616. In the original answer a prior invention of one Young was set up, which, it was said, was like that of Craig, and the public use of the machine, with the consent and allowance of Young, in Mobile and Memphis. The new matter alleged in the bill of review related to other machines used in other places. *Held*, that in legal effect the bill of review gave new notice of prior knowledge and use by different persons and in different places from those set out in the answer, and that, as it was filed more than thirty days before the final submission of the cause, all the requirements of section 4920 of the Revised Statutes were substantially complied with. *Craig v. Smith*, 100 U. S., 226.

§ 617. Laches of attorney in obtaining evidence of want of novelty is not ground for allowance of application to file a bill of review. When a bill of review may be filed. *De Florez v. Raynolds*, 16 Blatch., 379.

See *Evidence*, § 2272.

Bill — Of revivor, §§ 618-622.

§ 618. If the respondent in a suit for an injunction against infringing a patent and for an account dies before the decree, a bill will lie against his representatives to revive the suit and obtain an account. *Smith v. Baker*, 5 O. G., 496.

§ 619. A bill of revivor brought under rule 56 of court, the respondent having died while the case was before a commissioner to assess amount of award, and after interlocutory decree, establishing the validity and infringement of complainant's patent, will not revive the case under the rule unless an order is made to that effect. *Atterbury v. Gill*, 13 O. G., 276.

§ 620. No order reviving the case having been made, a demurrer to the bill of revivor was allowed to stand, although entered without leave. *Ibid.*

§ 621. A bill of revivor will not lie when filed by the assignee of the original complainant, as the right to file such a bill is confined to cases of representation of the party deceased by the mere operation of law. *Metal Stamping Co. v. Crandall*, 18 O. G., 1531.

§ 622. In case of the death of an original complainant and assignor the proper course for the assignee is to file a supplemental bill. *Ibid.*

Bill — Supplemental, §§ 623-630.

§ 623. A supplemental bill is necessary after a reissue made during suit. *Woodworth v. Stone*, 3 Story, 749.

§ 624. Where petition for leave to file a supplemental bill was made more than fourteen months after discovery of the evidence on which it was based, it was held a laches fatal to the application. *Blandy v. Griffith*, 6 Fish., 434.

§ 625. Where the question of priority of invention had been put in issue in the original suit, held, on a motion for leave to file a supplemental bill based on newly discovered evidence relating to anticipations other than those set up in the original suit, that the evidence was cumulative merely, and the motion was denied. *Ibid.*

§ 626. Where a suit in equity under a patent is pending at the time of the reissue, a supplemental bill setting up the reissued patent is not a proper pleading to revive such a suit, as nothing can be recovered, either as damages or profits, for the infringement of the surrendered patent. *Reedy v. Scott*, 23 Wall., 352.

§ 627. The infringement of the reissued patent becomes a new cause of action, for which, in the absence of any agreement or implied acquiescence of the respondent, no remedy can be had except by the commencement of a new suit. *Ibid.*

§ 628. But where the complainant, having reissued his patent pending a suit, set up this fact in a supplemental bill, all the proofs in the case being taken thereafter, and neither the respondent nor the court below made any objection to the irregularity of the pleadings, the irregularity was also disregarded by the court on appeal. *Ibid.*

§ 629. A petition to file a supplemental bill introducing new evidence in a cause, after a decision therein, dismissed, because it failed to show that the petitioner could not with reasonable diligence have obtained, prior to the former hearing, the testimony which he seeks to adduce, and also because such new matter is immaterial. *Spill v. Celluloid Manufacturing Co.*, 22 Fed. Rep., 94.

§ 630. The court, having refused to try a question of infringement on a motion for contempt, dismissed the motion without prejudice to complainant, to whom leave was given to file a supplemental bill, and the bill, when filed, was demurred to on the ground that plaintiff had obtained full relief in the former suit. The demurrer was overruled. *Allis v. Stowell*, 23 O. G., 1033.

See *Injunction*, §§ 3320-3322.

Bill — In equity — To obtain patent, §§ 631-648.

§ 631. The remedy by bill in equity under section 4915 applies only when the commissioner decides to reject an application for a patent on the ground that the applicant is not on the merits entitled to it. *Butterworth v. U. S. ex rel. Hoe*, 112 U. S., 50 (§§ 5935-36, *infra*).

§ 632. The jurisdiction of the circuit courts to grant a patent, notwithstanding an adverse decision of the commissioner of patents, is an independent original jurisdiction, and it is not within the mere discretion of the defeated party when and under what circumstances the action of the office shall be suspended. *Waipple v. Miner*, 15 Fed. Rep., 117.

§ 633. The rule that a patent should be granted in doubtful cases was perhaps a reasonable one when, under the law, the decision of the commissioner, if affirmed by the board of examiners, was final; but as the applicant has now a further remedy by bill in equity, under the provisions of the tenth section of the law of 1839, when his patent is refused for any cause either by the commissioner or the judge, the reason of the rule fails, and it will not be considered as binding upon the judge. *In re Kemper*, 1 MacA. Pat. Cases, 1.

§ 634. Section 739, Revised Statutes, applies to suits brought under section 4915, Revised Statutes. *Butterworth v. Hill*, 114 U. S., 133.

§ 635. A bill in equity implies a suit in equity with process and parties, and a bill brought under section 4915, Revised Statutes, is no exception to this rule. *Ibid.*

§ 636. The suit in equity authorized under section 4915, Revised Statutes, is an original and not an appellate proceeding. It is conducted according to equity rules, and a party contesting his right to a patent thereunder need not be confined to matters existing of record in the patent office or in the supreme court of the District of Columbia. *In re Squire*, 12 O. G., 1025.

§ 637. A motion to appoint a special examiner under the rules of the court, for the purpose of taking additional testimony, was accordingly granted. *Ibid.*

§ 638. Bill in equity under section 4915, Revised Statutes, to revise the judgment of the commissioner upon the question of priority of invention between complainant and respondent, in light of evidence before the commissioner and of evidence since taken, dismissed, it appearing from the evidence that the respondent is the prior inventor. *Damon v. Eastwick*, 22 O. G., 1709.

§ 639. The only question upon the merits of such a controversy is that of priority of invention. The question as to equitable rights arising out of the relation of the parties will not be entered upon. *Ibid.*

§ 640. Where a bill in equity is brought to obtain a patent (under section 4915, Revised Statutes) in the district of Vermont, and the commissioner of patents accepts service, *held*, that by such acceptance the commissioner consented to be found in said district, and his act in this respect is binding upon his successor. *Vermont Farm Machine Co. v. Marble*, 20 Fed. Rep., 117.

§ 641. The commissioner of patents, by accepting service of a process issued under a bill brought under section 4915, Revised Statutes, in the district of Vermont, and accompanying such acceptance with a letter declining to appear in defense of the suit, does not consent to the jurisdiction of the court, and therefore the court were without authority to proceed and enter the decree which has been appealed from. *Butterworth v. Hill*, 114 U. S., 133.

§ 642. In his official capacity the commissioner of patents is an inhabitant of Washington, in the District of Columbia. *Ibid.*

§ 643. Where an original application for a patent has been refused and a remedy is sought in equity, and the process is to be served on the commissioner of patents, then the circuit court of the District of Columbia is the proper tribunal to entertain the suit. *Prentiss v. Ellsworth*, 27 O. G., 623.

§ 644. Where, in an interference between an applicant and a patentee, the commissioner awards priority of invention to the former, priority of invention is the material issue between the parties on bill filed by the defeated party to have his adversary's patent declared void. *Sawyer v. Massey*, 25 Fed. Rep., 144.

§ 645. Wherever there are opposing parties, as in a contested case of interference, the ordinary rule should be followed and costs awarded to the party prevailing. Section 4915, Revised Statutes, requiring applicant to pay all expenses, applies only where there is no opposing party other than the commissioner of patents. *Butler v. Shaw*, 21 Fed. Rep., 321.

§ 646. Where, under a bill in equity filed under section 4915, Revised Statutes, by an applicant for a patent, the opposing patentee has transferred his interest in the invention, the assignee of that interest should be made a co-defendant. *Graham v. Teter*, 33 O. G., 758.

§ 647. To a bill in equity filed under section 4915, Revised Statutes, by an applicant for a patent, the commissioner is not a necessary party, where there is an opposing party to the bill. *Ibid.*

§ 648. On suit brought, praying for a decree ordering the issue of letters patent, in the circuit court of Pennsylvania, *held*, that the court had no jurisdiction, since no circuit courts but that of the District of Columbia have authority to issue a writ of *mandamus* to an officer of the United States, commanding him to do a ministerial act. *Prentiss v. Ellsworth*, 27 O. G., 623.

See *Appeal*, § 298. *Commissioner*, § 1110. *Contracts*, § 1337. *Secretary of Interior*, § 5993.

Bill — Motion to amend, §§ 649, 650.

§ 649. A motion to amend a bill for infringement, by bringing in a new party as plaintiff, refused on the ground that it would constitute a new and materially different suit, both as to parties and cause of action. *Goodyear v. Bourn*, 3 Blatch., 266.

§ 650. A bill was brought before the patent expired, but it was defective, and an amendment was filed after the patent had expired. *Held*, that the amendment made the bill as it should have been at first, and in effect as if it had been so at first, and if a case for equitable relief is shown, the bill should be retained for that and such cognate relief as is necessary to do complete justice. *Reay v. Raynor*, 19 Fed. Rep., 303.

See *Abandonment*, § 66. *Answer*, §§ 221, 231.

Bill — In equity — *Pro confesso*, § 651. *For taking testimony*, § 652. *Generally*, §§ 653-659.

§ 651. Bill taken *pro confesso* considered. *Thomson v. Wooster*, 114 U. S., 104.

See *Damages and Profits*, § 1569. *Practice*, § 4912.

§ 652. A bill for the taking of testimony *in perpetuam rei memoriam* will not be allowed, if it be possible that the matter in question can, by the party who files the bill, be made the subject of immediate judicial investigation. *New York & Baltimore Coffee Polishing Co. v. New York Polishing Co.*, 9 Fed. Rep., 578.

§ 653. Successive bills in different districts will lie for successive infringements of a patent. *Penna. Salt Co. v. Myers*, 1 Weekly Notes, 377.

§ 654. A bill in no wise auxiliary to the original suit, nor in continuation of that proceeding, is not a case proper for substituted service. *Rubber Co. v. Goodyear*, 9 Wall., 807.

§ 655. Where owner of legal title and party injured are joined in suit for infringement, it is sufficient if the bill is verified by the party injured. *Goodyear v. Allyn*, 6 Blatch., 33.

§ 656. Where bill should be filed by D., as trustee for R., joining R. as owner of equitable interest, and it was so brought, adding as plaintiffs D., as trustee for three companies, and the three companies themselves, such addition was held as surplusage; but the objection thereto not being raised until the hearing, and the title to claim in respect to the alleged infringement having been transferred to D. as trustee for the three companies and R., the bill was allowed to stand. *Dibble v. Augur*, 7 Blatch., 86.

§ 657. Where a bill in equity was filed, in case of infringement of reissued letters patent, to which answer was made by respondents, and complainant closed his *prima facie* case by taking proofs, it was held that such complainant would be allowed to file a subsequent bill for infringement of the letters patent after the filing of the first bill of complaint. *Turrell v. Spaeth*, 9 O. G., 1163.

§ 658. In such proceedings the testimony taken in the first proceeding, so far as relevant, should be allowed to be used and considered in the subsequent proceedings. *Ibid.*

§ 659. Where parties acquiesce in going on in a circuit court under complaint and answer filed in the state court, it will not be necessary to file a new bill in equity in the circuit court. *Gardner v. Crossman*, 21 O. G., 204.

See *Repeal of Patents*, §§ 5840-5858.

39. BOARD OF EXAMINERS.

See OFFICERS, OF PATENT OFFICE.

40. BURDEN OF PROOF.

See DAMAGES, BURDEN OF PROOF. DATE OF INVENTION, BURDEN OF PROOF. INFRINGEMENT, BURDEN OF PROOF. INVENTOR, BURDEN OF PROOF. INVENTION, PRIOR, BURDEN OF PROOF. USE, PRIOR, BURDEN OF PROOF. VALIDITY OF PATENT, BURDEN OF PROOF. NOVELTY, BURDEN OF PROOF.

Burden of proof—Generally—Abandonment, § 660. *Alien*, § 661. *Prior use and sale*, § 662. *Assignment, notice of*, § 663. *Term*, § 664. *False suggestions*, § 665. *On grant of injunction*, § 666. *Generally*, § 667.

§ 660. The burden of proof is on defendants to prove abandonment affirmatively. *American Hide & Leather Splitting Co. v. Tool Co.*, 1 Holmes, 503.

§ 661. Under act 1836, section 15, it rests on those who seek to defeat the patent granted an alien patentee to prove his failure to put his invention on sale within the time limited by the statute. *Tatham v. Lowber*, 2 Blatch., 49.

§ 662. The mere making of the invented article more than two years before applying for letters patent is quite immaterial, and where there is a doubt upon the evidence as to public use or sale of the article under like circumstances, the doubt should be resolved against the respondents, upon whom rests the burden of proof. *Comstock v. Sandusky Seat Co.*, 13 O. G., 230.

§ 663. The burden is on the plaintiff to establish actual notice of a prior assignment. *Wright v. Randel*, 19 Blatch., 495.

§ 664. The burden rests upon the party claiming that the patent should be limited as to the term of its duration, to show the facts which would limit it. *American Diamond Rock Boring Co. v. Sheldon*, 17 Blatch., 303.

§ 665. The burden of proof to prove that the patent was obtained "upon false suggestion" rests upon the plaintiff. (Act 1793.) *Stearns v. Barrett*, 1 Mason, 153.

§ 666. On a motion to dissolve an injunction the burden is on respondents to overcome the presumption that they are rightly enjoined. It is open to be overcome by new matter or evidence arising since the injunction was imposed. *Woodworth v. Rogers*, 3 W. & M., 135.

§ 667. When it is impossible to predict what the result of the change proposed by the applicant will be, the burden of proof rests on him to show what the actual results are. *In re Jackson*, 1 MacA. Pat. Cases, 485.

See *Defense*, § 1830.

41. CANCELLATION OF PATENTS.

See REPEAL OF PATENTS.

42. CASE SUBMITTED.

See PRACTICE, CASE SUBMITTED.

43. CAVEAT.

§ 668. An inventor is not required, by the twelfth section of the law of 1836, to file a caveat to preserve his right to a patent. That section was introduced for the benefit of the inventor, but was not necessary to the preservation of his right. It only enables him to have notice of any interfering application. *Heath v. Hildreth*, 1 MacA. Pat. Cases, 12.

§ 669. Act 1836, sections 12 and 15, was designed to protect the right of the first inventor, although he was not the first to adapt his invention to practical use, provided he has filed his caveat and has used reasonable diligence in perfecting his discovery. The caveat is to save the discoverer from the effects of the rule of law which gives to the inventor who first adapts his invention to practical use the right to a patent. *Phelps v. Brown*, 4 Blatch., 362.

§ 670. A paper annexed to a caveat is of no authority if the commissioner of patents has certified that it forms no part of the caveat. *Robertson v. Secombe Manufacturing Co.*, 10 Blatch., 481.

§ 671. The effect of the caveat is to protect the claim of an inventor from all interfering applications made within one year after its filing. But if in the interval between the filing of his caveat and his application he allows his invention to go into public use, his caveat will not protect him. *Bell v. Daniels*, 1 Bond, 212.

§ 672. A caveat is admissible in evidence as part of the *res gestæ* in proof of the invention so far as it contains a description of the invention and the machinery which was then constructed. *Jones v. Witherill*, 1 MacA. Pat. Cases, 409.

See *Construction of Patents*, § 1207. *Date of Invention*, § 1720. *Delay*, § 1872. *Inventors, Joint*, § 3795. *Novelty*, § 4332. *Patents*, § 4701.

44. CHANCERY, EXAMINER IN.

See EXAMINER IN CHANCERY.

45. CHANGE.

See SUBSTITUTION OF EQUIVALENT IN RESPECT TO SUBSTANTIAL CHANGE. INVENTION, NON-INVENTION, CHANGE IN THE APPLICATION. INVENTION, NON-INVENTION, CHANGE IN DEGREE. INFRINGEMENT, CHANGE IN FORM. INVENTION, NON-INVENTION, CHANGE OF FORM. PATENTABILITY, CHANGE OF FORM. COMBINATION, INFRINGEMENT OF, BY CHANGE IN LOCATION. INVENTION, NON-INVENTION, CHANGE OF LOCATION. PATENTABILITY, CHANGE IN LOCATION. INVENTION, NON-INVENTION, CHANGE OF MATERIAL. PATENTABILITY, CHANGE OF STRUCTURE.

46. CITIZENSHIP.

§ 673. A false allegation of citizenship is not an error which may be corrected by a reissue under act 1836, section 13. *Mini's Assignee v. Adams*, 3 Wall. Jr., 20.

§ 674. Evidence of citizenship held necessary on application for patent; or of an alien's two years residence in this country. *Taney's Opinion*, 2 Op., 511.

See *Jurisdiction*, §§ 3828-3835, 3882-3884. *Marking Articles Patented*, § 4149.

47. CLAIMS.

See REISSUES, CONSTRUCTION OF REISSUE CLAIMS. REISSUES, INVALID CLAIM, EFFECT ON REMAINING CLAIMS

Claims — Abandoned — *Allowance of abandoned claim condemned*, § 675. *Claim held abandoned*, § 676.

§ 675. The allowance of claims once formally abandoned by the applicant in order to get his patent through is the occasion of immense frauds upon the public, and is to be discountenanced. *Leggett v. Avery*, 11 Otto, 256.

§ 676. Non-action for a period of eighteen years after the rejection of his application claim, during which time his invention and description remained in the patent office, held an abandonment of the claim. *Marsh v. Commissioner of Patents*, 3 Biss., 321.

Claims — Alternative, §§ 677, 678.

§ 677. A patentee cannot claim an alternative combination if the separate combinations will not each make an operative machine. *Brown v. Whittemore*, 2 O. G., 248.

§ 678. An alternative claim to only one or the other of two things, but to neither positively, is void; but a claim to each of two things, whichever is used, is valid. *Union Paper-Bag Co. v. Nixon*, 4 O. G., 31.

Claim — Broad, right to, §§ 679-687.

§ 679. Where the fair interpretation of the words employed to describe an invention or discovery includes matters not in the mind of the patentee at the time, he is as fully authorized to claim the unlooked-for as he is the anticipated results. *Welling v. Rubber-Harness Trimming Co.*, 7 O. G., 606.

§ 680. Where the inventor had discovered a new art, held, that he had a right to hold the broadest claim which can be permitted in any case. *American Bell Telephone Co. v. Spencer*, 8 Fed. Rep., 509.

§ 681. The inventor being the first in the field of invention, his claims construed broadly. *Vogler v. Semple*, 7 Biss., 382.

§ 682. Where an inventor is the first to enter a particular field of invention, the claim of his patent should be construed broadly to cover any similar apparatus which effects the same result in substantially the same manner. *Worswick Manufacturing Co. v. City of Buffalo*, 20 Fed. Rep., 126.

§ 683. A party being the first discoverer of a process for making a certain product is entitled to make a broad claim for the product when made by his process; and such a claim is not to be construed as one for the product obtained by any method or process, but for any method which is the equivalent of the process described because it produces like results. *Pickhardt v. Packard*, 22 Fed. Rep., 530.

§ 684. A broad patent claim to a class, where the invention is only of a single variety of the class, is limited to that single variety. *Cushing's Opinion*, 8 Op., 270.

§ 685. A broad claim, so expansive as to exclude all previous or future inventions for the same purpose, is invalid. *Burr v. Duryee*, 1 Wall., 531.

§ 686. A patent having an expanded claim broad enough to include the prior invention of another, under cover of securing patentee's patentable improvement, is invalid. *Adjustable Window Screen Co. v. Boughton*, 1 B. & A., 327.

§ 687. It is doubtful whether a claim is valid which is so broad as to include every method known of effecting a particular result. *Lowther v. Hamilton*, 21 Fed. Rep., 811.

See *Construction of Patents, Right to Broad*, §§ 1156-1161.

Claims — Combination, §§ 688-701.

§ 688. A combination claim does not cover the elements separately. *Evans v. Eaton*, Pet. C. C., 322.

§ 689. If patentee has claimed, as a material part of his combination, and as new and original with him, that which is proved to have been discovered prior to his patent, it is fatal to it. *Parker v. Stiles*, 5 McL., 44.

§ 690. A claim for a combination need not embrace those devices which are well known and are applied in the usual way, although they, or some equivalents, are necessary to its operation. *Wheeler v. Clipper Mower and Reaper Co.*, 10 Blatch., 181.

§ 691. A claim for the whole combination, without particularly specifying the changes in the construction and arrangement of the parts of the combination which are set out as the real invention in the specification, held, to be too broad and indefinite. *In re Davis*, 1 MacA. Pat. Cases, 628.

§ 692. Where an inventor names equivalents for certain elements in his composition, and claims them, if all the various combinations are equally new, the claim is not too broad. *Ryan v. Goodwin*, 3 Sumn., 514.

§ 693. Separate claims to old elements will not protect a new combination which is not claimed. *Delaware Coal & Ice Co. v. Packer*, 1 Fed. Rep., 851.

§ 694. A claim for a combination may be valid, although the particular elements or sub-combinations embraced in it may be separately old. *Blake v. McNab & Harlan Manufacturing Co.*, 19 Blatch., 73.

§ 695. A claim cannot be sustained which, though in terms for a combination, seeks in fact to protect the convenient relative arrangement of an old device, having no coactive function with the other element specified. *Kerosene Lamp Heater Co. v. Littell*, 13 O. G., 1009.

§ 696. If the description of the invention clearly indicates the method of its use, and its relation to other mechanical elements operating with it, a claim for a combination of a part of them is good, although it may not embrace some essential to the operative efficiency of the combination. *Parham v. American Button Hole, etc., Sewing Machine Co.*, 4 Fish., 469.

§ 697. The patentee of a machine by which an article is fabricated may distribute the several mechanisms embodied in it into groups, each embracing such as co-operate in producing a definite effect upon the material, and may have a distinct claim for each group or combination, although no one of them is capable of any commercially useful result by itself, and the conjoined operation of every one, or an equivalent, is necessary to accomplish the object. A patent may be so framed on this plan as to obviate the danger of its being evaded by omitting parts of the combined machine when that is claimed. *Wells v. Jaques*, 5 O. G., 364.

§ 698. It is indispensable to the validity of a combination claim that the parts named therein should produce some new and useful result. Unless this is the case, even though the elements act reciprocally and in combination, the requirements of the law are not satisfied. The combinations must be new; so must the result. *Clark Pomace Holder Co. v. Ferguson*, 17 Fed. Rep., 79.

§ 699. If the claim be to a combination, and be restricted to specified elements, either directly by the language of the claim, or by reference to the descriptive part of the specification as carries such element into the claim, all must be regarded as material, leaving open only the question whether an omitted part is supplied by an equivalent device. *Fay & Co. v. Cardesman Bros.*, 109 U. S., 408.

§ 700. A combination claim which declares that it includes so much of stated machinery as produces a certain result is sufficient. *Sibby v. Foote*, 14 How., 218.

§ 701. A claim for a combination of devices when so arranged as to produce a specified mechanical result is not a claim for a function, and is valid if open to no other objection. *Renwick v. Pond*, 10 Blatch., 39.

Claims — Double, §§ 702-704.

§ 702. Double claim (10,477). *Lull v. Clark*, 22 O. G., 1535.

§ 703. Where a single claim was construed to have a double aspect embracing two processes, one of the processes, *i. e.*, part of the claim, was held valid and infringed, and the other wanting in novelty. *Irish v. Knapp*, 18 O. G., 735.

§ 704. A claim to the forming of the roll of a packing "either in connection with the India-rubber case, or other elastic material, or without," construed to be equivalent to two separate claims, and no disclaimer having been filed to part of it, infringement being found of the valid part, injunction was granted, but without costs. *Tuck v. Bramhill*, 6 Blatch., 95.

Claims — Duplicate, §§ 705, 706.

§ 705. A patent is not invalid for containing duplicate claims to the same invention, when not made with intent to mislead. *Tompkins v. Gage*, 5 Blatch., 268.

§ 706. Two claims in the same patent, or in different patents, for substantially the same combination or device, will not both be sustained, but one will be sustained, if otherwise valid, and the other rejected; and the court will exercise its discretion as to which claim shall, under the circumstances, be held good, and will sustain that claim which best protects the invention. *Dederick v. Cassell*, 9 Fed. Rep., 306.

Claims — Functional, §§ 707, 708.

§ 707. A claim for an effect or function cannot be sustained; the means by which the effect is produced or the function performed must be specified. *Wheeler v. Simpson*, 6 O. G., 435.

§ 708. A function cannot be claimed. The claim must be either to the physical structure, the combination of devices or the method of operation. *Matthews v. Schoneberger*, 18 Blatch., 357.

See *Claims, Combination*, § 701.

Claims — Result, §§ 709, 710.

§ 709. A patent will not be sustained if the claim is for a result, a principle, an idea, or any other mere abstraction. *Fuller v. Yentzer*, 4 Otto, 288.

§ 710. A claim to a result is not, *per se*, patentable; neither can a claim be sustained which covers every mode or means by which certain advantages can be secured in a harvester. *Marsh v. Dodge & Stevenson Manufacturing Co.*, 5 O. G., 398.

Claims — Construction of — Functional, § 711. Result, §§ 712-716.

§ 711. Claims which would be void as being functional should be so construed as to embrace the described means for effectuating the result. *Swain Turbine & Manufacturing Co. v. Ladd*, 11 O. G., 153.

§ 712. Claims to results construed to intend the means by which the results are accomplished. *Mitchell v. Tilghman*, 19 Wall., 891; *Henderson v. Cleveland Co-operative Stove Co.*, 12 O. G., 4.

§ 713. Claim construed to be for a result and not patentable. *Sangster v. Miller*, 5 Blatch., 243.

§ 714. The term "result," as used in a product claim, taken in connection with the other words, simply held to include any other method than that of the patent, which will obtain a like product resulting. It is something tangible and not a mere idea. *Badische Anilin & Soda Fabrik v. Higgin*, 15 Blatch., 290.

§ 715. A claim for the principle or mode of operation of thrusting cartridges into the rear of a barrel without joints, without reference to the particular devices employed, is a claim for a result, and is not patentable. *Palmer v. Gattling Gun Co.*, 19 Blatch., 392.

§ 716. It being understood that a result is not patentable, claims which read "forming one, two or more creases in cloth, by means of," etc., and "marking a line on the surface of cloth or other material sewed in a sewing machine by means of," etc., construed to be for the described apparatus for producing the results named. *Fuller v. Yentzer*, 4 Otto, 288.

See *Patentability*, § 4613.

Claims—Construction of—*Should be co-extensive with invention*, §§ 717-721. *Should be liberal*, §§ 722-732.

§ 717. It is the duty of the court to so construe claims, if they can without doing violence to the language used, as to make the claim commensurate with patentee's actual invention. *Ransom v. Mayor of New York*, 1 Fish., 252.

§ 718. The claim is to be construed as co-extensive with the invention, if it can be done without doing violence to its language. *Whipple v. Middlesex Co.*, 4 Fish., 41.

§ 719. If, by an examination of the specification, and applying to the then existing state of the art, we can learn what the invention was, then a claim, which was designed to be a condensed summary of the invention, is to be construed so as to be co-extensive with the invention, if that can be done without doing violence to its language. *Andrews v. Carman*, 13 Blatch., 307.

§ 720. The general terms, and sometimes special words, in the claim must receive such construction as may enlarge or contract the scope of the claim, so as to uphold that invention which the patentee has actually made and described, when such construction is not absolutely inconsistent with the language of the claim. *Estabrook v. Dunbar*, 10 O. G., 909.

§ 721. Claims should be so construed, if possible, as to embrace the invention actually made and described. *Clark v. Kennedy Manufacturing Co.*, 14 Blatch., 79.

§ 722. A claim should be construed in order that it may be sustained. *Wyeth v. Stone*, 1 Story, 273.

§ 723. Claims which can be construed to embrace meritorious combinations and devices will not be construed to embrace a principle, and to be therefore void, though they are capable of being so interpreted. *Union Paper Bag Co. v. Nixon*, 4 O. G., 31.

§ 724. Where the claim was not expressed with accuracy, *held*, that it should be construed "*ut res magis valeat quam pereat*," and in connection with the specification, so that the inventor shall have the benefit of what he has actually invented. *Stover v. Halsted*, 13 Blatch., 95.

§ 725. Patents will be construed, if possible, to sustain the claim, and statements in the specification, that certain things shown to be old are the equivalent of the invention, may be rejected. *Mallory Manufacturing Co. v. Marks*, 11 Fed. Rep., 887.

§ 726. The claim must be construed as favorably to the plaintiff as the language of the claim, the state of the art, and the extent and character of his actual invention, will allow. *Barden v. Corning*, 2 Fish., 477.

§ 727. A claim should be construed liberally in favor of patentee, and in view of the state of the art at the time. *Smith v. Pryor*, 2 Saw., 461.

§ 728. The claims in a patent should be liberally construed, but must be limited by the state of the art, showing the degree of improvement effected. *Mann v. Bayliss*, 10 O. G., 789.

§ 729. Claims and specifications are to be construed liberally, and mere rigid technicalities are to be set aside, unless there is a clear legal necessity for sustaining them. *Goodyear v. Berry*, 2 Bond, 189.

§ 730. Where patentee was first to make the combination (first in the field of invention), *held*, that he had a right to ask for a somewhat liberal construction of his claim. *Atwood v. Portland Co.*, 10 Fed. Rep., 283.

§ 731. The patentee, having described his invention and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim

every form in which his invention may be copied, unless he manifests an intention to disclaim some of these forms. *Union Paper Bag Machine Co. v. Pultz & Walkley Co.*, 15 Blatch., 160.

§ 732. Where a special function is relied upon to sustain a broad construction of a claim to a combination of known mechanical devices, it must clearly appear that it is a new function arising from the use of the devices in their new relation and for a new purpose, and due solely to such use. *Joyce v. Chillicothe Foundry & Machine Works*, 15 Fed. Rep., 230.

Claims — Construction of — *When the construction of a claim should be limited*, §§ 733-742.

§ 733. Where the claim is such as to leave no room for construction, where it is clear and explicit, and especially where there is nothing in the specification which shows that the patentee did not mean just what the plain language of the claim imports, there is no aid, and no need of it, from the specification. *Rich v. Close*, 8 Blatch., 41.

§ 734. Where a prior device accomplished the same thing, but not so perfectly as the patented device, the claim to the latter must be limited to its precise construction, whereby it accomplishes the results more perfectly, and will not include other means of doing it. *Matthews v. Schoneberger*, 18 Blatch., 357.

§ 735. Where the patent claims the whole as described, we cannot sever one part of the description from another; but we must take it in its totality and apply the description to the claim. *Evans v. Kelly*, 9 Biss., 251.

§ 736. The courts should be careful not to enlarge, by construction, the claim which the patent office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms. *Burns v. Meyer*, 10 Otto, 671.

§ 737. The claim cannot be enlarged by the language used in other parts of the specification. *Railroad Co. v. Mellon*, 104 U. S., 112.

§ 738. A claim to a combination of old elements will not be so broadly construed as to embrace a similar combination in which one of such old elements is omitted and an element performing a like office, but which is of a substantially different construction and which was new at the date of the patent, is employed. *Babcock v. Judd*, 1 Fed. Rep., 408.

§ 739. Had such element not been novel at the date of the patent, its substitution in the combination would have been simply the substitution of one well-known equivalent for another, and the change would have been but formal. *Ibid.*

§ 740. When the arrangement of the machine is such that the combination of all its several elements or their mechanical equivalent is necessary to its successful operation, claims to a limited number of these elements should fairly be construed to include the rest. *Wicke v. Ortrum*, 13 Otto, 461.

§ 741. A claim for a method or process consisting merely in the necessary mode of operation of a certain machine is to be construed as a claim for the machine, and not for a method or process independent of the machine. *Dederick v. Cassell*, 9 Fed. Rep., 306.

§ 742. The claims of a patent ought not to be expanded constructively beyond the limitations which the patentee has imposed upon them so as to cover subsequent improvements in an art in which the invention claimed was, at most, only a step in advance. *Couse & Blood v. Johnson, Black & Co.*, 16 O. G., 719.

Claims — Construction of — *Should be construed in view of the specification*, §§ 743-759; *the drawing*, §§ 760-766; *the model*, §§ 767, 768; *the state of the art*, §§ 769-774.

§ 743. Claims should be construed in view of the specification. *Hayden v. Suffolk Mfg. Co.*, 4 Fish., 86; *Goodyear v. New Jersey Central Railroad*, 2 Wall. Jr., 356.

§ 744. The claim must be construed in view of the explanations in the specification. *Turrill v. Railroad Co.*, 1 Wall., 491; *Tompkins v. Gage*, 5 Blatch., 268.

§ 745. The meaning of the claims in a patent is to be derived from the specification. *Holly v. Vergennes Machine Co.*, 18 Blatch., 327.

§ 746. Claims must be construed in connection with the descriptive part of the specification, and with reference to what is seen to be the real invention. *Coffin v. Ogden*, 7 Blatch., 61; *Bruff v. Ives*, 14 Blatch., 198.

§ 747. The claim must be construed in connection with the entire specification and in view of the state of the art at the time. *Rogers v. Sargent*, 7 Blatch., 507.

§ 748. Claims should be read in connection with the specification itself, and read in the light gained therefrom; and it is proper to give such construction to the language employed as expresses the evident intent, if that may be done. *Russell & Erwin Manuf'g Co. v. Mallory*, 10 Blatch., 140.

§ 749. The claim in every patent must be construed to be limited to the method or process described in the specification. *Mitchell v. Tilghman*, 19 Wall., 287.

§ 750. A claim must be construed in connection with the specification, if it refers to it, and may be so construed in all cases. *Roberts v. Dickey*, 4 Brewster, 260.

§ 751. The claim is to be read in connection with the specification, as if there was added to it the phrase "as specified," or "as set forth." *Bruce v. Marder*, 10 Fed. Rep., 750; *Matthews v. Schoneberger*, 18 Blatch., 357.

§ 752. The claim is to be read with reference to the specification, as though the words "substantially as described" were inserted. *Metropolitan Wringing Mach. Co. v. Young*, 14 Blatch., 46.

§ 753. Claims containing words referring back to the specification must be construed in the light of the explanations contained in the specification. *Gottfried v. Phillip Best Brewing Co.*, 17 O. G., 675.

§ 754. Where the claim immediately follows the description of the invention, it may be construed in connection with the explanations given in the description, and if the claim contains words referring back to the specification it cannot properly be construed in any other way. *Fuller v. Yentzer*, 4 Otto, 288.

§ 755. In construing the claim in a patent the specification is to be examined in connection with it, even when not referred to, and the statements contained in it are to be consulted as furnishing the patentee's interpretation of his claim. *Frañcis v. Mellor*, 1 O. G., 48.

§ 756. So where the specification speaks of a part or feature of the patented device as being "an important feature of the invention" and makes it a part of the claim, the omission of such feature from defendant's device saves him from infringing the patent. *Matthews v. Schoneberger*, 18 Blatch., 357.

§ 757. In construing the claims of a patent, the whole specification may be consulted, and where the claim itself incorporates in it, by reference, several features of the invention, this becomes essential. *Carter v. Messinger*, 11 Blatch., 34.

§ 758. The claim is construed in view of the specification, extraneous facts presented by the evidence as may aid therein, and particularly the documents from the patent office, which have preceded the granting of the patent itself. *Johnson v. Root*, 1 Fish., 351.

§ 759. A patent claim must be construed in the light of the specifications; and where the specifications describe the entire article, parts of the description cannot be separately considered to show an infringement of one of the parts. *Evans v. Kelly*, 9 Biss., 251.

§ 760. Where a claim refers to other parts of the specification and drawings, those parts are to be examined in connection with it, in order to ascertain what is claimed. *Hovey v. Stevens*, 3 W. & M., 17.

§ 761. The claim is to be construed in view of the specification and drawings; the whole instrument is to be construed together. *Brooks v. Fiske*, 15 How., 112; *Pitts v. Wemple*, 1 Biss., 87; *Kittle v. Merriam*, 2 Curt., 475.

§ 762. The claim of the United States patent is not separately construed, and with the same strictness, as the title or claiming part of the British patent. Under our law, the specifications and the drawings, as a whole, are included in and made component parts of the patent, and they should be taken in construction together in explanation of whatever is dubious; and according to this rule, one part of the specification and drawing may be resorted to to explain any other. *King v. Gedney*, 1 MacA. Pat. Cases, 443.

§ 763. The patent, the specifications, the whole specifications and the drawings may be referred to in ascertaining the extent of the patentee's claim. *Morris v. Barrett*, 1 Bond, 252.

§ 764. The drawings, as well as the specifications, are to be looked to in giving a construction to the claims of a patent in determining what was the invention of the original patentee. *Swift v. Whisen*, 2 Bond, 115.

§ 765. Reference in the claim to the drawings and the specification, *held* to constitute them to a certain extent, and for some purposes, a necessary part of the claim. *Reed v. Chase*, 25 Fed. Rep., 94.

§ 766. In view of the section of the law which requires an applicant for a patent not only to deliver a written description of his invention or discovery, but to particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery, and in view of the practice of the patent office under these provisions and the decisions of this court we think that the scope of letters patent should be limited to the invention covered by the claim, and that, although the claim may be illustrated, it cannot be enlarged by the language used in other parts of the specification. *Lehigh Valley Railroad Co. v. Mellon*, 104 U. S., 112.

§ 767. The claim may be construed in view of the descriptive part of the specification and by reference to the drawings and patent office model; but neither the correspondence between the commissioner and the applicant nor the proceedings in the patent office are admissible to enlarge, diminish or vary the language of the claim. *Goodyear Dental Vulcanite Co. v. Gardiner*, 3 Cliff., 408.

§ 768. Courts are allowed to look at the detailed specifications, models or drawings for the purpose of construing the claims. *Hancock Inspirator Co. v. Jenks*, 21 Fed. Rep., 911.

§ 769. Claims must be construed in view of state of art at the time they were made. *Washing Machine Co. v. Tool Co.*, 20 Wall., 342.

§ 770. Claims are to be construed with reference to the state of the art at the date of the invention. *Pitts v. Wemple*, 1 Biss., 87.

§ 771. A patentee's invention cannot be given a broad construction, so as to cover later inventions, when it appears from the state of the art that there was no opportunity for a great original discovery and the claim is properly limited to the specific improvement. *Root v. Lamb*, 7 Fed. Rep., 222.

§ 772. When the claims of a patent are susceptible of various meanings, that construction will be adopted which, in view of the state of the art, limits the patentee to and gives him the full benefit of the invention he has made. *Fitch v. Bragg & Co.*, 8 Fed. Rep., 588.

§ 773. Claims are to be construed by the state of the art, even though the patent contains no acknowledgment of it. *Jones v. Barker*, 11 Fed. Rep., 597.

§ 774. The technical claims in a patent are to be construed with reference to the state of the art, so as to limit the patentee to, and give him the full benefit of, the invention he has made. *Estabrook v. Dunbar*, 10 O. G., 909.

See *Substantially as Described*, §§ 6190-6202. *Construction of Patents*, §§ 1230-1233. *Drawings*, §§ 2066-2065. *Form*, §§ 2547-2552. *Reissues*, §§ 5428-5438.

Claims — Construction of — *Particular claims*, §§ 775-796. *Frivolous claims construed*, §§ 797, 798.

§ 775. Claim construed, in view of the specification, to be for a combination, by striking out a tautological expression. *Ames v. Howard*, 1 Sumn., 482.

§ 776. A claim "to cut ice of a uniform size by means of apparatus worked by any other power than human," construed to be for an art or principle in the abstract, broader than the invention, and utterly void. *Wyeth v. Stone*, 1 Story, 273.

§ 777. Where a patentee described his invention as consisting in "communicating motion to . . . and in the connection" of parts in the manner described, and concluded his specification by stating that the connection *might* be made and the motion communicated as specified, held, that the patent was only for the invention particularly described. *Stone v. Sprague*, 1 Story, 270.

§ 778. Claim construed to be for a combination, which requires different things, or contrivances or arrangements to be brought together to accomplish the given end. *Carver v. Brain-tree Mfg. Co.*, 2 Story, 432.

§ 779. A combination claim construed in view of the words "substantially as described," and limited to the particular application described in the specification. *Pitts v. Whitman*, 2 Story, 609.

§ 780. A claim for the discovery of a new principle and a process by which it may be made practical and operative, in which the process is minutely and fully described, sustained, as being patentable and all that the law requires (*Tilghman's Glycerine Patent*). *Tilghman v. Werk*, 1 Bond, 511.

§ 781. *Held*, that a process patent, by the fair import of the words, "a little below the point of fusion," claimed such a degree of heat as is necessary to effectuate the intention of the inventor. *Whitney v. Mowry*, 2 Bond, 45.

§ 782. Where the words "by treating them substantially as hereinbefore described" were added to a claim construed to be for an article of manufacture, *held*, that it became a claim for the product when formed by the process described. *Merrill v. Yeomans*, 1 Holmes, 331.

§ 783. A claim to a process which can only be worked out by a machine, which fails to work successfully, is void. *Union Mfg. Co. v. Lounsbury*, 2 Fish., 389.

§ 784. A claim construed to be for the new application of a principle by means of mechanical contrivances, and to be patentable, and not for the unpatentable discovery of the principle. *Foote v. Silsby*, 1 Blatch., 445.

§ 785. A claim to treating straw by a particular process construed in view of the specification not to be limited to the single substance mentioned. *American Wood Paper Co. v. Fibre Disintegrating Co.*, 6 Blatch., 27.

§ 786. A claim for "softening the upper parts of paper bags, and making them pliable" construed in view of the whole patent and specification to be for an improved bag — a patentable result. *Arkell v. Hurd Paper Bag Co.*, 7 Blatch., 475.

§ 787. *Held*, that a process claim, requiring a certain degree of heat, was not limited to the exact degree, and that a slight lowering of the heat countervailed by extending the process a

fraction of time, or other departures not substantially different, would not avoid infringement. *American Wood Paper Co. v. Glens Falls Paper Co.*, 8 Blatch., 513.

§ 788. A claim construed so as to confine it to the especial mode of producing the effect which was described, when the same effect had been produced before in other similar articles. *Sarven v. Hall*, 9 Blatch., 524.

§ 789. A patent for a device which is new is not the less valid because the claim for it is limited to the use of it in connection with another, although there is no legitimate combination between the two. *Russell & Erwin Manufacturing Co. v. Mallory*, 11 Blatch., 140.

§ 790. Although the claim in such case is expressed to be for "a combination" of the two devices, it is not to be technically construed, but is to be understood as indicating a single article of manufacture or use. *Ibid.*

§ 791. A claim construed to be not for a process, but for the combination of certain parts of known machinery by which a new variety of a well-known article may be produced; *held*, not patentable. *Le Roy v. Tatham*, 14 How., 156.

§ 792. A combination claim naming two independent sets of devices used for producing different operations or results, and containing the words "or either, in relation to each other," and to another part not affected by either of them, is void for uncertainty. *Edgerton v. Furst & Bradley Manufacturing Co.*, 10 Biss., 402.

§ 793. The word "tight" used in the claim to qualify the wooden tobacco-holding vessel, *held*, to mean sufficiently tight to subserve the purposes to be accomplished by the invention. *Robinson v. Sutter*, 8 Fed. Rep., 828.

§ 794. A claim to "giving the saw in its downward movement a rocking or rolling motion, by means of the combination," etc., is not a claim to the rocking movement itself, but the means devised for producing it. *Ives v. Hamilton*, 2 Otto, 426.

§ 795. A claim for "the preliminary shaping of the end of the metallic bar to make it correspond on all sides save one with the cross section of the finishing die box, by which the necessity of cutting off by the punch of more than one side of the nut to be formed is prevented, and from which results a very great saving of metal in manufacturing many-sided nuts at the same time, at a considerable saving of power, as produced in operating the machine. But this is only claim when the said preliminary shaping of the exterior portion of a nut is accomplished immediately in front of the mouth of a die box, substantially in the manner herein set forth,"—construed to be for a combination of the parts specified, arranged and operating, as described in the specification, to accomplish the desired result, and *held* to be patentable. *In re Cole*, 1 MacA. Pat. Cases, 539.

§ 796. Morse's eighth claim construed to be for the use of a manner and process, which he had not described nor invented, and therefore too broad. *O'Reilly v. Morse*, 15 How., 62.

§ 797. A peg or stop to prevent the rear part of a machine from tipping so far as to dump the driver on the ground is too frivolous a device to be regarded as an invention, and a patent for it is void. *Corn-Planter Patent*, 23 Wall., 181.

§ 798. When the claims of a patent present neither novelty nor utility they will be considered as frivolous and not within the sphere of what is properly patentable. *Densmore v. Scofield*, 12 Otto, 375.

Claims — Construction of.

SUMMARY (*CARLTON v. BOKEE*, §§ 799-803) — *The patent reviewed*, § 799, 800. — *Nebulous claims render patent void*, § 801. — *What constitutes a void claim*, § 802. — *Effect of void claim accidentally made*, § 803.

CARLTON v. BOKEE.

(17 Wallace, 463-473. 1873.)

APPEAL from U. S. Circuit Court, District of Maryland.

STATEMENT OF FACTS.—This was a bill by Carlton and others, to restrain Bokee from infringing a patent for an improvement in lamps. The patent was granted to Reichmann, and reissued to Carlton and Merrill. The bill was dismissed by the lower court and complainant appealed.

§ 799. *Patent No. 21,576, C. Reichmann, September 21, 1858, lamp, reviewed. Reissue construed, limited, and not infringed; claim four held void.*

Opinion by MR. JUSTICE BRADLEY.

The lamp as patented to Reichmann was one of a large number of attempts made about the time to utilize petroleum and its various products for purposes

of illumination. The old lamps adapted to sperm oil, lard and other gross and sluggish oils were unfitted for the use of so volatile and dangerous a substance. In them the flame was set close to the lamp, and the tube holding the wick was projected downward into the oil, so that the heat of the flame might be communicated thereto in order to render it more fluid and susceptible to the capillary attraction of the wick. Such an arrangement as this with petroleum would have produced a speedy explosion. This article required that the flame should be elevated as far as possible above the lamp, and that the metallic wick-tube should not communicate any heat to the fluid. This was one object to be attained in the burners required for the use of the new illuminator. Another was some contrivance for concentrating a current of air upon the flame itself, so as to consume as perfectly as possible all the rapidly escaping volatile gases, both as a saving of light and as a preventive of the disagreeable odors which they would otherwise diffuse.

Reichmann's burner was intended to accomplish these main objects as well as some subsidiary ones, which will hereafter appear. It consisted of several distinct parts, combined and arranged in a particular manner. First, a flat wick-tube attached to the cap or stopper of the lamp, and rising above the same one or two inches, more or less, according to the size of the burner, but not projecting into the lamp below. Secondly, ratchet-wheels attached to the side of the wick-tube on a small shaft for raising and lowering the wick. Thirdly, a slide or sleeve fitted to slip up and down over the wick-tube, and sufficiently tight to stay in any position thereon, and furnished with arms, two or more, for supporting above the wick-tube a dome or deflector. Fourthly, the dome aforesaid, having an oval or oblong slot for the flame to pass through, so that part of the flame might be above the dome and part below it. The object of this dome was to collect and concentrate the air upon the flame, in order to make it burn more brightly and consume the hydro-carbon and other gases which emanated from the petroleum. It also acted as a deflector of the light proceeding from the lower part of the flame, whereby it was thrown downward towards and around the lamp, whereas the light from that part of the flame above the dome was all thrown upward or horizontally about the room. Fifthly, around the periphery of the dome several narrow slips of the metal were turned up, to act as arms or supports to the glass chimney of the lamp, and between these arms spaces were cut out of the edge of the dome to allow air to pass up between the dome and chimney for the purpose of guiding the flame and feeding it with additional oxygen. Sixthly, the chimney itself, which was placed inside of and upon the said arms or supports, and held in its position thereby.

This was the combination of elements of which Reichmann's burner consisted, and it will be perceived that the chimney was so elevated that the flame of the lamp below the dome was exposed on every side, and a current of air or a rapid movement of the lamp would extinguish it. This was the great defect of the burner, which prevented its introduction into general use and rendered it of little value. The principal advantage which Reichmann, in his patent, claimed for it was that it allowed the light from the under side of the deflector to be reflected or thrown downward upon the table or lamp. This was effected by the use of upright, slender arms to support the dome, so that the space around and underneath the dome was left open and uninclosed. He also claimed some less important advantages in his arrangement of the ratchet-wheels for raising the wick, and one or two other things of no impor-

tance in this controversy. The patent had but one claim, and that amounted to the general combination of elements referred to and their peculiar arrangement. It was in these words:

“What I claim as new and desire to secure by letters patent is, in combination with the lamp, the slotted, open, bell-shaped cap (*i. e.*, the dome), when so constructed, arranged and operating as to allow light to be deflected downwards, substantially in the manner and for the purpose herein set forth and explained.”

In order to understand how narrow this claim really was, it is necessary to know a little of the history of the art. Two well-known burners are conceded to have been in use before Reichmann's invention, which have a material bearing on his claims; the Vienna burner and Stuber's burner. These have been exhibited to us. The Vienna burner contained the flat wick-tube, the ratchet-wheel attached thereto (but covered and not exposed as in Reichmann's), and a slotted dome above the wick for the flame to pass through, and a chimney; but the dome was not supported by slender arms, as in Reichmann's, but was connected with a gallery, which supported the chimney and surrounded the wick-tube and dome and rested on the lamp or cap below, so that all the light of the flame below the dome was inclosed and lost, and could not issue out as in Reichmann's burner.

The Stuber burner, invented by John Stuber in 1856, and made in considerable quantities in that and the following years at Utica, New York, was an improvement on the Vienna burner, in this, that the gallery was so low as to leave a considerable open space under the dome for the reflected light to pass out in a downward direction, and the dome was supported by slender arms, but these arms were attached to the gallery and not to a sleeve fitted on to the wick-tube. It differed, therefore, from Reichmann's in these respects: the chimney was supported on a low gallery instead of the dome itself, and the dome was supported by arms attached to this gallery instead of arms attached to a sleeve on the wick-tube. Therefore, with these burners before us, all the invention we can discover in Reichmann's burner is the peculiar mode of supporting his dome by slender arms attached to a sleeve fitted on to the wick-tube, and the elevation of the chimney on the outer edge of the dome. The latter peculiarity, as we have seen, is a defect which rendered the burner nearly useless. The lamp made and sold by the defendants was patented to L. J. Atwood, October 13, 1863.

The allegation of the complainants that the defendant uses Reichmann's invention of peripheral springs around the edge of the dome for steadying his chimney we regard as fallacious. The transformation by a mere trick of words and vague generalities of the arms or supports used by Reichmann to sustain his chimney into peripheral springs may be ingenious, but it cannot stand the test of sober consideration. It is not pretended that Reichmann produced anything more than the arms or support shown in his original patent. These were mere slips of metal turned up around the edge of the dome, such as had been in common use for a great period of time. All that Reichmann did new in this regard was to elevate his chimney on the top of the dome. This, in fact, rendered his lamp in the main useless, and the defendant does not copy it, but slips his chimney down around the dome and places it on a platform perforated with holes, which rests upon the cap of the lamp and answers to the bottom or floor of Stuber's gallery. He thus surrounds the flame with the chimney below as well as above the dome and prevents it from being

extinguished by drafts of air, without obstructing the issue of the light from below the dome. In this respect his lamp is more like Stuber's than Reichmann's. It is true that he keeps his chimney from coming in contact with the dome by surrounding the latter with a fine spiral spring or metallic fringe, but this has no resemblance or analogy to the supporting arms appended by Reichmann to his dome.

The question whether the defendant's burner, which is called the Comet, contains the other peculiarity of Reichmann's burner, namely, the supporting of the dome by slender arms attached directly to a sleeve fitted snugly upon the wick-tube, admits of more discussion. The dome was supported by slender arms both in Stuber's and Reichmann's lamps, but in the former the arms were attached to the surrounding gallery on which the chimney rested, and which was slipped over a raised portion of the base to which the wick-tube was affixed and there held in place by a bayonet fastening, whilst in Reichmann's burner the arms were attached to a sleeve, fitted directly upon the wick-tube so snugly as to support the dome and chimney firmly and steadily, as before described. Now, in the Comet burner of the defendant, the arms supporting the dome are attached to the platform before mentioned, which answers the place of the gallery floor in Stuber's burner, and the central portion of which is perforated with an opening or slot so as to pass down over the wick-tube when being placed on the lamp; around this slot or opening the platform is raised next to the wick-tube in a conical form so that the top edge of the raised part touches the wick-tube, and thus helps to give steadiness to the dome and chimney. The arms are attached to this raised part. But this raised portion of the platform is very far from being Reichmann's sleeve, which was a peculiar characteristic in his lamp, and the sleeve arrangement was all that Reichmann pretended to have produced. Its generalization in the reissued patent is simply effected by a dextrous use of words and vague generalities. We are constrained to hold, therefore, that the Comet burner is not an infringement of Reichmann's original patent or of the invention which is exhibited in his original specification.

It is proper next to inquire as to the bearing of the reissued patent on the question in litigation between the parties. The defenses made by the defendant against this reissue are, first, that it was obtained illegally, wrongfully, and by false pretenses, and because it seeks to claim things of which Reichmann was not the original and first inventor; secondly, that the original patent itself was void, because the only thing in it which Reichmann had any pretense of inventing was anticipated by a man by the name of Michael Collins, as early as 1843.

§ 800. *Reissue 3082, C. Reichmann, August 11, 1868, lamp, construed in view of state of the art at the date of the original patent.*

§ 801. *A specification containing a needless multiplication of nebulous claims, calculated to deceive and mislead the public, renders the patent void.*

The specification of the reissued patent describes the burner of Reichmann substantially as was done in the original patent, being interspersed, however, with observations as to the uses and objects of particular parts, evidently borrowed from subsequent experience and events. The single claim of the original patent is expanded into seven distinct claims. The first three of these claims, taken with the qualifications which they contain, and limited as they must be by the state of the art at the time when the original patent was applied for, amount to precisely the same thing and to no more than the one

claim of the original patent. The first is for a combination of only two elements, it is true, the flat wick-tube and the dome, which combination is found in both the Vienna and Stuber burners; but a qualification is added, that the combination is to be "under the *arrangement* substantially as shown and described, so that, *while directly connected with each other*, the said parts shall allow light to pass out or be reflected from between them, as set forth." Thus it is made essential to the invention here claimed, not only that the two elements named should be present, but that they should have the arrangement described in the patent, and should have a direct connection with each other, and that the light should be reflected from between them. All these things exist in the Stuber burner except one. In that burner the wick-tube and the dome are not directly connected together. The dome is first connected with the gallery and the gallery with the wick-tube. So that the claim is reduced to the same thing which was claimed in the original patent. The same may be said of the second and third claims. If they mean anything more than the claim in the original patent they are void. Being identical with that, they are needlessly multiplied, and by exhibiting a seeming of claims to which Reichmann was not entitled, they are calculated to confuse and mislead. We think it proper to reiterate our disapprobation of these ingenious attempts to expand a simple invention of a distinct device into an all-embracing claim, calculated by its wide generalizations and ambiguous language to discourage further invention in the same department of industry and to cover antecedent inventions. Without deciding that a repetition of substantially the same claim in different words will vitiate a patent, we hold that where a specification, by ambiguity and a needless multiplication of nebulous claims, is calculated to deceive and mislead the public, the patent is void.

The fourth claim was clearly anticipated by the burner of Stuber. It is in the following words: "A lamp-burner composed of two groups of elements, the first consisting of the base with its wick-tube and wick-adjusting rack and pinions; the second of a chimney-holder, deflector, and such other parts as may be needed for the proper combustion of the fluid so as to produce an illuminating flame, the two groups being united by friction, and the latter, when in position in the burner, being supported by the former without the intervention of any mechanical device whereby the two may be rigidly connected together, substantially as and for the purposes herein shown and set forth."

§ 802. *A claim is void if all the elements specified are found in a previous instrument of the same kind, although in the latter they were associated with another feature not essential to their operation.*

§ 803. *One void claim made by mistake or inadvertence will not vitiate a patent.*

Everything here claimed is found in Stuber's burner. If this claim is valid Stuber could be enjoined. The addition of a bayonet fastening by Stuber does not destroy the identity of his lamp with the alleged invention described in this claim. It follows that this claim is void for this reason, without reference to other objections which have been suggested in relation to it. One void claim, however, does not vitiate the entire patent, if made by mistake or inadvertence and without any wilful default or intent to defraud or mislead the public. Giving to the complainants the whole benefit of this indulgence there is still nothing in the remaining claims which the defendant is called upon to answer. They are merely for combinations of parts in the original burner of Reichmann which the defendant does not use, unless the pretense of

a claim to peripheral springs as distinguished from Reichmann's arms and supports can be sustained. We have already seen that this cannot be done.

Our conclusion, therefore, is that the Comet burner is no infringement of Reichmann's reissued patent so far as that patent is valid. This view of the case makes it unnecessary to discuss the question relating to the alleged invention of Collins. Whilst his conduct and testimony and that of the other witnesses who testify to his invention are susceptible of much criticism, we think it proper to say that we should feel great difficulty in disregarding it altogether. If the models presented by him were really his invention at the time sworn to, the Reichmann patent has no foundation whatever to stand on. But waiving the discussion of this question, we feel bound to affirm the decree of the circuit court for the reasons above stated.

Decree affirmed.

Claims — Construction of — Ambiguous claims, § 804. A matter of law, §§ 805, 806.

§ 804. Construction of claims, where expressed in ambiguous or loose terms, or expanded on reissue with fraudulent intent. Rule stated. *Taylor v. Garretson*, 9 Blatch., 156.

See *Reissue*, § 5373.

§ 805. The construction of the claim is matter of law. *Foster v. Moore*, 1 Curt., 279.

§ 806. In the construction of claims the questions involved as to their validity, on the points of novelty and patentability, are largely questions of law; and the fact that the claims had been granted upon appeal entitles the patentee to repose upon them as valid until a decision of a court holding them otherwise. *Burdett v. Estey*, 15 Blatch., 349.

See *Process and Product*, §§ 5113-5115.

Claims — Construction of.

SUMMARY — (KEYSTONE BRIDGE COMPANY v. PHOENIX IRON COMPANY, §§ 807-810) — *The patents in suit reviewed*, § 807. — *Their infringement*, § 808. — *Correction by reissue of matter not claimed*, § 809. — *Patentee is bound by his claim*, § 810.

KEYSTONE BRIDGE COMPANY v. PHOENIX IRON COMPANY.

(5 Otto, 274-279. 1877.)

APPEAL from U. S. Circuit Court, Eastern District of Pennsylvania.

Opinion by MR. JUSTICE BRADLEY.

STATEMENT OF FACTS.— The appeal in this case is brought to review the decree of the circuit court dismissing the bill of complaint, which charges an infringement of two certain patents belonging to the Keystone Bridge Company. These patents were for improvements in iron truss bridges. The first was granted to J. H. Linville and his assignee, J. I. Piper, January 14, 1862; the second to the same parties, October 31, 1865. The particular claims upon which the contest arises before us are the first claim in the former patent, and the third in the latter. Both of these claims relate to the lower chords of the truss, the primary office of which is to hold the lower parts of the structure together, and keep them from spreading, but which are also employed in the construction of the patentees to sustain the cross-sills which support the railroad.

§ 807. *Patents 34,183, Linville & Piper, January 14, 1862, iron truss for bridges, and 50,732, Linville & Piper, October 31, 1865, wrought iron bridges, construed. The specification and claim in both of complainants' patents having clearly indicated that certain characteristic features were regarded as of the essence of the invention, the court declined to enlarge the scope of the patents beyond what was thus explicitly set forth.*

We do not think we ought to disturb the decree of the circuit court in this case. We regard the construction of the claims in question insisted upon by

the appellee as substantially correct. Those claims are the first in the patent of 1862, and the third in that of 1865. It is manifest that, in the former, the form of the chords is deemed material, or, at least, it is made so by the terms of the specification and claim. They are flat bars placed on edge so as to sustain superincumbent weight, as well as perform the office of tension braces. They are made in this form in order that the floor beams of the railroad may be directly laid on them. This is apparent from the whole tenor of the specification. The patentee, in describing his invention, commences by saying: "My invention consists, 1st, in a novel construction of the lower chords, and mode of applying the same, in combination with the posts and other parts of the truss." Again: "The bottom chords are each composed of a series of wide, thin eye-bars, of wrought iron, of a length corresponding with the distances between the posts on one side of the truss, placed on edge to enable them to give vertical support to the roadway," etc. Then, after showing that these eye-bars or chords are made wider at the ends where the eye-holes are made for inserting the connecting pins or bolts, which connect the different sections together, and explaining the general construction of the bridge and its different parts, he concludes with the following claim: "I do not claim the use of eye-bars or links as chains of suspension bridges; but what I claim as my invention, and desire to secure by letters patent, is, 1st, the construction of the lower chords of truss bridges of series of *wide and thin* drilled eye-bars, C, C, *applied on edge* between ribs, S, S, on the bottoms of the posts, and connected by pins, P, P, supported in the diagonal tension braces D and E, all substantially as herein described." Words cannot show more plainly that the claim of the inventor does not extend to any other eye-bars or chords than such as are made wide and thin, and applied on edge. As those constructed by the defendant are cylindrical in form, only flattened at the eye for insertion between the ribs or projections of the posts, it is plain that no infringement of this claim of the patent has been committed.

The other claim in question, namely, the third claim of the patent of 1865, is for the employment in truss bridges of just such wide and thin chords as above described, whose ends are enlarged or widened by being upset (when heated) by compression into moulds in the manner described in the specification of the patent. The mode of upsetting, widening and shaping the ends of the bars is by placing the ends, after the bars have been rolled into proper shape and size, and the ends heated, into a die-box of the regular form, and then firmly locking them in place, and with great power pressing them up endwise with a movable head-die until the hot iron fills the die-box. By this pressure the ends are upset, widened and compressed into the desired shape. It is claimed, that by this process the ends are made stronger and better able to sustain the great strain to which they are subjected when in place in the truss. The defendant upsets the ends of the chords made by it before putting them into the die-box, then places them in the box and flattens them into shape in much the same way that is described in the patent. The process is not in all respects the same, but perhaps sufficiently alike to constitute an infringement if the claim of the patent were only for the process of forming the widened ends. But it is not so, and probably the patent could not be sustained if it were; for spike-heads, nail-heads, bolt-heads, and many other things of that sort, are formed by upsetting and compressing hot iron in the same way. It is only the use in truss bridges of flat bars or chords, with the ends upset and widened in this manner, which the patentees claim as their invention. Their

claim is for a particular product, made by a particular process, and applied to a particular use. The patent of 1865 refers to that of 1862, and the invention sought to be patented is claimed as an improvement on the prior one. The patentees say: "Our invention consists of certain improvements in the construction of the wrought-iron truss bridge for which letters patent of the United States were granted to us on the 14th of January, 1862. In the truss bridge shown in the accompanying drawings the general arrangement of the parts is similar to that shown in our previous patent just referred to,—the improvements forming the subject-matter of this invention relating to the following particulars:" [then, after specifying certain improvements in the posts and in the upper chords of the truss, the patentees proceed as follows:] "2. The use of bottom chords of thin wrought-iron plates, the eye of which at each end, instead of being cut out of a rolled plate and drilled or forged into shape, is upset under strong compression, so as to give at the eye of the bar a degree of strength equal or superior to that of the bar at any point between the eyes." Then, describing the various parts of the truss in its improved construction, in speaking of the bottom chords (which are those in question) the patentees say: "The bases of the posts, A, are connected at their bases longitudinally by the lower chords, D, of which four may be placed parallel to each other, on each side of each panel. They are made of *thin bars of rolled iron*, of sufficient depth, and *placed on edge*, so as to support the roadway, and are attached to the bases of the posts by the connecting pins, N, which pass through the hole or eye near the end of these bars." Again, in summing up, the patentees say: "The lower chords, D, consist of *wide, thin rolled iron bars*, with enlarged ends, which are made by upsetting the rolled bars by compressing them into the desired shape in moulds into which the heated iron is forced under immense pressure," etc. And then, in order to exclude the idea that they claim the mode of compressing the ends, they add: "We do not claim the upsetting of iron bars in the manner described, nor any peculiar mode of performing the operation, but merely the use of chord-bars for bridges, the eyes of which are thus formed so as to give additional strength to the bar where it is so much needed." The claims are then set forth categorically in the usual manner, the third claim (the one in question) being in these words: "3d. The use for the lower chords of truss frames of *wide and thin rolled bars* with enlarged ends, formed by upsetting the iron, when heated, by compression into moulds of the required shape, for the purpose of increasing the density, toughness, and strength of the eye of the rod, and enlarging the eye, without diminishing its transverse section, substantially as hereinbefore described."

§ 808. *A patent for wide and thin bars is not infringed by the use of round bars for the like purpose.*

Here, again, the patentees clearly confine themselves to "*wide and thin*" bars. They claim the use in truss bridges of such bars when the ends are upset and widened in the manner described. It is plain, therefore, that the defendant company, which does not make said bars at all, but round or cylindrical bars, does not infringe this claim of the patent. When a claim is so explicit, the courts cannot alter or enlarge it.

§ 809. *If the patentees have not claimed the whole of their invention, and the omission has been the result of inadvertence, the error can be corrected by the remedy of reissue.*

If the patentees have not claimed the whole of their invention, and the

omission has been the result of inadvertence, they should have sought to correct the error by a surrender of their patent and an application for a reissue. They cannot expect the courts to wade through the history of the art and spell out what they might have claimed but have not claimed. Since the act of 1836, the patent laws require that an applicant for a patent shall not only, by a specification in writing, fully explain his invention, but that he "shall particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery." This provision was inserted in the law for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture, derived from a laborious examination of previous inventions, and a comparison thereof with that claimed by him. This duty is now cast upon the patent office. There his claim is, or is supposed to be, examined, scrutinized, limited, and made to conform to what he is entitled to. If the office refuses to allow him all that he asks, he has an appeal.

§ 810. *When the terms of a claim in a patent are clear and distinct (as they always should be), the patentee in a suit brought for infringement is bound by it. He can claim nothing beyond it. Neither can he show that his invention is broader than the terms of his claim; or if broader, he must be held to have surrendered the surplus to the public.*

But the courts have no right to enlarge a patent beyond the scope of its claim as allowed by the patent office, or the appellate tribunal to which contested applications are referred. When the terms of a claim in a patent are clear and distinct (as they always should be), the patentee, in a suit brought upon the patent, is bound by it. *Merrill v. Yeomans*, 94 U. S. 568. He can claim nothing beyond it. But the defendant may at all times, under proper pleadings, resort to prior use and the general history of the art to assail the validity of a patent or to restrain its construction. The door is then opened to the plaintiff to resort to the same kind of evidence in rebuttal; but he can never go beyond his claim. As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their claim; or if broader, they must be held to have surrendered the surplus to the public.

The construction which we have felt bound to give to the patent obviates the necessity of expressing any opinion upon the other point made by the court below, namely, that the patents only covered the use of the chords in question in truss bridges, and not the making of such chords, which latter is all that the defendant company is shown to have done. *Decree affirmed.*

Claim — Patentee bound by his, §§ 811-834.

§ 811. Where patentee claims anything as his invention, courts of law cannot reject the claim; and if not new the patent is void. *Moody v. Fiske*, 2 Mason, 112.

§ 812. When a patentee claims anything as his own, courts of law cannot reject the claim, though he may disclaim it; otherwise he is limited to his claim and his patent must stand or fall by it. *Parker v. Sears*, 1 Fish., 93.

§ 813. The claim is binding on the patentee as a limitation to the thing patented. *Whitney v. Emmett*, 1 Bald., 303.

§ 814. Patentee is limited to his claim. *Smith v. Elliott*, 9 Blatch., 400; *Dennis v. Cross*, 3 Biss., 389.

§ 815. Patentee is bound by his claims. *Meissner v. Devoe Manufacturing Co.*, 9 Blatch., 363.

§ 816. The plaintiff can recover only for the invasion of what he has claimed, however much less the claim may be than his actual invention. *Howe v. Williams*, 2 Cliff., 245.

§ 817. If patentee claims only a part, or some particular form, of his invention, such part or particular form, only, is secured to him. *American Pin Co. v. Oakville Co.*, 3 Blatch., 190.

§ 818. The claim governs the patent, and, in order to ascertain what is patented, reference must be had to the claim. *Haselden v. Ogden*, 3 Fish., 378.

§ 819. A patentee will not be allowed to expand his patent inferentially. He can patent no more than he has proclaimed. *Detmold v. Reeves*, 1 Fish., 127.

§ 820. A patentee cannot repudiate one part of his machine after another inventor has taught him how to dispense with it. *Hale v. Stimpson*, 2 Fish., 565.

§ 821. Where the claim does not correspond with or cover the specifications, the patentees are confined to what is expressed in their claim. *Knox v. Quicksilver Mining Co.*, 4 Fed. Rep., 809.

§ 822. The patentee's exclusive right is enforceable only within the limits of his own definition of it. *Couse v. Johnson, Black & Co.*, 16 O. G., 719.

§ 823. Material words cannot be stricken out of a claim to enlarge the meaning of the invention; the invention must be limited to the language of the claim. *Fuller v. Yentzer*, 6 Biss., 203.

§ 824. An inventor cannot go beyond what he has claimed and insist that his patent covered something not claimed, merely because it is to be found in the descriptive part of the specifications. *Lehigh Valley R. Co. v. Mellon*, 104 U. S., 112.

§ 825. A patentee is estopped by his claim from abandoning any part of it claimed as material. *Bell v. Daniels*, 1 Bond, 212.

§ 826. Patentees having founded their claim on the specification can neither modify nor abandon it in whole or in part. *Le Roy v. Tatham*, 14 How., 156.

§ 827. A patentee is estopped by his claim from denying that part of the matter claimed is not of the essence of his invention; and his claim will be construed accordingly. *Carver v. Hyde*, 16 Pet., 513.

§ 828. Patentee is limited to his claims, and is estopped from showing that some part which he claims, though not his invention, is of slight value or importance. *Moody v. Fiske*, 2 Mason, 112.

§ 829. Where a certain element is distinctly claimed as part of the claim, the court cannot strike it out in construing the claim. *Bliss v. Haight*, 7 Blatch., 7.

§ 830. Where an element is claimed in a combination for a distinct and specific purpose, it cannot be rejected in construing the claim. *Rich v. Close*, 8 Blatch., 41.

§ 831. Where one of the elements of the combination by the express words of the claim was certain means described, *held*, that patentee was bound thereby and could not reject it as surplusage without meaning. *Sands v. Wardwell*, 3 Cliff., 277.

§ 832. Patentee is estopped by his claim from dispensing with an element in the combination in order to show an infringement. *Coolidge v. McCone*, 2 Saw., 571.

§ 833. Our law requires the patentee to specify particularly what he claims to be new, and if he claims a combination of certain elements or parts, we cannot declare that any one of these elements is immaterial. *Union Water-Meter Co. v. Desper*, 11 Otto, 332.

§ 834. Where in the specification an invention was stated to consist of four elements in combination, and in the claims there are two combinations of less number of elements and no claim for the combination of all four elements, *held*, that the claims, if clear and distinct, must control. *McKesson v. Carndick*, 19 Blatch., 158.

See *Combination*, § 878. *Estoppel*, §§ 2213-2217. *Reissues*, §§ 5437, 5438.

Claim — *Defined*, § 835. *Its office*, §§ 836, 837. *Must be for something distinctly described*, §§ 838-846. *Each claim is a distinct patent*, § 847.

§ 835. The claim is the attempt on the part of the inventor to describe the very thing which he supposes he has invented and for which he asks a patent. *Many v. Jagger*, 1 Blatch., 372.

See *Specification*, § 5997.

§ 836. The office of the claim is to define the limits of the patented discovery claimed by the patentee as his exclusive property. If it is so ambiguous and uncertain that its true meaning cannot be made out without resorting to conjecture, or if it includes that which is old, then the patent is void. Whether it is vague and uncertain is a question of law to be determined by the rules of construction, applied in the light of the state of the art. *Blake v. Stafford*, 6 Blatch., 195.

§ 837. It is the office of the claims of a patent to reveal to the world what the characteristics of the invention are for which the patentee desires protection. If he fail to state these fully and correctly, he may remedy the omission by a surrender and reissue, but until then the court has no power to give him relief against infringers. *Delaware Coal & Ice Co. v. Packer*, 24 O. G., 1273.

§ 838. The claim must be made to something as new, in such plain terms that it can be readily understood, and with "reasonable certainty" (1 Story, 286), what it is. *Hovey v. Stevens*, 3 W. & M., 17.

§ 839. The claim in a patent must be for something described in the specification, so that any person of ordinary mechanical skill, or skill in the art covered by the patent, can, from the specification, make a mechanism which will contain the claim. *Vogler v. Semple*, 7 Biss., 382.

§ 840. In a claim for an improvement, it is essential that the part improved should be so distinctly stated as to be distinguished from every other part of the machine. *Brooks v. Jenkins*, 3 McL., 432.

§ 841. Where the claim is not specific enough to cover the invention or indicate the improvement meant to be patented, the patent is invalid. *Maguire v. Eames*, 18 Blatch., 321.

§ 842. A patentee cannot claim the benefit of an element of his invention vaguely and indefinitely hinted at. Such vague and indefinite description is not a compliance with the statute. *Western Electric Mfg. Co. v. Ansonia Brass & Copper Co.*, 114 U. S., 447.

§ 843. The law makes special requisition for clearness and definiteness of claims in the specifications for machines, by declaring that the applicant shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions, and shall particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery. *In re Davis*, 1 MacA. Pat. Cases, 628.

§ 844. An inventor can lawfully claim only what he has invented and described, and if he claims more his patent is void, unless he disclaims. *O'Reilly v. Morse*, 15 How., 62.

§ 845. Where a claim covers a process not described in the specification, there is much reason for holding that it is invalid. *Needham v. Washburn*, 4 Cliff., 254.

§ 846. Where the subject of a claim is of a doubtful patentability and the specification vague with regard to it, the patentee cannot make a valid claim for it. *Couse & Blood v. Johnson, Black & Co.*, 16 O. G., 719.

§ 847. Held, that each claim of a patent is, in effect, a separate and distinct patent; and the right to use one patent does not carry with it the right to use the others without further license. *United Nickel Co. v. California Electrical Works*, 25 Fed. Rep., 475.

Claim — Failure to claim raises presumption of abandonment, §§ 848-853.

§ 848. If a patent is neither inoperative nor invalid, etc., and the patentee has omitted to claim anything which he has described, it is to be presumed that he has abandoned it to the public. *Conklin and Stafford*, 1 MacArth., 375.

§ 849. It being found that the omission in this case was not owing to inadvertence, accident or mistake, it was presumed that it was intentional, and with the view of abandoning to the public the devices not claimed in the original. *Ibid.*

§ 850. The presumption was held to be materially strengthened because the applicant had waited eighteen years after completing his invention before applying for a patent, and after obtaining it had lived five years without ever intimating that it was defective; had, on the contrary, made several improvements for which patents were obtained under his direction; and the reissue was not applied for until four years after his death, and the devices had meanwhile gone into extensive use. *Ibid.*

§ 851. The presumption was held to be strengthened, also, by evidence that the devices sought to be introduced in the reissue had been in use before the original application was filed, although the evidence might not be sufficient to show want of novelty. *Ibid.*

§ 852. Patentee can take no more by his patent than he has claimed, and what is not claimed or described by apt words in the patent, he must be presumed to have abandoned to the public. *Evarts v. Ford*, 5 O. G., 58.

§ 853. If the patentee omits to notice in his patent the intermediate machines he produced in the course of his experiments, he must be presumed to have abandoned them. *Evarts v. Ford*, 5 O. G., 58.

See *Abandonment*, §§ 41, 82, 87, 98-102. *Combination*, § 966. *Patents*, §§ 4706-4708, 4726, 4729. *Reissues*, §§ 5326, 5589.

Claim — Failure to claim raises presumption of want of novelty, §§ 854-857.

§ 854. Where patentee specifies what he claims as new, every mechanical part, principle or combination which he mentions in his specification, but not included in his invention as claimed and limited, must, by necessary implication, be considered as admitted to be old or in use before. *Winans v. New York & Erie R. R.*, 1 Fish., 213.

§ 855. The summary of the patentee's claim, usually annexed to the specification, admits that all that is not included is old, and it is a sufficient compliance with the law requiring the new to be distinguished from the old. (*Brown v. Hatch*; *Brown v. Selby*.) *Corn-Planter Patent*, 23 Wall., 181.

§ 856. It is a presumption of law, where a patent is claimed for combination simply, that all the elements of the combination are old. *Clark Pomace Holder Co. v. Ferguson*, 17 Fed. Rep., 79.

§ 857. Where a patentee claims as his invention only the combination which he describes, the separate constituent parts of such combination are to be regarded as old or common and public. *Rowell v. Lindsay*, 10 Biss., 217.

See *Disclaimer*, §§ 2020-2065.

Claims — Amendment to, §§ 858-860.

§ 858. A patentee's claim is as amendable under the statutes as is his specification. *Jordan v. Dobson*, 2 Abb., 398.

§ 859. The claim is part of the specification, and if defective may be amended. *Smith v. Merriam*, 6 Fed. Rep., 713; *Railway Register Mfg. Co. v. North Hudson R'y Co.*, 33 O. G., 355.

§ 860. A claim introduced upon amendment which includes an element additional to the combination of which the invention is stated in the body of the specification to consist is not void where such additional element is shown in the drawing and described in the specification, although not there mentioned as one of the elements of the invention of the applicant. *Hoe v. Cottrell*, 17 Blatch., 546.

Claims — Generally — *The conclusion is to be looked to for the claim*, § 861. *Inventor may narrow his claim at will*, §§ 862, 863. *Claim for a separate device, claimed also as inseparable from another element, is void*, § 864. *Multiplication of claims condemned*, § 865.

§ 861. The concluding part, where patentee sums up and states what he claims as new, is that and that only which is to be looked at in the first instance to see and understand all his claim. *Whipple v. Baldwin Mfg. Co.*, 4 Fish., 29.

§ 862. Nothing in the cases cited forbids an inventor of a new device from taking a patent under a claim, narrowed as closely as he sees fit, and, however much narrower than he might have claimed, the patent is valid. *Russell & Erwin Mfg. Co. v. Mallory*, 10 Blatch., 140.

§ 863. But a patentee may certainly restrict the comprehensiveness of his patent-rights by the tenor of his claims. *Grier v. Castel*, 17 Fed. Rep., 523.

§ 864. Where a claim in a patent embraces only a quality or feature, which is covered by another claim as an inseparable incident to the device therein claimed as an entirety, such claim is void. *Combined Patents Can Co. v. Lloyd*, 11 Fed. Rep., 149.

§ 865. The practice of unnecessarily splitting up and multiplying claims disapproved. *Bosstock v. Goodrich*, 21 Fed. Rep., 316.

48. COLLUSIVE CASE.

See PRACTICE, COLLUSIVE CASE.

49. COMBINATION.

See AGGREGATION. CLAIMS, COMBINATION. REISSUES, OF COMBINATIONS.

SUMMARY (*HAILES v. VAN WORMER*, §§ 866-872) — *Patentability of combination of old elements*, § 866. — *Aggregation*, §§ 837, 868. — *The patents examined*, § 869. — *Infringement of combination*, § 870. — “*Substantially as described*,” § 871. — *Patented claims construed to be for aggregation*, § 872.

HAILES v. VAN WORMER.

(20 Wallace, 353-375. 1873.)

APPEAL from U. S. Circuit Court, Northern District of New York.

STATEMENT OF FACTS.—Hailes and Treadwell sued Van Wormer for an infringement of two patents for base-burning stoves, one (reissued) granted to

complainants in 1861, the other granted in 1863, of both of which complainants were the owners. The patent claimed a new combination of old devices, producing a new and useful result. Further facts and an adequate description of the invention will be found in the opinion of the court. The bill was dismissed and complainants appealed.

§ 866. *A new combination of old devices is patentable, but the useful result must be the product of the combination.*

Opinion by MR. JUSTICE STRONG.

The sort of stoves known as "base-burners," or self-feeding stoves, had been made and they were well known years before either of the complainants' patents were granted, and it is not asserted that merely as base-burning stoves they are within the monopoly of the patents. The inventions claimed are alleged improvements in the structure and arrangement of such stoves. They consist in what is described as a new combination of old and known devices producing a new manufacture, namely, a stove uniting in itself all the advantages of a reservoir stove, and those of a revertible-draft stove, which prevents the products of the combustion in the fire-pot from passing up, around and over the reservoir, thereby heating the fuel therein so as to expel its gases, and cause their explosion as well as their escape into the apartments where the stove may be placed. All the devices of which the alleged combination is made are confessedly old. No claim is made for any one of them singly as an independent invention.

§ 867. *A grouping together of devices in which each one produces its customary effect unmodified by the rest, and no more, and in which no result follows the union which was not previously produced by some of the elements, is a mere aggregation, and not a legitimate and patentable combination.*

It must be conceded that a new combination, if it produces new and useful results, is patentable, though all the constituents of the combination were well known and in common use before the combination was made. But the results must be a product of the combination and not a mere aggregate of several results, each the complete product of one of the combined elements. Combined results are not necessarily a novel result, nor are they an old result obtained in a new and improved manner. Merely bringing old devices into juxtaposition, and there allowing each to work out its own effect without the production of something novel, is not invention.

§ 868. *No one can prevent others from using certain specified devices, either singly or together, because he was the first to use them together, unless he thereby produced a new and useful result which was due to the joint action of the constituent parts, and was not merely an aggregate of the effects which were produced by those parts when operating by themselves.*

No one by bringing together several old devices without producing a new and useful result, the joint product of the elements of the combination, and something more than an aggregate of old results, can acquire a right to prevent others from using the same devices, either singly or in other combinations, or, even if a new and useful result is obtained, can prevent others from using some of the devices, omitting others, in combination.

§ 869. *The patents examined.*

If now we examine the patents held by the complainants, looking first at the objects sought to be obtained by the combinations for which the patents were granted, they are, as described in the specification, first, to prevent the passage of the products of combustion up, around and over the top of the

coal-supply reservoir, so as to heat a surrounding jacket thereof; and, secondly, to heat a circulating or ascending body of air by means of radiated heat from the fire-pot, and at the same time to heat the base of the stove by means of direct heat circulating through descending flues which lead into the ash-pit, or around it, and to the smoke and draft flue. A third avowed object is to secure economy by retarding the fall of the coal into the fire-pot from the supply reservoir, and by causing the flame to circulate outside of the contracted discharge of the reservoir, and around the upper edge of the fire-pot, and thence to descend around or under the base of the stove in its passage to the smoke and draft flue. Such are the avowed objects of the combinations claimed to have been devised by the patentees, and their effects they assert to be husbanding the radiated heat, and using it for the purpose of warming the upper part of the stove and the room in which it is situated, as well as for heating air for warming rooms above, if desirable, and at the same time so confining the direct fire heat, and keeping it in contact with the base portion of the stove, as to insure warming it to a comfortable degree. A second effect claimed is relief of the incandescent coal from the weight of the body of superincumbent coal, thus preventing the compression of the burning coal in the fire-pot, and securing for the flame free expansion, thus enabling it to act with greater heating effect upon the lower portion of the stove in its passage to the smoke and draft flue.

The combination employed to produce these effects consists of the following devices, among others:

1st. A flaring fire-pot supported by a base, the diameter of the pot being larger at the top than at the bottom.

2d. A magazine or reservoir for supplying coal, located over the fire-pot, and having its lower end contracted.

3d. Revertible passages or flues outside of the pot for the conduct of the products of combustion downwards to the base of the stove and thence to a main draft flue leading thereout.

4th. A direct draft for such stoves as are constructed with revertible flues, the direct draft being obtained by a flue passing out above the fire-pot and provided with a damper to be closed after the fuel has been ignited.

5th. Openings in the case or exterior of the stove, and the insertion of mica therein for the purpose of illuminating the room in which the stove may be with the light of the burning fuel.

These devices *with others* are brought together and claimed as a new combination, and several combinations of some of them are also claimed as inventions, producing novel and useful results. What those other devices are we need not specify, for it is not shown that they are employed by the defendants.

The stove of the defendants does, however, contain all those mentioned and contain them in combination. That each of them was an old device, well known, and in public use before the patents of the complainants were granted, is abundantly proved by the evidence submitted. A flaring fire-pot, a supply reservoir with its lower extremity of smaller diameter than its upper, revertible flues, a place for flame expansion above the fire-pot, the addition of a direct draft for use in igniting the fuel, provided with a damper, and the insertion of mica for illumination openings, were all found in stoves before Hailes and Treadwell claimed to have made their invention. It is true, there is a peculiarity in the construction of the lower extremity of the complainants' supply reservoir. It is provided with a circular flange, extending outward and

bending downward, so as to fit upon the upper rim of the fire-pot, and thus form a close combustion-chamber. This, of course, cuts off communication with the space around the upper part of the reservoir, and confines the flame and other products of combustion within a circular combustion-chamber thus formed, leaving no outlet for them except through ear passages into revertible flues. For this device, the peculiar structure of the reservoir, and the formation of the closed expansion chamber, there is no equivalent in the defendants' stove. There is no such closed chamber. The reservoir does not rest on the fire-pot. It has no connection with it, or with the sides of the stove. Nor is there any obstacle interposed to the passage of the products of combustion up and around the reservoir when the flue for direct draft is open. And when that flue is closed the flame is not detained over the burning coal, but the products of combustion pass directly across the edge of the fire-pot and descend along the sides thereof to the inferior draft-passage. Such an arrangement is not fitted to produce the effects sought and claimed for the complainants' stoves. On the contrary, it plainly excludes them.

There are other differences in the devices used, both in the complainants' and the defendants' stoves, which we think are substantial, and not merely formal. The combination claimed by the complainants passes the products of combustion out of the chamber through perforations in the flange or through ears into flues leading downwards, but wholly exterior to the fire-pot, and not in contact with it. This arrangement makes it possible to introduce external air through perforations in the outer casing of the stove, and allow it, when heated by contact with the fire-pot and the descending flues, to escape from the top. Accordingly the outer casing is perforated, and there is no closed magazine around the fire-pot. But in the defendants' stove there is no such device, and no such effects are produced. There are no external downward flues separated from the fire-pot. The whole space around the magazine and the fire-pot is completely inclosed. There is but a single chamber around the reservoir, over the surface of the burning coal, and around the fire-pot. Through this chamber the products of combustion pass, either through the direct draft-flue, when that is in use, or to the base of the stove and thence outwards. This arrangement also excludes the possibility of an effect claimed for the Hailes and Treadwell invention. It admits of no space around the fire-pot to which the external air can have access.

§ 870. *It is not an infringement of a patent to use part of the same (old) devices in a combination different from that of the patent.*

It is not, then, the combination of old devices which the defendants use that Hailes and Treadwell invented. It is not those old devices that produce the new results claimed. The complainants' combination is a different thing. It has a greater number of constituent elements. It consists in the employment of the devices used by the defendants, together with others they do not use, and the result of the entire combination is the production of a stove differing very materially from that of the defendants. And the defendants' combination cannot produce the results claimed for that of the complainants. We have said that the new results claimed, whatever they may be, are not the production of the combined devices common to both stoves. The devices used by the defendants produce no new effects because used in combination. The space around the fire-pot leading to the base doubtless secures the beneficial results long known to follow the use of revertible flues. It may be conceded to be an equivalent for such flues. But the results of its construction are not

changed by the fact that a flaring fire-pot, and a supply reservoir with a contracted discharge end, and openings for illumination, are used in the same stove. It still operates to conduct the products of combustion to the base and into the exit flue. No new operation is given to it by the combination. The same may be said of every other device employed by the defendants which is also in the complainants' combination. Each produces its appropriate effect unchanged by the others. That effect has no relation to the combination; in no sense can it be called its product. Thus far nothing novel is produced. This, then, is mere aggregation of devices, not invention, and consequently the use of those devices, either singly or together, cannot be held to be any infringement of rights belonging to the complainants.

§ 871. *A claim to a combination which is defined to be "substantially as described" is thereby limited to the elements which are described in the specification as composing it.*

We pass now to consider more in detail the claims in the complainants' patents which it is alleged the defendants have infringed. The first in the re-issue patent, dated February 3, 1863, is unquestionably too broad to be sustained, unless limited to the means described in the specification. So it was doubtless intended by the patentees to be limited, for the claim speaks of the combination claimed "as substantially described," that is, described in the specification. Thus limited, one of its essential elements is a closed combustion-chamber over the fire-pot, formed by a flange of the reservoir resting on the upper edge of the pot, and provided with perforations or ears connecting with two flues passing downwards. This element is indispensable for the purposes asserted in the claim, as well as in the specification. And the peculiar structure of the chamber is more than formal. It is functional. It prevents the passage of the flame and other products of combustion up, around, and over the supply reservoir, which is a leading avowed object of the invention, precisely the improvement patented. But this constituent of the combination the defendants have never used, nor have they used any corresponding device, or device producing the same results.

The second claim is for contracting the discharge end of the coal-supply reservoir, expanding the fire-pot, and extending the flame passage downward for united operation in a base-burning coal-supply reservoir stove or furnace, essentially as set forth. The means set forth for extending the flame passage downwards are perforations through the flange forming the lateral boundary of the closed combustion-chamber, or ears leading thereout and close flues extending from the ears or perforations downward at some distance from the fire-pot through a space bounded on one side by the fire-pot and on the other by an outer casing of the stove perforated for the admission of external air. It might, perhaps, be questioned whether there is any device in the defendants' stove corresponding to this, but waiving the consideration of that question, it is very evident that the combination of the three devices named is not the work of invention. They have no relation to each other. Neither the form of the feeder nor the shape of the fire-pot bears at all upon the direction of the draft passages. There is no novel result flowing from the joint operation of the three devices. The revertible flues have no more to do with a stove supplied by a feeder than they would have with a stove supplied by hand. There is, therefore, nothing in this claim that interferes with what the defendants have done.

An essential element of the combinations mentioned in both the third and

fourth claims is the closed combustion-chamber formed, in part by a circular flange extending outward and closing on the top of the fire-pot, with perforations in it, or ears for connection with the downward flues, or it is those perforations or ears leading out of such a chamber to the descending passages. These devices the defendants do not employ, and they cannot be used in the defendants' stove. There has been, therefore, no infringement of these claims.

The fifth claim is the only remaining one contained in the reissue which the defendants are alleged to have invaded. It is constructing the fire-pot of a base-burning stove with an imperforated circumference and in the form of a trumpet mouth at its upper extremity, in combination with descending flame passages, substantially as described, and for the purposes set forth. How in combination? As described in the specification, united by means of perforated flanges or ears of the pot, involving, of course, the presence of a closed combustion-chamber constructed substantially as already described. Construing the claim thus, as we think it must be construed, the defendants have been guilty of no infringement.

§ 872. *Claims 1 and 2, of patent No. 39,535, August 11, 1863, construed to be for aggregations and not combinations.*

Passing now to the second patent, issued August 11, 1863, we observe that its first claim was for a combination of the illumination openings, flame-expansion chamber, coal-supply reservoir, fire-pot, descending-flue and draft-flue, substantially in the manner and for the purpose described. In the main this is the same combination as that claimed in the reissued patent we have had under consideration. The only change is the addition of illumination openings. These were a well-known device applied to stoves long before either of the patents were granted. They perform no peculiar office in the new combination. They have no possible relation to it. They do not affect, in the slightest degree, the results of that combination, whatever they may be. It is impossible to regard the mere addition of such openings to a stove containing the improvements described in the reissued patent as the formation of a new patentable combination. It is not invention. If, however, it were, the defendants have not trespassed upon it, for of the combination the peculiarly formed close expansion chamber is an essential constituent, and that is not found in the defendants' stove.

Similar remarks might be made respecting the second claim of the patent of August, the only remaining one alleged to have been infringed. All the elements of the combination have not been used by the defendants.

Decree affirmed.

See *Aggregation*, §§ 195-206.

Combination — Is a unit, §§ 873-880.

§ 873. The whole combination is to be regarded as a unit. *Watson v. Cunningham*, 4 Fish., 528.

§ 874. Patented combinations are to be regarded as entireties, and cannot be defeated or avoided by showing the separate elements to be old in other relations and combinations. *Williams v. Rome, Watertown & Ogdensburg R. Co.*, 15 Blatch., 200.

§ 875. The whole combination is to be regarded as a unit, and if all its essential elements have not before been employed and embodied together, it is to be taken as an original invention. *McCully v. Cunninghams*, 19 Pitts. L. J., 142.

§ 876. A combination must be maintained as an entirety. If one of the elements is given up the thing claimed disappears. The different parts may perform more or less important functions, but each and all are essential to make the thing which the patentee has claimed as his invention. *Rowell v. Lindsay*, 10 Biss., 217.

§ 877. A combination of old elements is an entirety, and where there is such a combination incapable of division or separate use, defenses as to originality and novelty must be addressed to the invention. *Bates v. Coe*, 8 Otto, 31 (§§ 1816-30).

§ 878. A combination is always an entirety. In such cases the patentee cannot abandon a part and claim the rest, nor can he be permitted to prove that a part is useless, and, therefore, immaterial. He must stand by his claim as he has made it. *Schumacher v. Cornell*, 6 Otto, 594.

§ 879. A combination is always an entirety. If more or less than the whole of patentee's ingredients are used by another, such party is not liable as an infringer, because he has not used the invention or discovery patented. With the change of elements the identity of the product disappears. *Ibid.*

§ 880. A combination of four elements is not the same invention as a combination of three of them without the fourth. *Gill v. Wells*, 22 Wall., 1.

See *Composition of Matter*, § 1142.

Combination — Defined, § 881. **Classification**, § 882. *All its elements must co-operate*, §§ 883-888. *Element of a combination*, §§ 889-893. *Sub-combinations*, § 894.

§ 881. A combination is a union in one thing of several elements, each of which modifies the action of some of the others, and may involve invention. An aggregation is an assemblage of parts which have no mutual operation upon each other, and is not patentable. *Sarven v. Hall*, 9 Blatch., 524.

§ 882. There are two classes of patentable combinations: 1st. A combination of old elements to produce a new and useful result, which is not infringed unless all the elements are used. 2d. Where some of the parts or elements are new and their invention claimed, and infringed by the use of the new part. *Lee v. Blandy*, 1 Bond, 361.

§ 883. In a combination the elemental parts must be so united that they will dependently co-operate and produce some new and useful result. *Wood v. Packer*, 17 Fed. Rep., 650.

§ 884. All the parts or devices of the combination claimed must coact to produce a given result, in order to form a legitimate combination. *Swift v. Whisen*, 2 Bond, 115.

§ 885. A combination is legitimate when all the elements co-operate in producing a result, and are necessary to it, though their several functions are not performed simultaneously. If performed in immediate succession it is sufficient. *Birdsell v. McDonald*, 6 O. G., 682.

§ 886. In a patentable combination of elements all the parts must so enter into it that each qualifies every other. The combination must either form a new machine of a distinct character and function, or produce a result due to the joint and co-operating action of all the elements, and is not the mere result of adding together the separate contributions. *Bradley & Hubbard Manufacturing Co. v. Charles Parker Co.*, 17 Fed. Rep., 240.

§ 887. There is a combination between two or more elements if there is a concert of action between them for a definite time to accomplish a result due to their conjoint action, even though the device may then be separated and perform other functions. *McKesson v. Carndick*, 19 Blatch., 158.

§ 888. To make a valid claim to a combination it is not necessary that the several elementary parts of the combination should act simultaneously, if they are so arranged that the successive action of each contributes to produce some one practical result, which result, when obtained, is the product of the simultaneous or successive action of all the elementary parts, viewed as one entire whole. *Forbush v. Cook*, 2 Fish., 668.

§ 889. It does not follow as a matter of law that every part of the machinery used constitutes an element of the combination. This may depend on the use and effect of it, and the purpose for which it is employed, in the plan devised to complete the improvement. *Foote v. Silsby*, 1 Blatch., 445.

§ 890. A subordinate device is not an "element" of a combination. *Smith v. Fay & Co.*, 6 Fish., 446.

§ 891. An element of a combination cannot be functionally subdivided so as to make valid claims for other combinations of the same elements. *Pattee v. Moline Plow Co.*, 10 Biss., 377.

§ 892. A part which under certain conditions may be a serviceable addition to the machine, but is not indispensable, and is not mentioned in the claim, held not to be an element of the patented combination. *Bradley v. Dull*, 19 Fed. Rep., 913.

§ 893. To eliminate what is a plainly-declared element of a combination is beyond the power of judicial construction. *Williams v. Stolzenbach*, 23 Fed. Rep., 39.

§ 894. Sub-combinations of elements that coact in the production of a perfected joint result can be rightfully claimed in conjunction. They constitute a true combination in the sense of the law, and not a case of juxtaposition. *Herring v. Nelson*, 14 Blatch., 293.

See *Claims, Combination*, § 697 (*Sub-combination*). *Scope of Patent*, § 5968.

Combination — Novelty — *A combination is not anticipated by prior existence of its uncombined elements, §§ 895-910. Novelty generally, §§ 911-921.*

§ 895. The prior existence of a combination of three distinct and indispensable elements will not defeat a patent for a new combination of two of said elements, whereby the third element is dispensed with. *Strobridge v. Lindsay, Sterrit & Co.*, 6 Fed. Rep., 510.

§ 896. A combination is not wanting in novelty unless the machines exhibited or proved have all the elements or parts. *Blanchard v. Puttman*, 2 Bond, 84.

§ 897. To defeat a combination for want of novelty it is not sufficient to show that each part or element has been known before, but that all the parts had been known and used in the present combination. *Hovey v. Henry*, 3 West. L. J., 153.

§ 898. Patented improvements consisting of a combination of old elements cannot be proved invalid by showing that one of the elements is found in some one prior machine, and another in another prior machine, until it is shown that all the elements are old. *Union Sugar Refinery Co. v. Matthiesson*, 3 Cliff., 639.

§ 899. Although the various elements or parts of the patented mechanism, when separately considered, may be regarded as old, they are to be viewed in the light in which they have been combined in connection with the new and useful results which the combination accomplishes. *Gottfried v. Phillip Best Brewing Co.*, 17 O. G., 675.

§ 900. Elements which are well known in other connections may form a novel combination when brought together in a machine to produce a new result. *Wicke v. Ortrum*, 13 Otto, 461.

§ 901. Alleged anticipations of a patented combination must show not merely the devices or elements themselves, but show them constructed and arranged substantially as in the patent, and having the same mode of operation. *Williams v. Boston & Albany R. Co.*, 17 Blatch., 21.

§ 902. It is no objection to the validity of a combination patent that some of its elements are not new. *Corn-Planter Patent*, 23 Wall., 181.

§ 903. Where the thing pointed out and claimed as new is the result of the entire adjustment and arrangement of parts, it is not anticipated by showing that parts of the construction and arrangement are old. *Winans v. The Schenectady & Troy R. Co.*, 2 Blatch., 279.

§ 904. A combination held not anticipated by prior existing separate uncombined elements. *Eickemeyer Hat Blocking Machine Co. v. Pearce*, 10 Blatch., 403.

§ 905. A new combination is not anticipated by a prior public use of one of the elements of the combination. *Knight v. B. & O. R. Co.*, Taney, 106.

§ 906. In a combination patent, where the novelty of the invention consists in the combination, it is immaterial whether the elements are new or old, provided the combination is novel and practically produces a new and useful result. *Buck v. Hermance*, 1 Blatch., 398.

§ 907. A combination patent is not anticipated by a prior description of the individual elements in full, but not in combination. *Brooks v. Jenkins*, 3 McL., 432.

§ 908. A combination of old elements is not anticipated by the prior existence of the elements, or their parts, except in the same combination. *Moody v. Fiske*, 2 Mason, 112.

§ 909. When the thing patented is an entirety, consisting of a single device or combination of old elements incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire invention is found in one prior patent, printed publication, or machine, and another part in another prior exhibit, and a third part in another, and from the three or more draw the conclusion that the patentee is not the original and first inventor of the patented improvement. *Imhaeuser v. Buerk*, 11 Otto, 647.

§ 910. Where a claim does not cover a mere aggregation of separate elements, and there is not shown a mere mechanical juxtaposition, but each one of the elements of the claim contributes to the combined result which is due to the joint and co-operating action of all of them, the claim is not anticipated by showing that certain of its individual parts are old. *Sessions v. Romadka*, 21 Fed. Rep., 124.

See *Composition of Matter*, § 1142.

§ 911. A combination to be new in the sense of the patent law must introduce some new mode of operation. *Forbush v. Cook*, 2 Fish., 668.

§ 912. It is a test of the novelty of an invention consisting of a combination, whether it could be made without suggestion by the ordinary knowledge and skill of a mechanic. *Woodman v. Stimpson*, 3 Fish., 98.

§ 913. In determining upon the novelty and utility of a combination, it must be regarded in its entirety as a unit, and must consequently be a fixed and definite organism. *In re Gould*, 1 MacArth., 410.

§ 914. The proof of want of novelty must go to the novelty of the whole combination, as a unit, not to the separate elements. *Latta v. Shawk*, 1 Bond, 259.

§ 915. To establish the novelty of a combination, it is not necessary that any one of the ele-

ments should be new, provided the combination is new and produces a new and useful or better result. *Bray v. Hartshorn*, 1 Cliff., 538.

§ 916. *Held*, that one part of a combination being new, the uniting that with an old contrivance makes the combination necessarily a new one. *Hall v. Wiles*, 2 Blatch., 19.

§ 917. Where there has been a modification of some of the elements of a prior combination, so as to change the mode of operation and produce a new result, the machine so produced cannot be held to be anticipated by such prior combination. *Turrill v. Illinois Central R. Co.*, 3 Biss., 66.

§ 918. It is not the same combination if it is substantially different in any of its parts; if the elements are the same, but differently arranged, or if one of the elements is new. *Singer v. Walmsley*, 1 Fish., 558.

§ 919. Where the patentee attained the result of producing a new thing — a silver-plated steel spoon — by a succession of old processes, which, though separately old, had not been practically grouped together in the order in which he used them, it was a patentable novelty in process. *Wallace v. Noyes*, 23 O. G., 435.

§ 920. A combination of articles, which though chemically very similar to a previous patented combination of articles, yet practically, for the uses to which it is applied, possessing very different properties from such prior combination, is not anticipated thereby. *Bridgeport Wood Finishing Co. v. Hooper*, 18 Blatch., 459.

§ 921. A combination claim consisting of several elements that co-operate together to produce the device claimed can only be anticipated by a prior device having identically the same elements, or the mechanical equivalents of those that are not used. *Worswick-Manuf'g Co. v. Steiger*, 17 Fed. Rep., 250.

See *Identity*, § 2707. *Improvement*, § 2726. *Novelty*, §§ 4375, 4378. *Process*, § 5102.

Combination — Patentability, §§ 922-940.

§ 922. A combination is patentable only when the several elements of which it is composed produce by their joint action a new and useful result, or an old result in a cheaper or otherwise more advantageous manner. *Railway Register Manuf'g Co. v. North Hudson R'y Co.*, 33 O. G., 355; *Stephenson v. Brooklyn Cross Town R. Co.*, 114 U. S., 149.

§ 923. No rule of universal application has been laid down defining a patentable combination, but two things are always necessary — first, a novel assemblage of parts exhibiting invention; second, the co-operation of parts in producing a new result. By the term "co-operation" the courts do not mean merely acting together or simultaneously, but united to a common end — a unitary result. *Hoffman v. Young*, 2 Fed. Rep., 74.

§ 924. The doctrine as to non-patentable aggregation announced in *Hailes v. Von Wormer* and *Reckendorfer v. Faber* does not apply when all the elements brought together contribute and co-operate in the production of an improved result, due to their combination. *Williams v. Rome, Watertown & Ogdensburg R. Co.*, 15 Blatch., 200.

§ 925. The addition to a combination, which is inoperative and worthless in itself, of an element which renders it practicable and valuable, constitutes a new combination, and is something more than a mere improvement on the old one. *Bliss v. Brooklyn*, 10 Blatch., 521.

§ 926. Although the subordinate combinations will not produce a useful result without the addition of other parts necessary to make the complete article (a locomotive lamp), they are nevertheless sufficient to sustain the patent, because by their co-operation they contribute to a new result, and may be used in conjunction with such other parts as are ordinarily employed in locomotive headlights. *Williams v. Boston & Albany R. Co.*, 17 Blatch., 21.

§ 927. When the application is for a combination of machinery and materials, form and structure become substance. They are the essence of the invention; and if changes in these respects enable the operator to do the work in a better manner, or with more ease or at less expense, or in less time, they are all improvements for which the inventor may have a patent. *Bain v. Morse*, 1 MacA. Pat. Cases, 90.

§ 928. Changing one of the elements of a combination that will not produce a desired effect, and substituting another that makes it effective, is to produce a new and patentable combination. *Woodward v. Dinsmore*, 4 Fish., 163.

§ 929. A combination of old and new matter is patentable. *Bain v. Morse*, 6 West. L. J., 372.

§ 930. A combination, all the elements of which except one have been before used, is patentable. *McCully v. Cunninghams*, 19 Pitts. L. J., 142.

§ 931. A new and useful combination is patentable, whether it required much or little thought, study or experiment to make it, or whether it cost much or little time or expense to devise and execute it. *Forbush v. Cook*, 2 Fish., 668.

§ 932. In order to constitute a patentable combination, the result must be some effect different from the effect of the separate parts, and produced by the combined forces. A new result must arise from the union of the elements of the combination, and not simply from the separate action of each element. *Slawson v. Grand Street, Prospect Park & Flatbush R. Co.*, 17 Blatch., 512.

§ 933. An old combination employed in a new organization, and producing a new result, or the same result by a new mode of operation, is patentable. *Child v. Boston & Fairhaven Iron Works*, 1 Holmes, 303.

§ 934. A new combination, producing new and useful results, and not merely an aggregation of the results, due to the independent action of the several parts, is a patentable invention. *Bussey v. Wager*, 9 O. G., 300.

§ 935. A combination which embraces an element new in itself, and produces new results, is patentable, although no one element is modified in its operation by any other, and is more than a mere aggregation. *Gallahue v. Butterfield*, 10 Blatch., 232.

§ 936. Where the parts of a combination have been invented, whether such invention be of a new machine, or of a combination of mechanical powers, it is protected in its distinctive character. *Pitts v. Wemple*, 6 McL., 558.

§ 937. A new combination of machinery incorporating in part an old apparatus for a new purpose is patentable, if new. *Pitts v. Whitman*, 2 Story, 609.

§ 938. When an apparatus is made up of new and old devices, the inventor is not bound to take his patent for the new elements or devices by themselves. He is at liberty to ask for a patent for a limited use of those new matters, to wit, in combination with the old, if the devices all co-operate to form a new combination. *Bain v. Morse*, 1 MacA. Pat. Cases, 90.

§ 939. A new combination is none the less patentable that certain elements or parts thereof are new and patentable by themselves. *Ibid.*

§ 940. The rule that an old device or combination applied to a new purpose is not patentable does not apply to the case when a new combination is applied to an old purpose. *In re Hebbard*, 1 MacA. Pat. Cases, 543.

See *Formal Change*, § 257. *Invention*, §§ 3525-3529, 3571, 3605, 3613-3617, 3632-3643, 3651-3658. *Machine*, § 4116. *Patentability*, §§ 4558, 4577-4579, 4586, 4619. *Patents*, § 4724. *Substitution*, § 6214.

Combination — Generally — *In what it should consist*, §§ 941-943. *Claim need not include all parts*, § 944. *Legitimate combination*, §§ 945, 946. *Void*, §§ 947-949.

§ 941. A patent for a combination of two things is not a patent for a combination of one of the two with a third and different thing. *American Nicholson Pavement Co. v. Hatch*, 4 Saw., 692.

§ 942. A combination in mechanism must consist of distinct mechanical parts, having some relation to each other, and each having some function in the organism. *Yale & Greenleaf Mfg. Co. v. North*, 5 Blatch., 455.

§ 943. Where the invention consists in a new combination of machinery or improvements on an old machine to produce an old effect, the patent should be for the combined machinery or improvements and not for the mere mode or device for producing such effect. *Barrett v. Hall*, 1 Mason, 447.

§ 944. It is not necessary to include in the claim for a combination all parts of the machinery which are necessary to its action, save as they may be understood as entering into the mode of combining and arranging the elements of the combination. *Forbush v. Cook*, 2 Fish., 668.

See *Claim*, §§ 677, 688-701. *Patents*, § 4722.

§ 945. It appearing that some of the elements of the combination claim formed a new combination of parts to secure a useful result, it became immaterial to inquire whether all the elements of the claim are strictly in combination and not merely aggregated. *Strobridge v. Landers*, 11 Fed. Rep., 880.

§ 946. Where a new relation is established between the means of strengthening and supporting the parts of a wheel, and a new and greater efficiency is given to each in consequence of the combination of them, the combination is a legitimate one. *Sarven v. Hall*, 9 Blatch., 524.

§ 947. A patent for a combination of elements, claiming the whole combination, where a part only is new, is void, for it exceeds the invention. *Moody v. Fiske*, 2 Mason, 112.

§ 948. A patent for a combination which proves inoperative and worthless is void. *Bliss v. Brooklyn*, 10 Blatch., 521.

§ 949. Parts wholly disconnected from each other and from the machine, and which are

inoperative for any purpose as enumerated in the combination claimed, do not constitute a valid combination. *Edgerton v. Furst & Bradley Manufacturing Co.*, 10 Biss., 402.

See *Abandonment*, § 102. *Claims*, §§ 732, 738, 775, 778-792, 830-834. *Construction of Patents*, § 1218. *Equivalents*, §§ 2112, 2113, 2173, 2174. *Evidence*, § 2298. *Invention, Joinder of*, §§ 3676, 3677, 3682, 3683. *Invention, Prior*, §§ 3710, 3711. *Invention, Abandoned*, § 3718. *Inventor*, §§ 3779, 3780. *Reissue*, §§ 5304, 5305, 5569-5605, 5638. *Repairs*, § 5824. *Scope of Patent*, § 5977. *Specification*, § 6080. "Substantially as Described," §§ 6193, 6200, 6202. *Void Patent*, § 6711.

Combination — Of old elements — Patentability, §§ 950-967.

§ 950. A new combination of old elements is patentable. *Foote v. Silsby*, 2 Blatch., 260; *Howe v. Morton*, 1 Fish., 583; *Carr v. Rice*, 1 Fish., 198; *Emigh v. Chicago, Burlington & Quincy R. Co.*, 1 Biss., 400; *Evans v. Eaton*, Pet. C. C., 322; *Westlake v. Carter*, 4 O. G., 636; *Gill v. Wells*, 22 Wall., 1; *Rice v. Heald*, 13 Pac. L. R., 33; *In re Boughton*, 1 MacA. Pat. Cases, 278; *In re Halsey*, 1 MacA. Pat. Cases, 439; *In re Wagner*, 1 MacA. Pat. Cases, 510; *Stanley v. Hewitt*, 17 Frank. J., 165 (2d series).

§ 951. A combination of old elements to produce a new and useful result is patentable. *Latta v. Shawk*, 1 Bond, 259; *Pennock v. Dialogue*, 4 Wash., 538; *Watson v. Cunningham*, 4 Fish., 528; *McCully v. Cunningham*, 19 Pitts. L. J., 142; *Willimantic Linen Co. v. Clark Thread Co.*, 4 Ban. & Ard., 133.

§ 952. A new combination of old elements is patentable, provided it involves invention and not mere ordinary mechanical skill. *Crosby v. Lapouraille*, Taney, 374.

§ 953. A patent for a new combination of old parts, if substantially new in structure and mode of operation, is valid. *Whitney v. Emmett*, 1 Bald., 303.

§ 954. A new combination of new or old machines is patentable, and is not infringed by a use of one machine alone, unless the entire combination is used. *Barrett v. Hall*, 1 Mason, 447.

§ 955. Old elements, organized into a new machine, having a new mechanical operation, where the organization involves the exercise of original thought and is productive of useful results, is patentable. If no inventive skill, but only mechanical dexterity, was necessary to produce it, it is not patentable. *Blake v. Stafford*, 6 Blatch., 195.

§ 956. A combination of old parts in a new way, producing a machine which operates differently and produces a different result in kind, is patentable. *Woodman v. Stimpson*, 3 Fish., 98.

§ 957. Old instruments, placed in a new and different organization, producing in such new organization different results, or the same results by a new and different mode of operation, are patentable. *Clark Patent Steam & Fire Regulator Co. v. Copeland*, 2 Fish., 221; *Gottfried v. Phillip Best Brewing Co.*, 17 O. G., 675.

§ 958. Old parts to be patentable must combine in operation and by their joint effect produce a new result. They need not act simultaneously, but if so arranged that the successive action of each contributes to produce the result which, when obtained, is the product of all the parts, viewed as a whole, a valid claim for this combination may be sustained. *Hoffman v. Young*, 2 Fed. Rep., 74.

§ 959. A combination of old devices supplemented by other and new devices co-operating therewith, and thereby a new and useful result is produced, not attained by the action of the old devices, is invention. *Hailes v. Van Wormer*, 7 Blatch., 443. See §§ 866-72.

§ 960. If the combination of old devices itself produces a new and useful result not due to the separate action of either element, nor attained thereby, but due to the co-operative or reciprocal action of the combined devices, it is invention. *Ibid.*

§ 961. Where in an old combination of old elements a new and independent element was substituted, which was not merely an improvement on, an addition to, or in aid of the old element replaced, it was held a new and patentable combination. *Potter v. Hollender*, 4 Blatch., 238.

§ 962. If the elements of a combination are unchanged, yet if with one arrangement they produce a result which another arrangement will not, such new arrangement is patentable unless such as would naturally suggest itself to one skilled in the art. *Woodward v. Dinsmore*, 4 Fish., 163.

§ 963. All the component parts must so enter into the combination of old elements that each qualifies every other. If the elements of a combination act independently of each other, or if one element acts independently of the others, it is an aggregation of parts, and not entitled to protection as a combination. *Clark Pomace Holder Co. v. Ferguson*, 17 Fed. Rep., 79.

§ 964. A device, in order to be patentable, must be the result of invention; but the mere mechanical adaptation of old things to new uses is not usually invention, unless in combination. *Washburn & Moen Manufacturing Co. v. Haish*, 10 Biss., 65.

§ 965. When the leading ideas are old, and devices having the same principle have been used for carrying the idea into effect, a patent can only stand on special improvements of the devices or on special combinations. *Pattee v. Moline Plow Co.*, 10 Biss., 377.

§ 966. The fact that a device comprising several patentable elements has been patented as a whole will not prevent the patentee from afterward securing a patent for a combination of any number of the elements less than the whole, provided he applies for it before the lesser combination has been two years in public use. *Cahn v. Wong Town On*, 19 Fed. Rep., 424.

§ 967. In a patentable combination of old elements all the constituents must so enter into it as that each qualifies every other, and together form either a new machine of a distinct character and function, or produce a result due to the joint and co-operating action of all the elements, and which is not the mere adding together of separate contributions. Otherwise it is only a mechanical juxtaposition and not a vital union. *Pickering v. McCullough, Dalzell & Co.*, 14 Otto, 310.

Combination — Of old elements — *Is an improvement*, § 968. *Identity*, § 969. *Matter of mere adjustment is covered by*, § 970. *In what a combination consists*, § 971. *Patentee bound by his combination*, § 972.

§ 968. A combination of old elements is regarded merely as an improvement upon what was before known, and which, without such new combination, would have belonged to the public. *Sands v. Wardwell*, 3 Cliff., 277.

§ 969. Combinations consisting of old elements are not the same when none of the devices employed in one can be substituted for those in the other, so as to render the apparatus operative to effect the described result without reconstruction and invention. *Fuller v. Yentzer*, 4 Otto, 288.

See *Formal Change*, § 2564.

§ 970. The mere matter of adjustment in a combination of old parts may be varied in different cases according to the intelligence, judgment or even caprice of the builder, and still the combination be the same in each case, equally covered by plaintiff's patent. *Hamilton v. Ives*, 3 O. G., 30.

§ 971. Where a new combination of old elements, producing new and useful results, is patented, it is the established rule that the invention, if any, within the meaning of the patent act, consists in the means or apparatus by which the result is obtained, and not merely in the mode of operation, independent of the mechanical devices employed. *Fuller v. Yentzer*, 4 Otto, 288.

§ 972. A patentee of a combination of old ingredients cannot, in his proofs, abandon any part of his combination as useless or immaterial. *Gill v. Wells*, 22 Wall., 1.

Combination — Of old elements, infringement of — *Not infringed by omission of an element*, §§ 973-978.

§ 973. A combination of old elements is not infringed by a use of less than the entire combination. *Burdett v. Estey*, 16 Blatch., 105; *Dodge v. Card*, 1 Bond, 393; *Rowell v. Lindsay*, 10 Biss., 217; *Storrs v. Howe*, 4 Cliff., 388; *Sanford v. Merrimac Hat Co.*, 4 Cliff., 404; *Sharp v. Tiffit*, 18 Blatch., 132; *Fuller v. Yentzer*, 94 U. S., 288; *Reedy v. Scott*, 23 Wall., 352; *Latta v. Shawk*, 1 Bond, 259; *Roberts v. Harnden*, 2 Cliff., 500; *Washburn v. Gould*, 3 Story, 122; *Parker v. Haworth*, 4 McL., 370; *Moody v. Fiske*, 2 Mason, 112.

§ 974. A combination of old elements is not infringed by the omission of one of its elements. *Willimantic Linen Co. v. Clark Thread Co.*, 4 B. & A., 133.

§ 975. A patentee of a combination of old elements cannot prevent the use of any number of those parts less than the whole, or of new and substantial improvements of those old parts, but only his own combination of parts or known substitutes therefor. *Hale v. Stimpson*, 2 Fish., 565.

§ 976. A combination of old elements is not infringed by use of less than the entire combination. An improvement thereon which employs the entire combination is an infringement. *Pitts v. Wempie*, 6 McL., 558.

§ 977. Where the invention consists in a combination of old elements, patentee cannot invoke the doctrine of equivalents to suppress all other improvements of the old machine. *Union Sugar Refinery Co. v. Matthieson*, 3 Cliff., 639.

§ 978. Held, that where the invention consisted in a combination of old elements, a different combination for a different purpose, but which could be forced to produce the same result, was not an infringement. *Buzzell v. Andrews*, 25 Fed. Rep., 822.

See *Construction of Patents*, § 1235.

Combination — Infringement — By addition, §§ 979-983

§ 979. It is no defense to the infringement of a combination that defendants have added to or improved it, provided they still use substantially the patented combination. *Gorham v. Mixer*, 1 Am. L. J., 539.

§ 980. The improvement of an element of a combination without destroying its identity is an infringement if the combination thus improved is used. *Foster v. Moore*, 1 Curt., 279.

§ 981. The use of plaintiff's combination with something in addition will not avoid infringement. *Pitts v. Wemple*, 1 Biss., 87.

§ 982. Where the defendant employs all the parts in combination covered by the claims of the patent, infringement is not escaped because others are employed in addition. *Williams v. Boston & Albany R. Co.*, 17 Blatch., 21.

§ 983. It is no infringement of a patent for a combination which is in itself impracticable and worthless, to add to the combination an element which renders it useful and valuable. *Robertson v. Hill*, 4 O. G., 132.

See *Improver*, § 2807.

Combination — Infringement — Not infringed by change of location of parts, §§ 984-988.

§ 984. A change of location of a part in a combination, where there is no new function performed by the changed member in its new location, will not evade a patent. *Adams v. Joliet Manufacturing Co.*, 3 B. & A., 1.

§ 985. The fact that it does its work better than in the position occupied in the infringed machine is merely of degree, and makes no difference so long as the result is the same. *Ibid.*

§ 986. A change of location of a part in a patented combination, where there is no new function performed by the changed member in its new location, will not evade a patent. *Knox v. Great Western Quicksilver Mining Co.*, 6 Saw., 430.

§ 987. Where a patent claims, first, a combination of two parts so arranged that one can have a "lateral rocking motion" on the other, and secondly, a combination of the same parts with two additional elements, "the whole being constructed and arranged substantially as specified," but not in terms referring to the rocking motion, the second claim is infringed by the use of its combination of mechanism, although the arrangement is such as not to permit any rocking motion. *National Car Brake Shoe Co. v. Lake Shore & Michigan Southern R'y Co.*, 9 Biss., 503.

§ 988. Where a claim in a patent is for a certain arrangement of elements which perform a distinct and independent result in a machine, a change of these parts changes the patented arrangement, and the machine becomes *pro tanto* a new machine, and is out of the reach of the patent. *Reay v. Berlin & Jones Envelope Co.*, 20 Fed. Rep., 506.

Combination — Infringement — Not infringed by omission of an element, §§ 989-999.

§ 989. A combination is not infringed by a use of less than all of its elements. *Gorham v. Mixer*, 1 Am. L. J., 539; *Hasselden v. Ogden*, 3 Fish., 378; *Gage v. Herring*, 107 U. S., 640; *Howe v. Neemes*, 18 Fed. Rep., 40; *New v. Warren*, 22 O. G., 587; *Wicke v. Ortrum*, 103 U. S., 461; *Fisher v. Craig*, 3 Saw., 69; *Case v. Brown*, 1 Biss., 382; *Blanchard v. Puttman*, 2 Bond, 84; *Pitts v. Wemple*, 1 Biss., 87; *Bell v. Daniels*, 1 Bond, 212; *Prouty v. Ruggles*, 1 Story, 568; *Brooks v. Jenkins*, 3 McL., 432; *Brooks v. Bicknell*, 4 McL., 70; *Foote v. Silsby*, 1 Blatch., 445; *Rice v. Heald*, 13 Pac. L. R., 33.

§ 990. A combination is not infringed by a use of part of the combination. *McCormick v. Manny*, 6 McL., 539; *Foss v. Herbert*, 1 Biss., 121; *Howe v. Abbott*, 2 Story, 191; *Prouty v. Ruggles*, 16 Pet., 336; *McCormick v. Talcott*, 20 How., 402.

§ 991. A patent for a combination is not infringed by anything in which one of its constituent elements is omitted. *Rees v. Gould*, 15 Wall., 187; *Dunbar v. Myers*, 94 U. S., 187; *Saxe v. Hammond*, 1 Holmes, 456; *Vance v. Campbell*, 1 Fish., 483.

§ 992. The claim of a combination is not infringed if any of the material parts of the combination are omitted. *Union Water-Meter Co. v. Desper*, 11 Otto, 332; *Watson v. Cunningham*, 4 Fish., 528.

§ 993. Unless every element embraced in a combination is used, or some equivalent for it, a patent for it is not infringed. *Brown v. Hinkley*, 3 O. G., 384; *Westlake v. Carter*, 4 O. G., 636; *Gould v. Spicer*, 20 Fed. Rep., 317; *Saladee v. Racine Wagon & Carriage Co.*, 20 Fed. Rep., 686.

§ 994. The use of one element of a combination is no infringement. *Gray v. James*, Pet. C. C., 394.

§ 995. A combination of the material parts of an entire machine is not infringed by the use of less than the entire combination. *Corn-Planter Patent*, 23 Wall., 181.

§ 996. Where a combination is claimed both in the declaration and patent as an entirety, there is no infringement unless the whole of it is used. Act 1837, section 9, applies only where the part invented can be clearly distinguished from the part claimed but not invented. *Vance v. Campbell*, 1 Black, 427.

§ 997. A combination is patented as an entirety, and is not infringed by a combination which does not contain all its elements. *Matteson v. Cains*, 17 Fed. Rep., 525.

§ 998. A combination of mechanical powers is not infringed by a substantial use of less than all the elements. The use of a part less than the whole is no infringement. *Eames v. Godfrey*, 1 Wall., 78.

§ 999. A claim for a combination of three elements is not infringed by the use of only two of them, where the omitted element has a function of its own not performed by the elements used in the device claimed to infringe. *Tobey Furniture Co. v. Colby*, 34 O. G., 1276.

Combination — Infringement, generally — *When infringed*, §§ 1000-1010. *When not*, §§ 1011-1020.

§ 1000. What constitutes and what does not constitute the infringement of a combination. *Crompton v. Belknap Mills*, 3 Fish., 536.

§ 1001. A patent is not confined to the precise form of the combination of the parts claimed, and may be infringed by the use of the substance though not the exact form of the combination, where the change is the mere effect of mechanical skill. *Case v. Brown*, 1 Biss., 382.

§ 1002. The inventive principle of a combination cannot be used in other patents without patentee's consent. *Sayles v. Chicago & Northwestern R. Co.*, 3 Biss., 52.

§ 1003. Infringement of a claim is not escaped by the employment in a combination of a certain board which only effects two-thirds of a desired result, it depending altogether on the thickness and stability of the board whether the whole operation is or is not copied. *Coupe v. Weatherhead*, 16 Fed. Rep., 673.

§ 1004. Plaintiff's invention, a water-wheel, construed to consist in a combination and in the improvement of several parts of which that combination is composed. *Held*, that a violation of one of them is an infringement for which an action will lie. *Parker v. Haworth*, 4 McL., 370.

§ 1005. Where an invention is described as consisting of the combination of two elements, and one of them proves defective, or is not used by the infringer, he will, nevertheless, be restrained from using the remaining one, if the patentee has included it in a separate claim. *Henderson v. Cleveland Co-operative Stove Co.*, 12 O. G., 4.

§ 1006. Where the claim was to a combination, and the defendants used all the elements but one, and so used one of these elements as to perform in addition to its own the function of the omitted element, the combination was held to be infringed. *Burdsall v. Curran*, 27 O. G., 1320.

§ 1007. Where some of the parts of a combination are new and others old, and where the new parts are distinctly claimed as inventions, the appropriation of a part which is new is an infringement. *Rowell v. Lindsay*, 10 Biss., 217.

§ 1008. The elements of a combination being old, *per se*, the essence of the invention consists in the novelty of their combination and its adaptation to the use for which it is intended, and its infringement will consist in the use of a machine, substantially embodying the combination in its entirety, for the same purpose. *Smith v. Marshall*, 10 O. G., 375.

§ 1009. When the defendant's device contains all the elements of the patentee's structure, combined in substantially the same way and having substantially the same mode of operation, there is an infringement, notwithstanding mere formal differences. *Putnam v. Vom Hofe*, 19 Blatch., 63.

§ 1010. Where one patented combination is asserted to be an infringement of another, a device in one to be the equivalent of a device in the other must perform the same functions.

* *Rowell v. Lindsay*, 113 U. S., 97.

See *Identity*, § 2659. *Improvement*, §§ 2741, 2742, 2752, 2758, 2773. *Infringement*, § 2966. *Infringer*, § 3001. *Patents*, § 4752. *Reissue*, § 5320.

§ 1011. A combination is not infringed by a combination of the same elements constructed and operating in a substantially different way. *Gorham v. Mixer*, 1 Am. L. J., 539.

§ 1012. It is no infringement to use those elements of a patented combination in which the patentee has no exclusive property, in combination with other mechanisms, when different results are thereby obtained. *Dane v. Chicago Manufacturing Co.*, 3 Biss., 374.

§ 1013. Although a combination of old devices may be patentable when a new and useful result is produced, it does not prevent a use of the elements separately, or in a new combination, or of some of them in combination omitting others. *Hailes v. Van Wormer*, 7 Blatch., 443.

§ 1014. The defendants had the same right to recombine the same parts that the complainants had, so long as they do not use the same combinations. *Pattee v. Moline Plow Co.*, 10 Biss., 377.

§ 1015. A patent may be granted for a new combination of old elements or ingredients if it produces a new and useful result: but in such case the invention consists merely in the new combination, and the patent therefor is not infringed by a substantially different combination, even though it includes the exact same elements or ingredients. *Fuller v. Yentzer*, 4 Otto, 288.

§ 1016. Where A. and B. each had a combination patent for a machine, which patents were assigned to C., *held*, that C.'s right was not infringed by a machine containing elements of each combination, but which did not infringe the separate combinations. *Washburn & Moen Mfg. Co. v. Fuchs*, 16 Fed. Rep., 669.

§ 1017. There is no infringement where the defendant's device does not contain a particular construction of two parts pointed out as material in the complainant's patent and which must be construed to be part of his claim. *Snow v. Lake Shore & Michigan Southern R'y Co.*, 18 Fed. Rep., 602.

§ 1018. Where there was a claim to a single part, temporary in its relation to the rest of a combination in a machine, and another claim to the same in combination with permanent parts, *held*, that the right to use the machine involved the right to replace, and that a renewal of the single part claimed alone was no infringement. *Farrington v. Water Commissioners*, 4 Fish., 216.

§ 1019. To show that the parts omitted by the defendant from a patented combination are unessential will not render him liable as an infringer for the use of the rest. *Westlake v. Carter*, 4 O. G., 636.

§ 1020. The use of a patented combination, which is inoperative and worthless in itself, in connection with a new element which renders it practical and useful, cannot be punished as an infringement. *Bliss v. Brooklyn*, 10 Blatch., 521.

See *Infringer*, § 3004.

Combination — Infringement — Sale of a part, §§ 1021-1028.

SUMMARY (*WALLACE v. HOLMES*, §§ 1021-1028) — *Parties*, § 1021. — *Power of guardian*, §§ 1022, 1023. — *The patent considered*, § 1024. — *The claim construed*, § 1025. — *Infringement of combination by sale of part only*, §§ 1026-1028.

WALLACE v. HOLMES.

(Circuit Court for Connecticut: 9 Blatchford, 65-77. 1871.)

Opinion by WOODRUFF, J.

STATEMENT OF FACTS.—The complainants sue, as the assignees and owners of letters patent granted September 19, 1865, to Michael H. Collins, for an improvement in lamps, for an alleged infringement by the defendants, praying an injunction and an account of the gains and profits made by the defendants by the unlawful manufacture and sale of the invention so patented. The answer puts the complainants to proof of the patent, and of their title as assignees, denies that the defendants have infringed the patent, and alleges that, if the patent recited in the bill of complaint shall be construed to cover anything contained in lamps heretofore and now manufactured and sold by the defendants, then, and in that case, such letters patent are, to that extent, void, for want of novelty.

Upon the trial, the defendants rested their defense solely upon two grounds — want of sole title in the plaintiffs, and the non-infringement of the patent by the defendants. The court, is, therefore, relieved from any examination of the testimony and documents which were apparently intended to show that Collins was not the first inventor, or any other proofs, except such as bear directly upon the two points above mentioned.

(1) As to the complainants' title. They first show that on the 23d of September, 1867, Michael H. Collins was, by the probate court of the county of Suffolk and state of Massachusetts, appointed guardian of the person and estate of his minor child, Florence E. Collins, upon his own petition and her nom-

ination, and upon the giving of bonds in the form required by the statutes of that state.

They next produce an instrument dated September 24, 1867, which recites the granting of the foregoing and other patents to him, the said Michael H. Collins; that the said Florence E. Collins and Frances M. Collins have become the owners of the said invention for the territory of the United States; that Frances M. has assigned her interest to Sylvester W. Warren; that the said Michael has been appointed guardian of the said Florence E., whereby he is empowered to dispose of all the real and personal estate, goods, chattels, etc., of the said Florence E., and that it appears to the said Michael to be for the interest of his ward that her interest in the patents should be sold. It thereupon, in consideration of \$50, sells, assigns, etc., to Warren, all the right, title and interest the said Florence has in the patent-right and in the invention, by virtue of an assignment to her and Frances M., dated February 12, 1867. The instrument is executed, under seal, by the said Michael, as guardian of the said Florence.

Next, an assignment by Frances M., dated, also, September 24, 1867 (reciting, also, the assignment of February 12, 1867, by Michael H. Collins to her and Florence E.), whereby, in consideration of \$50, Frances M. assigns to Warren. Next an assignment under the same date, by the said Sylvester W. Warren to the said Michael H. Collins, in consideration of \$50, assigning to the latter the same patent, for the territory of the United States.

Next, an assignment, dated December 24, 1867, which recites the granting of the patent, the assignment thereof to Florence E. (a minor daughter) and Frances M. Collins, and that said rights had been attempted to be reconveyed to the said Michael, but that some doubt exists as to the precise effect of said conveyances, and therefore, in consideration of \$30,000 paid to him, the said Michael, in his own behalf, and as guardian to the said Florence E., by the complainants in this suit, he, the said Michael, in his own right, and as guardian of the said Florence E., assigns to the complainants the said letters patent and the invention secured thereby, and all rights of reissue, extension, etc. Finally an assignment under date of December 25, 1867, reciting a doubt whether, Frances M., being the wife of Michael, received or now holds any interest in the patent, by the conveyance to her by her husband, and therefore the said Michael and Frances M., husband and wife, assign all the interest which she may have in the patent or invention to the complainants herein.

§ 1021. *Under what circumstances the want of parties, if not set up in the answer, can be made available to the defendant.*

The defendants insist that Michael H. Collins, as guardian of Florence E., had, under the laws of Massachusetts, no authority to sell her interest in the patent, without the order or license of one of the courts of that state, having jurisdiction for that purpose; and that the complainants, therefore, own only one-half of the patent (as tenants in common with her), and cannot maintain this suit without her presence as a party. The want of parties, not having been set up or suggested in the defendants' answer herein, cannot avail, unless the case is one in which the court cannot proceed to a decree between the parties before the court, without prejudice to the rights of those who are proper to be made parties, but who are not brought into court. Whether the suggestion of want of parties, first made on the trial, has any sufficient foundation in fact, depends upon the construction and effect of the statutes of Massachusetts. It was claimed to be apparent on the face of the assignments, that

Michael H. Collins had practiced a fraud upon his infant daughter, through the form of a sale of her interest for a consideration of \$50, with intent that that interest should be immediately conveyed to him by the apparent purchaser, and so it was plain that he made use of his guardianship for the mere purpose of obtaining title to his ward's property, that he might sell the entire patent for the large consideration of \$30,000 paid to him by the complainants.

Whatever reason the assignments of the 24th of September, 1867, furnish for such a suspicion, the actual transfer to the complainants is free from any such appearance of fraud. That instrument recites the doubt of the effect of the previous sale, and, in appropriate form, acknowledges the receipt of the full consideration in his own behalf, and as such guardian, and sufficiently charges him, in his capacity of guardian, with accountability for the actual proceeds of sale. If, therefore, he had authority to sell, the complainants, being plainly *bona fide* purchasers, acquired good title to the whole patent.

§ 1022. *Powers of a guardian to sell the personal property of his ward independent of statute.*

This question of authority must be determined by considering the effect of a statute of Massachusetts. Independent of the particular statute in question, it is not doubtful that a guardian of the person and estate of an infant, appointed by the court of probate, has, as incidental to his office and duties, the power to sell personal property of his ward. His duty to pay debts, and to provide for the support, maintenance and education of the ward, and, generally, to manage the estate and his trust, indicated and expressed in the bond he is required to give, conditioned to manage, dispose of and apply the same, and to account for all property and the proceeds thereof, all imply the power of the guardian in this respect. In this management he is under a rigid responsibility, not only for the property but for its management and disposal for the best interest of the ward. If, therefore, he assumed to sell, for investment in other property, and, especially, if he ventured to change the nature of the property by investing in real estate, he would incur the hazard of an accounting in that respect, it may be many years afterwards, in which, in case of depreciation, the discretion exercised by him might be assailed and impeached and he be subjected to loss on the one hand, and, on the other, the estate might be depreciated, notwithstanding the good faith of the guardian. And yet, at times, the interest of the ward may often be greatly promoted by change of investments, for the making of which the guardian would be unwilling to assume the responsibility.

§ 1023. *Powers of a guardian over the personal property of his ward by the statute of Massachusetts.*

The statute referred to enacts that "the probate courts in the several counties, or the supreme judicial court, on the application of a guardian or any person interested in the estate of a ward, after notice to all other persons interested therein, may authorize or require the guardian to sell and transfer any stock in the public funds, or in any corporation, or any other personal estate or effects held by him as guardian, and invest the proceeds thereof, and all other moneys in his hands, in real estate, or in any other manner that shall be most for the interest of all concerned. Said courts respectively may make such further order and give such directions as the case may require for managing, investing and disposing of the estate and effects in the hands of the guardian." Gen. Stats. of Mass., ch. 109, § 22.

It is argued that this statute has taken away the power of the guardian to

sell any personal estate of his ward without an order of court, and that a sale and transfer by the guardian, without such order, is void, and confers no title on the purchaser. I do not think that this was the design of the statute, or that such is its effect. It unquestionably gives jurisdiction to the courts named summarily to control the guardian in this respect. So, also, it gives them power to control him generally in the management of the estate. But the construction claimed would imply that he can, since the statute, do nothing lawfully except under a special judicial order obtained for the purpose. This jurisdiction is useful in a high degree. It looks chiefly to the investment, and change of investment, of the estate. It enables the guardian to obtain advice and protection. He may often think a change of the property, and even an investment in real estate, best for the interest of his ward, and yet be unwilling to make it at the hazard of the result, and of the judgment which may be passed thereon at the end of, perhaps, very many years. He can, therefore, apply to the court, and obtain recorded judicial approval, which will be his conclusive protection in the future. So, also, when any party interested in the estate is dissatisfied with the management of the estate, or deems a change in the investments desirable, he can apply, and, if it seem best, the courts may require change of investments, or make other order touching management or disposal of the property. This summary jurisdiction is conservative, it may be availed of by all parties, it protects the guardian in circumstances of doubt, and enables him to make investments not within the general line of his duty as guardian, and to make changes of investment without liability therefor on an accounting which may be required long afterwards, when, perhaps, unforeseen events make the acts seem negligent or improper; but it was not intended, and it does not operate, to deprive the guardian of power to sell personal property. In doing so, he acts subject to responsibility for good faith, proper prudence, and the proper use of the proceeds; and, in such case, the purchaser obtains title to the property sold.

This view of the complainants' title renders it unnecessary to say what, in this suit, would be the effect of a holding that they were not sole owners of the patent. The objection that Florence E. is not a party to the suit, not having been made either by plea or answer, would not necessarily defeat the suit. Even then the complainants have title, though not as sole owners. At law, in an action for a tort, such non-joinder could only be urged by plea in abatement, or in diminution of damages; and, in equity, if the court were of opinion that complete justice could be done between the parties before the court, without prejudice to the absent party, it might perhaps proceed, treating the defendants as having waived the objection, or, at most, in such a state of the case, direct the absentee to be made a party, if that was deemed necessary. The conclusion, however, that the complainants have title, disposes of the objection.

§ 1024. *Patent No. 49,984, M. H. Collins, September 19, 1865, lamps, considered.*

(2) The ground upon which alone the defendants claimed, on the trial, that they had not infringed the patent, is this — that the patent is for a combination of several parts, together constituting the improved lamp described in the patent; and that the defendants have only made and sold some of the parts of that combination, and cannot, therefore, be charged as infringers. The patent is, in terms, for “a new and useful improvement in lamps.” The specification describes “the main purpose of the invention, or the principal part

thereof," to be, not only to keep the lower part of the glass chimney of the lamp cool, so that it may readily be removed by the hand, but, also, to support the chimney without the use of a spring catch, or other devices, such as are ordinarily used. It thereupon proceeds to describe what is ordinarily called the burner of the lamp, namely, that portion which holds the wick-tube, and which is to be screwed into the cap of the reservoir or body of the lamp, containing the oil or fluid used for combustion, consisting of an "air induction annular plate" at the bottom, convex, and provided with holes, to admit the air, and turned slightly up at the outer edge, to receive and sustain the chimney. The wick-tube rises above it, and near, but just above the top, is surrounded by an "umbelliferous cone, or deflector," which extends outward to the sides of the chimney, and, the outer edge being cut or slit radially, the divided edge forms springs, which press against the interior of the chimney, and sustain it firmly in its upright position. The parts of the deflector between the slits being inclined downward, and being elastic, are adapted to receive the chimney, though there be irregularities and differences in the interior dimensions of chimneys which may be used. Other details are given pertaining to the construction, mode of operation, and uses of the parts, which it is not necessary to mention. It must suffice to say, that what is called the burner embraces all the metallic portion of the lamp containing, surrounding or placed above the wick, and to be screwed into the cap of the reservoir. The specification also describes the glass chimney to be used, thus: "The lower part of the chimney, or that portion which extends from the deflector to the chimney rest, is constructed tubular and cylindrical. Above this part, the chimney bulges out, and finally is contracted to its top, in manner as shown in the drawings;" and, in the operation of the lamp, stress is laid upon the effect of perforations in the chimney rest, in its convex sides, through which the air, passing in currents, is alleged to impinge against the inner surface of the cylindrical portion of the chimney between the deflector and the chimney rest, and keep that part of the chimney cool, so that it may readily be seized between the thumb and finger, when it is desired to remove it.

§ 1025. *A claim for "the improved lamp as not only constructed with its cone or deflector F, and its chimney rest D, and chimney, arranged with respect to each other, as described," etc., is a claim for the chimney in combination with the other parts specified, which constitute the burner, and not for the burner only.*

The claim is as follows: "I claim the improved lamp, as not only constructed with its cone or deflector (F), and its chimney rest (D) and chimney, arranged with respect to each other as described, but as having the said deflector provided with peripheral springs, or the same, or the slits (h, h), and the rest (D), made concavo-convex, and provided with an annular groove or lip at the bottom, for supporting the chimney, the whole being substantially as described or represented."

The proof shows that the defendants, from the fall of 1867, have been engaged in the manufacture and sale of lamp burners, called the "Comet burners," which were not claimed on the trial to differ in any material particular from the patented invention, the principal apparent difference being in the substitution of a spiral elastic wire wound into the edges of the deflector, to press against the interior of the chimney and maintain its upright position, instead of the slit edge of the deflector itself, formed into springs, performing the same office. This, however, was not claimed to be a substantial difference, but

was treated by both parties, for the purposes of the case, as (which, I think, it unquestionably is) an equivalent device, operating in the same manner and producing the same effect. But, although it is proved that the defendants used their burners, so manufactured, in their store, with chimneys placed thereon, to exhibit their burners to customers, in order to make sales, and to demonstrate their superiority over other burners, there is no proof that the defendants ever manufactured or sold a chimney; and hence, they insist, that, having made and sold only some of the parts included in the patented combination, they are not liable in this suit.

It is quite obvious that the distinguishing feature of the invention of Collins is the burner, with its chimney rest, a deflector having peripheral springs, to sustain the chimney without the aid of a catch or screw, and with air passages operating, when in use, to keep the lower part of the chimney cool, and obviously tending, by this means, and by the greater elevation of the flame, to prevent the lower portion of the burner, and top of the reservoir, from becoming unduly heated. It is also clear, and was proved, that the burner alone, or the burner attached to the reservoir, is utterly useless. A chimney must be applied, in order to its operation. So, also, a chimney without a burner is wholly useless.

§ 1026. *Infringed by sale and manufacture of part of the combination, useless without the other, and intended to be completed by the party purchasing the article.*

It was claimed, in behalf of the complainants, that the chimney is no material part of the invention, as patented, and, therefore, that the defendants have made and sold all that is material in the patent. I incline, however, strongly to the opinion that the patentee, in his specification and claim, instead of claiming the burner as new, and securing the exclusive right in respect to that, has claimed it in combination with a chimney, and must stand by his patent under that construction. In that view of the construction of the patent, the case stands thus: The complainants having a patent for an improved burner in combination with a chimney, the defendants have manufactured and sold extensively the burner, leaving the purchasers to supply the chimney, without which such burner is useless. They have done this for the express purpose of assisting, and making profit by assisting, in a gross infringement of the complainants' patent. They have exhibited their burner furnished with a chimney, using it in their sales room, to recommend it to customers, and prove its superiority, and, therefore, as a means of inducing the unlawful use of the complainants' invention. And now it is urged, that, having made and sold burners only, they are not infringers, even though they have distributed them throughout the country in competition with the complainants', and have, to their utmost ability, occupied the market, with the certain knowledge that such burners are to be used, as they can only be used, by the addition of a chimney. Manifestly, there is no merit in this defense, and it must be regretted if the law be not such as will protect the complainants against this palpable interference. If the complainants were to succeed in finding those who manufactured chimneys for the express purpose of selling them to be used on these burners, the latter could clearly urge the same, if not a better, defense to a prosecution; and so the complainants would be driven to the task of searching out the individual purchasers for use who actually place the chimney on the burner and use it—a consequence which, considering the small

value of each separate lamp, and the trouble and expense of prosecution, would make the complainants helpless and remediless.

§ 1027. *Where several parties concert to manufacture and sell each one a different part of a machine which is patented as a combination, and the whole are to be put together for sale or use, they must be deemed joint infringers, and every one is liable by himself for all the damages.*

The rule of law invoked by the defendants is this — that, where a patent is for a combination merely, it is not infringed by one who uses one or more of the parts, but not all, to produce the same results, either by themselves or by the aid of other devices. This rule is well settled, and is not questioned on this trial. The rule is fully stated by Chief Justice Taney, in *Prouty v. Ruggles*, 16 Pet., 336, 341, and in other cases cited by the counsel. *Byam v. Farr*, 1 Curt., 260, 265; *Foster v. Moore*, id., 279, 292; *Vance v. Campbell*, 1 Black, 427; *Eames v. Godfrey*, 1 Wall., 78, 79. But I am not satisfied that this rule will protect these defendants. If, in actual concert with a third party, with a view to the actual production of the patented improvement in lamps, and the sale and use thereof, they consented to manufacture the burner, and such other party to make the chimney, and in such concert they actually make and sell the burner and he the chimney, each utterly useless without the other, and each intended to be used, and actually sold to be used, with the other, it cannot be doubtful that they must be deemed to be joint infringers of the complainants' patent. It cannot be that where a useful machine is patented as a combination of parts, two or more can engage in its construction and sale, and protect themselves by showing that, though united in an effort to produce the same machine, and sell it and bring it into extensive use, each makes and sells one part only, which is useless without the others, and still another person, in precise conformity with the purpose in view, puts them together for use. If it were so, such patents would, indeed, be of little value. In such case all are tort-feasors, engaged in a common purpose to infringe the patent, and actually by their concerted action producing that result. In a suit brought against such party or parties, a question might be raised whether all the actors in the wrong should be made parties defendant; but I apprehend that even at law, and certainly when non-joinder was not pleaded, the want of all the parties would be no defense. Each is liable for all the damages.

§ 1028. *Actual concert with others to infringe a combination by the manufacture by each party of an element of the combination, useless without the other, will be inferred from sale to a purchaser of one of the elements.*

Here the actual concert with others is a certain inference from the nature of the case, and the distinct efforts of the defendants to bring the burner in question into use, which can only be done by adding the chimney. The defendants have not, perhaps, made an actual pre-arrangement with any particular person to supply the chimney to be added to the burner; but every sale they make is a proposal to the purchaser to do this, and his purchase is a consent with the defendants that he will do it or cause it to be done. The defendants are, therefore, active parties to the whole infringement, consenting and acting to that end, manufacturing and selling for that purpose. If the want of joinder of other parties could avail them for any purpose (which is not to be conceded), they must set it up as a defense, and point out the parties who are acting in express or implied concert with them. Nor is it any excuse that parties desiring to use the burner have all the glass manufacturers in the world from whom to procure the chimneys. The question may be novel, but

in my judgment upon these proofs the defendants have no protection in the rule upon which alone they rely as a defense against the charge of infringement.

Independent of this question, the proofs show an actual use by the defendants of the entire subject of the patent; but, as the conclusion reached charges them as manufacturers and vendors, it is not material to inquire whether that use is within the scope of the bill of complaint, or would, by itself alone, entitle the complainants to charge them as infringers in this suit.

The complainants must have a decree for an injunction and account, as prayed in the bill of complaint.

Combination — Infringement — By sale of a part only, §§ 1029-1039.

§ 1029. The general principle is well settled that the making and selling of the separate materials for a patented *combination* is not an infringement of the rights of its inventor. *Millner v. Schofield*, 4 Hughes, 258.

§ 1030. The mere manufacture of a separate element of a patented combination, unless such manufacture be proved to have been conducted for the purpose of aiding infringement, is not, in and of itself, infringement. *Saxe v. Hammond*, 1 Holmes, 456.

§ 1031. A party who sells some of the elements of a patented combination, but not all, is liable only when he sells them with a view to their being employed with the other elements. *Coolidge v. McCone*, 2 Saw., 571.

§ 1032. Different parties may all infringe by respectively making or selling, each of them, one of the elements of a patented combination, provided those separate elements are made for the purpose and with the intent of their being combined by a party having no right to combine them. *Saxe v. Hammond*, 1 Holmes, 456.

§ 1033. The defendants, though they manufactured only one part of the combination covered in the patent, are nevertheless infringers, if it appears that such parts were made and sold for the express use to which they were put. *Richardson v. Noyes*, 10 O. G., 507.

§ 1034. In order to render one who makes and sells part of a patented combination liable for infringement, the parts manufactured must be useless in any other machine, and they must be sold and manufactured with the understanding or intention that the remaining parts are to be supplied by another, and the whole then combined for use. *Millner v. Schofield*, 4 Hughes, 258.

§ 1035. Where the claim was for a combination, and the defendant sold only part of the patented invention, but at the same time furnished the means which afterwards became, and intended that they should become, the device described in the patent, and in that manner directly procured the infringement to be done, *held*, he is himself liable, if any one is, for that infringement. *New York Bung & Bushing Co. v. Hoffman*, 9 Fed. Rep., 199.

§ 1036. Where a party manufactured and sold an element of a combination, incapable of any use except in such combination, *held*, that there was an intent to procure infringement, and that there was infringement. *Schneider v. Pountney*, 21 Fed. Rep., 399.

§ 1037. Where the invention consisted of a combination having only its full effect when applied in a certain relation, it was held infringed by the combination ready to be so applied. *Barnes v. Straus*, 9 Blatch., 553.

See *Infringement*, § 2880.

§ 1038. Where the use of a combination of materials is an infringement of a patent, a sale of materials to persons using such combination with the intention that they shall be so used is also an infringement of the patent. *Bowker v. Dows*, 15 O. G., 510.

§ 1039. Where the device sold by the defendants is capable of use independently of a feature necessary to the plaintiff's apparatus, and it does not appear that the defendants intended that such feature should be added to their device, the case cannot be said to come within that class of cases where the seller of parts of a patented combination is liable for infringement if there be a concert of action proved or legally inferable between him and others who supply other parts necessary to the complete combination. *Maynard v. Pawling*, 3 Fed. Rep., 711.

See *Infringement, of an Entirety by Use of a Part*, §§ 2892-2901. *Re-use*, §§ 5864-5866.

Combination — Infringement — By substitution of an equivalent, §§ 1040-1064.

§ 1040. A combination is infringed by a mere change in form or proportion, or a substitution of mechanical means or equivalents in any one or all of the elements producing the same result. *Gorham v. Mixer*, 1 Am. L. J., 539.

§ 1041. A combination claim may be infringed, although the specific devices used by the defendant were not known at the time of the patentee's invention. *Potter v. Stewart*, 18 Blatch., 561.

§ 1042. A combination of old elements is infringed by the use for one of the elements of a device which was, at the date of the first patent, a well-known substitute for such omitted element. *Sands v. Wardwell*, 3 Cliff., 277.

§ 1043. The mere substitution of a mechanical equivalent or equivalents for one or more of the elements constituting the combinations and organizations thus claimed, or any mere formal or fraudulently evasive change in the parts or arrangement embraced in the claim, would not relieve a party from liability as an infringer. *Taylor v. Garretson*, 9 Blatch., 156.

§ 1044. A patent for a combination is infringed by the use of a similar combination, although one of the elements is omitted and another substituted for it, unless the substituted device is a new one, or performs a function essentially different, or was not known at the date of the patent as a proper substitute for the one omitted. *Welling v. Rubber Harness-Trimming Co.*, 7 O. G., 606; *Webster v. New Brunswick Carpet Co.*, 5 O. G., 522.

§ 1045. If any one uses all the elements of a patented combination except one, and, instead of that, employs what was known at the date of the patent to be a proper substitute for the omitted element, he is liable for an infringement of the patent. But he is not liable if he uses any other substitute, or even an old one, which performs a new function. *Gill v. Wells*, 22 Wall., 1.

§ 1046. A patented combination will not be defeated by a mere substitution of something for one of the parts which performs the same, or substantially the same, function, and no other, as the part for which it is substituted. *Whittlesey v. Ames*, 9 Biss., 225.

§ 1047. The infringement of a patent is not avoided by the substitution for one member of the combination of an old ingredient performing the same function, and well known at the date of the patent as a proper substitute for the one omitted. But the rule is otherwise if the ingredient substituted is a new one, or performs a substantially different function, or was not known at the date of the patent as a proper substitute for the one omitted. *Fuller v. Yentzer*, 4 Otto, 299.

§ 1048. If any one of the parts of a combination is only formally omitted, and is supplied by a mechanical equivalent, performing the same office and producing the same result, the patent is infringed. *Union Water-Meter Co. v. Desper*, 11 Otto, 332.

§ 1049. Where a machine is the first of its class, it is an infringement to substitute a known equivalent, not in form, but in the sense that in that combination it was the use of another well known device performing the same operation in the same way. *Maynadier v. Tenney*, 2 B. & A., 615.

§ 1050. Well known mechanical substitutes employed for one of the elements of a combination is an infringement. *Carter v. Baker*, 1 Saw., 512.

§ 1051. Immaterial changes or the substitution of mechanical equivalents will not relieve a party from the charge of infringement. *Brighton v. Wilson*, 18 Fed. Rep., 378.

§ 1052. The substitution of a known equivalent for one element of a combination will not avoid it. *Brooks v. Jenkins*, 3 McL., 432; *Reay v. Raynor*, 19 Fed. Rep., 308.

§ 1053. The substitution for one part of the operating mechanism of a combination the equivalent of that omitted does not avoid an infringement. *Robertson v. Blake*, 94 U. S., 728.

§ 1054. The unauthorized use of a combination which operates upon the same principle with one that is patented is an infringement of the patent, although in the place of some of the constituent devices others are substituted which were known to be the equivalents of them when the patent was issued. *King v. Louisville Cement Co.*, 4 O. G., 181.

§ 1055. A new combination of old elements is infringed whenever another employs substantially the same combination in plan and elements which operates in the same manner and produces substantially the same results. The doctrine of equivalents, with slight modifications, applies with as much force to such an invention as to any other. *Dederick v. Cassell*, 9 Fed. Rep., 306.

§ 1056. Where some parts of the combination are new, and those parts are taken and used in the same manner, but with different elements, for the rest of the combination patented, a part of the invention is taken, although the whole is not, and it is an infringement to that extent. *Sharp v. Tiff*, 18 Blatch., 132.

See *Formal Change*, § 2556.

§ 1057. A combination of three known elements, where the result is effected by the union of all arranged with reference to each other, is not infringed by a combination of two of the elements with a third substantially different element. *Brooks v. Fiske*, 15 How., 212.

§ 1058. The substitution of new elements for old in a combination is no infringement. *Brooks v. Bicknell*, 4 McL., 70.

§ 1059. A combination of old elements held not infringed by a combination of some of its

elements with another element substantially different in form or in manner of arrangement and connection. *Stimpson v. The Baltimore & Susquehanna R. Co.*, 10 How., 329.

§ 1060. A patented combination may be used without infringing the patent, if one of the elements of the combination is omitted, although another is substituted in its place, which is new, or performs a substantially different function, or if it was not known as a proper substitute when the patent was issued. *Smith v. Woodruff*, 1 MacArth., 459.

§ 1061. A combination is not infringed by the substitution of a new element or of one that performs a substantially different function, or by the substitution of an old element not known at the date of the patent as a proper substitute for the omitted ingredient, or by a new combination of the existing elements of the patented combination. *Rowell v. Lindsay*, 10 Biss., 217.

§ 1062. Defendant having dispensed with one of the essential elements of the combination, and having substituted therefor a new mode of accomplishing the same object, not a mechanical equivalent, and not similar in principle of operation, there is no infringement. *American Ballast Log Co. v. Barnes*, 4 Hughes, 278.

§ 1063. Where the defendant omitted an element of plaintiff's combination, and included a device not found therein, *held*, that he did not infringe. *Knox v. Murtha*, 9 Blatch., 205.

§ 1064. When the defendant dispensed with one element of the combination claimed in the patent, and substituted another whereby the same result was accomplished in a manner different from that described in the patent, *held*, that there was no infringement. *Schmidt v. Freese*, 12 Fed. Rep., 563.

50. COMITY, RULE OF.

See RULE OF COMITY.

51. COMMISSIONER.

As to Appeals from, see APPEAL FROM COMMISSIONER—IN GENERAL; IN INTERFERENCES; ADMISSIBLE EVIDENCE; LIMIT OF APPEAL FROM; REASONS OF APPEAL FROM. As to his acts in granting Reissues, see REISSUES, PRESUMPTION AS TO COMMISSIONER'S ACTS ON GRANTING. As to Commissioner's Decisions, see EXTENSION, CONCLUSIVENESS OF COMMISSIONER'S DECISION AS TO; REISSUES, CONCLUSIVENESS OF COMMISSIONER'S DECISION ON GRANTING; PRIORITY OF INVENTION, CONCLUSIVENESS OF PATENT OFFICE DECISION. See, also, REISSUES, COMMISSIONER'S POWERS IN GRANTING.

Commissioner—Acting, §§ 1065-1067.

§ 1065. Act of 1868, acting commissioner, construed. *American Wood Paper Co. v. Glens Falls Paper Co.*, 8 Blatch., 513; *Woodworth v. Hall*, 1 W. & M., 389.

§ 1066. A signature to the patent and the certificate of copies by one calling himself "acting commissioner" is sufficient on its face in controversies between patentee and third parties, as the law recognizes an acting commissioner to be lawful. *Woodworth v. Hall*, 1 W. & M., 248.

§ 1067. It is no objection to a patent that it is certified by the acting commissioner; and he will be presumed to have acted legally, until the contrary is shown. *Ibid*.

See *Reissues*, § 5735. *Statutes*, § 6123.

Commissioner—Conclusiveness of his decision—Generally, § 1068. *Abandonment*, § 1069. *Granting patents*, §§ 1070, 1071. *His authority*, §§ 1072-1074. *Novelty*, §§ 1075, 1076. *Questions of fact*, §§ 1077-1080. *Priority*, §§ 1081, 1082. *Correctness of his decision*, §§ 1083-1085. *Patentability*, § 1085.

§ 1068. When the decision of a public officer is conclusive. *Allen v. Blunt*, 3 Story, 742.

§ 1069. The decision of the commissioner under section 35, act 1870, is not conclusive on the question of abandonment. *Woodbury Patent Planing Machine Co. v. Keith*, 4 B. & A., 100; *id.*, 101 U. S., 479.

§ 1070. Presumption is that commissioner's decision in granting letters patent is correct. *Sands v. Wardwell*, 3 Cliff., 277.

§ 1071. The decision of the commissioner of patents in granting a patent is not conclusive on the courts on the question whether it be for the same invention as that covered by a prior patent. *Sargent Manuf'g Co. v. Woodruff*, 5 Biss., 444.

See *Identity*, § 2717. *Patentability*, §§ 4551-4559.

§ 1072. In a suit by patentee against an infringer, the decision of the commissioner in granting a patent is conclusive as to his authority, unless the contrary appears from matter apparent on the face of the patent. *Dorsey Revolving Harvester Rake Co. v. Marsh*, 6 Fish., 387.

§ 1073. Where a public officer is authorized to grant a patent upon proof of compliance with certain prerequisites which are satisfactory to him, his issuing of the patent is *prima facie* evidence that they have been complied with, and no recitals to that effect are necessary in the grant. *Gear v. Grosvenor*, 1 Holmes, 215.

§ 1074. The grant of a patent is an adjudication that every fact which must necessarily appear to entitle the patentee to it has been established by sufficient proof. *Konold v. Klein*, 3 B. & A., 226.

§ 1075. The decision of the commissioner of patents on the question of novelty, while not entitled to the force of *res adjudicata*, yet is entitled to the respect of the courts, and should not be reversed except upon most satisfactory proof. *McComb v. Ernst*, 1 Woods, 195.

§ 1076. The opinion of the commissioner of patents granting an extension is entitled to great consideration on the question of novelty, but not on a question of infringement. *Evarts v. Ford*, 5 O. G., 58.

§ 1077. The evidence exhibited at the department by an applicant for a patent is *ex parte* and interested; and questions of fact are left open to be controverted by any one who contests the patent. *Shaw v. Cooper*, 7 Pet., 292.

§ 1078. The decision of the commissioner of patents upon questions of fact upon which he is authorized to pass is unimpeachable, except upon the ground that it is *ultra vires*. *McMillin v. Barclay*, 5 Fish., 189.

§ 1079. The decision of the commissioner in regard to the questions which have been committed to his exclusive jurisdiction is final—such as the sufficiency and competency of the formal acts and proofs which the statute provides shall be a prerequisite to the issuing of a patent; the existence of those facts upon which a reissue is to be granted or an extension made; and the sufficiency of the reasons for delay exceeding two years in prosecuting an application made since the act of 1870. *United States Rifle and Cartridge Company v. Whitney Arms Co.*, 14 Blatch., 94.

§ 1080. The decision of the commissioner of patents upon the fact that an applicant had complied with the requirements of the statute with regard to his application, and that certain acts were properly done, such as that the drawings and model required by statute were presented, or that an attorney by whom amendments were made was the duly constituted attorney of the applicant or his assignee, and had authority to amend and alter the specification, or that the specification had been sufficiently sworn to by the inventor, is not to be reviewed collaterally. If the patent is invalid by reason of any or all of these defects, its invalidity is to be determined in a proceeding to set aside the patent by *scire facias* or by bill or information. *Hoe v. Cottrell*, 17 Blatch., 546.

§ 1081. The decisions of the commissioner of patents, though entitled to great weight on questions of priority, are not final, even between those who have been fully heard in the interference. *Gloucester Isinglass & Glue Co. v. Brooks*, 19 Fed. Rep., 426.

§ 1082. *Held*, that after the decision of the commissioner of patents in favor of one contestant upon the broad claim stated in the declaration of interference, and the reissue of said contestant's patent with such claim, he had no authority to revise that decision or to revoke the reissue. The remedy of the defeated contestant, who was an applicant for a patent, was by resort to the courts. *Butler v. Shaw*, 21 Fed. Rep., 321.

§ 1083. *Dictum*: The court should set aside the decision of the commissioner only for the reasons of appeal assigned by the appellants, treating them as a bill of exceptions; but they should sustain it if the record shows it was correct, as on a writ of error, although the grounds on which he rests it may be insufficient. (Pr. Olin, Asst. J.) *Conklin and Stafford*, 1 MacArth., 375.

§ 1084. Whether the decision of the commissioner is correct or erroneous must appear from the proofs and evidence which have been acted on in the trial before the commissioner. *Rugles v. Young*, 1 MacA. Pat. Cases, 160.

§ 1085. The decision of the patent office on the question of the patentability of an invention, although open to doubt, will not be reversed except upon clear evidence. *Fraim v. Keen*, 25 Fed. Rep., 320.

See *Grant of Patent*, §§ 2660-2643. *Errors*, §§ 2179-2183. *Injunction, Preliminary*, §§ 3155, 3161. *Injunction*, §§ 3289, 3294, 3343-3345. *Interfering Patents*, §§ 3497-3504. *Process*, §§ 5034, 5035. *Reissues*, §§ 5684-5738.

Commissioner — Jurisdiction — *Extends up to issuance of patent*, §§ 1086-1091. *To try abandonment*, §§ 1092-1094.

§ 1086. The authority vested in the commissioner of patents to issue patents exists in full in each case, until the patent shall have been actually issued. *Johnson's Opinion*, 5 Op., 220.

§ 1087. When a patent has issued, the jurisdiction of the commissioner is exhausted. He has no further control over it, except in the case provided for in the thirteenth section of the act

of 1836, when the patent is inoperative or invalid by reason of a defective or insufficient specification. *Pomeroy v. Connison*, 1 MacA. Pat. Cases, 40.

§ 1088. The power vested in the commissioner to examine and determine the right of an applicant to a patent continues until the patent actually issues, and is not exhausted by any preliminary or intervening opinion he may form — as a decision in an interference case — which does not result in the grant of a patent. It is his duty to be satisfied at the moment of issuing the patent of the existence of all the conditions necessary, under the seventh section of the act of 1836, to a valid grant. *Matthews v. Wade*, 1 MacA. Pat. Cases, 143.

§ 1089. The commissioner of patents, up to the moment of issuing the patent, has the discretion to rehear a case before decided by him, and ought to do so until his mind is convinced that the patent is to issue to the true inventor. *In re Rouse*, 1 MacA. Pat. Cases, 186.

§ 1090. The jurisdiction of the commissioner to refuse a patent continues after interference is declared and until the patent is delivered. *Mowry v. Barber*, 1 MacA. Pat. Cases, 563.

§ 1091. The commissioner of patents is now vested with the whole and only original initiatory jurisdiction that exists up to the granting and delivering of the patent. *Hunt v. Howe*, 1 MacA. Pat. Cases, 366.

§ 1092. The commissioner of patents has jurisdiction to try and determine the questions of public use and abandonment arising in connection with an application by due proceedings suitable to the nature of the inquiry. *Hunt v. Howe*, 1 MacA. Pat. Cases, 366.

§ 1093. The commissioner and the judge upon appeal have jurisdiction of the question of the abandonment of an invention. *Ellithorp v. Robertson*, 1 MacA. Pat. Cases, 585.

§ 1094. The law confers upon the commissioner authority to institute an inquiry into allegations of public use and sale of the invention, such as would bar the patent. This proceeding, on which the commissioner acquires his information through the testimony of others, is a kind of judicial inquiry, and when the testimony is furnished by those in adverse interest, it becomes substantially a contest, and in such case justice requires that the fate of the application be determined by proof which conforms to the fundamental canons of the law of evidence, according to which *ex parte* affidavits taken without opportunity to cross-examine are in no case admissible upon the merits of a cause. *Alteneck's Appeal*, 23 O. G., 269.

See *Jurisdiction*, § 3894. *Use*, § 6495.

Commissioner — Generally — *Right to take out patent*, § 1095. *When subordinate to secretary of interior*, § 1096. *Powers generally*, §§ 1097-1107. *Court cannot control his discretion*, §§ 1108, 1109. *Refusal to grant patent*, § 1110. *Does not warrant patent*, § 1111. *Reviving cases decided by past commissioners*, § 1112. *Use of insulting language; damages for refusal to grant patent*, § 1113.

§ 1095. The office of commissioner of patents does not disqualify the individual from obtaining a patent thereafter for an invention made while holding office. *Foote v. Frost*, 14 O. G., 860.

§ 1096. The commissioner of patents is subordinate to and subject to the control of the secretary of the interior in the appointment and payment of such temporary clerks in that office as are authorized by law. *Crittenden's Opinion*, 5 Op., 283.

See *Secretary of Interior*, §§ 5985-5994.

§ 1097. There is nothing in the laws relating to the patent office, or in the rules adopted by the commissioner, to prevent him from postponing, upon his own motion, the hearing of a cause, if in his opinion the justice of the case should require it, and especially for the correcting of irregularities in matters of form. To deny him this power would be to stifle justice in her own forms. *Smith v. Flickenger*, 1 MacA. Pat. Cases, 46.

§ 1098. While the commissioner must look to the statutes creating his office and defining his duties for every power which he can exercise, it by no means follows that every power and jurisdiction must appear upon the face of the statute in words of express reference and definition. It would be a strange construction of the law to require the commissioner of patents to issue a patent upon a state of facts which, when made apparent to a court of law or equity, would require the court to pronounce the patent utterly void. It is said that the law never requires vain things to be done; but to require the commissioner of patents to issue a worthless and void patent would be worse than vain — it would be to direct that persons should be armed with a warrant, under the great seal of the United States, to go into all the courts of justice in the land and hunt down their fellow-citizens with oppressive, idle and vexatious litigation. *Wickersham v. Singer*, 1 MacA. Pat. Cases, 645.

§ 1099. It is true that the jurisdiction of the commissioner of patents is a limited one, but it is equally true that it is to be understood not only from what is expressly stated, but from what ought necessarily to be inferred, and is as absolute within its proper legal limits as that of a tribunal of general jurisdiction would be. *Hunt v. Howe*, 1 MacA. Pat. Cases, 366.

§ 1100. By the twelfth section of the act of 1839, the commissioner is authorized to establish such regulations in respect to the taking of evidence as shall be just and reasonable; and to understand what the legislature meant by just and reasonable in this connection, it must be supposed that they had in mind the established principles and precedents in like cases. *Nichols v. Harris*, 1 MacA. Pat. Cases, 302.

§ 1101. The commissioner of patents has no right to confirm patents obtained on false suggestion. *Mini v. Adams*, 3 Wall. Jr., 20.

§ 1102. Powers and duties of the commissioner of patents declared. *Hull v. Commissioner of Patents*, 2 MacArth., 90.

§ 1103. A favorable decision of an examiner or of the board of examiners-in-chief in the patent office, upon an application for a patent, is not conclusive upon the commissioner of patents, and it does not follow thereupon that he has only the ministerial duty to perform of countersigning and sealing the patent. *Ibid.*

§ 1104. The result of an examination is to be reported to the commissioner, and if it should appear to him, upon inspection of the report, that the alleged invention is neither novel nor meritorious, he would be bound in duty, under section 31, not to issue the patent. (Sec. 4893, R. S.) *Ibid.*

§ 1105. If to decide that a claimant is justly entitled to a patent, and that his invention is sufficiently useful and important, be the office of examiners, then, by section 7 of the statute, it is made the duty of the commissioner to superintend the performance of these duties by the examiners. *Ibid.*

§ 1106. Under the twenty-third section of the act (sec. 4885, R. S.) it is not the duty of examiners to pass and allow patents. It is the duty of the commissioner alone, after the examination has been reported, to say whether the patent shall be allowed and passed. *Ibid.*

§ 1107. We do not doubt that it is within the executive discretion of the commissioner, even after making and communicating to applicant a decision in his favor, and at any time before the issue of a patent for the signature of the secretary, to reconsider the decision and make a contrary one; . . . and if nothing more appears the court will not interfere by writ of *mandamus* to compel the issue of the patent as the next and consequent step. *United States ex rel. Hoe & Co. v. Butterworth*, 27 O. G., 519.

§ 1108. The courts have no absolute control over the head of the patent office in the exercise of his discretion whether a given invention or improvement shall be embraced in one, two or more letters patent. *McKay v. Dibert*, 5 Fed. Rep., 587.

§ 1109. It is competent for the court to inquire whether the commissioner has exceeded his jurisdiction in granting a patent (R. I.). He has no power to dispense with what the statute declares to be a necessary prerequisite. *Whitely v. Swayne*, 4 Fish., 117.

§ 1110. The fifty-second section of the act (4885, R. S.) contains an express recognition of power in the commissioner to refuse patents, and an *ex parte* bill in equity is given applicants as a remedy for such refusal. This section provides for a different class of cases from those which come before the commissioner by appeal from the examiners under sections 47 and 48 — cases in which the commissioner may refuse patents after favorable decisions by his subordinates, by virtue of his general supervisory authority. (Secs. 4910, 4911 and 4915, R. S.) *Hull v. Commissioner of Patents*, 2 MacArth., 90.

§ 1111. The commissioner of patents in issuing letters patent for an alleged invention does not warrant the same. Its validity remains open to inquiry, whether at the instance of private persons or of the United States. *Cushing's Opinion*, 8 Op., 270.

§ 1112. The practice of reviving cases decided by a former commissioner upon frivolous grounds commented upon and disapproved. *In re Littlefield*, 1 MacA. Pat. Cases, 574.

§ 1113. Where an action for damages was brought against the commissioner of patents for refusing to furnish copies of patent office records, it being shown that the request was made in an insulting and vulgar way, *held*, that had the case rested there, plaintiff was not entitled to recover; but as a subsequent request, decently made, though without apology for the former rudeness, had been refused, *held*, that plaintiff was entitled to verdict for nominal damages. *Boyden v. Burke*, 14 How., 575.

See *Bill, to Obtain Patent*, §§ 631-648. *Mandamus*, §§ 4119-4127.

52. COMMON CARRIERS.

SUMMARY (AMERICAN COTTON TIE SUPPLY CO. v. MCCREADY, §§ 1114-1116) — *Liability for infringement of common carrier transporting infringing articles*, § 1114. — *Refusal to disclose names of the shippers*, § 1115. — *Jurisdiction of circuit court to grant injunction*, § 1116.

AMERICAN COTTON TIE SUPPLY COMPANY v. MCCREADY.

(Circuit Court for New York: 17 Blatchford, 291-302. 1879.)

Opinion by BLATCHFORD, J.

STATEMENT OF FACTS.— This bill is founded on two patents. One of them, No. 23,291, was granted to George Brodie, May 22, 1859, for fourteen years from March 22, 1859, for "improvements in metallic bands for baling," and was reissued to him April 27, 1869, as reissue No. 3,405, and was extended for seven years from March 22, 1873, and was reissued March 25, 1873, as reissue No. 5,333. The other patent, No. 31,252, was granted to James J. McComb, January 29, 1861, for fourteen years from that day, for an "improvement in iron ties for cotton bales," and was extended for seven years from January 29, 1875. The plaintiff, a Louisiana corporation, is the owner of the patents. The validity of the patents and the right of the plaintiff to be protected by preliminary injunctions against infringements are not in question in this suit.

The charge of infringement made in the bill is, that the defendants, without license, have entered upon and are now engaged in infringing upon the rights of the plaintiff, by aiding and abetting various other persons, not licensees of the plaintiff, in making, selling and using iron cotton ties which embody the said patented inventions. The defendant McCready is the president of the Old Dominion Steamship Company, a Delaware corporation, the defendant Stanford is the secretary and general freight agent of the said corporation, and the third defendant is the assistant general freight agent of the said corporation. The bill alleges that the defendants, as officers and agents of the said corporation, have been for some time past, and now are, actively engaged, without the license or authority of the plaintiff, and against the plaintiff's protest, in transporting cotton ties, embodying the said inventions, from the port of New York to various points in the south, and particularly to Norfolk, Petersburg and Richmond, well knowing that such ties are intended for sale and use in the cotton districts and in the cotton ports of the south; that the plaintiff has already suffered damage from such acts of the defendants; and that the defendants have been duly notified of the plaintiff's rights in the premises, and requested to desist from such acts, but refuse to do so, except as they shall be restrained therefrom by the order of this court. The bill prays that the defendants may account for profits and damages, and may be enjoined from making, using or vending the said inventions and from aiding others in so doing.

The bill is accompanied by an affidavit made by Frederic Cook, an agent of the plaintiff, on the 13th of October, 1879, setting forth that the said corporation has been engaged, without the license or authority of the plaintiff, in transporting from the city of New York to Norfolk and other places in the state of Virginia, iron cotton ties embodying the inventions covered by the third, fourth and fifth claims of the Brodie patent, and the claim of the McComb patent; that, within the past two weeks, he has seen upon the pier of said corporation various lots of said ties, which he carefully examined and is sure

were not of the manufacture of the plaintiff, but were unlicensed and infringing ties; that he has been unable to learn from the officers of said corporation who the actual shippers of the said infringing ties have been, although he has caused proper inquiry to that end to be made, the officers of the corporation declining to furnish the information, on the ground that the rules of the corporation forbid it; that he believes that other persons than those who have been restrained in suits brought by the plaintiff, in this court, against Bullard & Wheeler and John S. Long, V. Pugsley and G. P. Chapman, Earle & Perkins and Moses & Cohen, are making such shipments by the said line; that, on the 10th of October, 1879, there was received at the New York office of the plaintiff a letter from its Norfolk agent, C. Phillips, inclosing a copy of a part of the manifest of the Old Dominion, one of the steamships of the said corporation, which lately arrived from New York at Norfolk, and which showed the shipment on that vessel of six lots of cotton ties consigned to different parties, none of whom are agents of the plaintiff; that such ties were described in said letter as arrow ties; that the writer of the letter went on to state that the large quantity of such ties brought into his territory from New York was seriously affecting his trade, and that, unless the further introduction of such ties could be prevented, his sales would not be one-half of what they would otherwise be; that a letter of similar import was written within a few days, and received from the Petersburg agents of the plaintiff, in which complaint is made of the large number of competing ties brought into the Petersburg market from New York; that the counsel for the plaintiff has caused the attention of the officers of the said steamship company to be called to the injury that is thus being inflicted upon the plaintiff, and has served upon said company and one or more of the defendants herein a copy of the restraining orders and injunctions which have been issued in the above-named suits, but that, while the officers of said company acknowledge their obligation to refrain from transporting ties for the special parties defendant in said suits, they do not feel that they are at liberty to decline taking similar freights from other persons; that the counsel for the plaintiff has caused to be represented to the officers of said company the difficulty which the plaintiff now finds in protecting itself against shipments of infringing ties by unknown parties, and that it may, therefore, become necessary to apply to this court for an order restraining the said company generally from acting as carriers for parties who may offer such ties for shipment from the port of New York, and that the officers of said company have signified not only their willingness to yield a ready obedience to any such order, if obtained, but a disposition to abstain from any attempt to embarrass the plaintiff in securing such order; that he greatly fears that unless the said company be so restrained forthwith, and before a motion for an injunction can be heard in the due course of practice, infringers will succeed in removing their ties to points in the south and outside of the jurisdiction of the court; that, should they succeed in this, it will necessarily result in irreparable damage to the plaintiff; and that this is the most critical period of the cotton tie season, and a few thousand bundles of infringing ties thrown into the market at this juncture will almost inevitably unsettle prices and greatly disturb the trade, and thus inflict an injury upon the owners of the patents for which there is no adequate remedy.

On the bill and such affidavit an order was made by this court, on the 13th of October, 1879, ordering that from and after the service of the writ of subpoena in this cause, and a notice of motion for an injunction *pendente lite*,

to be heard on October 24, 1879, with copies of the papers on which said motion is to be made, "the said defendants, and each of them, their agents, servants, attorneys, workmen and employees, and each of them, be and stand in all respects restrained and prohibited from receiving at the wharves or docks of the said Old Dominion Steamship Company, or from placing on board said company's steamships, or from shipping or transporting from any point or points within the jurisdiction of this court, under any pretext whatever, any cotton ties containing the features of invention, or any of them, which form the subject of the third, fourth and fifth claims of the said patent No. 5,333, or the claim of the said patent No. 31,252, and particularly ties composed of a flat band of iron and an open-slotted link or buckle, having a single central opening for receiving the band, unless such ties be offered for shipment or transportation by the said American Cotton Tie Supply Company, or its duly authorized agents, and that they and each of them do stand so restrained and prohibited until the hearing of such motion, and until the same shall be by the court determined and decided."

The motion has been heard. It is opposed, on the part of the defendants, by an answer to the bill and by affidavits. The defendant McCready, in an affidavit, says that he is president of the Old Dominion Steamship Company, a corporation created under and by virtue of the laws of Delaware, and engaged in the business, as common carrier, of carrying and transporting freight and passengers between the ports of New York, Norfolk and Richmond, and having its general office in the city of New York; that said company owns many large steamships, by which it carries on its said business, which sail from the port of New York six times a week, laden with large cargoes of all kinds of merchandise; that said company receives upon its wharf, at pier 43, North river, from a very large number of persons, all kinds and descriptions of freight, in all quantities; that he is not acquainted with any of the details of such transportation, so far as the names of shippers and the different kinds of merchandise are concerned, his duties being confined to the general management of the business; that it would not be practicable for him to inform himself each day as to such details; that he has no knowledge whatever as to the claim of the plaintiff herein to the patents specified in the bill, nor to the articles claimed to be manufactured in accordance therewith; that it would be impossible for him, as president of said company, to inform himself, each day, or at any time, whether the articles received by the said company for shipment are shipped by persons licensed by the plaintiff, or whether the articles have been properly purchased by the shippers from the plaintiff, or whether the articles themselves are infringements of the plaintiff's manufacture, or different from the same; that, with regard to the shipments heretofore made, he has been entirely ignorant in the respects above set forth, except so far as he has been informed, by persons acting for the plaintiff, that the articles were infringements; that the business of said company is very large, and it would be impossible, in the proper conduct of the same, for the said company to inform itself of all the facts with regard to the articles shipped, to ascertain whether or not they were infringements of the plaintiff's manufacture; that it would necessitate the employment of experts to examine each and every one of the articles, out of many tons thereof, to determine whether or not they were infringements; that it would be necessary to employ persons to make inquiries as to the shippers of the articles, to learn, if possible, whether they had the right to ship the same; that all of this would seriously impede

and delay the business of the said company, to its great and irreparable injury; that he has in no way infringed upon the rights of the plaintiff; that he has not aided or abetted any persons, whether licensees of the plaintiff or otherwise, in making, selling or using the articles claimed by the plaintiff; that he has no knowledge, nor any means of ascertaining, whether or not the said company is shipping or transporting cotton ties embodying the plaintiff's patented invention, shipped by persons without authority or license; and that neither he nor the other officers of the said company would hesitate to obey any proper order of this court, but the said company and its officers do most earnestly oppose the making of any order which would inflict any serious injury upon said company, as the order prayed for herein inevitably would.

The defendants Stanford and Guillauden, in a joint affidavit, state that Stanford is secretary and general freight agent of the Old Dominion Steamship Company, and that Guillauden is assistant general freight agent of said company; that they have read the affidavit of the defendant McCready, and the same is true in every respect; that the defendants are entirely ignorant of the matters in the bill and affidavit of the plaintiff set forth, with relation to the letters patent and the plaintiff's rights and acts thereunder, as alleged in said bill and affidavit, nor have they any means of informing themselves as to such matters; that they deny any individual connection with, or relation to, the acts charged against them in said bill and affidavit, and allege that their only connection, directly or indirectly, with such matters is as officers and agents of the Old Dominion Steamship Company; that said company acts, in relation to the transportation of the articles alleged to be infringements of the plaintiff's invention, only as a common carrier for others, and that it has no other interest or connection with said articles; that the deponents are employed entirely in the office of said company; that they have never seen any of said articles; and that they have no power or authority to refuse to transport the same.

The defendant Stanford, in a separate affidavit, states that he is secretary and general freight agent of the Old Dominion Steamship Company; that, since the restraining order in this suit was issued, cotton ties have been offered to said company for shipment; that, by reason of said order, and the inability of the officers and agents of said company to ascertain and determine as to whether or not the said ties were infringements of the plaintiff's alleged inventions, or whether or not the persons offering the same were rightly authorized to ship them, the said company was compelled to refuse to receive or transport the same; that the said ties were subsequently offered to another company, a competitor of the Old Dominion Steamship Company, which received and transported the same; that, by reason of being placed in such a position, the said company is sustaining and will continue to sustain very serious injury, not only with regard to the freight on said ties, but with regard to other freight; that such injury will amount to upwards of \$1,000 a month directly, in addition to its liability to action by the parties offering said ties; and that the competitors of said company are thus greatly benefited at its expense and to its great injury.

§ 1114. *A common carrier transporting articles made, and intended to be sold, in violation of patent rights, and refusing to disclose the names of the owners of such articles, infringes the patent and is liable for such infringement.*

It is contended for the defendants that the steamship company, as it acts solely in the capacity of common carrier of these ties, does not come within

the meaning of the statute, as an infringer of the patents; that it has nothing to do with the rights of the plaintiff or the invasion of those rights by others; that it does not use, or aid others in using, the ties, because such use cannot be had until after transportation and delivery; that the company, by transporting the ties, does not sell them to others to be used, or aid in selling them to others to be used; that, as a common carrier, the company is bound to receive and carry all goods offered by any person; that it would be against public policy to restrain the company; that it would impede its business and inflict injury on the whole community; that the suit is improperly brought against the defendants and should be brought against the company; that the defendants are only officers of the company, with distinct duties, and have no control over the goods and no power to refuse to receive them; that the company ought not to be compelled, at its own expense, to protect the plaintiff's business; and that it owes no duty to the plaintiff, to answer for the diligence which the plaintiff ought to use in protection of its own interests.

It is entirely clear that the owners of infringing and unlicensed cotton ties, who are causing them to be transported by the vessels of the old Dominion Steamship Company, are sending them for sale and use, and are employing said company and its officers as agents and servants in promoting and effecting such sale and use. It would seem, on principle, that there ought to be no difficulty in restraining by injunction all persons, whether officers of a corporation or not, who are aiding in the promotion of the infringing sale and use, whether such persons would be liable for profits or damages or not. It has been so held by this court. *Goodyear v. Phelps*, 3 Blatch., 91; *Poppenhusen v. Falke*, 4 id., 493.

In *Hunt v. Maniere*, L. J., new series, vol. 34, part 1, Chy., 142, a wharfinger received notice that certain wine deposited at his wharf was marked with a fraudulent imitation of a trade-mark, and that the owner of the trade-mark was about to apply to the court of chancery for an injunction to prevent the wine from going on the market. After the injunction had been granted, but before the wharfinger had notice that it been granted, he refused to deliver the goods to their owner. It was held by the master of the rolls, and, on appeal, by the lords justices, that he was justified, in equity, in such refusal, and that the owner of the goods would be restrained from suing him at law for a wrongful conversion of the goods. The master of the rolls observed that the plaintiff acted rightly, and that, being in the possession of goods which he knew to be a fraudulent and spurious imitation of the manufacture or growth of other persons, and being informed that an injunction would be obtained, and being notified not to deliver the goods, he would have acted culpably if he had parted with the goods.

In *Upmann v. Elkan*, Law Rep., 7 Chy. App., 130, affirming the decision of the master of the rolls (Law Rep., 12 Eq. Cas., 140), a firm of forwarding agents in London received from correspondents abroad several boxes of cigars bearing forged brands, which were to be delivered to several persons in England. On application by the makers whose brand had been forged, the agents gave information as to the consignors, and offered either to send back the cigars or to erase the brands. On a bill for an injunction, filed by the makers whose brands were forged, it was held that the fact that the agents were merely carriers was no defense to the suit, but that, as they had given sufficient information and had offered to erase the brands, they were not to pay costs. The defendants were forwarding agents, to whom the goods had been consigned

to pay the duty on them and forward them to persons named. They were to be paid for so doing, but their profit did not arise from the sale of the goods. The master of the rolls said: "It does not, in my opinion, make any difference whether the goods are sent to a person who does not deal in the article consigned, and whose duty is simply to distribute the goods to other persons, or whether the goods are sent to him as consignee for his own purposes. In either case they are sent to the dock to be at his disposal, and without his signature the goods cannot be disposed of. It will not do for him to say, as he does in this case, 'I know nothing about the goods sent. I do not know whether they have any, or, if any, what brand on them, or whose it is.' It is his duty to know this, and, if he receives notice that they bear a fraudulent imitation of another man's brand, he ought to ascertain this as speedily as possible after such notice, and to take the proper and necessary steps to prevent their being disposed of in that state. It may be that, without notice, and when he sees the trade-mark, he does not know that it belongs to another. If so, he may deal with them innocently. But, as soon as he is informed of the fact, he should act at once, so as not to be, in any event, either from wilful or from accidental ignorance, made a party to the fraud committed by another; and, when he ascertains the fact, he should at once inform his correspondent abroad. If it be argued that this imposes upon him serious inconvenience, and a duty which, by taking the order for goods, he never undertook, this may be admitted to be true; but it is only what would be the case in the event of the importation of prohibited articles, and it arises from the circumstance that he has not taken sufficient care to ascertain what sort of persons the correspondents are for whom he consents to act as agent." Lord Hatherley, on the appeal, said: "It has been argued that the plaintiffs were not entitled to an injunction against the defendants, who had been guilty of no offense, being merely carriers receiving goods, which, though fraudulently marked, were not for their own use, nor to be sold by them for their own benefit, but were received merely for the purpose of transmitting them to the persons to whom they were consigned. I cannot conceive a doctrine more dangerous or mischievous or more fatal to the authority of the court with respect to trade-marks. If that argument prevailed, any persons, being abroad, as was the case in this instance, and minded to commit frauds upon an English trade-mark, could easily do so by sending their different consignments together to persons in the position of the defendants, who appear to be respectable agents and warehousemen, thereby committing an injury in a manner most convenient for themselves, and very mischievous to the person entitled to the benefit of the trade-marks."

§ 1115. *Refusal of common carrier to disclose names of the shippers of infringing device carried by them.*

In *Orr v. Diaper*, Law Rep., 4 Chy. Div., 92, it was held that a bill would lie against ship-owners who had shipped goods bearing counterfeits of the plaintiff's trade-marks, for a discovery of the names of the consignors from whom the goods had been received.

The doctrine of these cases in regard to trade-marks is entirely applicable to the case of the infringement of a patent. As the defendants have refused to disclose the names of the infringing shippers of ties, the plaintiff is without remedy by injunction, in respect of the infringing ties which the defendants' company transports in its vessels, unless it can obtain an injunction in this suit. It clearly ought to have such a remedy.

§ 1116. *Under section 4921 of the Revised Statutes, the authority of the United States circuit court, in a case arising under the patent laws, of which it has jurisdiction to grant an injunction, according to the course and principles of courts of equity, to prevent the violation of any right secured by a patent, is entirely independent of the award of any other relief in the same suit.*

No authority is cited by the defendants in which it is held that an injunction will not lie in a case like the present. The cases cited for the defendants are cases where it has been held that workmen and employees will not be held liable for profits and damages in a suit for the infringement of a patent. Under section 4921 of the Revised Statutes, the authority of this court, in a case arising under the patent laws, of which it has jurisdiction, to grant an injunction, according to the course and principles of courts of equity, to prevent the violation of any right secured by a patent, is entirely independent of the award of any other relief in the same suit.

The officers of the steamship company must have the same power to refuse to accept infringing cotton ties that they have to accept them. The defendant, McCready, does not disclaim such power to refuse. The cases of *Lightner v. Kimball*, 1 Low., 211, and *Heaton v. Quintard*, 7 Blatch., 73, are distinguishable from the present case.

As to the suggestion of hardship to the defendants and to their company, there can be no difficulty in so framing the order of injunction that, with the co-operation of the agents of the plaintiff, there will be but little practical difficulty in securing obedience to the injunction without serious practical inconvenience to the defendants. The defendants' company will be deprived of no more carrying trade in respect to infringing ties than they would be deprived of if the shippers of such ties were enjoined, and it must be presumed that they would be enjoined if their names were known. The defendants' company could have caused such names to have been disclosed, on inquiry, but it did not. The allegation that the information was asked and refused is not denied. The injunction asked for is granted.

53. COMPETENCY OF WITNESSES.

See WITNESSES, COMPETENCY OF.

54. COMPLETE INVENTION.

See INVENTION, COMPLETE.

55. COMPOSITION OF MATTER.

SUMMARY (*WOOD v. UNDERHILL*, §§ 1117–1119)—*Insufficient and sufficient description*, §§ 1117, 1118.—*Sufficiency of specification*, § 1119.

(*TYLER v. BOSTON*, §§ 1120–1122)—*Sufficient description*, § 1120.—*Chemical equivalent defined*, § 1121.—*Identity of two compounds a question of fact for the jury*, § 1122.

WOOD v. UNDERHILL.

(5 Howard, 1–6. 1846.)

ERROR to U. S. Circuit Court, Southern District of New York.

STATEMENT OF FACTS.—Action for infringement of a patent for making brick. The patent was held void in the lower court on account of a defect in

the specification as to the proportions of the ingredients to be used. The patentee described his process as follows:

“Take of common anthracite coal, unburnt, such quantity as will best suit the kind of clay to be made into brick or tile, and mix the same, when well pulverized, with the clay before [it] is moulded; that clay which requires the most burning will require the greatest proportion of coal-dust; the exact proportion, therefore, cannot be specified; but, in general, three-fourths of a bushel of coal-dust to one thousand brick will be correct. Some clay may require one-eighth more, and some not exceeding a half bushel. The benefits resulting from this composition are the saving of fuel, and the more general diffusion of heat through the kiln, by which the whole contents are more equally burned. If the heat is raised too high, the brick will swell, and be injured in their form. If the heat is too moderate, the coal-dust will be consumed before the desired effect is produced. Extremes are, therefore, to be avoided.”

Opinion by TANEY, C. J.

The question presented in this case is a narrow one, and may be disposed of in a few words. The plaintiff claims that he has invented a new and useful improvement in the art of manufacturing bricks and tiles; and states his invention to consist in using fine anthracite coal, or coal-dust, with clay, for the purpose of making brick or tile; and for that only he claims a patent. And the only question presented by the record is, whether his description of the relative proportions of coal-dust and clay, as given in his specification, is, upon the face of it, too vague and uncertain to support a patent.

The degree of certainty which the law requires is set forth in the act of congress. 5 Stats. at Large, 117. The specification must be in such full, clear and exact terms as to enable any one skilled in the art to which it appertains to compound and use the invention; that is to say, to compound and use it without making any experiments of his own. In patents for machines, the sufficiency of the description must, in general, be a question of fact to be determined by the jury. And this must also be the case in compositions of matter, where any of the ingredients mentioned in the specification do not always possess exactly the same properties in the same degree.

§ 1117. *Where the specification of a new composition of matter gives only the substances to be mixed, without any relative proportions, the court may declare the patent void; also where the proportions are vaguely or ambiguously stated.*

But when the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent to be void. And the same rule would prevail where it was apparent that the proportions were stated ambiguously and vaguely. For in such cases it would be evident, on the face of the specification, that no one could use the invention without first ascertaining, by experiment, the exact proportion of the different ingredients required to produce the result intended to be obtained. And if the specification before us was liable to either of these objections, the patent would be void, and the instruction given by the circuit court undoubtedly right.

§ 1118. — *but where certain proportions are specified as a general rule, the patent may be valid, notwithstanding the specification gives slightly varying proportions, according to the nature of the material used.*

But we do not think this degree of vagueness and uncertainty exists. The

patentee gives a certain proportion as a general rule; that is, three-fourths of a bushel of coal-dust to one thousand bricks. It is true, he also states that clay which requires the most burning will require the greatest proportion of coal-dust; and that some clay may require one-eighth more than the proportions given and some not more than half a bushel instead of three-fourths. The two last-mentioned proportions may, however, be justly considered as exceptions to the rule he has stated, and as applicable to those cases only where the clay has some peculiarity, and differs in quality from that ordinarily employed in making bricks. Indeed, in most compositions of matter, some small difference in the proportions must occasionally be required, since the ingredients proposed to be compounded must sometimes be in some degree superior or inferior to those most commonly used. In this case, however, the general rule is given with entire exactness in its terms; and the notice of the variations mentioned in the specification would seem to be designed to guard the brickmaker against mistakes into which he might fall if his clay was more or less hard to burn than the kind ordinarily employed in the manufacture.

§ 1119. *Where the nature of the material used in a composition is not susceptible of such a full, clear and exact description as to enable one skilled in the art to compound it, and the proportions have to be ascertained by experiment, the composition is not patentable.*

It may be, indeed, that the qualities of clay generally differ so widely that the specification of the proportions stated in this case is of no value, and that the improvement cannot be used with advantage in any case or with any clay without first ascertaining by experiment the proportion to be employed. If that be the case, then the invention is not patentable; because, by the terms of the act of congress, the inventor is not entitled to a patent unless his description is so full, clear and exact as to enable any one skilled in the art to compound and use it. And if, from the nature and character of the ingredients to be used, they are not susceptible of such exact description, the inventor is not entitled to a patent. But this does not appear to be the case on the face of this specification. And whether the fact is so or not is a question to be decided by a jury, upon the evidence of persons skilled in the art to which the patent appertains. The circuit court, therefore, erred in instructing the jury that the specification was too vague and uncertain to support the patent, and its judgment must be reversed.

TYLER v. BOSTON.

(7 Wallace, 327-331. 1868.)

ERROR to U. S. Circuit Court for Massachusetts.

STATEMENT OF FACTS.—Tyler sued the city of Boston for infringement of his letters patent for a new compound, which he described as a combination of fusel oil with the mineral and earthy oils, constituting a burning fluid. He described his compound as one part each, by measure, of crude fusel oil and kerosene, and that the combination might be varied by substituting naphtha or crude petroleum for kerosene, or a part of the kerosene by an equal quantity of naphtha or crude petroleum; also, that experiment was necessary to ascertain the exact quantity of fusel oil required to make the best compound.

The compound used by defendant consisted of seventy-two parts of naphtha and twenty-eight parts of fusel oil.

The court below instructed the jury that the suggested substitution of

naphtha for kerosene meant an equal quantity of the former in place of the latter, while the plaintiff's counsel contended that "equal" meant equal in character, or equivalent.

Opinion by MR. JUSTICE GRIER.

The patent states that "the exact quantity of fusel oil which is necessary to produce the most desirable compound must be determined *by experiment*."

§ 1120. *When a patent is claimed for the discovery of a new substance by means of chemical combinations of known materials, it should state the parts of the new manufacture claimed with clearness and precision, and not leave the person attempting to use the discovery to find it out "by experiment."*

Now a machine which consists of a combination of devices is the subject of invention, and its effects may be calculated *a priori*, while a discovery of a new substance by means of chemical combinations of known materials is empirical and discovered by experiment. Where a patent is claimed for such a discovery, it should state the component parts of the new manufacture claimed with clearness and precision, and not leave the person attempting to use the discovery to find it out "by experiment." The law requires the applicant for a patent-right to deliver a written description of the manner and process of making and compounding his new-discovered compound. The art is new; and therefore persons cannot be presumed to be skilled in it, or to anticipate the result of chemical combinations of elements not in daily use.

The defendants used a burning-fluid composed of naphtha seventy-two and fusel oil twenty-eight parts; and expert chemists proved that seventy-two parts *in bulk* of naphtha was the *substantial equivalent* of twenty-eight parts of kerosene.

§ 1121. *Chemical equivalent defined.*

This term "*equivalent*," when speaking of machines, has a certain definite meaning; but when used with regard to the chemical action of such fluids as can be discovered only by experiment, it only means *equally good*. But while the specification of the patent suggests the substitution of naphtha for crude petroleum, it prescribes no other proportion than that of equal parts by measure. The explanation that the "kerosene must be replaced by an *equal quantity* of naphtha" does not alter the case.

§ 1122. *Whether one compound of given proportions is substantially the same as another compound varying in the proportions is a question of fact for the jury.*

The charge which the court gave is a clear and intelligible statement of the principles of law which should govern the jury in making up their verdict. It said properly, that "whether one compound of given proportions is substantially the same as another compound varying in the proportions—whether they are substantially the same or substantially different—is a question of fact and for the jury."

If the jury in finding for the defendants have erred, the remedy is not in this court.

Judgment affirmed.

Composition of matter—Patentability, §§ 1123-1132. See *Articles of Manufacture*, §§ 398-418. *Equivalents, Chemical*, §§ 2132-2138. *Process and Product*, §§ 5105-5118. *Product*, §§ 5119-5128.

§ 1123. A new composition of matter or substance which is useful is patentable. *Goodyear v. Wait*, 5 Blatch., 468.

§ 1124. If a compound be made, not before known, of different ingredients, that is ground

for a patent, not for the thing constructed, but for the compound of which it is made. *Hotchkiss v. Greenwood*, 4 McL., 456.

§ 1125. To combine known elements in new proportions, and thereby produce a new composition with distinct properties and applicable to new uses, is patentable. *Francis v. Mellor*, 1 O. G., 48.

§ 1126. The omission from a composition of an ingredient before believed to be essential is patentable. *Tarr v. Folsom*, 1 Holmes, 312.

§ 1127. An artificial honey, consisting of sugar, water, rosin, butter, cream of tartar, gum arabic, honey, essence of peppermint and isinglass, compounded in a described manner and in definite proportions, and forming a substance which closely resembles the genuine article in appearance, taste and flavor, and which would seem to be a wholesome article of consumption, is a new and useful composition of matter, and forms the proper subject-matter of a patent. *Corbin v. Martlett*, 1 MacA. Pat. Cases, 521.

§ 1128. It is not an objection to such an imitation, on the ground of novelty, that it closely resembles the natural product, since that varies in composition from natural causes, and is made in an entirely different manner: nor, on the ground of utility, that it is a deception, and calculated to impose an inferior article upon the public, since the specification expressly declares its factitious character, and furnishes the formula by which it is made. *Ibid.*

§ 1129. *Held*, where the compositions of matter were shown to be useful, agreeable to those who used them, profitable to the plaintiff through his manufacture and sale of them, and new, that this constituted patentability. *Rogers v. Ennis*, 15 Blatch., 47.

§ 1130. The introduction of a flavoring extract, whether in substitution of another or as an additional ingredient of a beverage composition otherwise well known, *held*, a patentable improvement, and is substantially a new composition of matter, and as such may be protected. *Rogers v. Ennis*, 15 Blatch., 74.

§ 1131. It is not advisable to issue patents for newly invented medicines, to bear the name of other popular medicines existing. *Wirt's Opinion*, 2 Op., 109.

§ 1132. Patenting a compound for one purpose does not prevent its being patented for another, especially if there is an essential difference in the compositions. *Jenkins v. Walker*, 1 Holmes, 120.

See *Invention*, §§ 3616, 3634, 3636, 3660. *Reissues*, §§ 5540, 5559-5568. *Scope of Patent*, § 5977. *Specification*, § 6058. *Substitution*, §§ 6215, 6216. *Use, Double*, §§ 6368, 6369.

Composition of matter — Infringement of — *When infringed*, §§ 1133-1137. *When not*, §§ 1138-1141.

§ 1133. It is an infringement of a patent for a composition to use one made up of different materials, yet possessing the same qualities. *Jenkins v. Walker*, 1 Holmes, 120.

§ 1134. Substitution of a known equivalent for one element of a composition is an infringement, unless the same is expressly excluded in the claim from the invention. *Byam v. Farr*, 1 Curt., 260.

§ 1135. An unsubstantial or colorable change in a compound will not protect from infringement. Where the ingredients are the same, and the change merely in the mode of combining them, or there is a substitute of one ingredient having the same qualities and producing the same result, the principle remains the same. *Allen v. Hunter*, 6 McL., 303.

§ 1136. If the defendants are found to make substantially the same composition as that embraced in the patent, whether by the same process or another, it seems that they are guilty of infringing it. *Woodward v. Morrison*, 1 Holmes, 124.

§ 1137. Where the ingredients were the same as in complainant's patented medical compound, and were combined to produce the same result upon the same principle, although the proportions varied slightly, it was held such substantial identity as to establish infringement. *New York Pharmaceutical Association v. Tilden*, 14 Fed. Rep., 740.

See *Injunction*, § 3411.

§ 1138. A composition of matter is not infringed by another in which one of its elements is present as an impurity only. *Byam v. Farr*, 1 Curt., 260.

§ 1139. Patent construed to be for a composition consisting of a new combination of old materials before in use for the same purpose, and held that any one or all of the materials might be used without infringing, provided they were not used in the combination as patented. *Byam v. Eddy*, 2 Blatch., 521.

§ 1140. Where a compound is claimed only when made by the process set forth, and the process is claimed only as set forth, a compound made by a process lacking one of the essential steps does not infringe. *Dittmar v. Rix*, 1 Fed. Rep., 342.

§ 1141. Every patent for a product or composition of matter must identify it so that it can be recognized aside from the description of the process for making it, or else nothing can be held

to infringe the patent which is not made by that process. *Cochrane v. Badische Anilin & Soda Fabrik*, 111 U. S., 293.

See *Admissions*, § 160.

Composition of matter — New ingredients — *The combination constitutes the invention*, § 1142. *Novelty*, § 1143. *Scope*, § 1144. *Right to equivalents*, § 1145.

§ 1142. It is not necessary that every or even any ingredient used by a patentee should be new or unused before; it is the combination of the material which constitutes the invention. *Ryan v. Goodwin*, 3 Sumn., 514.

§ 1143. It is not necessary that the ingredients of a composition of matter should be new, or that they have not been before used for similar purposes, if the combination is new; that is, if they have not been before compounded in the same proportions. *Corbin v. Martlett*, 1 MacA. Pat. Cases, 521.

See *Combination*, § 920. *Novelty*, §§ 4304, 4394.

§ 1144. If a man makes a new compound, wholly unknown before, for a useful and valuable purpose, he is not limited to the use of the same precise ingredients, and if the same purpose can be accomplished by him by the substitution in part of other ingredients in the composition, he is at liberty to extend his patent so as to embrace them also. *Ryan v. Goodwin*, 3 Sumn., 514.

§ 1145. A patent for a composition of several ingredients covers and embraces known equivalents of each ingredient. *Matthews v. Skates*, 1 Fish., 602.

See *Claim, Combination*, § 692. *Construction of Patents*, § 1220.

56. COMPOUND.

See COMPOSITION OF MATTER.

57. CONSPIRACY TO INFRINGE.

See COMBINATION, §§ 1021-1039. INFRINGEMENT, §§ 2892-2901. RE-USE, §§ 5864-5866.

58. CONSTITUTION, THE, CONSTRUCTION OF.

See STATUTES, CONSTRUCTION OF THE CONSTITUTION.

59. CONSTRUCTION OF CLAIMS.

See CLAIMS, CONSTRUCTION OF.

60. CONSTRUCTION OF CONTRACTS.

See CONTRACTS, CONSTRUCTION OF.

61. CONSTRUCTION OF JUDICIAL OPINIONS.

See PRACTICE, CONSTRUCTION OF JUDICIAL OPINIONS.

62. CONSTRUCTION OF PATENTS.

See DISCLAIMER, §§ 2016-2065. FORM, §§ 2541, 2542.

Construction of patents — Is for the court, §§ 1146-1151.

§ 1146. It is a question for the court, and not the jury, whether the specification can be construed intelligibly in a particular way. *Whitney v. Emmett*, Bald., 303; *Blanchard v. Sprague*, 2 Story, 164; *Davoll v. Brown*, 1 W. & M., 53.

§ 1147. It is the duty of the court to settle the meaning of the patent. *Emerson v. Hogg*, 2 Blatch., 1.

§ 1148. Construction of the words of the patent and specification is for the court. *Washburn v. Gould*, 3 Story, 122.

§ 1149. The construction of the specification is for the court. *Parker v. Hulm*, 1 Fish., 44.

§ 1150. The construction of the specification is for the court. The application of the facts on such construction is for the jury. *Teese v. Phelps*, 1 McAl., 48.

§ 1151. It is for the court, as a matter of law, to construe a patent, and for the jury, as a question of fact, to determine whether it has been infringed, and the amount of damages that should be allowed. *National Car-Brake Shoe Co. v. Terre Haute Car & Manufacturing Co.*, 19 Fed. Rep., 514.

Construction of patents — Ambiguity, §§ 1152, 1153. Errors, §§ 1154, 1155.

§ 1152. Where the construction of the patent and specification as to the subject of the grant is doubtful, the oath, if more precise, may be resorted to, to explain the ambiguity. *Pettibone v. Derringer*, 4 Wash., 215.

§ 1153. In the construction of a patent, where the words are ambiguous, the intention of the parties is entitled to great consideration. *Evans v. Eaton*, 3 Wheat., 454.

§ 1154. Erroneous description in a specification rejected and the patent construed in view of the rest of the description, which was sufficient to correct the error. *Kittle v. Merriam*, 2 Curt., 475.

§ 1155. Incorrect lettering in a patent treated as an obvious error, and the patent construed without reference thereto. *National Pump Cylinder Co. v. Simmons Hardware Co.*, 18 Fed. Rep., 324.

See *Errors*, §§ 2179-2188.

Construction of patents — Right to a broad, §§ 1156-1162. See *Broad Claim, Right to*, §§ 679-686. *Invention*, §§ 3576-3583. *Inventor*, §§ 3777-3780. *Patents*, § 4755. *Scope of Patent*, §§ 5945-5960.

§ 1156. Where the patent is a pioneer and a foundation patent, both as to process and to machine, it is not to be construed as confined to specific details, if fairly admitting of the liberal construction such a patent is entitled to. *Hammerschlag v. Scamoni*, 7 Fed. Rep., 584.

§ 1157. Where the patentee is the first in the art, his patent may have a broader construction; otherwise it will be limited to the particular device. *Rapp v. Bard*, 1 Fish., 196.

§ 1158. Where patentee has discovered a wholly new art or method, his patent will be broadly construed to cover all such mechanical means as embody the real invention. *Standard Measuring Machine Co. v. Teague*, 15 Fed. Rep., 390.

§ 1159. Where the inventor was the first to employ his device for the peculiar functions performed, *held*, that he was protected not only in the particular devices which he employed for this purpose, but against all other devices which are the mechanical equivalents of his. *Knapp v. Joubert*, 19 Blatch., 148.

§ 1160. An inventor is supposed to describe in his patent the best mode of practicing his invention, but is not necessarily limited to the precise construction shown, so as to exclude a method differing from it only in a single detail, but producing the same result. *Lorillard & Co. v. McDowell & Co.*, 11 O. G., 640.

§ 1161. Evidence of fraudulent designs on the part of the defendants will incline a court to a liberal construction of the patent infringed. *Odiorne v. Denney*, 13 O. G., 965.

§ 1162. Where an inventor was not fully informed as to the peculiar use of an element of his combination, still had pointed it out as best for his purpose, a subsequent discoverer of its peculiar value cannot patent its use in the same combination; but the first inventor can claim it on reissue. *Bailey Washing and Wringing Machine Co. v. Lincoln*, 4 Fish., 379.

Construction of patents — Should be liberal, §§ 1163-1186.

§ 1163. Patents are to be construed liberally. *Dorsey Revolving Harvester Rake Co. v. Marsh*, 6 Fish., 387; *Ryan v. Goodwin*, 3 Sumn., 514; *Blanchard v. Sprague*, 3 Sumn., 535; *Brooks v. Bicknell*, 3 McL., 250; *Parker v. Stiles*, 5 McL., 44; *Goodyear v. The Railroad*, 2 Wall. Jr., 356; *Imlay v. Norwich & Worcester R. Co.*, 4 Blatch., 227; *Swift v. Whisen*, 2 Bond, 115; *Klein v. Russell*, 19 Wall., 433; *Goodyear Dental Vulcanite Co. v. Gardiner*, 3 Cliff., 408; *Union Sugar Refining Co. v. Matthieson*, 3 Cliff., 639; *Waterbury Brass Co. v. New York & Brooklyn Brass Co.*, 3 Fish., 43; *Ames v. Howard*, 1 Sumn., 482; *Stanley v. Hewitt*, 17 Frank. J., 165, 2d series; *Corning v. Burden*, 15 How., 252 (§§ 5028-35).

§ 1164. Patent is to be construed liberally, and so as to uphold it, if possible. *Ingels v. Mast*, 6 Fish., 415; *Davoll v. Brown*, 1 W. & M., 53.

§ 1165. A liberal construction is to be given to the language of all patents and specifications, so as not to limit the actual invention of the patentee. *Schillinger v. Gunther*, 14 Blatch., 152.

§ 1166. The correct rule of construction is one which will give the patentee what he has really invented, so far as is consistent with the language of his description and claim; both of which are to be read together. *Williams v. Boston & Albany R. Co.*, 17 Blatch., 21.

§ 1167. Liberal construction should be accorded to patents, so as, if possible, to secure to an inventor what is really his invention. *Bussey v. Wager*, 9 O. G., 300; *Hale v. Stimpson*, 2 Fish., 565; *Woodman v. Stimpson*, 3 Fish., 98.

§ 1168. The specifications are to be construed liberally, and so as to effect, if practicable, the end and object designed. *Judson v. Moore*, 1 Bond, 285.

§ 1169. A patent should be construed in a liberal spirit to sustain the just claims of the inventor; but nothing should be excluded which is in it, or anything interpolated which it does not contain. *Rubber Co. v. Goodyear*, 9 Wall., 788.

§ 1170. Patents should be construed liberally to support the claims of meritorious inventors. *Parker v. Sears*, 1 Fish., 93.

§ 1171. The specification is to be liberally construed; and effect, if possible, is to be given to the claims of the patentee, so as to give him all the benefits of his invention. *Whitney v. Mowry*, 2 Bond, 45; *Wintermute v. Redington*, 1 Fish., 239.

§ 1172. The courts will endeavor to give such construction to a patent as will support the invention, and will not unnecessarily adopt one that would render the patent invalid. *Goodyear Dental Vulcanite Co. v. Davis*, 12 O. G., 1.

§ 1173. The intention of the inventor, so as to effect the object designed, is to govern the construction of the language he employs. *Page v. Ferry*, 1 Fish., 298.

§ 1174. Patents are to be liberally construed in order to give effect to the intention of the parties. *Carew v. Boston Elastic Fabric Co.*, 3 Cliff., 356; *Harris v. Allen*, 15 Fed. Rep., 106.

§ 1175. Patents should be construed liberally, *ut res magis valeat quam pereat*. *Goodyear v. Providence Rubber Co.*, 2 Cliff., 351.

§ 1176. Patents are to be construed liberally, and not as monopolies odious to the law. *Turrill v. Railroad Co.*, 1 Wall., 491.

§ 1177. Patents should be construed in a fair and liberal spirit to accomplish the purpose of the laws under which they are issued. *Birdsell v. McDonald*, 6 O. G., 682.

§ 1178. Courts should lean to such a construction of a patent as will sustain and not avoid it. *Francis v. Mellor*, 1 O. G., 48.

§ 1179. A patent is to be construed liberally and in view of the specification and drawings. *Latta v. Shawk*, 1 Bond, 259.

§ 1180. A literal construction of a description of an invention in the application is not to be adopted where it would be repugnant to the manifest sense and reason of the instrument. *Corn-Planter Patent*, 23 Wall., 181.

§ 1181. Where a patent admits of two constructions, one of a mere result, which would be void, and the other of the means for accomplishing such result, which would be valid, it should be favorably construed to sustain the patent, if it can fairly be done. *Ibid.*

§ 1182. Where there is a slight change in a machine, by which a new result is brought about, and which might be the subject of a patent, courts do not feel inclined to extend the invention beyond the mere change, although they may be inclined to sustain the patent; but where something elementary has been discovered and constitutes fairly a part of the invention of the patentee, no other inventor or manufacturer ought to be permitted to use that elementary part without paying tribute to the first inventor or originator. *Cornell v. Downer & Bemis Brewing Co.*, 7 Biss., 346.

§ 1183. Patents are liberally construed, and courts will not go beyond the law for technical objections to defeat them. *Allen v. Hunter*, 6 McL., 303.

§ 1184. In construing the patent the court must be governed entirely by the claim. *Kidd v. Spence*, 4 Fish., 37.

§ 1185. While patents are to be construed liberally, they should not be so construed as to enable patentees to reach out and cover every improvement or invention which, after seeing the same, they conclude they might have embraced within their patent, but which was not so embraced and included. *Trader v. Messmore*, 7 O. G., 385.

§ 1186. In reducing his patent to practical application a patentee is not held to strictly and entirely follow the mere mechanical device shown in his drawings, but he may deviate so long as he does not violate the principle involved in his patent. *Weir v. North Chicago Rolling Mill Co.*, 9 Biss., 508.

See *Defenses*, § 1820.

Construction of patents — Should be in view of *specifications*, §§ 1187-1196; *drawings*, §§ 1197-1205; *model*, § 1206; *caveat*, § 1207; *state of the art*, §§ 1208-1212.

§ 1187. What may be resorted to for ascertaining the object of the specification. *Davoll v. Brown*, 1 W. & M., 53.

§ 1188. In construing letters patent the whole instrument should be taken together. *Hudson v. Draper*, 4 Cliff., 178.

§ 1189. In deciding the meaning of a patent the specifications are to be looked to. *Hogg v. Emerson*, 6 How., 437.

§ 1190. Patent and specification are to be construed together, in order to ascertain the subject-matter of the invention. *Whittemore v. Cutter*, 1 Gall., 429; *Hogg v. Emerson*, 6 How., 479; *Forbes v. Barstow Stove Co.*, 2 Cliff., 379.

§ 1191. In construing a patent, the entire specification is to be taken together, as embracing the particular description which the law requires. *Page v. Ferry*, 1 Fish., 298.

§ 1192. The entire description in a patent, as well as the name given to the subject of invention, is to be looked at in order to give effect to every part and to ascertain from the whole what is meant. *Day v. Combination Rubber Co.*, 2 Fed. Rep., 570.

§ 1193. The intention of the parties is to be collected from a comparison of the whole specification, and though portions of it may seem, when read by themselves, to claim devices to which the patentee is not entitled, yet, if other portions unmistakably disclaim them, the specification is to be interpreted accordingly. *Carew v. Boston Elastic Fabric Co.*, 3 Cliff., 356.

§ 1194. Words of the specification are to be taken together, and to be so construed as to give effect to the meaning and intention of the person using them; they are not to be distorted from their meaning to effect a supposed intention, but to be reasonably construed as connected with the sentence in which they are used. *Allen v. Hunter*, 6 McL., 303.

§ 1195. In construing a patent, single phrases are not to be taken alone, but the whole must be taken in connection. *Ames v. Howard*, 1 Sumn., 482.

§ 1196. The language of the specification is to be so received, as, consistently with its fair import, "will make the claim co-extensive with the actual discovery." *Parker v. Stiles*, 5 McL., 44.

§ 1197. The patent embracing the specification and drawings is to be taken together. *Ibid.*

§ 1198. Drawings and description must all be taken together. *Doughty v. Day*, 9 Blatch., 262.

§ 1199. The question as to what the patented improvements are must be determined by the court as a question of law arising upon the construction of the patent, including the specification and drawings. *Cahoon v. Ring*, 1 Cliff., 592.

§ 1200. The plaintiff (patentee) is not controlled by his title, but the patent, specification and drawings are all to be examined, and are all to have a fair and liberal construction in determining the nature and extent of the invention. *Bell v. Daniels*, 1 Bond, 212.

§ 1201. In construing a patent, the court should look to the patent, specifications and drawings to ascertain what is the thing claimed and patented. *Geier v. Goetinger*, 7 O. G., 563.

§ 1202. The description and drawings in an original patent may be looked to, to disclose the real invention of a patentee, when the original claims are defective, or the reissue claims obscure. *Bussey v. Wager*, 9 O. G., 300.

§ 1203. Effect must be given to the whole of the description contained in the specification and drawings of a patent. Hence, if it can be ascertained that a patentee intended to divide his invention into two parts and to describe and claim them as separate improvements, the patent must be construed according to this intention, so as to give full effect to each part of the invention. *National Car-Brake Shoe Co. v. Lake Shore & Michigan Southern R'y Co.*, 9 Biss., 503.

§ 1204. A patent construed in view of the drawings, although not so claimed in the specification. *Heinrich v. Luther*, 6 McL., 345.

§ 1205. In order to determine the invention covered by the patent, the drawings and model should be considered as well as the specification. *Hoffheims v. Brandt*, 3 Fish., 218.

§ 1206. The model is not to be resorted to for the purpose of construing the patent, except in cases where the specifications are ambiguous or uncertain. *Frazer v. Gates & Scoville Iron Works*, 22 Fed. Rep., 439.

See *Model*, § 4201.

§ 1207. The caveat, original specification and subsequent renewals are to be looked to in construing the patent; and no fancied construction traveling too far on a doubtful ground is to be adopted; rather what is natural and clear, considering what already exists on the same subject. *Smith v. Downing*, 1 Fish., 64.

§ 1208. In construing the general terms in the description of a patent the commonest knowledge and experience in the business in life should be kept in view, and a patentee with

such knowledge not be presumed to describe an impossibility. *Tilghman v. Mitchell*, 2 Fish., 518.

§ 1209. A patent will be construed in the light of uncontradicted testimony as to prior existing devices for the purpose of determining its scope. *Day v. Combination Rubber Co.*, 2 Fed. Rep., 570.

§ 1210. Patents are to be construed in the light of what was before known to persons skilled in the art to which they relate in order to give effect to the true meaning of what is there described. *Webster Loom Company v. Higgins*, 15 Blatch., 447.

§ 1211. A patent should be construed in view of the prior state of the art, to determine what the inventor has actually accomplished, and this having been found, such a construction should be given as will secure the actual invention to the patentee so far as consistent with the giving of due effect to the language of the specification and claim. *Van Marter v. Miller*, 15 Blatch., 562.

See *State of the Art*, §§ 6092-6107.

§ 1212. A patented invention cannot be stretched beyond the legitimate bounds of discovery, so as to exclude all other inventions within the same field of operations. *Fuller v. Yentzer*, 6 Biss., 203.

Construction of patents—Practice, §§ 1213-1216. See *Injunction, Preliminary*, § 3154. *Marking Articles Patented*, § 4146.

§ 1213. On the construction of a patent arising on a motion for injunction, where error may be followed by irreparable mischief, the court is not bound by the rule of comity which requires justices of the supreme court to conform to the opinions of each other under given conditions. *Many v. Sizer*, 1 Fish., 31.

§ 1214. On motion for attachment for contempt for violation of an injunction restraining an infringement, after the construction of the patent by the court, no testimony would be proper or of any effect to vary it. *Burdett v. Estey*, 16 Blatch., 105.

§ 1215. None but parties to the suit for infringement will be heard to pray to have a construction given to the patent not arising out of matters in issue in the suit. *Page v. Holmes Burglar Alarm Telegraph Co.*, 18 Blatch., 118.

§ 1216. Upon the decision of a motion for a preliminary injunction against the infringement of a patent, which has been sustained by a previous adjudication, it is proper, as a general rule, to follow the construction of the patent which was given upon such adjudication, provided the construction was given with deliberation and thoughtfulness in the use of language. *Mallory Mfg. Co. v. Hickok*, 20 Fed. Rep., 116.

Construction of patents—Particular patents, §§ 1217-1227.

§ 1217. A patent for an improvement in the art of making nails by means of a machine is not for an abstract principle, but for an improvement applicable to a practical use, effected by a combination of various mechanical powers to produce a new result. *Gray v. James*, Pet. C. C., 394.

§ 1218. Patent for "a new and useful improvement" covers only the whole combination in its entirety, and not the several improvements specified in the claim, separately and distinctly from each other. *Pitts v. Whitman*, 2 Story, 609.

§ 1219. Where the patented invention was for a machine for stamping a particular design, held, that the right to the use of the machine carried along with it the right to use the design. *Clark v. Bousfield*, 10 Wall., 133.

§ 1220. Where, in a patent for a compound, a general reference to "fluxes" was made, it was held to include those which were in general use, and which would overcome by their chemical attraction the opposing powers of the other ingredients of the compound. *Allen v. Hunter*, 6 McL., 303.

§ 1221. Where the specification failed to describe shape, proportions, etc., of a device claimed, the invention was limited to the peculiar shape shown in the drawings, and held not infringed by a differently constructed device involving invention beyond that in the drawing. *Schneider v. Lovell*, 10 Fed. Rep., 666.

§ 1222. Where nothing was said in the specification as to the material out of which a certain element of the invention was to be made, it was limited to that shown in the patent office model. *Holt v. Keeler*, 13 Fed. Rep., 464.

§ 1223. Where complainants had used their patented device thirteen years without becoming aware that it covered the alleged infringing device, which had been patented subsequent to theirs, their patent was limited in construction so as not to cover it. *Trader v. Messmore*, 7 O. G., 385.

§ 1224. Where an inventor patentee, acquainted with a prior inoperative model, which had been laid aside, proceeded to put his invention into practical shape, *held*, that his territory was as broad as he had actually reduced to possession. *Union Paper Bag Co. v. Pultz & Walkley Co.*, 16 Blatch., 76.

§ 1225. The original application for a patent made by Thompson and Bachelder was filed in June, 1847. Being rejected, it lay unaltered in the patent office until 1852, when it was considerably amended, and a patent was granted thereon to Tanner on the 6th of July, 1852. *Held*, that no material alterations introduced by such amendments could avail as against parties who had introduced other brakes prior thereto. *Railway Company v. Sayles*, 7 Otto, 554.

§ 1226. Though the proofs do not show that the defendant's product was made by the process described in the patent, yet there is nothing to the contrary, and as sufficient appears to establish the chemical identity of the defendant's product with the complainant's, a sufficient *prima facie* case is shown upon the question of infringement. *Pickhardt v. Packard*, 22 Fed. Rep., 530.

§ 1227. Where the part infringed was shown in the drawing and was a mechanical feature of the device patented, on construing the patent it was held not to have been an essential part of the invention in the mind of the inventor, nor to have been made by him a distinctive part of the improvement. *Bradley & Hubbard Mfg. Co. v. Charles Parker Co.*, 34 O. G., 249.

Construction of patents—*Art*, §§ 1228, 1229. *Claim*, §§ 1230-1233. *Disclaimer*, §§ 1234, 1235. *Drawings*, § 1236. *Form*, § 1237. *Improvement*, §§ 1238, 1239. *Material*, §§ 1240, 1241. *Two patents simultaneously granted*, §§ 1242, 1243.

§ 1228. When it is too clear to admit of a doubt that a patent is for a machine, the court cannot change it into a patent for an art. *Boston Elastic Fabric Co. v. East Hampton Rubber-Thread Co.*, 1 Holmes, 372.

§ 1229. Whether a patent is for a process or a composition is especially a question of construction, and is for the court to decide; and whether a patent for a process is the same invention as a patent for a composition is certainly a mere question of law. *Atlantic Giant Powder Co. v. California Powder Works*, 8 Otto, 126.

§ 1230. In construing a patent the claim should be looked to, and is conclusive upon the right and title of patentee. *Wyeth v. Stone*, 1 Story, 273.

§ 1231. Although a patent describes a process which is novel, yet, if it declares the invention to be a particular machine, and claims only that the machine is made of several parts which are named, it cannot be sustained if a prior machine, capable of performing the same process, contained all the mechanisms enumerated, even if one of them was smaller than the corresponding part described in the patent, the size not being specified in the claim. *Boston Elastic Fabric Co. v. East Hampton Rubber-Thread Co.*, 1 Holmes, 372.

§ 1232. The rule of construction is that each patentee is restricted to the matters set out in his claim. *Toohy v. Harding*, 4 Hughes, 254.

§ 1233. The court cannot consider whether a claim might have been made broader in view of the invention described in the specifications and drawings. If it fails to cover all the patentee intended to secure, his remedy was through reissue. The court cannot enlarge it by construction. The patent, as it stands, *held* not to be infringed. *Becker v. Hastings*, 22 Fed. Rep., 827.

§ 1234. A construction of a patent which would render a disclaimer in the patent altogether nugatory is essentially wrong and cannot be accepted. *Atlantic Giant Powder Co. v. Hulings*, 21 Fed. Rep., 519.

§ 1235. In patents for combinations of mechanism, limitations and provisos imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and in favor of the public, and looked upon in the nature of disclaimers. *Sargent v. Hall Safe & Lock Co.*, 114 U. S., 63.

§ 1236. In construing the specification, the drawings are to be regarded as part and parcel of it. *Judson v. Moore*, 1 Bond, 285; *Forbes v. Barstow Stove Co.*, 2 Cliff., 379.

§ 1237. When the several elements of a patented machine differ from a prior machine only as to the form of certain parts common to both, the patent, in order to be sustained, must be restricted in scope to the improvements in the form of such parts. *Williams v. Barker*, 2 Fed. Rep., 649.

§ 1238. If an improvement of a well-known appendage to a machine is fully described in a specification, it is not necessary to show the ordinary modes of attaching the appendage to the machine. The patent is to be read as if the machine and its appendage were present or in the mind of the reader, and he a person skilled in the art. *Webster Loom Co. v. Higgins*, 105 U. S., 580.

§ 1239. A patent for an improvement merely in a department of mechanics to which it per-

tains must be limited in its scope to the arrangement of devices described and claimed; and cannot be expanded to apply to substituted devices dissimilar in character and form, merely because they perform the same functions, or because the same general result is effectuated by both. *Dyer v. National Hod Elevating Co.*, 24 Fed. Rep., 182.

§ 1240. Where the patentee covers with his patent the material of which part of his machine is composed he entirely endangers his right to prosecute where a different and inferior material is employed, and especially one which he himself, after repeated experiments, has rejected. *Aiken v. Bemis*, 3 W. & M., 348.

§ 1241. In patents for machine, the terms "any suitable materials," used for the construction of the parts, means known materials; but even when not used, the discoverer of a new material would have only the exclusive right to his new material, and no right to make the machine. *Bailey Washing & Wringing Machine Co. v. Lincoln*, 4 Fish., 379.

See *Construction of Patents*, § 1222.

§ 1242. Where two patents have been issued, each claiming, broadly, the same invention, and the earlier patentee is held to be the first inventor, the claim in the second patent must be restricted to the particular devices there specially described. *Richardson v. Noyes*, 10 O. G., 507.

§ 1243. The invention of the patentee, under which the defendants manufacture, having been completed at about the date of that contained in the complainants' patent, and there being no lack of diligence in applying for protection, the court construed complainants' patent strictly to avoid infringement and to sustain both grants. *Moore v. Thomas*, 14 O. G., 1.

Construction of patents — Generally, §§ 1244-1256. See *Technical Terms*, §§ 6244-6253.

§ 1244. A patent is to be construed as a whole. Rule of construction stated. *Carver v. Braintree Mfg. Co.*, 2 Story, 432.

§ 1245. Plain and ordinary rules of construction should be applied to patent specifications and the works of inventors. *Hogg v. Emerson*, 6 How., 437.

§ 1246. The construction of patents and specifications must be reasonable. Rules for construction of patents. *Bates v. Coe*, 8 Otto, 31 (§§ 1816-30).

§ 1247. The patent must speak for itself, and be understood as expressing what is to be gathered from what is there. *Badische Anilin & Soda Fabrik v. Cochrane*, 16 Blatch., 155.

§ 1248. A patent, like any other written instrument, must be interpreted by its own terms; but when a patent bears on its face a particular construction, it is reasonable to hold that this construction may be confirmed by what the patentee said when he was making his application; and for this purpose the correspondence between an applicant and the commissioner may be employed, although such correspondence would not be allowed to enlarge, diminish or vary the language of the patent. *Goodyear Dental Vulcanite Co. v. Davis*, 12 Otto, 222.

§ 1249. A patent must be construed as the patent was obtained, when the claim was drawn and adopted, and not with reference to subsequent modes of manufacture in that particular. *Elfelt v. Steinhart*, 6 Saw., 480.

§ 1250. Whenever a change or device is new and effects beneficial results, courts look with favor upon it. *Middletown Tool Co. v. Judd*, 3 Fish., 141.

§ 1251. A model and rejected application of a third person, and the patentee's knowledge of the same, are admissible to show the circumstances connected with the invention and the state of things existing at the time, in order to enable the court to understand the subject-matter of the patent and to aid in its construction. *Union Paper Bag Machine Co. v. Pultz & Walkley Co.*, 15 Blatch., 160.

§ 1252. The construction which would otherwise be given to a patent ought not to be varied in order to conform to the testimony of a patentee and former owner, whereby he undertakes to restrict the invention within a narrower compass than that which he had previously shown in the specification. *Ibid.*

§ 1253. In constructing machines, or carrying into effect a process, under patents, something must be left to the judgment and discretion of the mechanic or operative to whom the work is committed. *Swift v. Whisen*, 2 Bond, 115; *Whitney v. Mowry*, 2 Bond, 45.

§ 1254. In considering the mode of operation of a machine, it is proper to regard more particularly those portions of a given part which do the real work, so as not to attach too much importance to those other portions of the same part used only as a convenient method of constructing the entire part under consideration. *Cahoon v. Ring*, 1 Cliff., 592.

§ 1255. When the inventor says in his specification "I recommend the following method," he does not thereby constitute such method a portion of his patent. *Sewell v. Jones*, 1 Otto, 171.

§ 1256. The expression "names of the months of the year" interpreted to mean the names of the months only, and not as including the name of the year. *Robertson v. Secombe Manufacturing Co.*, 10 Blatch., 481.

63. CONSTRUCTION OF REISSUE CLAIMS.

See REISSUES, CONSTRUCTION OF REISSUE CLAIMS.

64. CONSTRUCTION OF SPECIFICATIONS.

See SPECIFICATION, CONSTRUCTION OF.

65. CONSTRUCTION OF STATUTES.

See STATUTES, CONSTRUCTION OF.

66. CONSTRUCTION OF STATUTES, ASSIGNMENTS.

See ASSIGNMENTS, CONSTRUCTION OF STATUTES.

67. CONSTRUCTION OF STATUTES, REPEAL OF PATENTS.

See REPEAL OF PATENTS, CONSTRUCTION OF STATUTES.

68. CONSTRUCTION OF STATUTES, EXTENSION.

See EXTENSION, CONSTRUCTION OF STATUTES.

69. CONSTRUCTION OF STATUTES, FOREIGN PATENTS.

See FOREIGN PATENTS, CONSTRUCTION OF STATUTES.

70. CONSTRUCTION OF TECHNICAL TERMS.

See TECHNICAL TERMS.

71. CONSTRUCTIVE DISCLAIMER, EFFECT OF, IN ORIGINAL, ON A REISSUE.

See REISSUES, CONSTRUCTIVE DISCLAIMER IN ORIGINAL, EFFECT ON.

72. CONSTRUCTIVE LICENSE.

See LICENSE, CONSTRUCTIVE.

73. CONSTRUCTIVE NOTICE.

See NOTICE, CONSTRUCTIVE.

74. CONTEMPT.

See INJUNCTION, MOTION FOR CONTEMPT FOR VIOLATION.

§ 1257. At a hearing for contempt for violation of an injunction restraining defendant from use of an infringing machine, on defendant's affidavit that the machine in his shop was run by others who had leased the shop from him for hire, the court doubted whether his connection with it was such as to render him liable for its use, and exonerated him from the supposed contempt, on payment of costs. *Woodworth v. Rogers*, 3 W. & M., 135.

§ 1258. Where a party continues, in violation of an injunction, in the sale of a patented article, either in his own right, or as the agent of another, he is guilty of contempt. *Potter v. Muller*, 1 Bond, 601.

§ 1259. Where a prisoner confined for violation of an injunction was unable to secure bail, was without means and had a family, the court released him on his own recognizance. *Good-year v. Mullee*, 5 Blatch., 463.

§ 1260. Where a party acted under competent advice and did not intend to disobey the order of the court, infringement being found, no fine for contempt was imposed, but he was ordered to pay costs. *Carstaedt v. U. S. Corset Co.*, 13 Blatch., 371.

§ 1261. Motion for contempt for interference with sequestered property. *Held*, there was no contempt within section 725, Revised Statutes. *Steam Stone Cutter Co. v. Windsor Mfg. Co.*, 18 Blatch., 291.

§ 1262. On a motion for commitment for contempt for violating an injunction issued upon a patent, the question as to whether the new machine is the same as the old is a question of fact to be determined on the evidence. *Birdsell v. Hagerstown Agricultural Implement Co.*, 1 Hughes, 59.

§ 1263. Where, on motion for contempt for violating an injunction, the alleged infringing device differed from that against which the injunction was issued, *held*, that the question of infringement raised could not be determined on such a motion, and that, in view of the grant of a patent subsequently granted defendant therefor, he had a right to insist that it was not so plainly a colorable departure as to entitle plaintiff to a grant of the motion. *Onderdonk v. Fanning*, 2 Fed. Rep., 568.

§ 1264. In proceedings for an alleged wilful contempt, a clear case must be made in order to warrant the court in exercising its power in the way of summary punishment. The case should be one that admits of no substantial doubt in the mind of the court that the party has intentionally disobeyed the injunction. *Allis v. Stowell*, 19 O. G., 727.

§ 1265. While the mere fact of the defendant's advertising a machine may not constitute a violation of an injunction, such advertisement would be regarded as very strong evidence that the party was transgressing the order of the court, and would justify a complainant in applying for an order for the punishment of the defendant for contempt of court. *Ibid.*

§ 1266. A contempt of court is a specific criminal offense, and the imposition of a fine for such contempt is a judgment in a criminal case. *Fischer v. Hayes*, 20 O. G., 601.

§ 1267. The court has no power to vary such judgment after the expiration of the term at which the fine was imposed. *Ibid.*

§ 1268. The order adjudging the contempt need not recite the offense, where the latter is set forth with sufficient particularity in the affidavits and reports filed in the proceedings, and the order is connected therewith by sufficient reference. *Ibid.*

§ 1269. An order adjudging contempt for the violation of an injunction need not recite that such injunction was lawful. *Ibid.*

§ 1270. In proceedings in equity between parties to the suit for contempt in not obeying an order in the cause, the fine for such contempt can be imposed by an order made in the original suit. *Ibid.*

§ 1271. An order adjudging the contempt and setting on foot a proceeding for the purpose of ascertaining what amount of pecuniary fine should be imposed therefor, and directing on what principle and by what means it should be fixed, does not exhaust the power of the court to make a subsequent order fixing the amount of the fine and directing commitment until the same should be paid. *Ibid.*

§ 1272. Where a statute authorizes or prescribes the infliction of a fine as a punishment for a contempt of court, it is lawful for the court inflicting the fine to direct that the party stand committed until the fine is paid, although there be no specific affirmative grant of power in the statute to make such direction. *Ibid.*

§ 1273. A party having been adjudged guilty of criminal contempt in the violation of an injunction in a patent suit (6 Fed. Rep., 63), and a warrant of commitment being about to issue for the non-payment of the fine imposed, *held*, if the defendant desired to suspend the execution of the warrant until a final decree could be had and appeal taken to the supreme court, that he should give a bond, with sureties to pay the amount of said fine whenever the court should vacate the suspension, and that a reasonable time would be allowed to give such bond after the warrant was issued, during which time the execution of said warrant would be suspended. *Fischer v. Hayes*, 20 O. G., 672.

§ 1274. Form of process for carrying into effect the provision of the order in the contempt proceedings, directing that the defendant stand committed till the fine be paid, prescribed by the court. *Ibid.*

§ 1275. Motions for contempt for violation of injunctions are not granted unless the violation of the injunction is plain and free from doubt. Doubted in this case whether there is a violation. *Smith v. Halkyard*, 19 Fed. Rep., 602.

§ 1276. Motion for punishment of the defendant for a violation of the injunction granted on final hearing denied, for the reason that the device employed by the defendant is not the equivalent of the patented device. *Fetter v. Newhall*, 20 Fed. Rep., 113.

§ 1277. An adjudication that a defendant was guilty of contempt for the violation of an injunction denied, where the affidavits of defendant's officers and agents raised sufficient doubt as to such violation, which ought to be shown by clear proof. *Celluloid Mfg. Co. v. Chrolithian Collar and Cuff Co.*, 24 Fed. Rep., 585.

75. CONTINUING APPLICATION.

See APPLICATION, CONTINUING.

76. CONTRACTS.

Contracts — Particular — Territorial grant, §§ 1278-1290. See *Grantee, Territorial*, §§ 2649-2653.

§ 1278. Contract relating to right to construct a patented invention in a certain territory indefinitely defined, construed in favor of grantor. *Smith v. Selden*, 1 Blatch., 475.

§ 1279. A contract granting "the exclusive right to make, use, and vend to others to construct and use," for the full term of the patent within the limits specified, construed to license the use of the machine sold within the specified territory only, reserving the right to license the use of those sold outside such territory, and is infringed by making within the territory and selling outside. *Jenkins v. Greenwood*, 1 Boyd, 126.

§ 1280. A deed in which the grantors gave, granted, bargained and sold "unto A. one of B.'s machines, and the right to use the same, and of vending to others to be used," within a given territory, "being the same machine for which letters patent were issued," and held to be a conveyance of the machine itself, as already constructed and in existence, and of the right to use and sell the same within the prescribed territory, and not of the right to construct it. *Baldwin v. Sibley*, 1 Cliff., 150.

§ 1281. The limitations of the numbers of machines to be made or used under a patent is not consistent with the grant of an exclusive right in the patent, within a particular territory. *Washburn v. Gould*, 3 Story, 122.

§ 1282. Where W. granted to V. an exclusive right to construct, use and vend to others to construct and use, ten patented machines within a particular territory, and the grant declared that V. was to enjoy an exclusive use of the patent limited to ten machines within the territory, *held*, that the entire interest in the patent for such territory was thereby vested in V., and a subsequent grant by W. for the same territory was held void. *Ritter v. Serrell*, 2 Blatch., 379.

§ 1283. An instrument conveying a right within a given district in which, *ex vi termini*, the patentee grantor is excluded from any interest or control, is a grant of the exclusive right under the patent to use, and to grant to others to make and use, the thing patented within and throughout a specified part of the United States, and warrants a suit in the name of the grantee or assignee for an infringement within the territory named, and is required to be recorded by act of congress. *Perry v. Corning*, 7 Blatch., 195.

§ 1284. *Held*, on an agreement transferring the right to use one machine in a specified place only, the patentee assignor being paid as employee of defendants to construct the machine under the agreement, and on a further conveyance to use certain additional machines on the performance of certain conditions, that the right conferred upon the defendants, subject to the conditions of the agreement, was a right to construct and use the machines therein mentioned. *Steam Stone Cutter Co. v. Sheldon*, 10 Blatch., 1.

§ 1285. *Held*, also, that it further conferred the right to repair, and, if necessary, to rebuild the first machine made, paid for and put to use in the locality specified; that the defendants were liable for profits derived from the use elsewhere by others of the particular machine, they having consented to such use; that having procured and used the additional machines, without performance of the conditions, they were liable as infringers, nor could, by tender of such performance, avoid the right of recovery; that this, with other circumstances, was evidence of abandonment of the contract as to the additional machines, and entitled complainant, owner of patentee's interest, to an injunction as to such additional machines. *Ibid*.

§ 1286. The grant of the full and exclusive right to use and sell the invention within a limited territory, the grantor reserving a right (not the exclusive right) to make, *held*, under all the circumstances, to vest a right to make in the grantees. *Hamilton v. Kingsbury*, 15 Blatch., 64.

§ 1287. To give effect to every part of the instrument, it was ruled that the exclusive right to make within the territory was enjoyed in common by grantor and grantees. *Ibid.*

§ 1288. The fact that the government granted to the defendant the exclusive right, for a defined period of time, to lay submarine telegraphic cables and maintain thereby telegraphic communication between the state of Florida and the island of Cuba, does not confer upon the defendant the right to use, without molestation, all subsequently patented inventions in the construction of said cables. *Colgate v. International Ocean Tel. Co.*, 17 Blatch., 308.

§ 1289. A provision in the grant excluding the patentee from the privilege of laying cables in a certain locality does not confer upon such parties as have that privilege the right to use his invention. *Ibid.*

§ 1290. A deed conveying a full consent, permission and license to him, his executors, etc., to construct and use thirty machines within Wisconsin, with authority to prosecute suits, etc., with covenant not to construct within the territory ceded, is a grant recordable under act of 1838, and not a license. *Olcott v. Hawkins*, 2 Am. L. J., 317.

Contracts — Particular — Construed, §§ 1291-1328. See *Assignments. Deeds. Licenses*

§ 1291. An agreement made by the treasurer of a company is presumed to be ratified by the company acting upon and paying money under it. *Eureka Co. v. Bailey Co.*, 11 Wall., 488.

§ 1292. Where a contract recites that L. agrees to furnish M. & H. a certain device, and concludes "that the said parties mutually bind themselves and their legal representatives to the covenants and agreements therein contained, to continue in force until the full expiration of the term for which said letters patent have been granted, and during such period as the same may hereafter be renewed or extended," and L. sells to the M. & H. Co. the exclusive right to sell his improvement under his patent and reissues thereof, *held*, that the corporation were entitled to the benefit of the contract made with M. & H. *Hammond v. Mason, etc.*, *Organ Co.*, 2 Otto, 724.

§ 1293. Patentee, an officer and incorporator of a company owning his patents, under an agreement therewith to extend them, and on the payment of a certain compensation and expenses, secured such extension and reassigned the extended patents — previously assigned to him for such purpose — to the company. While legal owner of the patents he executed licenses to another, whose licensees thereunder are the defendants. *Held*, in suit by the company against defendants, that it would be inequitable to relieve patentee, or those claiming under him, from a full surrender of the property and a strict performance of the duties under his agreement for which he had been paid. *Consolidated Fruit Jar Co. v. Whitney*, 2 B. & A., 375.

§ 1294. *Held*, further, that while it was doubtful whether defendants were liable prior to actual notice of claim, that after such notice they proceeded at their peril, and decree and injunction against defendants was accordingly granted. *Ibid.*

§ 1295. A contract to convey the exclusive right to "machines invented or improved" by the inventor, etc., "for which improvements I am now preparing," etc., construed to mean all improvements then in embryo in his mind, as well as that first patented. *Nesmith v. Calvert*, 1 W. & M., 34.

§ 1296. Where the action was on a sealed covenant to pay so much for every patented article manufactured, *held*, that the covenantor could not defend his non-payment on the ground that the patent was invalid; *semble*, to be otherwise on a parol promise. Fraud or contravention of public policy may be set up as a defense. *Wilder v. Adams*, 2 W. & M., 329.

§ 1297. Where a covenant was entered into under seal, that, in consideration of a license to manufacture a patented article, a report of sales and payments *pro rata* was to be made, *held*, that it was no breach of the covenant on the part of the covenantor that the patent was invalid, provided the covenantees had sustained no damage thereby. The remedy for an invalid patent, in such a case, is to be sought on the license, where damages can be recovered. *Ibid.*

§ 1298. A stipulation as to forfeiture of a license in the event of non-payment of notes given therefor construed as a double security, and that vendor might either resort to his remedy at common law or have an injunction. *Woodworth v. Weed*, 1 Blatch., 165.

§ 1299. Where owner of interest in extended term conveyed his interest, under agreement to purchase, to certain parties, and the purchase money being partly paid, it was held to be a contract partly executed, and on their refusal to continue the payment, they were still entitled to the enjoyment of the interest, so that assignor could not reconvey it to third parties. *Gibson v. Barnard*, 1 Blatch., 388.

§ 1300. Agreement construed to be a compromise allowing defendants to manufacture under plaintiff's patent without liability for infringement, and being made by patentee, as agent for plaintiff, a party to the suit for infringement and holder of a legal interest in the patent, plaintiff was held bound thereby. *Troy Iron & Nail Factory v. Corning*, 1 Blatch., 467 (reversed).

§ 1301. An agreement of a joint holder of a patent interest, *held* to be an ordinary partnership arrangement and not void, as being in restraint of trade. *Parkhurst v. Kinsman*, 1 Blatch., 488.

§ 1302. *Held*, that a patent right having some market value, and capable, in the hands of experienced persons and in favorable circumstances, to be worked to advantage, is a consideration to support a contract, although ultimately proving unsuccessful. *Leavitt v. Connecticut Peat Co.*, 6 Blatch., 139.

§ 1303. Instrument construed to be a contract under which rights were acquired for a certain time, and not revocable as a mere power of attorney; and that the rights were such that a receipt for the use of the four machines mentioned therein was an acquittance of any claim for the same by plaintiff. *Burdell v. Denig*, 2 Otto, 716.

§ 1304. Where an inventor made several agreements on the same day, wholly disposing of his patent to a company in one of them, in another licensing the company to use his invention or improvement in connection with former patents, should the same be patented, *held*, that all should be construed together, and his assignee or purchaser protected, though the improvement was never patented and the reissued patent extended. *Hammond v. Mason, etc., Organ Co.*, 2 Otto, 724.

§ 1305. An agreement between two patentees, one of whom was an improver upon the invention of the other, concerning rights to manufacture under the respective patents, construed, and *held* violated. *Star Salt Caster Co. v. Crossman*, 4 Cliff., 568.

§ 1306. Where A. agreed that B. should manufacture under B.'s patent, which involved an infringement of A.'s patent, and that he, A., would continue to manufacture under his own patent, *held*, that A. on violating the agreement became an infringer, and that A.'s licensees, who took with knowledge of the agreement, on violating such agreement, also became infringers of B.'s patent. *Star Salt Caster Co. v. Crossman*, 3 B. & A., 281.

§ 1307. Where A. agreed with B. that, upon the fulfillment of certain conditions by B., he would assign B. the extended term of a certain patent, if extended, *held*, that the conditions being unfulfilled by B., A.'s legal and equitable ownership continued as to third parties; nor was it necessary that a decree be made without prejudice to B.'s rights. *Aiken v. Dolan*, 3 Fish., 197.

§ 1308. Where a patentee during the original term conveyed the extension and agreed to execute papers therefor, and before application for extension the full title was reconveyed to him for the purpose of securing it, without a consideration and in fraud of the patent office, *held*, that the original instrument was binding in equity on patentee, and that grantee held the equitable title to extension, and as neither party had title except through these fraudulent and inoperative conveyances, the court would leave the parties where it found them. *Prime v. Brandon Mfg. Co.*, 16 Blatch., 453.

§ 1309. An agreement made between the owners of a patent and an infringer, in which mention is alone made of the right secured by the patent set forth, though operating to estop the grantees of original patent from prosecuting such infringers, does not extend to a subsequent reissue obtained by assignees, or estop them from maintaining a suit against such parties. *Pickering v. Phillips*, 4 Cliff., 383.

§ 1310. Infringement being found as to but two of a number of patents which had collectively formed the subject of a rescinded contract fixing the same royalty rate for the use of any or of all the patented improvements, *held*, that the terms of said contract could not be applied to the condition of affairs after it had ceased to be obligatory, and that in the absence of other proofs only nominal damages could be awarded. *Bussey v. Excelsior Manuf'g Co.*, 1 McC., 161.

§ 1311. Where the defendant procured four wells to be put down, and the wells put down were driven wells, the plaintiff permitted to show by parol testimony what the contract actually was, though it was in writing and not produced. *Andrews v. Creegan*, 19 Blatch., 113.

§ 1312. Where the contract was read to the workman as a contract for constructing plaintiff's device, the testimony of the workman to that effect, in the absence of all other testimony, is conclusive. *Ibid.*

§ 1313. A contract by which one person agrees to pay a sum of money for the time, labor and skill of another for a given period gives the employer no right to an assignment of a patent that is issued to his employee for an invention made during the period of his employment. *Hapgood v. Hewitt*, 11 Fed. Rep., 422.

§ 1314. If under such a contract of employment the employer has any right to the invention, it is a mere naked license to make and sell the patented improvement as a part of its business. This right, being a mere personal one, is not transferable, and is extinguished with the dissolution of the corporation which exercised it. *Ibid.*

§ 1315. Where a contract between three parties was construed to invest two of the parties with the entire legal title of the patents, jointly, as trustees, with full power to dispose of

them at their discretion, *held*, that a subsequent assignment by one of the trustees conveyed no title to the patents; *held*, also, that by the terms of the contract there was no merger of the equitable and legal title in the trustees; *held*, also, that in the suit brought to protect the trust and to collect a debt due thereon, there was no need of joining the third party, who was represented by the trustees. *Wescott v. Wayne Agricultural Works*, 11 Fed. Rep., 298.

§ 1316. If the agreements between the parties have defined their contracts, it is out of place for an entire stranger to them to seek to circumscribe their scope by a technical limitation of the spirit and sense which the parties have impressed upon them. *Nellis v. Pennock Manufacturing Co.*, 22 O. G., 1131.

§ 1317. A contract to use, sell, etc., patented machines, construed to create an agency coupled with an interest, and held not revocable without notice. *Burdell v. Denig*, 2 Fish., 588.

§ 1318. A contract to use two machines is not broken by constructing other machines which are not used. *Burr v. Duryee*, 2 Fish., 275.

§ 1319. Where A. assigned to B. a patent right conditioned on the payment of a royalty, and on forfeiture in case of want of diligence in B., and actually received more than the value of the right, and was a stockholder in B.; and A. agreed to use reasonable diligence under penalty of the forfeiture of all rights of reversion; and on B.'s failure, C., a large stockholder, purchased the assets of B., and was sued by A. to have his right declared forfeited, *held*, that A., having failed to fulfill his part of the agreement, and having received full pay for his patent right, had forfeited his reversion. *Buckley v. Sawyer Mfg. Co.*, 2 McC., 350.

§ 1320. Where complainant had broken a mutual and reciprocal covenant with defendant relating to the conveyance of a patent-right, *held*, that although it arose from misapprehension of the agreement, he could not obtain the aid of a court of equity to restrain the other covenantor from its violation. *Clum v. Brewer*, 21 (Mo.) L. Rep., 390.

§ 1321. A contract to the effect that a patented device was to be used by defendants on their boat during the continuance of the patent, if the boat should last so long, the mode of ascertaining the compensation being set out, but no time stated when account should be rendered or payment made, and the exact sum not being stated, is one entire contract, and cannot be divided into a number of small contracts, and no right of action for any portion of the same could be supported until the patent expired. *Steam Packet Co. v. Sickles*, 10 How., 419.

§ 1322. A contract between an inventor and his assignees construed to convey such an interest in his invention that they were entitled to have the patent therefor issue in their names. *Black's Opinion*, 9 Op. 403.

§ 1323. A written instrument having imperfectly expressed the intention of the parties, but the parties having acted according to their actual agreement, and over two years having elapsed, the appellant could only have the mutual mistake in the language of the instrument corrected, and it would be inequitable to absolve him from the obligation of his contract. *Laver v. Dennett*, 25 O. G., 882.

§ 1324. Where a manufacturing company and a firm entered into a contract by which the former let out to the latter all the power, machinery, etc., of the company to be used for the manufacture of tools, and for carrying on the business of the company agreed to be done by the latter parties in co-operation with the directors, the firm agreeing to pay as rent ten per cent. of their net sales, the profits of the consolidated company to be shared in certain proportions, *held*, that the manufacturing company are not responsible for the manufacture of try-squares complained of, made by the firm for its own use in the rented premises. *Starrett v. Athol Machine Co.*, 14 Fed. Rep., 910.

§ 1325. In a contract in the usual form, promising to convey the patent of 1866 and the invention therein patented, the word invention held to include reissues and extensions, and to cover only the specified patent and no other. *United Nickel Co. v. American Nickel Plating Works*, 4 B. & A., 74.

§ 1326. Where defendant, patentee, granted plaintiff, under sealed contract, an exclusive right to sell his patented invention, *held*, that plaintiff was entitled to protection thereunder until it was set aside, and that defendant and his partner could be restrained from violating it, although they set up in defense fraud on part of plaintiff in obtaining it. *Held*, further, that remedy in equity was properly invoked, and that the contract was not a power of attorney revocable at the pleasure of the maker. *Goddard v. White*, 17 Fed. Rep., 845.

§ 1327. Where defendants under contract took certain machines in part payment for debt, plaintiff reserving right to royalty for their use until a new bargain should be made, *held*, that such stipulation was not repugnant to the grant, and that the transfer of the machines was not such as to relieve defendants from the payment of the royalty. *Porter Needle Co. v. National Needle Co.*, 17 Fed. Rep., 536.

§ 1328. Where patentee, by contract with another, sought to transfer to him an exclusive and unlimited power over patentee's claims for unliquidated damages for numerous infringements of an expired patent, with power to sue and press the claims to judgment in all courts

in patentee's name, his compensation being fifty per cent. of the gross amount collected, and patentee reserving no power to adjust, settle or discharge the claims, the contract was held to partake of champerty and maintenance, and that a court of equity would not sustain it. *Gregerson v. Imlay*, 4 Blatch., 503.

Contracts — Concerning patents, generally, §§ 1329-1338. See *Employer and Employee*, § 2096. *Jurisdiction*, §§ 3837-3863. *Patents*, §§ 4636-4639.

§ 1329. Patentee's contracts with third parties are interpreted and enforced just as other legal engagements. *Morse v. O'Reilly*, 6 Penn. L. J., 501.

§ 1330. Contracts touching the transfer, use and enjoyment of patented inventions are to be construed in the same way as contracts respecting other species of property, so as to carry into effect the intention of the parties, as collected from the language employed, the subject-matter and the surrounding circumstances. *Star Salt Caster Co. v. Crossman*, 3 B. & A., 281.

§ 1331. The grant of a patent for a limited time is not a binding and irrevocable contract with the people that on its expiration it shall become their property. The state, and in like manner congress, has a right to renew or refuse the grant. *Evans v. Eaton*, Pet. C. C., 322.

§ 1332. Where the patentee by special covenant prohibits the assignee from vending the articles beyond his own exclusive right, the remedy is on the contract and not under the patent law. *Boyd v. Brown*, 3 McL., 295.

§ 1333. A covenant for the benefit of any renewal of a patent should be construed with reference to the law at the time it was made, and does not entitle covenantee to the benefit of a renewal under a law subsequently passed. *Wilson v. Rousseau*, 4 How., 646.

§ 1334. Wherever the contract is of a character to create an interest in the patent itself, it must be shown by an instrument in writing. *Baldwin v. Sibley*, 1 Cliff., 150.

§ 1335. Where a written contract transferring an interest in a patent is not put into operation by the consent of the parties, and the grantee does not comply with any of his engagements and never claims any right thereunder, the contract passes no title. *Railroad Co. v. Trimble*, 10 Wall., 367.

§ 1336. Where the terms of a contract are based upon the undetermined action of the patent office, it must be assumed that the parties contracted in view of the probability of such action as the amendment or withdrawal of the specification. *Read v. Bowman*, 2 Wall., 591.

§ 1337. Upon a suit under section 4915, Revised Statutes, a court of equity will not aid the inventor to obtain a patent himself in direct violation of his agreement transferring the property in his invention. *Runstetler v. Atkinson*, 23 O. G., 940.

§ 1338. A contract respecting transfer of interest in a patent not further described is sustained by a transfer of its reissue. *Stanley v. Whipple*, 2 McL., 35.

Contracts — Government — Construed, §§ 1339-1343.

§ 1339. Army regulation 1002, prohibiting certain purchases and contracts by and with army officers, does not apply to contracts on behalf of the United States which require for their validity the approval of the secretary of war. *United States v. Burns*, 12 Wall., 246.

§ 1340. Although the infringing device was made by the respondents under a contract with the government, they derived no power, by virtue of their contract, to take the property of private individuals without their consent, and to use and apply the same in fulfilling their contract obligations. *Brady v. The Atlantic Works*, 4 Cliff., 408.

§ 1341. Where a contract between a patentee and the United States for the use of his invention provides that it can be determined by notice from the patentee, the United States can terminate it only by ceasing to use it, and its refusal to pay royalty; but continued use of the invention will not terminate it. *Burns' Case*, 4 Ct. Cl., 113.

§ 1342. Where claimant transmitted to the proper and responsible officer of defendants, the United States, two specimens of his invention, the receipt of which was acknowledged; and it was recommended by the advisory board for adoption, and thereupon was immediately, and without further communication with claimant, manufactured by the government; and claimant, on indirectly hearing of this, acquiesced in such manufacture, *held*, that there was an implied contract existing between them and that it was not a tortious conversion by defendant. *McKeever v. United States*, 14 Ct. Cl., 396.

§ 1343. And the measure of damages in such case is such royalty as it may reasonably be presumed the defendants would have been willing to pay and claimant to accept if the matter at the outset had gone to an express agreement. *Ibid.*

See *Contracts*, §§ 1288, 1289.

Contracts — Specific performance, §§ 1344-1351.

§ 1344. A covenant by a defendant, that he will desist from further infringement, will be enforced against him by a court of equity. *Sargent v. Larned*, 2 Curt., 340.

§ 1345. A contract to give notes for the invention of *four* improvements when patented, enforced where one patent issued covering the whole. *Read v. Bowman*, 2 Wall., 591.

§ 1346. The court will not inquire into the existence or the terms of a parol agreement between the counsel respecting the proceedings in a cause alleged, on the one hand, to have been made out of court, and denied on the other; neither will the court enforce it. *American Saddle Co. v. Hogg*, 1 Holmes, 177.

§ 1347. While the courts will not enjoin the specific performance of a contract when they can exercise no supervision over it, or when it would force upon an employer a servant personally objectionable to him, they will nevertheless restrain the parties from any action infringing the contract. *Singer M. Co. v. Union Button Hole, etc., Co.*, 1 Holmes, 253.

§ 1348. The inchoate right of an inventor to an extension of his patent may be the subject of a contract of sale, and such a contract may be enforced by a bill for specific performance. *Newell v. West*, 13 Blatch., 114.

§ 1349. A party may be restrained from selling in violation of his agreement, although it may not be possible to enforce a specific performance of it. *Goddard v. Wilde*, 17 Fed. Rep., 845.

§ 1350. Where letters patent were conveyed by patentee with certain conditions as to reconveyance on a given emergency, the court decreed the execution of such reconveyance, the emergency having arisen. *Andrews v. Fielding*, 20 Fed. Rep., 123.

§ 1351. Agreements for the assignment of a patent will be specifically enforced by a court of equity. *Hapgood v. Rosenstock*, 23 Fed. Rep., 86.

See *Injunction*, § 3264. *Jurisdiction*, § 3838.

Contracts — Violation of, § 1352.

§ 1352. There is nothing in the constitution of the United States which forbids congress to pass laws violating the obligation of contracts, although such a power is denied to the states individually. *Evans v. Eaton*, 1 Pet. C. C., 322.

Contracts — Construction of — General principles, §§ 1353-1363.

§ 1353. Grantors are chargeable with obscurity in an agreement. *Smith v. Selden*, 1 Blatch., 475.

§ 1354. Equity rule, that matter entitling a party to an amendment of his contract, may be set up in defense against its enforcement. *Woodworth v. Cook*, 2 Blatch., 151.

§ 1355. A party claiming under a contract must take it as it is. Equity can order the cancellation of a contract, but cannot alter it. *Brooks v. Stolley*, 3 McL., 523.

§ 1356. Where one party to a contract has already received a benefit from the performance of it by the other, he will be restrained from violating it, although the other is not bound by it. *Singer M. Co. v. Union Button Hole, etc., Co.*, 1 Holmes, 253.

§ 1357. A promise in the alternative puts the alternative in the election of the promisor, unless there is something to take it out of the general rule. *Foster v. Goldschmidt*, 21 Fed. Rep., 70.

§ 1358. Where a contract stipulates that an arbitration is to be a condition precedent to the right to sue upon the contract, or if this may be inferred upon construction, no suit can be maintained unless the plaintiff has made all reasonable efforts to comply with the condition. *Perkins v. United States Electric Light Co.*, 24 O. G., 204.

§ 1359. A corporation may bind itself by a contract not under its corporate seal when the law does not require the contract to be evidenced by a sealed instrument. *Gottfried v. Miller*, 14 Otto, 521.

§ 1360. Such contracts may be executed by an agent, and the rule is that the agent should in the body of the contract name the corporation as the contracting body, and sign as its agent or officer. *Ibid.*

§ 1361. In construing an instrument, all its provisions must be looked to, and undue weight must not be given to single words. *Washburn v. Gould*, 3 Story, 122.

§ 1362. Where there is doubt as to the proper construction of an instrument, the interpretation of the parties is entitled to great consideration. But where its meaning is clear in the eye of the law, the view of the parties cannot control its effect. *Railroad Co. v. Trimble*, 10 Wall., 367.

COPIES OF SPECIFICATIONS AND PATENTS—CORPORATIONS. §§ 1363–1377.

§ 1363. Where both parties have acted upon a certain construction of an ambiguous document, that construction, if in itself admissible, will be adopted by the court. *Foster v. Goldschmidt*, 21 Fed. Rep., 70.

77. COPIES OF SPECIFICATIONS AND PATENTS.

Right to copies, §§ 1364–1368.

§ 1364. Copies of specifications of a patented article may be furnished to any applicant. *Pinkney's Opinion*, 1 Op., 171.

§ 1365. A defendant in a suit has a right to a copy of the specification of plaintiff's patent for open and public production in court. *Wirt's Opinion*, 1 Op., 376.

§ 1366. Patentees, their assigns, and defendants in patent suits, should, upon demand and payment, be furnished with copies of specifications; but this privilege cannot be extended to citizens indiscriminately. *Wirt's Opinion*, 1 Op., 719.

§ 1367. Copies of papers belonging to the patent office may not be made by individuals, but by the proper officers. *Taney's Opinion*, 2 Op., 455.

§ 1368. Patents are public records, and it is the duty of the commissioner of patents to give authenticated copies to any person who shall demand the same, as soon as he conveniently can, on payment of the legal fees. *Boyden v. Burke*, 14 How., 575.

78. CORRECTION OF ERRORS.

In patents, and of the patent office, see **ERRORS**.

79. CORPORATIONS.

See **AGENT**, §§ 181–194.

Corporations—Right to own patent and sue for infringement, §§ 1369–1371.

§ 1369. *Semble*, that a corporation, incorporated to manufacture by means of an invention, can purchase the patent therefor. *Blanchard's Gun-stock Turning Factory v. Warner*, 1 Blatch., 258.

§ 1370. A Massachusetts corporation, assignees, not confined by its charter to manufacture in that state, may properly use the invention in New York. *Grover & Baker Sewing Machine Co. v. Sloat*, 2 Fish., 112.

§ 1371. A corporation may maintain a suit in the district where its rights are infringed, although it was created under the laws of a state without the district. *Elm City Co. v. Wooster*, 4 O. G., 83.

Corporations—Liability for infringement, §§ 1372–1384.

§ 1372. A corporation may be sued for infringement. *Kneass v. Schuylkill Bank*, 4 Wash., 9.

§ 1373. A corporation is liable for infringement. *Ransom v. Mayor of New York*, 1 Fish., 252.

§ 1374. A city is liable in its corporate capacity for the use by its officers of a patented invention. *Munson v. City of New York*, 18 Blatch., 237; *Allen v. City of New York*, 17 Blatch., 350.

§ 1375. For an infringement of a patent by its fire department a city is liable. *Brickill v. City of New York*, 18 Blatch., 273.

§ 1376. To render the corporation of a city liable, it is not necessary that they should have actually committed the breach in person; but if they were present, aiding and abetting the commission of the act, prompted it to be done by other persons, or, having charge of a public work like this (paving a public street), permitted their contractors to depart from the letter of the contract, and accepted the report of inspectors with approval of the work so done, they are liable for an infringement and guilty of disobedience to the writ of injunction. *Phillips v. City of Detroit*, 2 Flip., 92.

§ 1377. Where the city had no power to direct the discontinuance of the infringing use of complainant's patented seats, purchased by direction of its board of education, and no liability on the part of the city to pay for their use was created, an injunction against the city was refused. *Allen v. City of Brooklyn*, 8 Blatch., 535.

§ 1378. *Held*, that the use of complainant's seats in the public schools of the city under the direction of the board of education did not create a liability on the part of the corporation, as the latter had no power by law to direct the discontinuance of their use; and an injunction against the corporation was refused. *Ibid*.

§ 1379. A board of county commissioners are not liable in their official capacity for a tort, unless the liability is created by law, either expressly or by implication. *Jacobs v. Commissioners of Hamilton Co.*, 1 Bond, 500.

§ 1380. In Ohio the commissioners of a county are not officially liable for the violation of a patent by a contractor in building a jail. *Ibid*.

§ 1381. If a few persons form themselves into a corporation under the Missouri statute, the business of which is a necessary infringement of a patent, they cannot escape individual liability for the acts done in the corporate name. *St. Louis Stamping Co. v. Quimby*, 18 O. G., 571.

§ 1382. The defendant in this case is a proper party to account for profits, as are also its board of education and department of instruction, by whom the seats constituting the infringement were introduced into the schools. *Allen v. City of New York*, 17 Blatch., 350.

§ 1383. Where plaintiff was a corporation existing under a Pennsylvania charter, and its stock subscribed for by a Maryland corporation, and the infringing cars were the property of the latter, run over a road in which their joint capital was invested, *held*, the relations existing between them were such as to constitute plaintiff a principal co-operating with another corporation in the infliction of the wrong, and is directly responsible for damages. *York & Maryland Line Road v. Winans*, 17 How., 30.

§ 1384. Where persons are acting in concert in infringing a patent they are liable to be sued jointly therefor, although they are servants of a corporation. *Poppenhusen v. Falke*, 4 Blatch., 493.

See *License*, § 4056.

Corporations — Pleading and practice, §§ 1385-1388.

§ 1385. A corporation non-resident in the district where suit is brought may be required to give security for costs. *Lyman Ventilating & Refrigerator Co. v. Southard*, 12 Blatch., 405.

§ 1386. A defense that complainant was not a corporation must be pleaded in abatement, not in bar, and cannot be put in under the general issue, which plea admits the existence of the corporation. *Goodyear Dental Vulcanite Co. v. Wetherbee*, 3 Cliff., 555.

§ 1387. The bill of an unincorporated company should be prosecuted in the names of the individual partners, and not in the name of the company. *Metal Stamping Co. v. Crandall*, 18 O. G., 1531.

§ 1388. When a corporation is sued for infringement, and its officers are made parties, the fact that they are officers of the corporation should be averred. *Schickle v. South St. Louis Foundry Co.*, 22 Fed. Rep., 105.

See *Admissions*, § 161.

Corporations — Generally, §§ 1389-1396.

§ 1389. "Liability of individual corporators," statute 1821, construed to be remedial. *Carver v. Braintree Mfg. Co.*, 2 Story, 432.

§ 1390. A railroad company cannot transfer its corporate entity or corporate franchises without the consent of the legislature. *Emigh v. Chamberlain*, 1 Biss., 367.

§ 1391. The assignment of the revenues of a railroad, with the privilege of using the road and its property, does not convey its property to the assignee. *Ibid*.

§ 1392. The purpose of a corporation may be inferred from its corporate name alone, and where the patent relates to such purpose, the right to hold it is expressly conferred upon the corporation by the supplementary act of 1867 of the Pennsylvania statute. *Dorsey Revolving Harvester Rake Co. v. Marsh*, 6 Fish., 387.

§ 1393. Where the by-laws of a corporation require that notes payable to it shall only be transferred by the indorsement of its secretary, the indorsement of a note by the president passes no title to a person affected by notice of the law. *Leavitt v. Connecticut Peat Co.*, 6 Blatch., 139.

§ 1394. Act May 4, 1858 (11 U. S. Stat. at Large), providing that suits against a single defendant must be brought in the district in which defendant resides, does not apply to corporations. *Locomotive Engine Safety Truck Co. v. Erie R'y Co.*, 10 Blatch., 292.

§ 1395. The members of the board of public works of Detroit are bound by an injunction against the city, of which they have notice, notwithstanding they are not parties to the suit nor the writ, and the same is not actually served upon them. *Phillips v. City of Detroit*, 2 Flip., 92.

§ 1396. A foreign corporation without charter from a state, but transacting business therein and amenable to the process service of its courts in accordance with local law, is *found* within the state in the sense of the judiciary acts, and may be sued in the United States circuit court. *Williams v. Empire Transportation Co.*, 14 O. G., 523.

See *Assignment*, §§ 426, 427. *Contracts*, §§ 1359, 1360.

80. COSTS.

See DISCLAIMER, IN RELATION TO COSTS.

Costs — What taxable in patent cases, §§ 1397-1404.

§ 1397. Under act February 26 of 1853, the expense of a model of defendant's machine to show infringement is not included among taxable costs. *Parker v. Bigler*, 1 Fish., 285.

§ 1398. Models of plaintiff's invention, procured in good faith by defendants, may be included in cost taxed. Copies of patents procured by defendants cannot be so included in cost taxed. *Woodruff v. Barney*, 1 Bond, 528.

§ 1399. Plaintiff is not bound by law to produce models of his invention described in his patent, and when produced by defendant they are taxable as costs. *Hathaway v. Roach*, 2 W. & M., 63.

§ 1400. Models from the patent office of the patented invention in suit are taxable as costs. *Wooster v. Handy*, 23 Fed. Rep., 49.

§ 1401. Expense incurred in obtaining a model of the defendant's infringing machine cannot be deemed a taxable disbursement in favor of the prevailing party. *Cornelly v. Markwald*, 24 Fed. Rep., 187.

§ 1402. Sketches introduced by witnesses in giving their evidence, which are not drawings from the patent office, are not taxable as costs. *Wooster v. Handy*, 23 Fed. Rep., 49.

§ 1403. Copy of plaintiff's patent procured by defendant is not taxable as costs. Copies of his assignments, competent and proper evidence as to plaintiff's interest, are taxable. *Hathaway v. Roach*, 2 W. & M., 63.

§ 1404. Costs taxable against defendant on decree in favor of plaintiff in infringement suit. *Hussey v. Bradley*, 5 Blatch., 210.

Costs — In patent cases, generally, §§ 1405-1416. See *Disclaimer*, §§ 1991-2003. *Damages and Profits*, §§ 1499-1507.

§ 1405. The discretion of the court in awarding costs under act 1836, section 14, considered. *Merchant v. Lewis*, 1 Bond, 172.

§ 1406. A verdict for plaintiff under act 1837, section 9, finding infringement of his valid claims and rejecting others as void, does not entitle plaintiff to costs. *Peck v. Frame*, 5 Fish., 211.

§ 1407. It was not the intent of the statute, in declaring that if a patentee has claimed too much in any part of his patent he shall not recover costs, to direct that claims not in issue should be contested for the mere purpose of settling the costs. *American Bell Telephone Co. v. Spencer*, 8 Fed. Rep., 509.

§ 1408. Where the defendants infringe only one of two patents sued upon, neither party should recover costs as against the other. *Adams v. Howard*, 19 Fed. Rep., 317.

§ 1409. A decree for the complainant on only one of the two patents declared on should be without costs. *Everest v. Buffalo Lubricating Oil Co.*, 20 Fed. Rep., 848.

§ 1410. Where patent sued on was held to have been in public use and sale for more than two years prior to application for patent, the bill was dismissed, but without costs. *Sisson v. Gilbert*, 9 Blatch., 185.

§ 1411. Where defendant had been misled by complainant in a manner amounting almost to an estoppel into the belief that he was not infringing, he was not charged with costs. *Sarven v. Hall*, 11 Blatch., 295.

§ 1412. Although a bill for restraining the infringement of a patent is dismissed, the defendant will be allowed no costs if the rights of the parties are thereby settled, and a benefit consequently results to him as well as the public. *Smith v. Woodruff*, 1 MacArth., 459.

§ 1413. Where the orator has a substantial recovery on the merits for infringement, and defendant has not prevailed upon any issue upon any distinct item made in the case, on accounting for profits and damages, the costs are all to be borne by defendant. *Urner v. Kayton*, 17 Fed. Rep., 845.

§ 1414. Prior to final decree and taxation of costs, the defendants, having been adjudged infringers and decreed to account for the gains, profits and damages of their infringement, are

to bear the necessary expenses of the accounting, among which are the master's fees. *Urner v. Kayton*, 17 Fed. Rep., 539.

§ 1415. Where, on reference to master, complainant was entitled to nominal damages only, the expense of the reference was held properly adjudged against defendants, who had contested the questions of infringement, the validity of the patent and the question of damages to the utmost. *Calkins v. Bertrand*, 10 Biss., 445.

§ 1416. Objection based on section 4921, Revised Statutes, having been made to a proposed interlocutory decree because an account of the gains, profits, savings and advantages of infringement was directed instead of profits merely, and because costs were awarded to be taxed with execution to issue by it as drawn, *held*, first, the right of recovery for infringement does not wholly rest on the section cited; second, the act of 1870 enlarged the jurisdiction of courts of equity by providing that damages, in addition to profits to be accounted for, might be recovered, but this did not restrict the right to recover for gains, savings or advantages recoverable before; third, all questions as to whether the gains, savings or advantages are such as are due to the infringement, and as the defendants are legally accountable for, will arise upon the accounting; fourth, costs do not follow as a matter of right in equity proceedings as in proceedings at law, but are subject to the discretion of the court, and are to be awarded as a part of the decree, or they cannot be recovered, although they may be, and generally are, taxed after the decree; fifth, the determination of costs must ordinarily be made upon the hearing in chief; sixth, costs cannot be taxed fully, and no execution can properly issue until the final decree, but should be awarded or refused when the interlocutory decree is presented; seventh, execution cannot issue until after the final decree, and then an appeal and *superseas* seasonably taken out will stay the execution. *Coburn v. Schroeder*, 19 Blatch., 493.

Costs — Generally — Counsel fees, § 1417. *Equity rule as to*, §§ 1418-1420. *Settling costs*, § 1421. *Discretion of court of equity*, § 1422. *Taxation of docket fee*, §§ 1423-1426. *On reference to master*, §§ 1427-1431. *Generally*, §§ 1432-1437.

§ 1417. Differences of the rules controlling costs in civil and common law. Costs and counsel fees, in their relation to damages, considered. *Stimpson v. The Railroads*, 1 Wall. Jr., 164.

§ 1418. In equity, as at law, the general rule is to give costs to the prevailing party. Modifications of the equity rule. *Hovey v. Stevens*, 3 W. & M., 17.

§ 1419. Where a decree is rendered for each party on one of two issues, no costs will be allowed. *Yale & Greenleaf Mfg. Co. v. North*, 5 Blatch., 435.

§ 1420. Where neither party fully prevails, decree will be without costs to either. *Hayes v. Bickelhaupt*, 21 Fed. Rep., 567.

§ 1421. The decree will not be reviewed on appeal for the mere purpose of settling the costs. *Union Paper Bag Mch. Co. v. Nixon*, 15 Otto, 766.

§ 1422. Courts of equity have a large discretion as to costs, and frequently give them in intermediate stages of a cause, without waiting for the final decree. *Avery v. Wilson*, 20 Fed. Rep., 856.

§ 1423. The right to tax the docket fee, where the case is one of a number embraced by stipulation in a single hearing, the decree in one to stand for the decree in all, is undoubted. *Goodyear Dental Vulcanite Co. v. Osgood*, 13 O. G., 325.

§ 1424. So, too, after issue and interlocutory decree deciding the merits, if the case is finally dismissed by the court on final decree, and upon motion of the complainants, the docket fee is to be taxed. *Ibid.*

§ 1425. The docket fee is not to be taxed for an attorney unless his name has been entered on the docket before the filing of the general replication, and unless he has been admitted to the bar of some circuit court or of the supreme court of the United States. *Ibid.*

§ 1426. No docket fee whatever is given by the statute (R. S., § 824) in a suit in equity voluntarily discontinued by the complainant before any hearing, interlocutory or final. *Consolidated Bunting Apparatus Co. v. American Process Fermentation Co.*, 24 Fed. Rep., 658.

§ 1427. Taxation of costs on reference to master considered. *Doughty v. West, Bradley & Cary Mfg. Co.*, 4 Fish., 318.

§ 1428. Costs having been taxed equitably and in the manner to which both parties had consented, neither can be allowed to withdraw consent upon coming in of the master's report. *Holbrook v. Small*, 17 O. G., 55.

§ 1429. Costs allowed the plaintiff, except as to the reference of the cases to the master and all the subsequent proceedings, with decree for the party in whose favor the difference in amount of opposing costs should exist. *Ingersoll v. Musgrove*, 14 Blatch., 541.

§ 1430. Costs of reference taxed against complainant. *Kirby v. Armstrong*, 10 Biss., 135.

§ 1431. Where defendants at the outset and through their attorney offered to pay the amount of net profits realized by them (and subsequently decreed against them), and costs

have been unnecessarily accumulated, *held*, each party should pay his own costs and one-half of the master's fee. *Ford v. Kurtz*, 12 Fed. Rep., 789.

§ 1432. Attorneys' fees for the examination of witnesses called before a master, or special examiner, are not taxable as costs. *In re Strauss v. Meyer*, 22 Fed. Rep., 467.

§ 1433. Taxation of costs as to marshal's and witness' fees. *Parker v. Bigler*, 1 Fish., 285.

§ 1434. A party against whom judgment for costs has been entered is not chargeable with the mileage of witnesses who have attended without being summoned by legal process. *Woodruff v. Barney*, 1 Bond, 528.

§ 1435. Rule as to costs in injunction cases. *Hovey v. Stevens*, 3 W. & M., 17.

§ 1436. Where testimony is taken to be used in two cases, its cost should be equally divided between them. *Thayer v. Hart, Jr.*, 30 O. G., 776.

§ 1437. Where it appeared that one of the co-defendants in a suit to set aside a patent for fraud had not participated in the fraud and was a *bona fide* purchaser of an interest in the patent, which was held void for the reasons alleged, costs were not decreed against her. *United States v. Gunning*, 22 Fed. Rep., 653.

See *Corporations*, § 1386. *Damages and Profits*, §§ 1569, 1570.

81. COURTS.

As to Jurisdiction, see JURISDICTION, SUPREME AND CIRCUIT COURT OF DISTRICT OF COLUMBIA. JURISDICTION, COURT OF CLAIMS. JURISDICTION, FEDERAL COURTS. As to Rules, see RULES OF COURT.

82. CREDIBILITY OF WITNESSES.

See WITNESSES, CREDIBILITY OF.

83. CROSS-EXAMINATION.

See EVIDENCE, CROSS-EXAMINATION.

84. CUMULATIVE EVIDENCE.

See EVIDENCE, CUMULATIVE.

85. DAMAGES AND PROFITS.

See ACCOUNTING, §§ 117-139. RECOVERY, OF FULL DAMAGES AND PROFITS.

Damages — Burden of proof — *Burden of proving damages is on plaintiff*, §§ 1438-1447.

§ 1438. The burden of showing the extent of damages is on plaintiff. *Carter v. Baker*, 1 Saw., 512.

§ 1439. The burden is upon the plaintiff to establish the amount of the damages. *Buerk v. Imhaeuser*, 14 Blatch., 19.

§ 1440. Where plaintiff is allowed to recover only actual damages, he is bound to furnish evidence by which the jury may assess them. *Burdell v. Denig*, 2 Fish., 588.

§ 1441. Plaintiff must show his damages by evidence. They cannot be left to conjecture by the jury. *Phillip v. Nock*, 17 Wall., 460.

§ 1442. The burden of proof, to show the amount of damages or profits is upon the plaintiff. Where he fails to show the profits or damages arising from the use of the patented improvement, as distinguished from the profits on the entire machine, nominal damages only can be recovered. *Gould's Manuf'g Co. v. Cowing*, 12 Blatch., 243.

§ 1443. The burden is on the plaintiff to lay a basis by evidence for ascertaining the proper profits or damages, and it is not the province of the master nor of the court to suggest any specific line of proof as proper or necessary. *Garretson v. Clark*, 17 Blatch., 256.

§ 1444. In an infringement suit the burden is on the plaintiff to show the amount of damages he has suffered, and if he furnishes reasonably satisfactory evidence on that subject he is entitled to substantial damages; otherwise to nominal damages. *National Car-Brake Shoe Co. v. Terre Haute Car Manufacturing Co.*, 19 Fed. Rep., 514.

§ 1445. The law would presume damage and deprivation of profits from infringement; but there must be at least proof of the latter to make out either by it. *Wooster v. Muser*, 20 Fed. Rep., 162.

§ 1446. The plaintiff is obliged, in order to recover damages, to prove affirmatively that the defendants have employed the invention patented, and having in this case failed to do so satisfactorily, the bill was dismissed. *Rogers v. Beecher*, 3 Fed. Rep., 639.

§ 1447. The principle that plaintiff must affirmatively show, by satisfactory evidence, how much of the damage was attributable to infringement, does not mean that after proving it to have been the sufficient operative cause of the entire damage, and refuted all suggestions of contributory causes which defendant made, he must disprove all possible causes which might have existed, but which it was not suggested ever did exist. *Fitch v. Bragg & Co.*, 16 Fed. Rep., 243.

See *Damages and Profits*, §§ 1567, 1568.

Damages — Actual, §§ 1448-1462.

§ 1448. Act 1800, actual damages, reviewed and construed. *Whitney v. Emmett*, 1 Bald., 303.

§ 1449. Rule as to allowance of actual damages. *Rice v. Heald*, 13 Pac. L. R., 33.

§ 1450. Patentee is entitled to recover actual damages only for infringement of his patent in an action at law. *Carr v. Rice*, 1 Fish., 198.

§ 1451. Actual damages means damages in fact. *Goodyear v. Bishop*, 2 Fish., 154.

§ 1452. The actual damages are the profits the defendant has made. *Conover v. Rapp*, 4 Fish., 57.

§ 1453. "Actual damages" are those actually proved and sustained as contradistinguished from mere imaginary or exemplary damages. *Whittemore v. Cutter*, 1 Gall., 478.

§ 1454. The amount of actual damages must be proved, not presumed. *City of New York v. Ransom*, 23 How., 487.

§ 1455. Patentee can have only the actual damages which he has sustained by the use of the infringing machine from the date of use to the date of writ. *Hayden v. Suffolk Mfg. Co.*, 4 Fish., 86.

§ 1456. The rule in trial at law is to give the actual damage or loss incurred by reason of the infringement, and that is the profits which the plaintiffs would have made if they had not been embarrassed by the interference of the defendant's machine. *Tatham v. Le Roy*, 2 Blatch., 474.

§ 1457. The actual damage to which plaintiff is entitled is the profits he would have made, provided defendant had not interfered with his rights. *McCormick v. Seymour*, 2 Blatch., 240.

§ 1458. Where the invention was an improved article, the actual damages were determined by the difference in value between it and the old article. *Brodie v. Ophir S. M. Co.*, 5 Saw., 608.

§ 1459. Where actual damages are found, and plaintiff is not inventor, but assignee and purchaser for speculative purposes, such damages only will be given, and the court will not treble them. *Schwarzel v. Holenshade*, 2 Bond, 29.

§ 1460. The jury should find actual damages only — those directly resulting from the infringement. *Carter v. Baker*, 1 Saw., 512.

§ 1461. The jury are limited to actual damages, which the court may treble. *McCormick v. Seymour*, 3 Blatch., 209.

§ 1462. In suit for infringement of patent right, the jury may include counsel fees as part of plaintiff's actual damages. *Boston Mfg. Co. v. Fiske*, 2 Mason, 119.

See *Damages and Profits*, §§ 1539, 1541, 1545. *Jurisdiction*, § 3907.

Damages — Nominal, §§ 1463-1480.

§ 1463. Every infringement imports some damage. Nominal damages allowed, if none other be proved. *Whittemore v. Cutter*, 1 Gall., 429.

§ 1464. Damages are nominal where making only is proved. Where law gives right and remedy, violation imports damages; in the absence of other evidence, the law presumes nominal damages. *Whittemore v. Cutter*, 1 Gall., 478.

§ 1465. The mere infringement of a patent entitles patentee to nominal damages. Should he claim more he must show the extent of the damages sustained. *Campbell v. Barclay*, 5 Biss., 179.

§ 1466. The mere making of a machine, without selling or using the machine, is still an infringement, and, if nothing else was done, entitled to nominal damages only. *Carter v. Baker*, 1 Saw., 512.

§ 1467. Where parties abstained from further infringement on acquiring knowledge of patentee's right, and made but two of the infringing articles subsequent thereto, nominal damages were granted. *Boyce v. Dorr*, 3 McL., 582.

§ 1468. Where plaintiff has established no license for the separate use of device covered by each of his claims, if the patent is sustained on only one of the claims he can recover nominal damages only. *Proctor v. Brill*, 4 Fed. Rep., 415.

§ 1469. Where patentee varied his price according to the courage and ability of infringer to resist, *held*, that no fixed price or royalty was established, and nominal damages only were allowed. *Matthews v. Spangenberg*, 14 Fed. Rep., 350.

§ 1470. The scope of a patented invention having been defined, and the court having declared that the damages could not exceed the profits arising from the use of the improvement, a failure to show any such profits makes nominal damages alone recoverable. *Gould's Manufacturing Co. v. Cowing*, 14 Blatch., 315.

§ 1471. The amount of profits and damages arising under infringement being a question of fact to be satisfactorily proven, and the master having based his report upon evidence merely in the nature of estimate, opinion and conjecture, the exceptions thereto were sustained and nominal damages alone awarded. *Ingersoll v. Musgrove*, 14 Blatch., 541.

§ 1472. The complainant was found entitled to nominal damages only, the burden of proof being upon him, and it appearing that the proof was meager and indefinite, but four machines made, no established license fee, the profits made being due in part to inventions covered by other patents, and no distinction made between profits accruing from the use of complainant's invention, and that from the other inventions and manufacturers' profits. *Robertson v. Blake*, 94 U. S., 728.

§ 1473. When a complainant's patent covers but one of many features of a machine, the gains on the whole machine cannot be reckoned as damages, but only the gains arising from the use of the special device covered by complainant's patent; and where the latter showed only the profits on the entire machine, *held*, that they had not proved a reliable standard for estimating damages, and nominal damages only were decreed. *Calkins v. Bertrand*, 10 Biss., 445.

§ 1474. The sale, to be an infringement, so as to entitle orator to anything more than a mere nominal sum, must be a sale for use. *Steam Stone Cutter Co. v. Windsor Mfg. Co.*, 17 Blatch., 24.

§ 1475. Whatever distinctive profit belongs to the use of the patented improvement, the plaintiff is entitled to recover. *Schillinger v. Gunther*, 15 Blatch., 303.

§ 1476. But where the *quantum* of such profit is not shown affirmatively by license fee or otherwise, and it does not appear that the profits of infringing manufacture are wholly due to the use of the improvement, nominal damages alone can be awarded. *Ibid.*

§ 1477. Certain findings of the master accordingly overruled, the profits of manufacture not being apportioned between those arising from the general character of the pavement and those pertaining to the use of the specific improvement patented. *Ibid.*

§ 1478. Judgment for and payment of nominal damages upon a bill in equity by a patentee without joining his licensee, against one who has made and sold a machine in violation of the patent, are no bar to a bill in equity by the patentee and licensee together, for the benefit of the licensee, against another person who afterwards uses the same machine. *Birdsell v. Shaliol*, 112 U. S., 485.

§ 1479. It does not always follow that, because a party may have made an improvement and obtained a patent for it, another using the improvement will be mulcted in more than nominal damages for the infringement. If other methods in common use produce the same result with equal facility and cost, the use of the patented invention cannot add to the gains of the infringer or impair the just rewards of the inventor. The inventor may, indeed, prohibit the use or exact a license fee for it, and if such license fee has been generally paid, its amount may be taken as the criterion of damages to him when his rights are infringed. In the absence of such criterion the damages must necessarily be nominal. *Black v. Thorne*, 111 U. S., 122.

§ 1480. Although the questions may be close, still it is manifestly wrong, his invention appearing to be valuable, that a patentee should only be allowed nominal damages against an infringer. *Graham v. Geneva Lake Crawford Mfg. Co.*, 32 O. G., 1603.

See *Damages and Profits*, §§ 1442, 1444, 1569, 1570, 1660.

Damages — Punitive, §§ 1481-1487.

§ 1481. A master in chancery cannot award punitive damages, and a decree based thereon will not be sustained. *Livingston v. Woodworth*, 15 How., 546.

§ 1482. Under act 1836, the jury are confined to actual damages. The court may inflict punitive damages. *Seymour v. McCormick*, 16 How., 480.

§ 1483. Where the infringement was innocently done, damages should be compensative only; but where the infringement was of an aggravated character, vindictive damages, including counsel fees, might be allowed. *Parker v. Corbin*, 4 McL., 462.

§ 1484. Punitive damages are not to be visited upon a defendant who is not a wilful infringer, but manufactures under a patent. *Buerk v. Imhaeuser*, 14 Blatch., 19.

§ 1485. The defendants having acted in good faith, and having reason to suppose that they were protected by a patent, are not to be mulcted with punitive damages, but are simply to restore what they have made by the use of the plaintiff's property. *American Nicholson Pavement Co. v. Elizabeth City*, 6 O. G., 764.

§ 1486. If the defendants purchased and used the patented machine without knowledge of the patent, and ceased to use it on being notified of the complainants' rights, they are not liable for exemplary damages. *Emerson v. Simms*, 3 O. G., 293.

§ 1487. It is a fair ground for the mitigation of damages if the maker of the machine appeared in truth to be ignorant of the existence of the patent-right, and did not intend any infringement. *Hogg v. Emerson*, 11 How., 587.

Damages — Triple — *When allowed*, §§ 1488-1495. *When not*, §§ 1496-1498.

§ 1488. Under act 1836, the power to increase actual damages now rests in the discretion of the court, to be exercised in view of all the circumstances of the case. It should only be exercised to remunerate parties who have been driven to litigation to sustain their patents by wanton and persistent infringement. *Brodie v. Ophir S. M. Co.*, 5 Saw., 608.

§ 1489. Where the infringement was of an aggravated character, the court increased the damages found to cover the expenses of the trial and something more. *Peck v. Frame*, 9 Blatch., 194.

§ 1490. The statute authorized an increase of damages to be recovered, not of gains and profits. *Campbell v. James*, 5 B. & A., 630.

§ 1491. Where plaintiff's failure to file disclaimer until suit brought deprived him of his right to costs, *held*, that it was none the less in the discretion of the court to treble the damages or not, and that the rights of plaintiff, and the powers of the court with respect thereto under act 1836, section 14, remained as if costs had been allowed. *Guyon v. Serrell*, 1 Blatch., 244.

§ 1492. The court has a discretion to increase damages awarded by a jury, as well as to set aside a verdict for excessive damages. Act 1836, section 13. *Stimpson v. The Railroads*, 1 Wall. Jr., 164.

§ 1493. Under act 1846, the court may treble the damages awarded the patentee by the jury, and give judgment therefor. *Allen v. Blunt*, 2 W. & M., 121.

§ 1494. Damages beyond the profits made by the defendant are recoverable in a suit in equity under the act of July 8, 1870. *Carew v. The Boston Elastic Fabric Co.*, 3 Cliff., 356.

§ 1495. The court may increase such damages in excess of profits, when duly ascertained, to not exceeding treble the amount. *Ibid*.

§ 1496. A court of equity proceeds by injunction and account, and cannot treble the damages awarded complainant under act 1836, section 4. *Livingston v. Jones*, 3 Wall. Jr., 330.

§ 1497. In an action for infringement, one cent damages being found, *held*, that the recovery being less than \$500, the damages could not be trebled under act 1798, section 20. *Kneass v. Schuylkill Bank*, 4 Wash., 106.

§ 1498. Triple damages, when not allowed. Prior legislation reviewed. *Schwarzel v. Holensshade*, 2 Bond, 29.

Damages — Expenses of suit, §§ 1499-1507. See *Costs*, §§ 1397-1404.

§ 1499. The plaintiff is entitled to such damages as will establish the right, and indemnify him against all expenses of the litigation. *Alden v. Dewey*, 1 Story, 336.

§ 1500. Where the validity and infringement of the patent are established, plaintiff is entitled to such reasonable damages as shall vindicate his right and reimburse such reasonable expenses as are incurred beyond what taxable costs will repay. *Pierson v. Eagle Screw Co.*, 3 Story, 402.

§ 1501. Expenses of suit are never allowed in assessing damages, nor is interest to be computed upon the amount of profits except under peculiar circumstances. *Holbrook v. Small*, 17 O. G., 55.

§ 1502. Damages allowed patentee may include the actual costs of the suit and reasonable counsel fees. *Allen v. Blunt*, 2 W. & M., 121.

§ 1503. Counsel fees are not counted as damages. *Whittemore v. Cutter*, 1 Gall., 429.

§ 1504. Counsel fees should not be allowed in the estimation of damages by the jury. *Stimpson v. The Railroads*, 1 Wall. Jr., 164.

§ 1505. Counsel fees paid or to be paid by plaintiff are not admissible in damages. *Phillip v. Nock*, 17 Wall., 460.

§ 1506. Under act 1870, section 55, counsel fees are not recoverable as damages in suit in equity for infringement. *Bancroft v. Acton*, 7 Blatch., 505.

§ 1507. Counsel fees are not a proper element for the consideration of the jury in the estimation of damages for infringement. *Teese v. Huntingdon*, 23 How., 2.

Damages — Apportionment of, §§ 1508-1513. See *Damages and Profits*, §§ 1644-1662. *Owners, Joint*, §§ 4476-4484.

§ 1508. Where an inventor has invented only an improvement, which is violated in connection with the invention of another, or with an old machine, damages must be limited to the value of his improvement in connection with the other elements of the machine. *Burdell v. Denig*, 2 Fish., 588.

§ 1509. When the patent on which a recovery is based is for a combination, the complainant may recover simply for the value of the improvement or element that he has added to what was before old. *Ingals v. Mast*, 1 Flip., 424.

§ 1510. Damages are not the same for the infringement of an entire machine as for that of an improvement on one. *Seymour v. McCormick*, 16 How., 480.

§ 1511. The rule is settled that when the patent is for an improvement upon a machine, the damages for the infringement of such patent are confined to the profits made by the use of the improvement only, and not by the manufacture of the whole instrument. The complainants, at the accounting, proved the expenses of making and selling the infringing pumps; that they were prepared and ready to fill the orders taken by the defendants, and the prices at which the pumps were sold by the defendants, and the master took the difference between such expenses and such prices (being \$47.71 on each pump) as the measure of damages. *Held*, that as the patented invention was merely an *improvement* in pumps, being only a special construction of the side chamber, whereby the same is adapted to use with the valve-casings bolted on the outside, and constituting but a small part of the aggregate mechanism, this rule was erroneous, and that the damages could not exceed the profits upon such improvement. *Gould's Manufacturing Co. v. Cowing*, 12 Blatch., 243.

§ 1512. The patentee must in every case give evidence tending to separate or apportion the defendant's profits and the patentee's damages, between the patented and unpatented features, and such evidence must be reliable and tangible, and not conjectural or speculative; or he must show by equally reliable and satisfactory evidence, that the profits and damages are to be calculated on the whole machine, for the reason that the entire value of the whole machine as a marketable article is properly and legally attributable to such patented feature. *Garretson v. Clark*, 15 Blatch., 70.

§ 1513. Accordingly, where the plaintiff proved nothing but the profits of the finished machine, and it was not shown that these were due entirely to the presence of the patented details, nominal damages alone were awarded and the master's report awarding them sustained. *Ibid.*

Damages — Consequential, §§ 1514, 1515.

§ 1514. Remote consequential damages cannot be recovered. Only those which immediately flow from the wrongful act can be considered. *Carter v. Baker*, 1 Saw., 512.

§ 1515. The damages must be confined to the direct and immediate consequences of the infringement, and not embrace those which are both remote and conjectural. *Buerk v. Imhaeuser*, 14 Blatch., 19.

Damages — In addition to profits, §§ 1516-1519. Profits in addition to damages, § 1520. Right to damages, §§ 1521-1530. Duration of infringement, § 1531.

§ 1516. The terms *profits* and *damages* as used in the patent act are not convertible. *Good-year Dental Vulcanite Company v. Van Antwerp*, 9 O. G., 497.

§ 1517. Damages are to be awarded "*in addition*" to the former. Profits, doubtless, refer to what the *defendant* has gained by the unlawful use of the patented invention, and damages to what the *complainant* has lost. *Ibid.*

§ 1518. Plaintiff in equity may recover damages sustained by the infringement of his patent in addition to the profits to be accounted for. *Buerk v. Imhaeuser*, 14 Blatch., 19.

§ 1519. In some cases the profits may be in excess of the amount of damages, in which event only the former are to be allowed. *Ibid.*

§ 1520. In a suit in equity the plaintiff, on recovery for an infringement, may obtain the profits to be accounted for by the defendant in addition to the damages which the plaintiff has sustained by the infringement, and these profits incident to a decree in equity cannot be turned

into the license fee which would have been the remuneration in a suit at law. *Williams v. The Rome, Watertown & Ogdensburg R. Co.*, 18 Blatch., 181.

§ 1521. A patentee is entitled to damages for the use of his invention on the high seas by an American citizen on board an American vessel. *Gardiner v. Howe*, 2 Cliff., 462.

§ 1522. It is the making and selling to be used, and not the selling, or buying, or making alone, for which full damages are usually given. *Hogg v. Emerson*, 11 How., 587.

§ 1523. The infringement being of a patent for an improved chain composed of alternate closed links and open spiral links formed of one or more coils of gold tubing, the distinctive feature of the invention consisting in the construction of the open spiral links from a specified material — viz., gold tubing — the damage sustained is not the advantage derived from the use of open links or open spiral links of gold tubing over what would have ensued from the use of closed links or tubing or open spiral links of solid gold, as the two elements of utility and novelty which the new article possesses do not exist in a soldered chain of tubing, or in a chain made of split gold rings of solid wire. *Mulford v. Pearce*, 14 Blatch., 141.

§ 1524. The patented and unpatented articles are entirely distinct from each other, and the result which is found in the former cannot be obtained from the latter; therefore the principle decided in *Mowry v. Whitney* is not applicable. *Ibid.*

§ 1525. Reduction of prices and consequent loss of profits enforced by infringing competition constitute a proper ground for an award of damages. *Sargent v. Yale Lock Manufacturing Co.*, 17 Blatch., 244.

§ 1526. Damages of a compensatory character may be allowed to a complainant in an equity suit where it appears that the business of the infringer was so improvidently conducted that it did not yield any substantial profits. *Marsh v. Seymour*, 7 Otto, 349.

§ 1527. Where defendant had appropriated plaintiff's imperfect, but labor-saving machine to improve it, *held*, that damages were properly given by jury. *Gray v. James*, Pet. C. C., 476.

§ 1528. The real question now is whether the fact of the invalidity of the patent is a good answer to this action upon the contract. The defendant has had and enjoyed what was contracted for, and it is no answer to say that the same might have been had without the contract. The defendant could not both stand upon the patent and repudiate it, nor upon the plaintiff's title and repudiate that. *Milligan v. Lalance & Grosjean Manufacturing Co.*, 21 Fed. Rep., 570.

§ 1529. Where patentee assigned his patent to the United States in consideration of being solely employed to manufacture thereunder, and that on breach of such contract the assignment was to be null and void, and such breach occurred, but there was a refusal to re-assign the patent, and manufacture was continued thereunder, on suit brought to recover damages for breach of contract and failure to re-assign, *held*, that there were no damages arising by the employment by defendant of others to manufacture under the patent, as its use had been assigned, but that the damages arose out of failure to employ plaintiff under the contract, and must be found in the profits growing out of it, either as manufacturer under the contract, or royalty on the patent, but not both. *Nock's Case*, 2 Ct. Cl., 451.

§ 1530. On suit for infringement of a reissued patent the infringers are not liable for damages prior to date of reissue. *Knight v. Baltimore & Ohio R. R.*, Taney, 106.

§ 1531. Damages for the infringement of a patent are controlled by the duration of the infringement. The recovery of such damages vests no right in the infringer, and does not authorize a continuation of the infringement. *Suffolk Co. v. Hayden*, 3 Wall., 315.

Damages — Generally, §§ 1532-1538. See *Jurisdiction*, §§ 3905-3913. *Libel*, §§ 3982-3985. *New Trial*, §§ 4223-4228. *Recovery*, §§ 5213-5221. *Verdict*, §§ 6703-6706.

§ 1532. The act of congress alone gives to an inventor the right of property in the subject of his invention, and consequently an action for the infringement of such right is not a case on which damages could be recovered at common law. *Kneass v. Schuylkill Bank*, 4 Wash., 106.

§ 1533. Under the prayer for general relief the complainants in a suit in equity for the infringement of a patent may recover damages without a special prayer for them. *Emerson v. Simms*, 3 O. G., 293.

§ 1534. Although the suit is upon the contract, the damage to complainants, if any, is the damage sustained from the injury to their patent-rights. *Magic Ruffle Co. v. The Elm City Co.*, 13 Blatch., 151.

§ 1535. Damages will not be considered excessive, unless they clearly exceed what would indemnify patentee; and a verdict will not be set aside on such account unless palpably unreasonable. *Allen v. Blunt*, 2 W. & M., 121.

§ 1536. *Quære*: Whether "damages," not recoverable on plaintiff's failure to stamp his patented article in compliance with section 38, act 1870, are damages, technically considered, or include profits. *Putnam v. Ludhoff*, 1 B. & A., 198.

§ 1537. Damages for infringement must be determined from the evidence, not guessed at. *Spaulding v. Tucker*, Deady, 649.

§ 1538. Affirmative proof that defendants made no profits by the use of complainant's device, supplemented to the lack of proof by complainant as to what profits were made by the use of his device, makes no record from which it can be said any profits or damages are shown. *Calkins v. Bertrand*, 10 Biss., 445.

Damages — Measure of.

SUMMARY (*BIRDSALL v. COOLIDGE*, §§ 1539-1546) — *Actual damages at law*, § 1539. — *Damages, for what given*, § 1540. — *Compensatory damages*, § 1541. — *The patent considered*, § 1542. — *Patentee's right to sue*, § 1543. — *Measure of damages at law*, §§ 1544, 1546. — *Compensatory damages in equity*, § 1545.

BIRDSALL v. COOLIDGE.

(3 Otto, 64-71, 1876.)

ERROR to U. S. Circuit Court, District of Nevada.

§ 1539. *Rule as to assessment of damages for infringement.*

Opinion by MR. JUSTICE CLIFFORD.

Juries, in an action at law for the infringement of a patent, are required to find the actual damages sustained by the plaintiff in consequence of the unlawful acts of the defendant. Power is given to the court, in such a case, to enter judgment for any sum above the amount of the verdict, not exceeding three times the amount of the same, together with costs; but the jury are strictly limited in their finding to the actual damages which the plaintiff has sustained by the infringement. 16 Stat., 207; 5 id., 123; R. S., sec. 4914, p. 960.

§ 1540. *Damages are given as a compensation, recompense or satisfaction to the plaintiff for an injury actually received by him from the defendant.*

§ 1541. *Compensatory damages and actual damages mean the same thing.*

Damages are given as a compensation, recompense or satisfaction to the plaintiff for an injury actually received by him from the defendant. Compensatory damages and actual damages mean the same thing; that is, that the damages shall be the result of the injury alleged and proved, and that the amount awarded shall be precisely commensurate with the injury suffered, neither more nor less, whether the injury be to the person or estate of the complaining party. 2 Greenl. Ev. (10th ed.), sec. 253.

STATEMENT OF FACTS.—Improvements in machines for amalgamating gold and silver were made by Zenas Wheeler, then in full life, for which he received letters patent in due form of law. Sufficient also appears to show that the patentee subsequently — to wit, on the 15th of August, 1869 — departed this life; that, at the time of his death, he was a resident of San Francisco, in the state of California, and that he left a last will and testament, duly executed, as required by the laws of that state; that he gave, devised and bequeathed to the plaintiff all and singular his property, real and personal, wheresoever situated, including all debts owing to him, and all moneys belonging to him of which he might die seized and possessed, in trust for certain uses and purposes therein specifically set forth and described, leaving his patent-rights, machinery, and certain other specified interests, in the hands of his executor to be managed, controlled, improved, changed or disposed of as his executor may in his judgment deem best for the interests of the estate. Due probate of the will has since been made, and letters testamentary have been duly granted to the plaintiff, as sole executor of the deceased patentee.

Pursuant to the power vested in the plaintiff as such executor, he instituted the present suit, in which he alleges that the deceased testator was the original and first inventor of the improvement described in the patent, and that the defendants, though well knowing the premises, and in order to deprive the plaintiff of the gains and profits of the same, have, without license from the testator in his life-time, or from the plaintiff since the decease of the testator, used and caused to be used twenty amalgamating machines, embracing substantially the same improvement, in violation and infringement of the exclusive right secured by the said letters patent.

Service was made; and the defendants appeared and pleaded the general issue, and gave notice of certain special defenses, as follows: 1. That the testator in his life-time executed a license to J. Booth & Co., to manufacture the patented machine, and that the defendants purchased the machines they use of the licensees. 2. That the patented improvement has been openly and universally used by the public since the patent was granted. 3. That the curved grooves in the face of the muller and in the bottom of the pan had been previously patented to the respective parties named in the notice of special matter. 4. That the patentee was not the original and first inventor of the improvement. 5. That the curved grooves in the face of the muller and bottom of the pan were in public use more than two years before the alleged inventor made application for a patent. 6. That the patented improvements were described in the printed publications mentioned in the notice of special matter.

§ 1542. *Patent No. 40,874, Z. Wheeler, December 8, 1863, amalgamator, considered.*

Reference to the specification will show that the patented improvement is called a new and improved gold and silver amalgamator and pulverizer, and that the object of the invention, as stated by the patentee, is to obtain a device of simple construction, which will cause a thorough incorporation of the quicksilver with the pulp containing the metal, so as to insure a perfect amalgamation of the latter. Mechanically considered, the invention consists in the arrangement of spiral ribs on the periphery of the rotary muller, and spiral ribs reversed on the inner side of the pan, to operate in connection with curved grooves on the face or under side of the muller, and curved grooves reversed in the bottom of the pan for the purpose explained.

These explanations are the same as those given in the specification; and the patentee also states that the invention consists in the manner of connecting the muller to its shaft by a universal joint, so as to insure its parallelism with the bottom of the pan, and in the employment or use of curved plates, which are placed in the pan just above the muller, and arranged in such a manner as to be capable of being adjusted higher or lower, as set forth in the specification.

Two of the claims of the patent — to wit, the first and second — are omitted, as the plaintiff admits that those claims have not been infringed by the defendants. What he charges is, that they have infringed the third claim, which is as follows: "In combination with the muller and pan, the curved plates supported at their outer ends on slides, and at their inner ends in a frame, which is supported on the upper end of the shaft in such a manner that the plates will follow any adjustment of the muller, and thus bear the same relation to it whether in its highest or lowest working position."

Viewed in the light of these suggestions, it is clear that the charge of

infringement has respect chiefly to the curved plates supported, as explained, when used in combination with the muller and pan.

Subsequently the parties went to trial; and the verdict and judgment were for the plaintiff, in the sum of \$2,266.66, with costs of suit. Exceptions were duly filed by the defendants, and they sued out the present writ of error. By the bill of exceptions it appears that the plaintiff introduced his patent in evidence, together with a model of the patented machine for amalgamating gold and silver, and gave testimony tending to show that the defendants purchased twenty amalgamating pans, which contained wings or curved plates of iron twelve inches wide and fourteen inches long, fastened at one end to the inner side of the rim of the pans in a vertical position, in such a manner that they could be raised or depressed by sliding up or down in a groove or fastening, and could be adjusted at different heights, and extending lengthways towards the center of the pans, which were a little more than four feet in diameter.

Wings of the kind, however, were used in only sixteen of the pans for a few weeks after the defendants commenced to use the pans for amalgamating purposes; and the defendants testified that the wings were useless, and even detrimental, for working over old tailings, which was the work on which they were engaged, for the reason that such material does not require further grinding or pulverization; that, finding the wings useless or detrimental, they took them out of the sixteen pans, and sold them for old iron. They also gave evidence tending to show that, when they used the mill as a quartz-mill, they used the wings in sixteen only of the pans, but that when they commenced to work what are called "tailings," they took out the wings, because they found them to be detrimental or useless; and the bill of exceptions also states that the defendants took the wings out of four of the pans before they used them at all, and only used the wings in some of the other pans for a short time, and that they did not use any of them more than six weeks; which is all the evidence introduced to show the extent of the infringement.

Wide differences of opinion existed between the parties as to the rule of damages in such a case; and, to aid in the solution of that question, the plaintiff introduced testimony tending to show that the decedent in his life-time allowed manufacturers to make and sell the invention for a royalty of \$100 for a machine containing only the same combination as that used by the defendants, and proved that he, the plaintiff, had sold royalties to a large amount at the same rate. Questions of various kinds, other than those relating to the measure of damages, are also presented in the bill of exceptions; but the court here, in the view taken of the case, do not find it necessary to decide any other in this investigation.

Instructions as to the measure of damages were given by the court to the jury, in substance and effect as follows: That when a person, without license, appropriates the patented invention of another, the measure of damages, if a royalty has been established, is the regular royalty paid by purchasers and licensees; that, if the jury find for the plaintiff, the damages will be the royalty which the plaintiff established for that part of the invention used by the defendants; that, if the royalty paid for that part of the invention is \$100, then the jury will allow \$100 *on each pan* used by the defendants, and interest on that sum, at ten per cent. per annum, for the time of the appropriation, which is the rate of interest allowed in that state. Under those instructions the jury returned a verdict for the plaintiff in the sum of \$2,266.66, as appears by the record. Seasonable exception was taken to the instruction by the de-

defendants, and that instruction presents the only question which the court deems it necessary to decide in disposing of the case.

§ 1543. *A patentee may sue for infringement either in equity or at law.*

Controversies and cases arising under the patent laws are originally cognizable, as well in equity as at law, by the circuit courts, or by any district court having circuit powers. Prior to the passage of the act of the 8th of July, 1870, two remedies were open to the owner of a patent whose rights had been infringed, and he had his election between the two: he might proceed in equity and recover the gains and profits which the infringer had made by the unlawful use of his invention, the infringer in such a suit being regarded as the trustee of the owner of the patent as respects such gains and profits; or the owner of the patent might sue at law, in which case he would be entitled to recover, as damages, compensation for the pecuniary injury he suffered by the infringement, without regard to the question whether the defendant had gained or lost by his unlawful acts,—the measure of damages in such case being not what the defendant had gained, but what the plaintiff had lost. Curtis on Pat. (4th ed.), 461; 5 Stat., 123.

§ 1544. *Measure of damages at law in patent cases.*

Where the suit is at law, the measure of damages remains unchanged to the present time, the rule still being, that the verdict of the jury must be for the *actual* damages sustained by the plaintiff, subject to the right of the court to enter judgment thereon for any sum above the verdict, not exceeding three times that amount, together with costs. 16 Stat., 207.

§ 1545. *Compensatory damages in equity in patent cases.*

Damages of a compensatory character may also be allowed to the complainant suing in equity, in certain cases, where the gains and profits made by the respondent are clearly not sufficient to compensate the complainant for the injury sustained by the unlawful violation of the exclusive right secured to him by the patent. Gains and profits are still the proper measure of damages in equity suits, except in cases where the injury sustained by the infringement is plainly greater than the aggregate of what was made by the respondent; in which event the provision is, that the complainant "shall be entitled to recover, in addition to the profits to be accounted for by the respondent, the damages he has sustained thereby."

Cases occurred under the prior patent act where manifest injustice was done to the complainant in equity suits, by withholding from him a just compensation for the injury he sustained by the unlawful invasion of his exclusive rights, even when the final decree gave him all that the law allowed. Examples of the kind may be mentioned where the business of the infringer was so improvidently conducted that it did not yield any substantial profits, and cases where the products of the patented improvements were sold greatly below their just and market value, in order to compel the owner of the patent, his assignees and licensees, to abandon the manufacture of the patented product.

Courts could not, under that act, augment the allowance made by the final decree, as in the case of the verdict of a jury; but the present patent act provides that the court shall have the same powers to increase the decree, in its discretion, that are given by the act to increase the damages found by verdicts in actions at law. Such difficulties could never arise in an action at law, nor can it now, as both the prior and the present patent act authorize the court to enter judgment on the verdict of the jury for any sum above the verdict, not exceeding three times that amount. No discretion is vested in the jury; but

they are required to find the *actual damages*, under proper instructions from the court.

Still, it is obvious that there cannot be any one rule of damages prescribed which will apply in all cases, even where it is conceded that the finding must be limited to actual damages. Frequent cases arise where proof of an established royalty furnishes a pretty safe guide both for the instructions of the court and the finding of the jury. Reported cases of undoubted authority may be referred to which support that proposition; and yet it is believed to be good law, that the rule cannot be applied without qualification, where the patented improvement has been used only to a limited extent and for a short time, but that in such a case the jury should find less than the amount of the license fee; and it is admitted in several cases that the circumstances may be such that the finding should be larger than the royalty. *Seymour v. McCormick*, 16 How., 490; *Livingston v. Woodworth*, 15 id., 560; *Dean v. Mason*, 20 id., 203; *Curtis on Pat.* (4th ed.), 459.

§ 1546. *Rule as to measure of damages in patent cases.*

Evidence of an established royalty will undoubtedly furnish the true measure of damages in an action at law, where the unlawful acts consist in making and selling the patented improvement, or in the extensive and protracted use of the same, without palliation or excuse; but where the use is a limited one, and for a brief period, as in the case before the court, it is error to apply that rule arbitrarily and without any qualification. *Packet Co. v. Sickles*, 19 Wall., 617; *Burdell v. Denig*, 92 U. S., 716; *Suffolk Co. v. Hayden*, 3 Wall., 320.

Four of the pans in this case were used throughout without wings, and wings in most of the others were used only for a short time, and in none of the pans for more than six weeks. Under these circumstances, it was error to charge the jury that, if they found any damages, they must find the amount of the royalty for each pan so used, as that was instructing the jury in effect that they must find \$100 for each pan, which is plainly more than the actual damages proved by the evidence. Actual damage is the statute rule; and, whenever the royalty plainly exceeds the rule prescribed by the patent act, the finding should be reduced to the statute rule. Judgment reversed, and cause remanded with directions to issue a venire *de novo*.

Damages — Measure of — Profits, §§ 1547-1573. See *Use*, § 6383.

§ 1547. Profits as a measure of damages (act 1800) considered. *Whitney v. Emmett*, 1 Bald., 303.

§ 1548. Rule of damages (act 1793) allows the actual profits received by defendants to be trebled. *Lowell v. Lewis*, 1 Mason, 182.

§ 1549. The rule on the question of damages is to give the actual damages, which will be the ordinary profits the patentee derives from the sale of his invention. *Buck v. Hermance*, 1 Blatch., 398.

§ 1550. The measure of damages is the profits made, not what might have been made. *Dean v. Mason*, 20 How., 198.

§ 1551. The general rule of damages is the amount of profits made by the person infringing the patent from the unlawful use of the improvement. *Wayne v. Holmes*, 1 Bond, 27.

§ 1552. Where ascertainable, the defendant's profits are the measure of damages. *Hays v. Sulzor*, 1 Bond, 279.

§ 1553. There is no unbending or unyielding rule of damages; the usual rule allows plaintiff, as damages, the profits defendants have actually derived from the use of his improvement, not what they might have realized, or made from the use of improvements other than his. *Bell v. Daniels*, 1 Bond, 212.

§ 1554. Plaintiff is entitled to all actual profits which defendant has made by use of the principle of plaintiff's combination. *Data* that may be considered in estimating damages. *Wilbur v. Beecher*, 2 Blatch., 132.

§ 1555. Where the right granted plaintiff as to all territory outside of that described in the contract as granted defendant was the naked right to construct the machine, with right to sell but not to license for use, the rule of damages must be defendant's actual profit from the manufacture of the machine within defendant's territory and sold in plaintiff's, excluding any profit as patentee. *Jenkins v. Greenwald*, 1 Bond, 126.

§ 1556. The rule of damages is the profits which have been derived to the defendants by using the patented machine over any other mode defendants had a right to adopt. *Serrell v. Collins*, 1 Fish., 289.

§ 1557. The infringer of a patented process is not liable for the entire profits of the manufacture in which it was used, but only for what he has made by using the patented process over and above what he would have made by the use of other processes open to the public. *Mowry v. Whitney*, 14 Wall., 620 (§§ 5036-45).

§ 1558. For measure of damages the proper rule to apply is what amount of profit the infringer makes or ought to have made, and not what plaintiff can show he might have made. This rule applies mainly to cases in equity, where infringer is treated as a trustee and must so account. But at law, where licenses of machines or established royalties are concerned, their value constitutes the measure of damages. *Burdell v. Denig*, 2 Otto, 716.

§ 1559. Where the infringement was free from aggravating circumstances, and made under the belief that the infringers were protected by a patent, the measure of damages was held to be the profits realized after deduction of all expenses in carrying on their operations. *Pitts v. Edmonds*, 1 Biss., 168.

§ 1560. Where on reference to master the rule as to profits in *Mowry v. Whitney*, 14 Wall., 620, was followed, and no profits in using the infringing device was shown over those open to the public, *held*, that the master was right in allowing none; that the case was one for damages only,—that plaintiff's established royalty was the proper measure. *Locomotive Safety Truck Co. v. P. R. Co.*, 2 Fed. Rep., 677. See § 1557.

§ 1561. If the patentee is engaged in manufacturing the patented article for sale, his damages will be manufacturer's profits. *Westlake v. Carter*, 4 O. G., 636.

§ 1562. If the patentee has been ready to supply the market, and the defendant by his infringements has diminished his sales, the damages will be the profits the plaintiff has consequently failed to receive. *McComb v. Brodie*, 1 Woods, 155.

§ 1563. The measure of damages for infringement of a patent is the profits that the plaintiffs would have made on the sales of the patented article had they supplied the customers to whom the defendants sold such article. *Zane v. Peck Brothers & Co.*, 23 O. G., 191.

§ 1564. In estimating the amount of such profits the cost of manufacture and sale should be deducted, and on sales of a large amount clerks' hire, storage, freight, etc., should be considered as part of such cost; but in this case, as these expenses would make only a trifling difference in amount awarded by master, a reaccounting will not be ordered. *Ibid.*

§ 1565. In this case motion of plaintiffs for treble damages should be denied. *Ibid.*

§ 1566. The amount of profits on a manufactured article is not always the rule of damages for an infringement. The court should endeavor to ascertain the damages which resulted to the plaintiff by the unauthorized use of his invention. *Magic Ruffle Co. v. Elm City Co.*, 14 Blatch., 109 (EQUITY, §§ 1171-75).

§ 1567. It is no compliance with the requirement of the court that the profits arising from the use shall be proven to show that, wherever the particular patented improvement was introduced, other kindred devices could not be sold. *Gould's Manufacturing Co. v. Cowing*, 14 Blatch., 315.

§ 1568. The report of the master which gave to such showing the erroneous effect of proof of profit arising from the use and estimated damages accordingly was consequently overruled. *Ibid.*

§ 1569. Where a bill is taken *pro confesso* and the case referred to a master to ascertain the complainant's damages and the defendants' profits arising from infringement of a patent, and the complainants fail to make satisfactory proof thereof before the master, he can report only nominal damages against the defendants. *Fisk v. West, Bradley & Cary Manufacturing Co.*, 19 O. G., 545.

§ 1570. In such case, if the complainants except to the master's report, and their exceptions are overruled by the court, they will be allowed costs to and including the interlocutory decree; but the defendants will be allowed costs thereafter, the one to be set off against the other to the extent of its amount and the excess to be recovered of the party against whom it exists. *Ibid.*

§ 1571. Where complainant, who had facilities to supply the entire market, derived his profits solely from the manufacture and sale of bottle-stoppers, one feature of which was covered by his patent, and the defendant, instead of buying from him, made his own fasteners in complete imitation of the patented device, damages were allowed to the amount of defendant's profits on the complete stopper. *Putnam v. Lomax*, 10 Biss., 546.

§ 1572. Where there is a limited and local demand for a patented device which is the only one salable for a particular purpose, and the patentees consequently have control of the market, the measure of damages for infringement is all the profits made by the infringers upon their entire sales. *Gould's Manufacturing Company v. Cowing*, 105 U. S., 253.

§ 1573. Where plaintiffs would have had a monopoly of the market but for the fact that defendants, who had previously bought from them, imported the article from abroad, and sold at a lower price, yet at a loss to defendants, *held*, that, on estimating damages, the measure should be the profits plaintiffs would have made on the trade diverted by defendants; and as complainants' sales fell off to the extent of defendants' former purchases, they were entitled to the profits that would have accrued on such sales. *Hall v. Stern*, 20 Fed. Rep., 788.

Damages — Measure of — *License fee*, §§ 1574-1594. *Royalty*, §§ 1595-1598. See *Royalty and License Fee*, §§ 5882-5891.

§ 1574. Rules for damages in patent cases with respect to license fees and infringer's profits stated. *Livingston v. Jones*, 3 Wall. Jr., 330.

§ 1575. Where proof shows no close monopoly in plaintiff, the license fee is the proper measure of damages, which plaintiff must prove. *Burdell v. Denig*, 2 Fish., 588.

§ 1576. Where a patent fee has been established, it, with the interest, constitutes the measure of damages; in its absence, it is the profits of the infringer taking into view the loss or injury sustained by reason of the infringement. *Sickles v. Borden*, 3 Blatch., 535.

§ 1577. The market value of licenses to use a patent forms the measure of damages in claims for infringement. *Packet Co. v. Sickles*, 19 Wall., 611.

§ 1578. That which constitutes the license fee or its equivalent, where patentee makes and sells his invention, is that which he is entitled to recover as damages against an infringer, and in ordinary cases it is this only. *Buerk v. Imhaeuser*, 14 Blatch., 19.

§ 1579. If the owner of a patent has an established fee for a license to work under it, that constitutes the proper measure of damages to be recovered by him for infringing it. *Emerson v. Simm*, 3 O. G., 293.

§ 1580. The amount of license fee fixed by the complainant is usually considered a proper compensation in damages, except in those cases where the evidence warrants an allowance of exemplary or punitive damages, by reason of a wanton infringement. *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 9 O. G., 497.

§ 1581. In the absence of other evidence of damages, it was computed from the license fee for a device for a similar purpose, which defendants had substituted in lieu of plaintiff's device, as used by them before. *Sargent v. Yale Lock Mfg. Co.*, 17 Blatch., 249.

§ 1582. The usual license fee exacted for the use of a patented invention is a proper measure for the damages sustained by its unlawful use. *Canan v. Pound Mfg. Co.*, 23 Fed. Rep., 185.

§ 1583. Where an exclusive license is sold at a certain price, in addition to a royalty on the articles manufactured thereunder, the cost of the license may be considered, as well as the royalty, in estimating damages for infringement. *Goodyear v. Bishop*, 2 Fish., 154.

§ 1584. The measure of damages being the market value of a license to use in the case of an infringer without license, it should not be harsher where used by a party with owner's expressed or implied consent, but without agreement as to compensation. *Packet Co. v. Sickles*, 19 Wall., 611.

§ 1585. While an established license fee may be the measure of damages against an infringer, in favor of a patentee, the rule cannot be applied without qualification, and where the use has been a limited one, it is erroneous to charge the infringer with the whole fee. *Wooster v. Simonson*, 16 Fed. Rep., 680.

§ 1586. Where the patentee makes his patent available exclusively by the sale of licenses for its use at a fixed sum, such license fee furnishes the just measure of his damages in case of the unlicensed use of his invention. *Seymour v. McCormick*, 16 How., 489; *Sickles v. Borden*, 3 Blatch., 536; *Emerson v. Simm*, 6 Fish., 281; *Star Salt Caster Co. v. Crossman*, 4 Ban. & Ard., 566; *Stulz v. Armstrong*, 25 Fed. Rep., 147.

§ 1587. Where a patentee does not desire to retain a close monopoly of his invention, the amount of the license fee which he has fixed in his dealings with other parties may be considered a proper compensation in damages where the character of the infringement does not justify exemplary damages. *Graham v. Geneva Lake Crawford Mfg. Co.*, 32 O. G., 1603.

§ 1588. On the question of damages it is competent for a patentee to prove the prices at which licenses were granted under the patent while it was in force; but in order to be competent evidence of value the prices agreed upon must have been prices fixed with regard to the future use, when, there being no liability between the parties, they are presumed on both sides to have acted voluntarily, and therefore to have made up their minds deliberately as to what was a fair price. Such arrangements, licenses thus granted, fees thus fixed, are competent evi-

dence to consider in determining what the actual value of an invention is and what the recovery ought to be for its use. *National Car-Brake Shoe Co. v. Terre Haute Car & Mfg. Co.*, 19 Fed. Rep., 514.

§ 1589. It is not competent for a patentee to prove the prices paid for infringements already perpetrated. Such settlements are not at all admissible on the subject of value. *Ibid.*

§ 1590. Where the infringement of the patented machine was deliberate and without excuse, the infringer was held justly chargeable with the full established license fee for the use of two machines for three years and of four machines for eighteen months only. *Stulz v. Armstrong*, 25 Fed. Rep., 147.

§ 1591. When the sale of licenses by the patentee has been sufficient to establish a price for such licenses, that price should be the measure of his damages against an infringer; but a royalty or license fee, to be binding on a stranger to the licenses which established it, must be uniform. *Westcott v. Rude*, 19 Fed. Rep., 830.

§ 1592. There is no question but that the amount of an established license fee for the use of a patented invention is what the patentee loses by the use of the invention in violation of the patent without license, and a proper measure of damages for such infringement. *Wooster v. Simonson*, 20 Fed. Rep., 316.

§ 1593. A transfer by the owners of their entire interest in a patent, to be paid for by a certain royalty, is not the establishment of the ordinary license fee. It cannot be invoked as a safe criterion of measure of complainant's damages unless evidence is offered showing that licensees of complainant were deprived of the sale of the number of machines which defendants made and sold. *La Baw v. Hawkins*, 2 B. & A., 561.

§ 1594. The established license fee for the use of the entire invention secured by the six claims of the patent is not the correct measure of damages where the defendant has not infringed all the claims; and where less than the whole invention is infringed, evidence must be given to show the nature of the part appropriated. *Wooster v. Simonson*, 16 Fed. Rep., 680.

§ 1595. If a territorial assignee has agreed with the owners of a patent that he would license others, for a stipulated royalty, to use the invention where he was prevented from it by municipal regulations, he is not to be restricted by the amount of such royalty in estimating the damages he should recover from infringers, if through their management the regulations were made which prevented his doing the work. *American Nicholson Pavement Co. v. Elizabeth City*, 6 O. G., 764.

§ 1596. Where a territorial assignee had agreed with the owners of a patent that he would license others for a stipulated royalty to lay down the pavement embraced in the patent in any place where he was prevented from laying it himself, either by judicial decisions or because the law required the work to be let to the highest bidder, *held*, that his being prevented by a law giving the adjacent property owners the right to select the pavement did not come within the terms of the agreement, and that the stipulated royalty formed no criterion for estimating the damages to be recovered for laying the plaintiff's pavement in the place. *Ibid.*

§ 1597. If patentees have been accustomed to grant licenses for the use of their invention, the royalty they have required will be a criterion for estimating the damages they should recover in a suit for infringements. *Ibid.*

§ 1598. While an established royalty furnishes a safe rule of damages for the court and jury in many cases, this rule cannot be applied without qualification where the patented improvement has been used only to a limited extent and for a short period of time. Where there is proof of an established license fee, it may, in case of a protracted infringement, be regarded as a safe guide; but in other cases general evidence may be resorted to as a basis for the estimate of damages. *Judson v. Bradford*, 16 O. G., 171.

See *Use*, § 6386.

Damages — Measure of — Rule of damages, §§ 1599-1607. Estimation of, §§ 1608-1630.

§ 1599. Estimation of damages at law. Rule stated. *Cowing v. Rumsey*, 8 Blatch., 36.

§ 1600. Rule stated for ascertaining the measure of damages for infringement of a patent. *City of New York v. Ransom*, 23 How., 487.

§ 1601. Measure of damages — considerations which govern it. *Campbell v. Barclay*, 5 Biss., 179.

§ 1602. There can be no general rule for estimating damages or profits. *Graham v. Mason*, 1 Holmes, 88.

§ 1603. No general rule of damages in patent cases can be stated. The profits of the infringer, or the price of a license, may afford a rule. *Seymour v. McCormick*, 16 How., 480.

§ 1604. Rule of damages. The value of use of machine during illegal use. *Whittemore v. Cutter*, 1 Gall., 478.

§ 1605. The rule of damages is: When an infringement is made out, to give to plaintiff his actual losses and no more. *Hall v. Wiles*, 2 Blatch., 194.

§ 1606. Rule of damages is to allow actual as distinguished from punitive damages. *Pitts v. Hall*, 2 Blatch., 229.

§ 1607. Measure of damages where the patent covers an entire machine or an improvement thereon is the same (reversed). *McCormick v. Seymour*, 2 Blatch., 240.

§ 1608. The question of damages is this: The benefits and advantages, whatever they may be, if there are any, derived in the use of plaintiff's improvement over the old modes practiced and in use. *Smith v. Higgins*, 1 Fish., 537.

§ 1609. In an action for infringing a patent the damages are not to be estimated according to what the defendant has made or might have made, but according to what the plaintiff has lost. *McComb v. Brodie*, 1 Woods, 153.

§ 1610. Measure of damages determined by taking the difference between cost of manufacture and the price at which the infringing article was sold, *held* properly ascertained. *American Saw Co. v. Emerson*, 8 Fed. Rep., 806.

§ 1611. The price of the machine, the actual state and extent of use of the invention, and the particular losses to which plaintiff may have been subjected by the infringement, are all proper ingredients to be weighed by a jury in estimating damages. *Earle v. Sawyer*, 4 Mason, 1.

§ 1612. Measure of damages where licenses are granted is the license fee; where exclusive use is retained and product sold, it is, in the case of a whole machine, the profits made by constructing and vending over and above the mere profits arising out of its manufacture, and in the case of an improvement, all the advantages of its use excluding the profits of manufacture and the value of the old machine. *McCormick v. Seymour*, 3 Blatch., 209.

§ 1613. It is no true measure of damages that the machine, as improved, commands a virtual monopoly of the market. Other circumstances quite aside from the value of the added improvements may tend to give them a fictitious importance. *Garretson v. Clark*, 15 Blatch., 70.

§ 1614. Gains and profits are the proper measure of damages in equity suits for the infringement of patents, except in certain cases where the injuries sustained by the complainant plainly exceed the profits realized by the respondent; as, for example, when the business of the infringer is unremunerative, because improvidently conducted, or when the products of the patented improvement are sold by the infringers greatly below their just market value, in order to compel the owner of the patent, his assignees or licensees, to abandon the manufacture of the patented product. *Brady v. The Atlantic Works*, 15 O. G., 965.

§ 1615. In an action or proceeding for the money the measure of damages would be the amount of money received, not the amount of damages done, and all right of recovery beyond that would be waived. This is the effect of waiving the tort. The recovery of satisfaction in either form would pass the right to that for which satisfaction was had, and there could be no damages beyond. Consequently, when the plaintiff has recovered and received satisfaction for the tort committed, the title to so much of his property as was wrongfully converted will have passed by the sale and conversion, and no damages will accrue to him on account of further use of that property. *Steam Stone Cutter Co. v. Sheldons*, 15 Fed. Rep., 608.

§ 1616. Estimate of damages for infringing use of a water wheel. *Parker v. Bamker*, 6 McL., 631.

§ 1617. Where the patented article was the tongue of a snap-hook, and the master, in his estimate of damages, considered the enforced reduction on the entire article, an exception thereto was overruled on the ground that the essential and necessary feature of the entire structure was the patented device, by which he was enabled to make his profit on the entire structure, of which profit he was deprived by defendant's low price, after allowing a proper sum for any other patented device contained in defendant's structure and other causes which gave defendant advantage in his sales. *Fitch v. Bragg & Co.*, 16 Fed. Rep., 243.

§ 1618. Where a patentee of a "turning-bolt," which is not marketable except when embodied in a lock, is compelled to sell his locks, of which the patented device is an essential feature, at a reduced price, by the acts of an infringer, who sells, at low prices, locks embracing, as an essential element, the patented device, the infringement must be held to have occasioned the entire loss resulting to the plaintiff from the reduction of prices, after making proper allowance for any other patented device contained in the defendant's locks and for any other causes which may have given the defendant an advantage in the sale of his locks. *Sargent v. Yale Lock Mfg. Co.*, 17 Blatch., 244.

§ 1619. Where, on reference under a joint resolution of congress to determine whether claimant was first and original inventor of three patented inventions, and whether he was entitled to compensation and to recover therefor, the total amount being limited, *held*, that the validity of the patents being sustained, he was entitled to recover; but the ordinary rule of damages did not apply, the resolution having set a particular rule for the case, and the amount awarded was two-thirds the limit set by the resolution. *Hubbell's Case*, 5 Ct. Cl., 1.

§ 1620. In this case the question of infringement had been settled in favor of plaintiffs, and

reference to a master to report the amount of damages sustained by plaintiffs for the use by the defendants of their invention. The master, in his report, bases his opinion upon the productive capacity of the machines employed. *Held*, that the calculations should have been made on the *actual production* of such machines of the article manufactured. *Webster v. New Brunswick Carpet Co.*, 9 O. G., 203.

§ 1621. Where the United States had not dealt in the patented article, nor used it, so as to gain a profit in the usual sense of the word, the damages to patentee were estimated by the utility and advantage of the invention to the United States over the old modes or devices that had been used for working out similar results. *Dahlgreen's Case*, 16 Ct. Cl., 30.

§ 1622. Where it is sought to recover in equity profits resulting to the defendant from using through a series of years a mechanical invention without the owner's consent or authority, which profits do not consist in specific sums of money received by the defendant in so using the invention, but simply consist in the advantage and convenience derived from using them, and such advantage is a matter to be estimated as a whole, it is not a matter of accounts, and therefore a bill cannot be sustained for an account. *Sayles v. Richmond, Fredericksburg & Potomac R. Co.*, 3 Hughes, 172.

§ 1623. Damages to plaintiff, beyond profits actually received by defendant, considered. *Carter v. Baker*, 1 Saw., 512.

§ 1624. The amount of damages to be recovered in an action for an infringement is not to be reduced because the defendants might have used other machines to as good advantage. *Emerson v. Simms*, 3 O. G., 293.

§ 1625. No damages can be recovered upon a bill in chancery brought before July 8, 1870, for the infringement of a patent, except the actual profits made by the defendants from the use of the plaintiff's patent. *American Nicholson Pavement Co. v. Elizabeth City*, 6 O. G., 764.

§ 1626. The defendants in a suit for infringing can have no allowance made them on the ground that they might have used other improvements with as much profit as they made out of the plaintiff's invention. *Ibid*.

§ 1627. The evidence on this point was properly received by the master, and the objection should be taken by a motion to suppress the testimony, and not by exceptions to the master's report. *Ibid*.

§ 1628. In what circumstances damages, other than profits, will not be allowed, the infringement consisting in the sale of a patented product. *Burdett v. Estey*, 19 Blatch., 1.

§ 1629. The value of an invention for which an infringer is liable is the value at the time of the infringement. A man who has got a patent owns it as property, and if anybody sees fit to infringe it he is bound to pay for its fair value, and the fact that there is something else just as good or better does not entirely destroy its value, but may affect it. *National Car-Brake Shoe Co. v. Terre Haute Car & Mfg. Co.*, 19 Fed. Rep., 514.

§ 1630. The amount subsequently paid by the defendant to another patentee for the use of a device which subserved the same purpose may afford a proper measure of the value of the use of the plaintiff's invention to the defendant. *Sargent v. Yale Lock Mfg. Co.*, 17 Blatch., 249.

Damages — Evidence of — Value of invention, §§ 1631-1639.

§ 1631. Where in accounting for profits the difference in economy derived by defendant's use of the patented improved process was the inquiry, *held*, that testimony as to the commercial working of processes open to the public was admissible. *Black v. Thorne*, 12 Blatch., 20.

§ 1632. The plaintiff having failed to give adequate evidence as to damages and profits, objections to the admissibility of defendant's proofs become unimportant. They are not called upon to report until the plaintiffs have made out a case. (*Black v. Munson, Hunt, J.*, North Circ. N. Y., June 19, 1877.) *Garretson v. Clark*, 15 Blatch., 70.

§ 1633. There being no inadvertence in taking the testimony, it appearing from the record that the inadequacy of the proofs had been excepted to, and no other or further evidence to be offered, a new reference to the master refused. *Ibid*.

§ 1634. In an infringement suit the defendant rendered before the master an account of the number of machines which he had made, of which he represented some as infringing three, and others only one, of the claims of the complainant's patent. The complainant then alleged that he had "for many years, to the knowledge of the defendant, exacted and received from many other persons a royalty," at a specified rate, "upon all harness manufactured by the use of machines similar to those employed by the defendant," who thereupon admitted, in writing, "the license and the terms of the same as alleged" by the plaintiff. Here the plaintiff rested his case. The respondent then offered to verify the statement of his account that a large part of his machines infringed only one of the three claims mentioned in the original decree. The

master held this evidence to be inadmissible, and assessed the damages for all the machines at the usual rate. Upon exception his action was affirmed by the court. *Kendrick v. Emmons*, 15 O. G., 966.

§ 1635. In an account before a master, evidence of payments for past infringement, for the purpose of ascertaining the amount which should be paid by the defendant, is incompetent. To admit it is contrary to the maxim "*inter alios acta*," etc. *Westcott v. Rude*, 19 Fed. Rep., 830.

§ 1636. The price at which sales have been made, licenses granted, etc., under a patent, being in the nature of admissions, is competent evidence against a plaintiff in respect to the value of the patented invention; but the plaintiff is not necessarily concluded thereby. *Gottfried v. Crescent Brewing Co.*, 22 Fed. Rep., 433.

§ 1637. In these cases the court holds that a contract or license between the co-patentees, and sales of machines made at an early day, and at varying prices, were not sufficient to show an established royalty or license fee, and confirms a master's report based on general evidence as to the value of the invention. *Ibid.*

§ 1638. The evidence taken before the master failing to show any fixed and established license fee, and his finding being upon the basis of profits and not of damages, he could not properly determine the amount by reference to the settlement effected in another suit, where the situation and condition of the defendant were not the same. *Greenleaf v. Yale Lock Manufacturing Co.*, 17 Blatch., 253.

§ 1639. The mere opinion and estimate of two witnesses may be insufficient to establish the value of the use of the invention to the defendant. *Sargent v. Yale Lock Mfg. Co.*, 17 Blatch., 249.

Damages — Interest on, §§ 1640-1643. See *Damages and Profits*, §§ 1687-1698.

§ 1640. Interest allowed on actual damages from commencement of suit. *McCormick v. Seymour*, 2 Blatch., 240; *Pitts v. Hall*, 2 Blatch., 229.

§ 1641. Interest may be allowed on damages at law, from time infringement occurred. *Tatham v. Le Roy*, 2 Blatch., 474.

§ 1642. Where the amount of royalty was fixed at the time when the defendants began to use the invention, it was held that the damages could not be said to have been unliquidated from the first, and interest was allowed thereon. *Locomotive Safety Truck Co. v. Railroad Co.*, 2 Fed. Rep., 677.

§ 1643. Defendants are not to be charged with interest upon the damages until the date of the final decree. *American Nicholson Pavement Co. v. Elizabeth City*, 6 O. G., 764.

See *Royalty*, § 5885.

Profits — Apportionment of, §§ 1644-1655. See *Damages and Profits*, §§ 1508-1513.

§ 1644. Where an article is utterly valueless without the patented improvement, it would seem that patentee should recover all the profit for infringement without apportionment; but where the patented improvement is but of trifling value compared to the article improved upon, such an apportionment should be made. *Whitney v. Mowry*, 4 Fish., 141.

§ 1645. A patentee cannot recover from an infringer the profits which the latter has made upon the machines in which the patented devices are used, over and above those profits which are due to the use of those devices. *Graham v. Mason*, 1 Holmes, 88.

§ 1646. If defendant has cheapened the cost of producing the infringing device by an improvement of his own, he is entitled to a corresponding credit in the ascertainment of the profits which complainants are entitled to recover. *Mason v. Graham*, 23 Wall., 261.

§ 1647. The profits which the complainant is entitled to recover do not include those realized from such portions of the infringing machine as are not embodied in the patented machine. *Brady v. Atlantic Works*, 15 O. G., 965.

§ 1648. Where plaintiff's invention contributed but a small part to the usefulness of a pavement, *held*, he could recover only the profits on the patented improvement, and not of laying the entire pavement. *Schillinger v. Gunther*, 15 Blatch., 303.

§ 1649. In ascertaining profits derived by defendant in using a furnace burning wet tan, *held*, that plaintiff must show to the master the profits derived from the peculiar device to which the patent had been limited by the court, not that arising from the use of the whole furnace. *Black v. Munson*, 14 Blatch., 265.

§ 1650. Where the increased profits were partly due to a furnace adopted by defendants, aside from complainants' process, *held*, that the latter were entitled only in proportion to their contributory efficiency in the beneficial result; and it being impossible to adjust their relative value exactly, profits were apportioned equally to each. *Wetherill v. New Jersey Zinc Co.*, 1 B. & A., 485.

§ 1651. Where master in his report appeared to have proceeded on the ground that, because the aggregate business of defendant did not result in profit, complainant was not entitled to recover, *held*, that while in cases in which gains and profit alone were to be awarded, in the absence of profits resulting from an unskillful use of the machine, complainant could not recover. *Conover v. Mers*, 11 Blatch., 197.

§ 1652. But that defendant could not prejudice complainant by applying the gains arising from the use of an infringing machine to make up losses on other branches of his business. *Ibid*.

§ 1653. Where the master allowed the net profits on the sale of the entire device, and plaintiff's patented invention constituted a part only of it, *held*, he was bound to infer there was a profit on the unpatented part as well, and that plaintiff was limited to such as properly arose from his improvement. *Maier v. Brown*, 17 Fed. Rep., 736.

§ 1654. Where there was attached to the infringing machine an additional improvement belonging to defendants, *held*, that the sole question was as to how much was received from the appropriation and sale of the orator's invention, and not what damages resulted; and what was received from the sale of something else, belonging to defendant and not the orator, should not be allowed to orator. *Steam Stone Cutter Co. v. Windsor Mfg. Co.*, 17 Blatch., 24.

§ 1655. Where the master allowed as damages the license fee paid for the entire machine, part of which only was infringed, *held*, that it should have been apportioned to the several parts covered by distinct inventions, and that license fee only allowed which was paid for the part infringed, unless it was proved that that particular mechanism embraced all that was of value in the entire machine. *Porter Needle Co. v. National Needle Co.*, 22 Fed. Rep., 829.

See *Assignee*, § 546. *Damages and Profits*, § 1477. *Master's Report*, § 4180.

Profits — Apportionment of — Burden of proof, when on plaintiff, when on defendant, §§ 1656-1662.

§ 1656. Where the defendants have wrongfully connected the plaintiffs' improvement with their own, and have caused the confusion of rights, if any portion of the profits are properly to be credited to the defendants' improvements, the burden rests on them to show affirmatively that fact. *Carter v. Baker*, 1 Saw., 512.

§ 1657. It is the duty of the plaintiffs to give evidence separating the profits arising from their improvement from those on the matter not included therein. In the absence of such proof only nominal profits can be allowed. *Faulks v. Kamp*, 10 Fed. Rep., 675.

§ 1658. Where the complainant fails to show what, if any, definite part of the whole profits was produced by his improvement, his recovery must be nominal only. *Kirby v. Armstrong*, 10 Biss., 135.

§ 1659. Where the patent is for an improvement in machines, the burden is on the complainant to separate the profits due to the improvement from the general profits of the business. This rule is recognized, not reversed, in *Elizabeth v. Pavement Company*, 7 Otto, 126. *Ibid*.

§ 1660. Where complainant's patent was for an improvement upon old machines, and was infringed by a patent embodying further improvements, *held*, that the burden rested on complainant to prove the proportion of profits justly ascribable to his improvements; and that, having failed to do so, he was entitled to nominal damages only. *Bostock v. Goodrich*, 25 Fed. Rep., 819.

§ 1661. If the plaintiff's patent covers all that is meritorious in what constitutes the infringement, the plaintiff should recover all the profits the defendants have made out of it; but if they used other improvements, which increased the value of the production and enhanced their profits, a corresponding reduction should be made in their favor. *American Nicholson Pavement Co. v. Elizabeth City*, 6 O. G., 764.

§ 1662. It belongs to the defendants to show the value of such improvements; if they furnish no such proof no deduction will be made. *Ibid*.

Profits — Estimation of — The rule, §§ 1663-1665. How determined, §§ 1666-1689c.

§ 1663. Profits, as a measure of damages. Rules for estimating. *Pitts v. Hall*, 2 Blatch., 229.

§ 1664. Rule for ascertaining profits in case of sale of infringing machines having the patented improvement. *McCormick v. Seymour*, 2 Blatch., 240.

§ 1665. Reasons of equity rule of profits as measure of damages. *Packet Co. v. Sickles*, 19 Wall., 611.

§ 1666. If the invention, as an entirety, was infringed, then the whole profits are the profits of infringement. *Ruggles v. Eddy*, 12 O. G., 716.

§ 1667. Where defendants were manufacturing under a patent which was held to be an infringement of complainants' patent, *held*, that as they were acting in good faith, the royalty paid

for the use of such patent should be allowed them on the question of profits. The rule stated. *La Baw v. Hawkins*, 2 B. & A., 561.

§ 1668. Where the patent was only valuable to the patentee as he could induce railroads to use it and pay him for its use, and it was worth nothing to him as a monopoly, in view of the great difficulty of proving with exactness the profits which had accrued to defendant from an infringing use, the license fee found by the master to have existed was adopted as the measure of profits. *Emigh v. B. & O. R. Co.*, 4 Hughes, 271.

§ 1669. Where the profits made by defendant amount to more than the license fee charged by plaintiff for the use of his machine, he is entitled to recover them, and is not limited to such license fee. *Wooster v. Taylor*, 14 Blatch., 403.

§ 1670. An infringer is to be charged with the profits obtained by him for repairs upon machines sold by him as well as the original profits on the machines. *Graham v. Mason*, 1 Holmes, 88.

§ 1671. The profits made by the defendants in selling the machines are proper to be given as a part of the damages. But as mere profits, the plaintiffs are only entitled to the profits of the sale of their machine as patented. *Carter v. Baker*, 1 Saw., 512.

§ 1672. A patentee is entitled to recover all the profits an infringer has made upon the use of any of the patented devices, without deducting anything for what he has lost on the use of others, even though the bill charged the respondent in general terms. *Graham v. Mason*, 1 Holmes, 88.

§ 1673. The profits to be charged against an infringer are the profits made upon the patented devices, without deducting anything, on the ground that the defendant produced them cheaper by making them after a pattern of his own. *Ibid.*

§ 1674. The profits which the patentee is entitled to recover in equity from the infringer by use of the patented invention are not the profits of the business, but the value of the advantages derived by the infringer from the use of the invention over what he would have by the use of other machines then known and open to the public, and adequate to produce an equally beneficial result. *Knox v. Great Western Q. M. Co.*, 6 Saw., 430.

§ 1675. The fact that the general result of the business is unprofitable does not affect the recovery. The question is, What advantage in the reduction of cost, etc., has been derived from the use of the invention? *Ibid.*

§ 1676. The profits are not all that an infringer made in the business in which he used the patented invention, but they are the worth of the advantage he obtained by such use — or, in other words, they are the fruits of that advantage. (*Mowry v. Whitney*, 14 Wall., 651.) *Mers v. Conover*, 11 O. G., 1111.

§ 1677. Thus, where no profits actually resulted from the use by reason of the defective mechanism in combination with which the infringed device was employed, yet, as the loss was less than it would have been with the infringed device omitted, this benefit is equivalent to an equal gain, and was rightly estimated as a part of the profits for which the infringer was responsible. *Ibid.*

§ 1678. In ascertainment of profits before a master, evidence to establish what advantage defendants derived from using plaintiff's improvement over any other furnace open to their use is admissible. *Black v. Munson*, 14 Blatch., 265.

§ 1679. When the only profits that could have been derived by the defendant are the saving of time in using complainant's patented system of bond registration, the inquiry to be determined by the master is what they did actually derive by its use, as they used it, not when used to most advantage; and where the only evidence before the master is the opinion of a witness as to the value of the time that might be saved under supposed circumstances by its use, the master's report cannot be sustained. *Munson v. City of New York*, 16 Fed. Rep., 560.

§ 1680. Where the entire value of the whole machine as a marketable article is properly and legally attributable to the patented features, the profits may be estimated by showing the profits derived from making and selling the article containing the patented features, and the profits realized from the manufacture and sale of other forms of the same article not embodying the patented features. *Garretson v. Clark*, 17 Blatch., 256.

§ 1681. In estimating profits of infringer, the device infringed must be compared with what was known and open to the public at and prior to the date of the patent. *Turrill v. Illinois Central R. Co.*, 20 Fed. Rep., 912.

§ 1682. It is now well settled that savings in cost by infringement of a patent may be recovered as profits. (*Cawood Patent*, 94 U. S., 695; *Elizabeth v. Pavement Company*, 97 U. S., 126.) *Campbell v. James*, 18 Blatch., 92.

§ 1683. Where the patented article is a product, the profits made by the infringer, and to which plaintiff is entitled, are the difference between the cost and yield. *Burdett v. Estey*, 19 Blatch., 1.

§ 1684. It is what the defendants did gain, not what they might have gained, that they are accountable for by way of profits. *Ibid.*

§ 1685. Where defendant had been in the habit of selling the infringing picker-staff motion both separately and attached to looms, in ascertaining his profits upon those sold with the looms, regard should be had to his profits upon those sold separately, rather than to the aggregate profits made by him upon the loom and attachment combined. *Mason v. Graham*, 23 Wall., 261.

§ 1686. The profits to be charged against an infringer as having been made upon patented devices are not to be limited so as to bear the same proportion to all the profits made on the whole machine as the cost of those devices bears to that of the machine. *Graham v. Mason*, 1 Holmes, 88.

§ 1687. Where, of certain infringing lamps, some infringed fewer claims of the patent than others, *held*, that the master properly allowed the same rate of profit for the former as for the latter. *Williams v. Rome, Watertown & Ogdensburgh R. Co.*, 18 Blatch., 181.

§ 1688. In this case the defendant used the combination that gave a peculiar value to the patent faucet of the plaintiffs, and they were chargeable with damages in respect to the entire faucet, and the master's report so charging them should be confirmed. *Zane v. Peck Brothers & Co.*, 23 O. G., 191.

§ 1689. When the claim infringed is for pressing and binding short-cut hay into bales, the profits to which the plaintiff is entitled are those due to selling the short-cut hay pressed and bound in bales over selling it as loose-cut hay, or as short-cut hay manipulated for the market in some prior known way. *Faulks v. Kamp*, 10 Fed. Rep., 675.

§ 1689a. Estimation of profits in the case of infringing use of a process considered. *Tilghman v. Mitchell*, 9 Blatch., 1.

§ 1689b. Where the appropriated invention is an art, the simplest method of attaining the profits is by a comparison between it and cognate means used and available for the production of the same result. The saving in cost of production due to the new process is a fair measure of the infringer's actual profits. *Wetherill v. New Jersey Zinc Co.*, 1 B. & A., 485.

§ 1689c. Where a large quantity of fish is preserved by a patented process, the enhanced price obtained for the fish that are left, in consequence of withdrawing the others from the market, is an incident of trade too remote and indirect to be charged as profits made by infringing the patent. *Piper v. Brown*, 1 Holmes, 196.

Profits — Estimation — Allowance of expenses, §§ 1689d-1689q.

§ 1689d. Expenses for advertising should be allowed defendants in estimating profits. *La Baw v. Hawkins*, 2 B. & A., 561.

§ 1689e. The use of shop-room and tools can be properly estimated and allowed in determining profits. *Troy Iron & Nail Factory v. Corning*, 6 Blatch., 328.

§ 1689f. Where defendants were dealers in musical instruments, and some of the instruments bought and sold by them contained a tremolo attachment which infringed complainants' patent and others not, defendants were properly allowed, in the ascertainment of the profits made by them from the sales, to prove the general expenses of their business incurred in effecting the sales of all musical instruments, and deduct a ratable proportion from the gross profits made by the sale of the attachments. *Tremolo Patent*, 23 Wall., 518.

§ 1689g. Profits ascertained by finding the difference between cost and the amount realized. In estimating the cost, the elements of price of materials, interest, expenses of manufacture and sale, and other necessary expenses, if any, as well as bad debts, are to be taken into account, and usually nothing more. *Rubber Co. v. Goodyear*, 9 Wall., 788.

§ 1689h. Manufacturers' profits, as well as the cost of material, are to be deducted from the amount derived from the sale of the patented article in estimating the profit received from the invention. *Buerk v. Imhaeuser*, 14 Blatch., 19.

§ 1689i. In estimating profits the use of tools, machinery, power and other facilities employed in the manufacture should be taken into account, as well as material, labor, wastage and expenses of marketing. *Mowry v. Whitney*, 14 Wall., 620, commented on and approved. *Gould's Mfg. Co. v. Cowing*, 105 U. S., 253.

§ 1689j. Where insurance of personal and other property was no part of the cost of making the infringing machines, it was not allowed; and so of the local taxes. *Steam Stone Cutter Co. v. Windsor Mfg. Co.*, 17 Blatch., 24.

§ 1689k. Defendants will be allowed to deduct the royalty they paid for the use of a patented improvement which they used, unless the plaintiff shows that they paid more than it was worth. *American Nicholson Pavement Co. v. Elizabeth City*, 6 O. G., 764.

§ 1689l. It would seem, also, that they should be allowed the cost of introducing any improvement, if they furnished evidence of what the cost was. *Ibid.*

§ 1689m. They should not be charged for the profits upon work for which they could not collect their pay. *Ibid.*

§ 1689n. The commission paid an agent would not be included in the profits accounted for by his principal, as such commission is a distinct profit to the agent. *Steiger v. Heidelberger*, 18 Blatch., 426.

§ 1689o. No deduction from the profits the respondents have made by infringing a patent are to be allowed on account of their time and services, nor any commission on their sales, when they have paid none. *Piper v. Brown*, 1 Holmes, 196.

§ 1689p. Reasonable salaries paid by the defendants to their officers who superintended the work should be deducted from the profits charged to them. *American Nicholson Pavement Co. v. Elizabeth City*, 6 O. G., 764.

§ 1689q. The loss incurred during one season in carrying on the infringing business is not to be deducted from the profits made during another season, if there is no connection between the business of one season and that of the other, and the accounts of each have been kept distinct. *Piper v. Brown*, 1 Holmes, 196.

See *Damages and Profits*, § 1565. *Infringer*, § 3010.

Profits — Interest on — *When allowed*, §§ 1689r-1696. *When not*, §§ 1697, 1698.

§ 1689r. Interest on profits held properly chargeable. *Tatham v. Lowber*, 4 Blatch., 86.

§ 1689s. Interest allowed plaintiff on recovery for infringement, from and after the close of each year of infringing use, on the ascertained value of the savings and profits arising out of the use of his process, for the twelve months next preceding. *Tilghman v. Mitchell*, 9 Blatch., 1.

§ 1689t. The profits recoverable against the infringer of a patent are properly unliquidated damages until ascertained by the decree, and interest should not therefore be charged upon them. *Mowry v. Whitney*, 14 Wall., 620 (§§ 5036-45).

§ 1690. Where the infringement of a patent consisted in the use of a process for which defendant held another patent, it was considered not to have been wanton, and that he should not be charged with interest upon the profits for which he was held liable. *Ibid.*

§ 1691. Allowance of interest on capital will be made in estimating profits on settling an account, where it has been paid upon the capital invested, or is to be paid on borrowed capital. Allowance for cost of power is to be determined by the same rule. *Herring v. Gage*, 15 Blatch., 124.

§ 1692. In an accounting interest charged on profits from the entry of the decree, because even after that the detention was known to be wrongful. *Steam Stone-Cutter Co. v. Windsor Mfg. Co.*, 17 Blatch., 24.

§ 1693. Interest allowed on profits to the date of the decree. *Steam Stone-Cutter Co. v. Winsor Mfg. Co.*, 18 Blatch., 47.

§ 1694. Interest will be allowed on profits where the infringement is intentional, but not until after filing disclaimer, where such is necessary to obtain the decree. *Burdett v. Estey*, 19 Blatch., 1.

§ 1695. Interest allowed on profits from the date at which the master's report was in proper form for exceptions. *Turrill v. Illinois Central R. Co.*, 20 Fed. Rep., 912.

§ 1696. As a general rule a patentee is not entitled to interest on profits made by an infringer, because profits are regarded in the light of unliquidated damages; but where a case was sent back to ascertain how much should be deducted from decrees for errors in the accounting as then stated, it seems not at all inequitable to allow interest on the corrected amounts from the date of the master's report. The cases are entirely different in this particular from what they would have been if the original decrees had been reversed for error in the principles of the accounting. The decrees in the present cases may be considered as affirmed in part and reversed in part, the new reference being had only to find out the exact extent of the reversals. *Illinois Central R. Co. v. Turrill*, 26 O. G., 917.

§ 1697. Interest on profits cannot be recovered. *Brady v. Atlantic Works*, 15 O. G., 965.

§ 1698. Interest on the profits decreed to the complainant should not be allowed. The profits in such case are to be regarded in the light of unliquidated damages, which usually do not draw interest without the special order of the court. *Parks v. Booth*, 12 Otto, 96.

See *Assignee*, § 547. *Damages and Profits*, § 1501.

Profits — Defined, §§ 1699, 1700. *Generally*, §§ 1701-1707.

§ 1699. "Profit" is the gain made upon any business or investment, when both the receipts and payments are taken into account. *Rubber Co. v. Goodyear*, 9 Wall., 788.

§ 1700. Under the patent act, profits may be defined to be the net gains of the infringer from

the use of the patented invention, while damages are the losses sustained by the owner in consequence of the infringement. *La Baw v. Hawkins*, 2 B. & A., 561.

§ 1701. The profits recoverable in an action for infringement are not regarded in the light of unliquidated damages. This profit is ascertainable by evidence, and does not, like a claim for damages in an action for a tort, rest in the mere discretion of a court or jury. *Jenkins v. Greenwald*, 1 Bond, 126.

§ 1702. A party who has earned profits by the infringement of a patent is chargeable as trustee for the use of the real owner. *Vaughn v. East Tennessee, Virginia & Georgia R. Co.*, 1 Flip., 621.

§ 1703. The power given the court by the statute to treble the *damages* does not extend to *profits* in a suit in equity. *Holbrook v. Small*, 17 O. G., 55.

§ 1704. A motion to recommit a case to master for further statement of profits to date of final decree on machines enjoined since the interlocutory decree was made, denied. *Union Met. Cartridge Co. v. U. S. Cartridge Co.*, 8 Fed. Rep., 446.

§ 1705. In a suit in equity for the infringement of a patent by the use of the patented invention, the patentee is entitled to recover the profits resulting to the infringer from the use of the invention. *Knox v. Great Western Quicksilver Mining Co.*, 6 Saw., 430.

§ 1706. In such case the patentee is not limited in his recovery in equity to the amount of the royalty established by him for the use of his invention. *Ibid.*

§ 1707. In view of the former decision of this court in these cases (reported under the name of the Cawood Patent, 94 U. S., 695), nothing was left open for further inquiry but the amounts of the former recoveries for the use of the non-infringing machines, and the true way of determining this clearly was to find out what part of the profits for which the original decrees were rendered had been made by the use of the non-infringing machines. *Illinois Central R. Co. v. Turrill*, 26 O. G., 917.

86. DATE TO WHICH AN ACCOUNTING IS BROUGHT DOWN.

See ACCOUNTING, DATE TO WHICH BROUGHT DOWN.

87. DATE OF APPLICATION.

See APPLICATION, DATE OF.

88. DATE OF FOREIGN PATENTS.

See FOREIGN PATENTS, DATE OF.

89. DATE OF INVENTION.

See NOVELTY, §§ 4348, 4349. USE, FOREIGN, § 6435.

Date of invention—Is that of *inceptive invention*. §§ 1708-1713; *application*, §§ 1714-1719; *caveat*, § 1720; *drawing*, § 1721; *patent*, §§ 1722-1725; *reduction to practice*, §§ 1726, 1727.

§ 1708. The date of invention is the date of the discovery of the principle involved and the attempt to embody that in some machine,—not the date of the perfecting of the instrument. *Colt v. Massachusetts Arms Co.*, 1 Fish., 108.

§ 1709. The *time of invention* is when the idea is not only distinct and complete in the mind of the inventor, but that idea is reduced to practice and embodied in some distinct form. *Matthews v. Skates*, 1 Fish., 602.

§ 1710. The date of invention is when the intellectual production or idea or conception was so perfected, that, without more inventive power or experiment, it could be successfully applied in practice, and the requirements of the law as to a sufficient description be complied with. *Ransom v. Mayor of New York*, 1 Fish., 252.

§ 1711. Conception of the idea and embodiment in a model considered as the date of invention. *Grover & Baker Sewing Machine Co. v. Sloat*, 2 Fish., 112.

§ 1712. A patentee, who is assailed upon the ground of want of novelty, may show by sketches and drawings the date of his inceptive invention, and if he has exercised reasonable

diligence in perfecting and adapting it, and in applying for his patent, its protection will be carried back to such date. *Reeves v. Keystone Bridge*, 1 O. G., 466.

§ 1713. Where a patent is assailed for lack of novelty, sketches and drawings may be resorted to to fix the date of inceptive invention, and if there has been no unreasonable delay subsequently in adapting the invention and applying for patent, the protection of the patent will be carried back to the date thus established. *Draper v. Potomska Mills Corporation*, 13 O. G., 276.

See *Priority of Invention*, § 5010.

§ 1714. Date of the application viewed as the date of invention. *Whitney v. Mowry*, 2 Bond, 45.

§ 1715. In the absence of other evidence, a patented invention will be held to date from the time of filing the application, and not from the time of the grant. *Pennington v. King*, 7 Fed. Rep., 462.

§ 1716. The date of an invention must be taken to be when the application was filed, if it does not appear when the models and drawings were made, which show it to have been perfected, although the patentee had previously commenced experiments upon it. *Dane v. Chicago Manufacturing Co.*, 3 Biss., 380.

§ 1717. The presumption as to date of invention arising on the grant of a patent extends back to date of filing application. *White v. Allen*, 2 Cliff., 224.

§ 1718. Where patentee filed a caveat, and at the same time took the model of the machine so protected to pieces, not having produced an operative apparatus, and at a subsequent period reconstructed an operative machine out of the same, which was patented, *held*, that the date of invention was that of the application for patent, and that what his caveat had protected was an abandoned experiment. *Johnson v. Root*, 2 Cliff., 108.

§ 1719. On a question as to whether patentee was first inventor, his patent was limited to the date of his application, in view of his prior unsuccessful experiments, and held anticipated by another patent based on a caveat filed, and successful experiments made, prior to his application, though subsequent to the date to which he referred his unsuccessful experiment. *Burrows v. Lehigh Zinc Co.*, 1 B. & A., 529.

See *Abandonment*, § 76. *Novelty*, § 4385. *Patents*, §§ 4659, 4691.

§ 1720. The invention dates from the filing of the caveat. *Latta v. Shawk*, 1 Bond, 259.

See *Inventors, Joint*, § 3795.

§ 1721. An invention may date from time the drawing was made disclosing the same. *Stephenson v. Hoyt*, 1 MacA. Pat. Cases, 292.

See *Drawings*, § 2090.

§ 1722. Although a patent is not set up by way of defense in an answer, yet if the invention patented thereby is afterward put into actual use, the date of the patent will be evidence of the date of the invention on a question of priority between different parties. *Atlantic Works v. Brady*, 107 U. S., 192.

§ 1723. If a patent was not accompanied by an application, the date of the patent would be deemed the date of the invention; and the application, to be effective evidence to carry the date of the invention back to its own date, must be an application for substantially the same invention for which the patent is granted, without material variation or addition. *Eagleton Manufacturing Co. v. West, Bradley & Cary Manufacturing Co.*, 18 Blatch., 218.

§ 1724. In the absence of other evidence, the date of the patent is to be taken as the date of invention, and the burden of proof is upon the defendant to show, beyond any fair doubt, prior knowledge and use. When such evidence has been produced, the burden is shifted upon the plaintiff to show still earlier invention. *Webster Loom Company v. Higgins*, 15 Blatch., 447.

§ 1725. In the absence of the original application, the presumption as to the date of invention extends no further back than the date of the patent, and the burden of proof is on the party making the allegation to show a prior date. *Union Sugar Refinery Co. v. Mathieson*, 3 Cliff., 639.

§ 1726. The date of invention of the device covered by the patent on which infringement suit was brought, fixed at the time when the inventor perfected the invention, made models of the device, and entered into a contract for its manufacture. *Comstock v. Sandusky Seat Co.*, 13 O. G., 230.

§ 1727. Where there was evidence of prior public use of an article at a certain date, *held*, that the court will presume that, in the due course of business, it took at least some months before that time to devise and produce the device. *Weir v. Morden*, 21 Fed. Rep., 243.

Date of invention — Burden of proof — *On plaintiff*, §§ 1728-1730.

§ 1728. Where plaintiff undertakes to prove date of invention and reduction to practice prior to filing application, the burden of proof is on him. *Johnson v. Root*, 2 Cliff., 108.

§ 1729. Where patentee sets up a date of invention prior to that of filing his application, it throws on him the burden of proving not only that he made his invention at the period claimed, but that he reduced it to practice as an operative machine. *Jones v. Sewall*, 3 Cliff., 563.

§ 1730. When the application fails to take the date of the invention back of the date of the patent, and the defendants make out prior knowledge and use by others beyond any fair or reasonable doubt, as the law requires, the burden is shifted on the plaintiff to show invention or discovery by the patentee still prior to that. *Eagleton Mfg. Co. v. West, Bradley & Cary Mfg. Co.*, 18 Blatch., 218.

Date of invention — Evidence of, §§ 1731-1739.

§ 1731. The declarations of an inventor describing his invention are admissible to prove that it was then known to and claimed by him to the extent of such description. *Phila. & Trenton R. Co. v. Stimpson*, 14 Pet., 448.

§ 1732. The statements and declarations of the inventor made before the contest arose, describing orally or by drawings a certain invention, are admissible in evidence as part of the *res gestæ* to show that he knew of or had made the invention at that time. *Yearsley v. Bookfield*, 1 MacA. Pat. Cases, 193.

§ 1733. The conversations and declarations of an inventor, stating that he had made an invention, coupled with a description of its nature and objects, are to be deemed as part of the *res gestæ*, and legitimate evidence that the invention was then known to and claimed by him; and thus its origin may be fixed at least as early as that period. (*Phila. & Trenton R. Co. v. Stimpson*, 14 Pet., 462.) *Stephens v. Salisbury*, 1 MacA. Pat. Cases, 379.

§ 1734. The positive testimony of a credible witness fixing the date of an invention outweighs circumstantial evidence merely raising a doubt as to the correctness of the witness' recollections. *Cundell v. Parkhurst*, 1 MacA. Pat. Cases, 63.

§ 1735. Testimony taken to show that a certain invention annexed to a patent, under the thirteenth section of the law of 1836, as an improvement invented subsequent to the date of the patent, was in fact invented by the patentee before the date of the patent, is receivable in evidence to show that an applicant is not the inventor, whether or not the patentee, under the circumstances named, could sustain his patent. *Burlew v. O'Neil*, 1 MacA. Pat. Cases, 168.

§ 1736. The measure of proof requisite to show the date of an invention on an issue of priority depends upon the nature of the invention, the capacity of the witnesses and the distance of time. Where the invention is complicated, of many parts, contrivances and devices, mere verbal description may be insufficient to establish the priority of invention without the support of contemporaneous drawings or models. *Stephens v. Salisbury*, 1 MacA. Pat. Cases, 379.

§ 1737. On issues of novelty and infringement, evidence as to date of invention is not admissible. *Cahoon v. Ring*, 1 Cliff., 592.

§ 1738. Where the pleadings averred that the improvements patented in 1843 were contemplated in 1841, *held*, that evidence on this point was admissible on account of the broad allegation. *Nesmith v. Calvert*, 1 W. & M., 34.

§ 1739. In the absence of any explanatory facts of delay intervening between a time when the patent might have been applied for and the time when the application was made, evidence offered to carry back the date of invention to a period considerably anterior to the application for patent, in order to save the patent from being defeated for want of novelty, should be critically examined. *Walker Glass Co. v. Souweine*, 32 O. G., 1466.

90. DATE OF PATENT.

See DATE OF INVENTION. TERM.

91. DATE OF PRIOR PUBLICATION.

See PUBLICATION, PRIOR, DATE OF.

92. DECLARATION.

§ 1740. If the declaration aver that a grant by the United States in the form prescribed by law was issued, it is sufficient. *Cutting v. Myers*, 4 Wash., 220.

§ 1741. The declaration must aver delivery of the patent grant to the petitioners, and that it was tested by the president. *Ibid.*

§ 1742. A general averment in the declaration, of extension in due form of law, is sufficient. *Phelps v. Comstock*, 4 McL., 353.

§ 1743. Where damages are sought for an injury done, the declaration need not set forth the act complained of — an infringement — as contrary to the statute; and a motion for arrest of judgment on such grounds was refused. *Parker v. Haworth*, 4 McL., 370.

§ 1744. Proper averments in the declaration of a suit for infringement considered. *Wilder v. McCormick*, 2 Blatch., 31.

§ 1745. The grant of a patent is sufficient evidence that all the preliminary steps required by law were properly taken. In pleading it is sufficient to set forth the grant in substance. *Ibid.*

§ 1746. Averment as to time when the patented invention was made is not inserted in the approved proceedings of declarations of infringements of patents. *Ibid.*

§ 1747. Acts done by plaintiff in obtaining the patent need not be specified in the declaration. *Ibid.*

§ 1748. In an action at law to determine complainant's rights pending a suit in equity for infringement, an allegation in the declaration, stating that plaintiff did not sue for damages, etc., but only to determine his legal rights, is not irrelevant nor redundant. *Knox v. Great Western S. M. Co.*, 3 Saw., 422.

§ 1749. Where plaintiff was patentee and assignor of a certain invention and the substance of the declaration was that defendants, in consideration of an exclusive grant thereunder to supply a certain district and to manufacture and vend the patented articles separately, promised to account and pay a certain tariff, and also for the patented articles sold separately, and the action was covenant broken to recover damages for neglect and refusal to account and pay, *held*, that the declaration was sufficient. *Heckers v. Fowler*, 2 Wall., 126.

§ 1750. Where the infringement complained of was of the entire right, united in the plaintiff, by the different patents and assignments, *held*, that the declaration was not demurrable for multifariousness. *Case v. Redfield*, 4 McL., 526.

§ 1751. Where declaration contains all necessary allegations to show that the patent was regularly granted, and the patent is designated by terms which itself uses, it is not too vague. *Gray v. James*, Pet. C. C., 476; *Cutting v. Myers*, 4 Wash., 220.

§ 1752. Failure to set out in the declaration the recording of the assignment is not demurrable. *Case v. Redfield*, 4 McL., 526.

§ 1753. Where a declaration purports to set forth the specification of a patent, the slightest variance is fatal (act 1793). *Tryon v. White*, Pet. C. C., 96.

§ 1754. Where the declaration sets up title to patent-right by assignment without stating the recording of the same, the defect is cured by verdict. *Dobson v. Campbell*, 1 Sumn., 319.

§ 1755. A failure in the declaration in setting out the breach, to state the number of the machines used by defendant, is cured by the verdict. *Gray v. James*, Pet. C. C., 476.

§ 1756. A declaration defective in not stating that a patent was obtained and exclusive right rested in plaintiff, *held* cured by verdict. *Stanley v. Whipple*, 2 McL., 35.

§ 1757. Where the declaration failed to set out what the improvement was in which the invention consisted, a demurrer thereto was sustained. *Peterson v. Wooden*, 3 McL., 248.

§ 1758. Where the declaration shows the patent to be for a combination, plaintiff cannot abandon a part of the combination and rely upon the remaining part, as such action would change the issue. *Vance v. Campbell*, 1 Black, 427.

§ 1759. In an action of damages for infringement, plaintiff having given notice by his declaration of the term of user for which he sought damages, which was that of a renewal of the patent, he was held strictly bound thereby, and not allowed to cover term of original patent. *Eastman v. Bodfish*, 1 Story, 528.

§ 1760. In an amended declaration it is proper to state the citizenship of the parties in the present tense. *Birdsall v. Perego*, 5 Blatch., 251.

93. DECLARATIONS, ADMISSIBILITY IN EVIDENCE, OF INVENTOR'S.

See EVIDENCE, ADMISSIBILITY OF INVENTOR'S DECLARATIONS.

94. DECREE.

Decree — Pro confesso, §§ 1761-1764.

§ 1761. Decree in a judgment sustaining the validity of a patent rendered on a *pro confesso* is not such as to preclude a full inquiry in a subsequent suit. *Everett v. Thatcher*, 2 Flip., 234.

§ 1762. A decree taken *pro confesso* will not be set aside upon the mere presentation of a meritorious answer without other circumstances excusing laches. *Andrews v. Denslow*, 14 Blatch., 182.

§ 1763. A decree *pro confesso* having declared a reissue patent to be valid, the attempt to show before the master that it was for a different invention from the original, and void for unreasonable delay, *held* inadmissible; and the original patent, introduced pending the appeal, *held* also inadmissible. *Thomson v. Wooster*, 114 U. S., 104.

§ 1764. A decree *pro confesso* regularly entered up, declaring the validity of a patent and infringement by defendants, concludes the latter, so far as supported by the allegations of the bill. Decree *pro confesso* considered. *Ibid.*

See *Injunction, Preliminary*, § 3196.

Decree — Interlocutory, §§ 1765-1774.

§ 1765. Where infringement is to any extent admitted, if the patent is held valid, the correct practice is to enter an interlocutory decree for complainant and send the cause to a master to ascertain the amount which plaintiff is entitled to recover. *Carew v. Boston Elastic Fabric Co.*, 3 Cliff., 356.

§ 1766. In case of motions to suspend the interlocutory decree for a perpetual injunction, each court should, according to the facts presented, decide whether, in justice to the parties, the interlocutory decree should be suspended until the final determination of the suit or take immediate effect. *Brown v. Deere*, 2 McC., 425.

§ 1767. A decree is to be considered interlocutory whenever an inquiry as to matter of law or fact is directed preparatory to a final decree. When a decree finally decides and disposes of the whole merits of the cause, and reserves no further questions or directions for the future judgment of the court, so that it will not be necessary to bring the cause again before it for its final decision, it is a final decree. *Rumford Chemical Works v. Hecker*, 10 O. G., 289.

§ 1768. A mere interlocutory decree for gains, profits and damages against the manufacturer of infringing machines cannot operate as any defense in behalf of the purchaser of one of such machines. *Gilbert & Barker Manufacturing Co. v. Bussing*, 12 Blatch., 426.

§ 1769. Interlocutory orders and decrees are subject to revision until a final decree is made, and if, after an interlocutory decree, the master's report discloses facts, properly heard by him upon the order of reference, which, in the opinion of the court, should be further investigated, it is competent for the court to direct such an investigation. *Magic Ruffle Co. v. Elm City Co.*, 14 Blatch., 109 (EQUITY, §§ 1171-75).

§ 1770. Circumstances in which a court will refuse to open an interlocutory decree. *Ingersoll v. Benham*, 14 Blatch., 362.

§ 1771. An interlocutory decree is always open to amendment and correction. *De Florez v. Raynolds*, 17 Blatch., 436.

§ 1772. Interlocutory decrees remain under the control of the court and subject to its revision until the master's report comes in and is finally acted upon by the court; and therefore, upon final hearing, the court is at liberty to interpret the law in the light of decisions announced since the rendition of the interlocutory decree. *Wooster v. Handy*, 21 Fed. Rep., 51.

§ 1773. An interlocutory decree rendered some years since may be overruled at final hearing, in view of decisions on the questions of law involved made in the interval between the interlocutory and final decrees. *American Diamond Drill Co. v. Sullivan Machine Co.*, 21 Fed. Rep., 74.

§ 1774. Application to open an interlocutory decree for the purpose of setting up a new defense, because, as alleged, the defendants were misled in preparing their defense by a false allegation in the bill of complaint, refused on the ground of laches, more than twelve years having elapsed since the filing of the bill of complaint. *Willimantic Linen Co. v. Clark Thread Co.*, 32 O. G., 1356.

See *Estoppel, by Judgment and Decree*, §§ 2231-2237.

Decree — When conclusive, §§ 1775-1784.

§ 1775. In order that a decision of the United States court in another district shall be considered *res judicata*, the matters in controversy should be fully settled, and a final decree entered. *Rumford Chemical Works v. Hecker*, 10 O. G., 289.

§ 1776. A decree for infringement was entered against Wright and a co-defendant, and, pending the report of the master, the former associated another party with him as partner, and engaged in the manufacture of the patented article in another district. *Held*, that Wright's present partner is so far in privity with the former case by his partnership relation to Wright that he is bound by the decree. *Dayton v. Wright*, 11 O. G., 197.

§ 1777. A decree by the court, made at the request and in accordance with an agreement of the parties litigant, not effective against others not parties thereto. *Spring v. Domestic Sewing Machine Co.*, 16 O. G., 721.

§ 1778. A decree by consent of parties litigant should have very little weight in any court when produced as an adjudication in favor of the validity of the patent. *Ibid.*

§ 1779. A decision in a previous suit in the same court between other parties, determining the validity of the same reissue and the identity of the defendant's apparatus, will not be disturbed without cogent reasons. *Odorless Excavating Apparatus Co. v. Clements*, 16 O. G., 854.

§ 1780. On suit brought for injunction, and account, where the question is, whether the decree rendered in the action between the same parties precludes all inquiry as to the right of defendant to make and sell devices such as he is making, the burden is upon plaintiff. *Clarke v. Johnson*, 16 Blatch., 495.

§ 1781. This suit barred by the decree in the former suit between the same parties and upon the same issues, in which it was held that the invention claimed by the plaintiff was anticipated, and that his patent was invalid. *Barker v. Stowe*, 11 Fed. Rep., 303.

§ 1782. Although the court will not vacate a decree at the instance of strangers, third parties having an interest may, in a proper case, have a further hearing. *Cochrane v. Deener*, 5 Otto, 355.

§ 1783. Where appellant, upon whom rested the burden of proving infringement, failed to produce the necessary proof, the decree below was affirmed. *Price v. Kelley*, 20 O. G., 1452.

§ 1784. A decree rendered against a plaintiff because of his failure to reply to a plea or set it down for argument is not conclusive, since all the authorities agree that in order to constitute the former judgment or decree a bar it must appear that the point in issue was judicially determined after a hearing and upon consideration of the merits. *Keller v. Stolzenbach*, 20 Fed. Rep., 47.

See *Acquiescence*, § 149. *Appeal*, § 244. *Damages and Profits*, § 1478. *Practice*, § 4817.

Decree — Motion to reverse, §§ 1785-1788.

§ 1785. Under section 701, Revised Statutes, application to affirm, modify or reverse a decree of the circuit court should be made to the supreme court, and such an application made to the circuit court after appeal taken was not entertained. *Roemer v. Simon*, 2 B. & A., 72.

§ 1786. Motion by a stranger company to vacate or modify certain decrees, on the ground that they were being used to obtain injunctions against itself in other circuits, refused, where said decrees had been obtained by consent of the parties, but it did not so appear in the decrees. Power to grant such motion on application of a stranger doubted. *Washburn & Moen Mfg. Co. v. Colwell Steel Barb Fence Co.*, 1 Fed. Rep., 225.

§ 1787. Where motion was made by a stranger for leave to intervene and vacate decrees entered into by consent, but which fact did not appear in the decrees, sustaining the validity of certain patents, the motion alleging that the decrees were, to a certain extent, used against him or his agents elsewhere, and seeking to modify them, so that the true circumstances in which they were obtained should appear, the motion was refused. *In re Iowa Barbed Steel Wire Co.*, 5 B. & A., 279.

§ 1788. Where the evidence of new witnesses as to prior use, introduced on rehearing, was merely cumulative and less persuasive than the evidence to the same point on the former trial, held, that the decree should not be disturbed. *American Bell Telephone Co. v. People's Telephone Co.*, 25 Fed. Rep., 725.

Decree — Final, §§ 1789-1792.

§ 1789. A final decree in an equity suit awarded a recovery in favor of the complainants for a specified amount, and then proceeded to decree that the defendants pay to the master the sum of \$500 allowed to him as his compensation, less such sum as the defendants had already paid him, and that the complainants have execution for the sum awarded to them. The defendants appealed from the whole of the decree, giving the complainants a bond to respond for the amount which the decree awards to the complainants as a recovery, and a citation was issued and served. The defendants, having previously paid the master \$35, refused to pay more; and the master applied for an attachment against them for \$465. Held, that the provision for the payment of the master was not subject to be stayed in its operation by proceedings such as are employed to stay the execution of a decree *inter partes*. The attachment was granted. *Myers v. Dunbar*, 12 Blatch., 380.

§ 1790. Whenever a final decree is entered by the court in an equity cause, after replication filed, for the purpose of taxation of the docket fee, this is to be considered as the "final hear-

ing" referred to in section 824, Revised Statutes. *Goodyear Dental Vulcanite Company v. Osgood*, 13 O. G., 325.

§ 1791. In the taxation of costs, "final hearing" is to be considered as the submission of a case in equity for the determination of the court after the case is at issue. *Ibid.*

§ 1792. Although there has been an interlocutory decree for the orator, still, as upon the master's report the orator is not entitled to recover, a final decree for the defendants is proper. *Steam Stone Cutter Co. v. Sheldons*, 21 Fed. Rep., 875.

See *Appeal*, § 247.

Decree — Generally, §§ 1793-1812.

§ 1793. It is the usual practice to make a perpetual injunction part of the decree which finds the infringement. *Potter v. Mack*, 3 Fish., 428.

§ 1794. Where the decree of the court dismissed the bill of complainant with costs, *held*, that it did not necessarily imply the finding of one of the two interfering patents in such suit to be void and inoperative, and that such decision cannot be received in another court as amounting to the positive and affirmative declaration demanded by the statute regarding interfering patents. *Tyler v. Hyde*, 2 Blatch., 308.

§ 1795. The reason for which English chancellors have refused a decree for an account where they could not decree an injunction does not apply to controversies in the federal courts involving the rights of patentees under the laws of the United States. *Smith v. Baker*, 5 O. G., 496.

§ 1796. The decree of a court of probate appointing an administrator can only be impeached in a direct proceeding for that purpose before a tribunal which has jurisdiction over the matter; not in an action upon a patent granted to him as the representative of the inventor. *N. W. Fire-Extinguisher Co. v. Phila. Fire-Extinguisher Co.*, 6 O. G., 34.

§ 1797. Whether, in a suit brought against the respondents *as copartners*, but in which the proofs fail to show a partnership, but do show that the respondents with others were organized into a corporation, with the same name as the alleged copartnership, it would be competent for the court to enter a decree against the *corporation, quere*. *Needham v. Washburn*, 4 Cliff., 254.

§ 1798. In such case the court will not delay the hearing of the cause, since the defect, if it be one, may be cured by an amendment. *Ibid.*

§ 1799. A decree for damages "for all profits made in violation of the rights of the complainants, under the patent, by respondents, by the manufacture, use or sale of the articles named in the bill," is correct. *Rubber Co. v. Goodyear*, 9 Wall., 788.

§ 1800. The sale of articles made under the sanction of a patent, not considered at the trial of the case, cannot be regarded as covered by a decree in such suit, unless a strong and obvious case of infringement beyond all question or mere colorable difference is made out. *Buerk v. Imhaeuser*, 11 O. G., 112.

§ 1801. Neither the act of 1839 nor rule 47 of this court (S. D. of N. Y.) enables the circuit court to make a decree in a suit in the absence of a party whose rights must necessarily be affected by such decree, and the objection may be taken at any time at the hearing or in the appellate court. *Florence Sewing Machine Co. v. Singer Sewing Machine Co.*, 8 Blatch., 113.

§ 1802. Inventions secured by letters patent are presumed to be new and useful until the contrary is shown; and in the absence of countervailing proof, that *prima facie* presumption is sufficient to entitle the complainant to a decree in a suit for infringement. *Thomas v. Shoe Machinery Manufacturing Co.*, 16 O. G., 541.

§ 1803. The fact that the judgment in a former suit was obtained without resistance does not, in the absence of collusion, make it less strong evidence of the validity of the patent. *McWilliams Manufacturing Co. v. Blundell*, 11 Fed. Rep., 419.

§ 1804. Where the decision of a circuit court is a simple one — such as affirmance or reversal, or the like — it constitutes a decree, from which appeal may be taken to the supreme court, and a decree afterward entered will be regarded as having the date of the decision. *Barker v. Stowe*, 11 Fed. Rep., 303.

§ 1805. It being made to appear to the court by the petition of strangers to the record that a decree was obtained by collusion between complainant and defendant, it is annulled and the cause dismissed. *Barker v. Todd*, 15 Fed. Rep., 265.

§ 1806. *Semble*, that if a final decree in an action for infringement by manufacture and sale were made, and the amount which should be thereby awarded to the complainants should be paid, it would be held an indirect affirmance of all sales made and accounted for, or a satisfaction of the damages resulting from such sales, so that as to the particular machines so made and sold, there would result to the purchaser a right to hold and take the benefit of his purchase. *Gilbert & Barker Mfg. Co. v. Bussing*, 12 Blatch., 426.

DECREE AND JUDGMENT, ESTOPPEL BY — DEFENSES. §§ 1807-1815.

§ 1807. When the validity and infringement of the letters patent are supported by statement of facts admitted by defendant, who also admits the want of any valid defense, the judgment must be for complainant and decree accordingly. *Franz & Pope Knitting Machine Co. v. Lamb Knitting Machine Manufacturing Co.*, 19 O. G., 1000.

§ 1808. When suit is brought on two patents, but after testimony is taken in respect to one of them the plaintiffs make a motion for leave to discontinue so much of the bill as relates thereto, *held*, that the decree should be for dismissal, with the condition that the evidence taken by the defendants in relation to the patent may be stipulated into any future suit between the same parties. *Brush v. Condit*, 20 Fed. Rep., 826.

§ 1809. The words "perpetual injunction" in a decree mean only for the life of the patent. *De Florez v. Raynolds*, 17 Blatch., 436.

§ 1810. *Held*, that a decree under foreclosure conveys the right to use the patented machine sold, in the absence of an intention to limit such right expressed in the decree. *Detweiler v. Voegel*, 19 Blatch., 482.

§ 1811. In view of decisions in certain suits in which the complainants in this case occupied a similar position, and in which the defendants herein were closely identified with the defendants therein, although not in such sense privies as to effect an estoppel, the court declined to render a decree until a rehearing (the motion for which had been made) had been had of the former cases, and an opportunity thus afforded for a consideration in them of recent decisions of the supreme court on the subject of reissues. *Tuttle v. Loomis*, 30 O. G., 344.

§ 1812. It cannot be the duty of the court to render a money decree for the infringement of a void patent, even though that defense (the invalidity of the patent) is not properly made by the respondent. *Nicodemus v. Frazier*, 19 Fed. Rep., 260.

See *Injunction, Provisional*, § 3223. *Injunction*, §§ 3346-3351.

95. DECREE AND JUDGMENT, ESTOPPEL BY.

See ESTOPPEL, BY JUDGMENT AND DECREE.

96. DECREERING PATENTS TO BE VOID.

See REPEAL OF PATENTS.

97. DEEDS.

§ 1813. What is the technical delivery of a deed. *Hammond v. Hunt*, 4 B. & A., 111.

§ 1814. Construction of deeds, general principles. *Goodyear v. Cary*, 4 Blatch., 271.

§ 1815. Where a license executed by the complainant is in the possession of the defendant and is produced by it on the trial, and on its face is absolute and without any limitation or condition, the burden of proof is upon the complainant to show that it was delivered as an escrow. *Mellon v. Delaware, Lackawanna & Western R. Co.*, 21 O. G., 1616.

98. DEFECTIVE PLEA.

See PLEA, DEFECTIVE.

99. DEFECTIVE SPECIFICATION.

See SPECIFICATION, DEFECTIVE.

100. DEFENSES.

See FRAUD, IN PROCURING PATENT, DEFENSE OF. FRAUD, IN PROCURING REISSUES, DEFENSE OF. PUBLICATION, PRIOR, DEFENSE OF. USE, PRIOR, DEFENSE OF. NOVELTY, DEFENSE, WANT OF.

SUMMARY (*BATES v. COE*, §§ 1816-1830) — *Special defenses*, §§ 1816-1819. — *Notice of*, § 1817. — *The patent considered*, § 1818. — *Rule for construction of patents*, § 1820. — *Reissues, identity with original*, § 1821. — *Patent prima facie evidence of first inventorship*, § 1822. — *Combination of old elements is an entirety*, § 1823. — *Identity, how determined*, § 1824. — *Prior use, rule stated*, § 1825. — *Secret invention*, § 1826. — *Assignment of errors*, § 1827. — *Defenses, to what addressed*, § 1828. — *Joinder of invention*, § 1829. — *Burden of proof*, § 1830.

BATES v. COE.

(8 Otto, 31-50. 1878.)

APPEAL from U. S. Circuit Court, Southern District of Ohio.

§ 1816. *Special defenses.*

Opinion by MR. JUSTICE CLIFFORD.

Persons sued as infringers in a suit in equity, if they give the required notice in their answer, may prove at the final hearing the same special matters in defense to the charge of infringement as those which the defendant in an action at law may set up under like conditions.

Defenses of the kind which it is important to notice in the present case are the following: 1. That the patentee is not the original and first inventor of any material and substantial part of the thing patented. 2. That the improvement had been patented or described in some printed publication prior to the supposed invention. 3. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

§ 1817. *Notice of special defenses, where given.*

Notices of the kind, when the suit is in equity, may be given in the answer or amended answer; and if the defense is previous invention, knowledge or use of the thing patented, the respondent must state in the notice the names of the patentees, and the dates of their patents and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used. Each of these defenses, it will be seen, goes to the entire invention, and not to separate parts of the thing patented; and the provision is, that if any one or more of the special matters alleged shall be found for the defending party, the judgment or decree shall be rendered in his favor, with costs. R. S. (2d ed.), sec. 4920.

Evidence to sustain the second defense is sufficient, if the patent introduced for the purpose, whether foreign or domestic, was duly issued, or the complete description of the invention was published in some printed publication prior to the patented invention in suit; and the patent offered in evidence or the printed publication will be held to be prior, if it is of prior date to the patent in suit, unless the patent in suit is accompanied by the application for the same, or unless the complainant introduces parol proof to show that his invention was actually made prior to the date of the patent, or prior to the time the application was filed.

Neither the defendant in an action at law, nor a respondent in an equity suit, can be permitted to prove that the invention described in the prior patent, or the invention described in the printed publication, was made prior to the date of such patent or printed publication, for the reason that the patent or publication can only have the effect as evidence that is given to the same by the act of congress. Unlike that, the presumption in respect to the invention described in the patent in suit, if it is accompanied by the application for the same, is that it was made at the time the application was filed; and the complainant or plaintiff may, if he can, introduce proof to show that it was made at a much earlier date.

§ 1818. *Patent No. 37,433, C. W. Coe, January 20, 1863, drilling and screw-cutting machine, considered.*

Improvements, it seems, were made by the complainant in drilling and bolt-

tapping machines, called in the introductory part of the specification a new and improved drilling and screw-cutting machine, for which he, on the 20th of January, 1863, received letters patent in due form; and the record shows that on the 19th of February, four years later, he surrendered the same, and that a new patent, being the reissued patent in suit, was granted to him for the same invention. Special reference is made in the specification to the figures given in the drawings for a description of the invention, and they show, beyond doubt, what the specification alleges, that the invention relates to a novel and improved arrangement of the parts of a machine constructed and designed for the purpose of drilling and cutting screws; nor is it doubted that the allegation of the patentee is true, that it affords to the operator engaged in cutting screws considerable advantages beyond what he would obtain by the use of the ordinary hand-machine.

Inventors, before they can receive a patent, are required to file in the patent office a written description of their invention, and of the manner and process of making and using the same, in such full, clear, concise and exact terms as to enable any person skilled in the art to make, construct and use the same. Pursuant to that requirement, the patentee gave a particular and full description of all the operative devices of the machine, even to the minutest, and of the function performed by each, and of the mode of operation of the whole, when the machine is put in motion, including the devices employed when the machine is operated by steam. The devices may be divided into two classes: 1. Those employed to do the work. 2. Those employed to operate the machine, whether by steam or by hand.

Constituted, as the machine is, of numerous devices operating as a whole, it is scarcely possible to define its operations without first taking into the account its separate parts. Of course it has a frame secured to some appropriate fixture, which constitutes, directly or indirectly, the support of all the parts of the machine. Operated, as the machine is, by power, which may be either steam or hand power, it follows almost necessarily that it has a shaft, which in this machine is fitted horizontally in the upper part of the frame, with a fly-wheel at one end and a bevel-pinion at the other, which latter device gears into the bevel-wheel shown in the drawings, the shaft of which is fitted in suitable bearings on the upper part of the frame and at right angles with the main shaft, as shown in the second figure of the drawings, the outer end of the last-named shaft being provided with a crank.

Besides the pinion already mentioned, there is another, called a bevel-pinion, which also gears into the same wheel, the statement being that it is fitted loosely on the shaft of the wheel in such a manner that the shaft may rise and fall independently of the wheel, and the latter be made at the same time to rotate the shaft, which is tubular at its lower end, and is provided with a set-screw, by which a drill or screw-cutting die may be secured in it. In addition to that, there is a vertical screw, which works in a nut on the upper part of the frame, the lower end of the screw being connected by a swivel-joint with the upper end of the tubular shaft. On the screw above the nut there is placed a ratchet, fitted on the screw in such a manner that when turned it turns the screw, and at the same time admits the latter to rise and fall under the action of the nut.

Speaking of the ratchet, the patentee states that it is turned by means of a pawl which is connected by a pivot to the arm, the latter being attached to the frame of the machine by a pivot. Connected with the arm is a spring,

which has a tendency to keep the outer or free end of the pawl in contact with the face of the wheel, which is of such a shape as to form a cam and operate the pawl, so that the latter will turn the ratchet and cause the ratchet as it rotates to turn the screw, the ratchet causing the same to descend as it is turned, so that the tubular shaft will be forced down and the drill fed to its work. Such is the described mode of operation of the working devices when the motive power is steam; but the patentee states that it is easy to throw the pawl back so that it can no longer be operated by the cam, in which event the drill must be fed to its work by hand, which is done by turning the screw by means of the handle attached to the wheel on the top of the screw.

Next follows the description of that feature of the machine which may be denominated the screw-cutting apparatus. Brief as the description is, it is obviously sufficient to justify the patentee in his claim that it is both new and useful. He commences by stating that the base of the frame has an oblong opening made through it vertically to receive the shanks of the jaws constituting the vice, one of which has the ends of the yoke, so called, bolted to it. Two screws are also described, one of which passes through the semicircular end of the yoke, and the other passes into the jaws of the vice. These jaws are for the purpose of clamping or holding the rods on which screws are to be cut. Such rods are clamped firmly between the jaws by turning the screw that passes through them which constitutes the vice, the screw-cutting die being screwed in the lower end of the tubular shaft, and the pawl being disengaged from the ratchet. No feed movement is required in the operation, as the jaws and rod rise and fall under the action of the die, the shanks of the jaws serving as guides. When more speed is required for either drilling or screw-cutting than can be obtained by turning the bevel-wheel, it is accomplished by applying additional power to the main shaft, which shows that the machine is adapted to both heavy and light work.

§ 1819. *Special defenses.*

Service was made; and the respondents appeared and filed an answer setting up several defenses, as follows: 1. That the complainant is not the original and first inventor of the alleged improvement. 2. That the alleged improvement, in all its parts, was fully described in the several patents, printed publications, and rejected applications for patents set forth in the answer, prior to the alleged invention thereof by the complainant. 3. That the improvement secured by the reissued patent is not for the same invention as that embodied in the original patent. 4. That the alleged improvement was in public use and was known to divers persons in the United States prior to the alleged invention thereof by the patentee, more particularly set forth in the amended answer subsequently filed by leave of court. 5. That the respondents have not infringed the alleged invention, and that if they have, the complainant has not suffered any damages by such infringement.

Proofs were taken, hearing had, and the court entered a decree in favor of the complainant, and sent the cause to a master to compute the gains and profits of the infringement made by the respondents. Prompt report was made by the master, to which both parties excepted; but it is wholly unnecessary to notice the exceptions of the complainant, as he did not appeal; nor is it necessary to give much consideration to the exceptions filed by the respondents, as the assignment of errors varies materially from the exceptions taken to the master's report. Both parties appeared and were heard; and the court confirmed the report of the master as to the amount awarded, and entered a

final decree that the complainant recover of the respondents the sum of \$290 and costs; from which decree the respondents appealed to this court.

Since the appeal was entered here the respondents have filed the following assignment of errors: 1. That the circuit court erred in finding that the respondents had infringed the first claim of the reissued patent. 2. That the court erred in finding that the complainant was the original and first inventor of the improvement specified in the second claim of the patent. 3. That the court erred in finding that the respondents had infringed the second claim of the patent. 4. That the court erred in finding that the respondents had infringed the third claim of the patent. 5. That the court erred in finding that the complainant was the original and first inventor of the improvement specified in the fourth claim of the patent. 6. That the court erred in finding that the respondents had infringed the fourth claim of the patent. 7. That the court erred in adjudging that the reissued patent is a good and valid patent. 8. That the court erred in confirming the fifth finding in the report of the master. 9. That the court erred in the construction given to the reissued patent.

Annexed to the specification are the claims of the patent, which are as follows: 1. The arrangement of the three bevel-wheels in such a manner that the tubular shaft may be revolved with more or less speed and power for the different purposes to which the machine may be adapted. 2. The automatic feed arrangement, consisting of the ratchet, pawl, spring and cam, whereby the drill is fed to its work, the arrangement being so made that it can be detached and the drill fed by hand. 3. He also claims the vice for holding the rods for making screws, in combination with the machine, the vice consisting of the described jaws and the described screw arranged in the base of the frame. 4. Finally, he claims the combination of the tubular shaft and the described vertical screw with the pinion and nut, whereby the rotary motion and the necessary feed is given to the drill, as described in the specification.

§ 1820. *Construction of patents and specifications must be reasonable. Rules for construing patents.*

Cases arise not unfrequently where the actual invention described in the specification is larger than the claims of the patent; and in such cases it is undoubtedly true that the patentees in a suit for infringement must be limited to what is specified in the claims annexed to the specification, but it is equally true that the claims of the patent, like other provisions in writing, must be reasonably construed, and in case of doubt or ambiguity it is proper in all cases to refer back to the descriptive portions of the specification to aid in solving the doubt or in ascertaining the true intent and meaning of the language employed in the claims; nor is it incorrect to say that due reference may be had to the specifications, drawings and claims of a patent, in order to ascertain its true legal construction. *Brooks v. Fisk*, 15 How., 215.

Apply that rule to the case, and it follows that there is no substantial variance between the claims of the patent and the description of the invention or inventions described in the specification. In construing patents it is the province of the court to determine what the subject-matter is upon the whole face of the specification and the accompanying drawings. *Curtis, Patents* (4th ed.), sec. 222.

In case of a claim for a combination, where all the elements of the invention are old, and where the invention consists entirely in the new combination of old elements or devices whereby a new and useful result is obtained, such

combination is sufficiently described if the elements or devices of which it is composed are all named, and their mode of operation given, and the new and useful result to be accomplished pointed out, so that those skilled in the art and the public may know the extent and nature of the claims, and what the parts are which co-operate to produce the described new and useful result. Curtis, Patents (4th ed.), sec. 289*a*, p. 275; Seymour v. Osborne, 11 Wall., 542 (§§ 5292-5322, *infra*).

Accurate description of the invention is required by law for several important purposes: 1. That the government may know what is granted, and what will become public property when the term of the monopoly expires. 2. That licensed persons desiring to practice the invention may know during the term how to make, construct and use the invention. 3. That other inventors may know what part of the field of invention is unoccupied. Gill v. Wells, 22 id., 27.

Sufficient has already been remarked to show that the invention in its primary feature is an improved machine for drilling, composed of the devices pointed out in the specification, which operate and perform the functions therein described, and which by their joint operation in the manner described accomplish the patented result; that the other feature of the invention is an improved vice constructed on the same frame, consisting of the several devices already described, and which operate in the manner described to accomplish the described result. Construed in that way, as the specification should be, it is clear that the whole invention, including the drill and the vice, is sufficiently described both in the specification and in the claims of the patent, and that the objection of the respondents in that regard must be overruled.

§ 1821. *Reissued patents.*

Reissued letters patent must be for the same invention as that secured in the original patent; and if it appears that such a patent is for a different invention, it is clear that it is void, as no such power is vested in the commissioner; but no such defense can be sustained in this case, as the original patent was not introduced in evidence. Persons seeking redress for the infringement of a reissued patent are not obliged to introduce the surrendered patent; and if the old patent is not given in evidence by the party sued, he cannot have the benefit of such a defense. Seymour v. Osborne, 11 Wall., 546 (§§ 5292-5322, *infra*).

§ 1822. *A patent is prima facie evidence and casts upon the defendant the burden of proving his defense.*

Power to grant patents is conferred upon the commissioner; and when that power has been duly exercised it is of itself, when introduced in evidence in cases like the present, *prima facie* evidence that the patentee is the original and first inventor of that which is therein described as his invention. Proof may be introduced by the respondent to overcome that presumption; but, in the absence of such proof, the *prima facie* presumption is sufficient to enable the party instituting the suit to recover for the alleged violation of his rights. Availing himself of that rule of law, the complainant in this case introduced the reissued patents referred to in the bill of complaint, the effect of which is to cast the burden of proof upon the respondent to prove his first defense,—that the complainant is not the original and first inventor of the alleged improvement. Both parol and documentary evidence is admissible to establish that defense; and, inasmuch as the same documentary evidence is sufficient to prove the second defense, the two defenses will be considered together.

§ 1823. *Defenses of the kind where the invention consists in a combination of old elements, incapable of division or separate use, must be addressed to the entire invention and not merely to separate parts of the thing patented.*

Throughout it should be borne in mind that such defenses are authorized by the act of congress, and that they are required to be addressed to the invention as described in the specifications and claims of the patent. None of the elements or devices of the patented machine are new, and the invention itself consists in a combination of old devices. Such a combination is an entirety, though more than one combination may be included in the same patent. *Gill v. Wells*, 22 Wall., 2-24.

Where there is only one combination of an entire character, incapable of division or separate use, the defenses of the kind mentioned must be addressed to the invention. Exact conformity to that rule was observed by the respondents in framing their answer in this case; and inasmuch as no parol evidence of any considerable importance was introduced to support the first defense, the two under consideration are substantially identical in respect to the proofs introduced in their support. Exhibits in great numbers were introduced by the respondents to establish those defenses, consisting of patents, printed publications and rejected specifications, of which those regarded as most material will be separately examined.

Briefly described, the invention embodied in the reissued patent is a hand-drill and screw-cutter, designed for ordinary mechanical use, with five constituent or elementary parts: 1. The frame to support the operating mechanism, with a base for holding the material to be wrought or worked. 2. Bevel-gearing for driving a shaft or spindle propelled by manual power, capable of running at two speeds, and arranged so that the operator who turns the crank can properly adjust and attend to the material and cause the several parts of the machine to work harmoniously. 3. Automatic and hand-feeding devices, so arranged to the machine as to be easily controlled by the operator to give vertical motion to the spindle when used for drilling. 4. A shaft or spindle for holding the tool for performing the work, constructed and arranged in the machine so that it may be fed automatically or by hand, or by both, and so connected by a pinion to the crank that it can receive rotary motion independent of its vertical feeding motion, by means of which it is enabled to act as a screw-cutter. 5. A vice attachment for holding rods when the machine or spindle is receiving rotary motion only and is cutting screws.

Screw-cutting requires the drill to be made vertical, so as to allow the vice to rise and fall under the action of the die, in which respect the invention differs from all other hand-drills described in the record. Owing to the peculiar construction of the machine, it is adapted to drilling, and may be converted into a screw-cutter by placing a vice in the opening of the base and detaching the feed devices. Arranged as it is, it may be propelled at two different speeds, so that it can have more or less power either to cut screws or drill holes, simply by changing the point where power is applied. When the greater power and less speed is required, the smaller gear is used; and when greater speed and less power is required, the larger gear is used as the driving-pinion,—the change being only in the use of pinions acting on the driving-gear.

Exhibit 1, introduced by the respondents, is a wooden model of a part of a planer. Unquestionably, it shows a cam, spring, ratchet and pawl; but they are not combined so as to give vertical or lateral motion to a revolving spindle,

and as separate devices will perform no useful function. They are connected by a series of rods and levers, but they give simply an intermittent motion to the shaft. Instead of that, the device of the reissued patent employs in connection with the spindle a swivel-joint, nut and screw, to give vertical as well as rotary motion to the shaft.

§ 1824. *Identity, how determined.*

Devices in one machine may be called by the same name as those contained in another, and yet they may be quite unlike, in the sense of the patent law, in a case where those in one of the machines perform different functions from those in the other. In determining about similarities and differences, courts of justice are not governed merely by the names of things; but they look at the machines and their devices in the light of what they do, or what office or function they perform, and how they perform it, and find that a thing is substantially the same as another, if it performs substantially the same function or office in substantially the same way to obtain substantially the same result; and that devices are substantially different when they perform different duties in a substantially different way, or produce substantially a different result. *Cahoon v. Ring*, 1 Cliff., 620.

Reference will next be made to the patent of Amos Morgan, dated May 30, 1844, and called exhibit 3. It is what is called a horizontal machine, and is so arranged that all parts of the operative machinery, including the feeding devices and driving machinery, move forward on ways like the carriage of a mill. Unlike the invention of the reissued patent, it has but one speed for the spindle, which is imparted by two pinions. Two pinions are also employed to feed the spindle when the machine is to bore wood. When iron is to be drilled, two cams are employed, which are put through the driving-shaft, and made to slip out and in so as to adjust the apparatus to feed fast or slow. Suffice it to say that the claim of the patent, without entering further into the descriptive portion of the specification, shows that the two inventions are unlike in most or all of their essential features. It is not in any aspect a vertical machine, and it is without any such base for a vice as that exhibited in the reissued patent of the complainant, and is not at all adapted to be used as a screw-cutter; nor is it arranged with two speeds, nor with a cam fixed on the pinion driving the spindle, so that the automatic feed will always correspond, as in the patent in suit, with the speed of the spindle. Many other differences might be pointed out; but those given are amply sufficient to show that the exhibit has no tendency to support the defense for which it was introduced.

Next follows exhibit 4, which is a second patent granted to the same patentee for a small horizontal hand-drill, with one motion or speed. By the specification it appears that it is fed automatically by certain described devices, which are so entirely unlike those employed in the reissued patent, both in their combination and mode of operation, that it is not deemed necessary to waste words in their description, as it is clear that the invention, if any, secured by the patent, is in every material respect different from the patent in suit.

Nor will it be necessary to examine very fully two other exhibits introduced by the respondents, for the same reasons. They consist of two patents issued to George C. Taft, of which the first in date is for an improved drill-shaft apparatus, and in the construction of the machine, so far as respects its automatic feed arrangement, it bears a pretty strong resemblance to the mechanism described in exhibit 3, already somewhat fully described; but it is not adapted

to feed a drill running at different speeds, and in that respect bears no resemblance to the mechanism described in the reissued patent in suit. Complicated as the devices in the feeding apparatus are, it is quite difficult to compare the same with the more simple mechanism found in the machine of the complainant, except by saying that they are unlike the former in almost every important particular.

Three years later, the same patentee obtained another patent, called in this case exhibit 5, which is also for an improved hand-drill or drilling-machine of a horizontal construction. According to the specification, the invention consists in the arrangement and application of a support-piece to the slide-rod, together with a drill-shaft, and the operating mechanism of such shaft, by the employment of which the patentee is enabled to support not only the vibrating lever of the pawl, but other parts of the drilling apparatus, and particularly to employ a driving-shaft and certain gears for the purpose of increasing the speed of the drill-shaft.

Evidently it is an improvement grafted upon the prior invention of the patentee, bearing very little resemblance to the invention of the complainant, except that it has automatic feed devices, by which alone the drill is fed to the work. Precisely what the feed mechanism is it is difficult to state, as the only description given of it in the specification is the following: During the rotations of the drill-shaft the pawl mechanism will be put in action in such a manner as to turn the ratchet-gear and the tubular shaft, and thus cause the drill-shaft to be moved forward regularly and gradually, in order that the drill may be fed into an article during the process of drilling the same.

Should inquiry arise as to what the mechanism is that performs those functions, it is very clear that no one can answer the question without other means than those given in the specification. Better description is given of the operating devices of the machine, in respect to which it will be sufficient to say that they are quite unlike those shown in the specification of the complainant. Improvements in machinery for making envelopes and paper were made by E. W. Goodale, and the patents granted to him were introduced by the respondents as exhibits in the case to support the first and second defenses; but it is so obvious that they have no such tendency, that it is not necessary to give the exhibits any special examination.

Certain extracts from a printed publication were also introduced in evidence by the respondents for the same purpose, in respect to which it is only necessary to state that, in the judgment of the court, they fall far short of what is required in such a controversy to constitute satisfactory proof that the invention had been described in a printed publication prior to the invention of the complainant. *Seymour v. Osborne*, 11 Wall., 555.

These several exhibits have been carefully examined; and the conclusion of the court is, that there is not found in any one of them a machine with a frame secured as described in the complainant's specification to which a drill-spindle is attached by means of the device called a nut, with a hand-wheel and the described screw and the automatic feed devices, consisting of the ratchet carrying the drill-shaft, the pawl, and the spring keeping the lever in contact with the cam mounted on the hand-wheel, which is capable of being operated at two different speeds; nor is there found in any one of them the two kinds of feeding mechanism designed to be employed in the manner and for the purposes described in the complainant's specification. For these reasons the court is of

the opinion that the first and second defenses set up by the respondents in their answer and amended answer must be overruled.

§ 1825. *The rule of law as to the prior use of the alleged invention by other parties.*

Evidence of a parol character was also introduced by the respondents, having some slight tendency to prove that the complainant is not the original and first inventor of the patented improvement; but it is so slight, and so manifestly insufficient to overcome the *prima facie* presumption arising in favor of the complainant, that the court does not deem it necessary to enter into the details of the evidence. Suppose that is so, still it is insisted by the respondents that the improvement was in use in divers places in the United States prior to any alleged invention thereof by the complainant. Before proceeding to examine the evidence in that regard, it is proper to remark that the defense as pleaded does not state how long the invention had been in public use, nor does the answer state anything from which it can be inferred when the public use commenced, except that it was prior to any alleged invention thereof by the patentee. Authority is given by the act of congress to plead or set up in the answer that the invention had been in public use or on sale in this country for more than two years before the application for a patent. R. S. (2d. ed.), sec. 4920.

§ 1826. *Secret invention.*

Inventors may, if they can, keep their invention secret; and if they do for any length of time, they do not forfeit their right to apply for a patent, unless another in the meantime has made the invention, and secured by patent the exclusive right to make, use and vend the patented improvement. Within that rule and subject to that condition, inventors may delay to apply for a patent; but the patent act provides, as before stated, that the defending party in a suit for infringement may plead the general issue, and, having given the required notice, may prove in defense that the patented invention had been in public use or on sale for more than two years before the alleged inventor filed his application for a patent, and the provision in that event is, that if the issue be found for the party setting up that defense, the judgment or decree shall be in his favor.

Different phraseology was employed in a prior patent act, which made it necessary for the party setting up such a defense to prove that the invention had been in public use or on sale, with the consent and allowance of the patentee, before his application for a patent was filed. 5 Stat., 123. Decided cases adjudicated under that act and certain earlier acts show that a very limited public use or sale of the invention, if prior to the application and with the consent and allowance of the patentee, was held to be sufficient to defeat the right of the inventor to the protection of the patent act. *Pennock v. Dialogue*, 2 Pet., 19; *Whiting v. Emmet*, Baldw., 310; *Ryan v. Goodwin*, 3 Sumn., 518; *Wyeth v. Stone*, 1 Story, 281.

Congress, however, interfered, and provided that no patent shall be held to be invalid by means of such purchase, sale or use prior to the application of a patent, except on proof of abandonment to the public, or that such purchase, sale or prior use has been for more than two years prior to such application. 5 Stat., 354. Public use or sale, even under that provision, which was in the nature of an amendment to the earlier patent act, in order to defeat the right of the inventor to a patent, must have been for the period prescribed, with his consent and allowance. *Pierson v. Eagle Screw Co.*, 3 Story, 305.

Unlike that, the present patent act provides that the defending party, having given the requisite notice, may prove that the invention has been in public use or on sale in this country for more than two years before the inventor applied for a patent, and that if that special matter is found in his favor he is entitled to the judgment or decree with costs. Nothing of the kind is pleaded in the answer, nor is there anything in the record to support the proposition, if it had been well pleaded, from which it follows that the fourth defense must be overruled.

§ 1827. *Defenses not set up in the answer cannot be used as grounds for an assignment of errors.*

Two assignments of error, to wit, the second and the fifth, must not be passed over without comment. They are to the effect that the court erred in holding that the patentee was the original and first inventor of the respective improvements specified in the second and fourth claims of the patent.

Two objections to those assignments of error exist, each of which is sufficient to show that they cannot be allowed: 1. That there is no such defense set up either in the answer or amended answer. Nothing can be assigned for error which contradicts the record, nor can an appellant be allowed to assign for error the ruling of the court in respect to any defense not set up in his plea or answer. Appellate courts cannot amend the pleadings, nor can they allow that to be accomplished by an assignment of error. 2. Neither of those defenses is pleaded as required by the act of congress, as each is pleaded to a separate claim of the patent, and not to the invention which is embodied in the specification.

§ 1828. *Defenses to a charge of infringement of a patent, when the invention is an entirety, must be addressed to the whole invention and not to a part of it.*

Such defenses, if well pleaded to the invention described in the patent act, are good defenses, as the act of congress provides that the defending party may plead a general denial of the charge of infringement, and, having complied with the requirement as to notice, may give such special matters in evidence to defeat the patent. Under such a pleading and notice, the respondent in an equity suit may prove that the patentee was not the original and first inventor of the alleged improvement, or that it had been patented or described in some printed publication, or that the invention had been in public use or on sale in this country for more than two years prior to the application; and the provision is, that the judgment or decree must be in favor of the defending party, if he proves any one or more of these special matters.

Where the thing patented is an entirety, consisting of a single device or combination of old elements, incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication or machine, and another part in another prior exhibit, and still another part in a third one, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement.

Attempts of the kind are sometimes made; but it is plain that the plea, which in the action at law is the general issue, is required to be addressed to the entire charge of the declaration, and that its effect is to cast the burden of proof upon the plaintiff to make good the charge of infringement. Infringement is the charge made by the party seeking redress; and it is competent beyond all doubt for the defending party to show that he does not infringe at all,

or that he has infringed only a part of the claims of the patent. Authority for that proposition is found in the very nature of the issue between the parties; but the only authority for attacking the originality or validity of the patent is that given in the act of congress, and consequently the attack must be made in the mode the patent act prescribes. R. S., sec. 4920.

§ 1829. *Joinder of inventions in a single patent.*

Defenses of the kind must, if the thing patented be an entirety, and incapable of division or separate use, be addressed to the invention, and not merely to one or more of the claims of the patent if less than the whole invention. More than one patent may be included in one suit, and more than one invention may be secured in the same patent; in which cases the several defenses may be made to each patent in suit, and to each invention included in the bill of complaint. *Gill v. Wells*, 22 Wall., 24.

Combination patents may be mentioned as examples where more than one invention may be secured by a single patent, and in such a case the patentee may give the description of each combination in one specification. Cases of the kind often arise; and in such a case the party charged with infringement may plead and prove the statutory defenses to each invention, just as if the two combinations had been embodied in separate patents, for the reason that each combination in such a case, like what is secured in a division patent, must be regarded as a distinct invention, at least for the purpose of pleading the statutory defenses to the charge of infringement. Ample support to that proposition is found in the language of the patent act and in the practice of the courts; but where the patent is an entire invention, incapable of division or separate use, the defenses authorized by the act of congress must be addressed to the thing patented, and the evidence to support the defense must show that the patentee was not the original and first inventor, or establish some one of the other statutory defenses.

§ 1830. *The burden of proof and when it is shifted.*

Patentees seeking redress for the infringement of their patent must undoubtedly allege and prove that they are the original and first inventors of the alleged improvement, and that the same has been infringed by the party against whom the suit is brought. In the first place, the burden to establish both of those allegations is upon the party instituting the suit; but the law is well settled that the patent in suit, if introduced in evidence, affords to the moving party a *prima facie* presumption that the first allegation is true, the effect of which is to shift the burden of proving the defense upon the defending party. *Blanchard v. Putnam*, 8 Wall., 42; *Seymour v. Osborne*, 11 id., 538 (§§ 5292-5322, *infra*). Infringement being denied, the burden of proof is upon the complainant to establish the charge.

Where the invention is embodied in a machine, manufacture or product, the question of infringement, which is a question of fact, is ordinarily best determined by a comparison of the exhibit made by the respondent with the mechanism described in the complainant's patent. Both parties gave evidence upon the subject; but the weight of the proofs, in the judgment of the court, supports the affirmative of the charge.

Strong support to that view is derived from the stipulation filed in the case, in which the respondents admit that between the date of the patent and the filing the bill of complaint they made and sold drilling-machines with a vice attached, like complainant's exhibit B, which is equivalent to a confession of the charge, leaving open only the question as to the extent of the infringe-

ment. They also except to the master's report; but the exception is not well founded, and the amount of profits found being quite reasonable, it is clear that the decree of the circuit court is correct.

Decree affirmed.

Defenses — Particular — **Acquiescence of plaintiff; of public*, §§ 1831-1833. *Alienage of plaintiff*, § 1834. *Description of unnecessary parts*, § 1835; *useless parts*, § 1836. *Not original inventor*, §§ 1837-1839. *Patent of later date*, § 1840. *Patent issued through office error*, § 1841. *Public employment*, § 1842. *Res adjudicata*, § 1843. *Utility*, § 1844.

§ 1831. Where the defense to suit for infringement was plaintiff's acquiescence in defendant's infringement and laches in bringing suit, the infringing article not appearing to have been sufficiently on the market to prove that plaintiff must necessarily have known of it, the defense was not sustained. *Magic Ruffle Co. v. Elm City Co.*, 13 Blatch., 151.

§ 1832. When an invention is both new and useful, the want of public acquiescence cannot avoid infringing parties. *Hussey Manufacturing Co. v. William Deering & Co.*, 20 Fed. Rep., 795.

§ 1833. Though the defense of a permissive use, if acknowledged by complainant, might bar a suit for infringement, yet if defendant in his answer and proofs denies all recognition of the validity of the patent, such denial leaves complainant his standing in court, and a defense to the infringement must be made out to defeat his right to recovery. *Shaw v. Colwell Lead Co.*, 11 Fed. Rep., 711.

§ 1834. Under act 1793, plaintiff's alienage is a defense. So also is license. *Whittemore v. Cutter*, 1 Gall., 429.

§ 1835. An objection that a part of patentee's device is unnecessary is no defense to infringement, where it is used. *Blaisdell v. Puffer*, 4 B. & A., 500.

§ 1836. The objection that the specification describes and the claim covers a useless form or construction, as well as a useful one, is of no avail where the infringer uses the latter. The well known maxim applies: "*Utile per inutile non vitiatur*" — that which is serviceable is not to be rendered invalid by that which is useless. *Brown Manufacturing Co. v. Deere & Co.*, 21 Fed. Rep., 709.

§ 1837. Doubted whether in an action for the infringement of an art, it is a valid defense that patentee was not the inventor of one of the machines used in the art. *Evans v. Eaton*, Pet. C. C., 322.

§ 1838. The sixth section of the act of 1793, in enumerating the defenses to a patent, expressly specified that the prior invention must have "been in use." Under the corresponding section (section 15) of the act of 1836, from which these words are carefully excluded; the defense "that the patentee was not the original and first inventor or discoverer of the thing patented" is complete without showing that the first inventor had put his invention into practice. *Heath v. Hildreth*, 1 MacA. Pat. Cases, 12.

§ 1839. Besides these defenses the assignment of errors presented two others, not set up in the answer: 1. That the circuit court erred in holding that the patentee was the original and first inventor of the improvement specified in the second claim. 2. That the circuit court erred in holding that the patentee was the original and first inventor of the improvement specified in the fourth claim of the patent. Both of those claims refer to parts of the drilling feature of the improvement, which is merely a combination of old elements, and the court overruled the defenses for two reasons: 1. Because they were not set up in the answer. 2. Because they were addressed to a part only of an indivisible improvement and not to the entire invention, as required by the act of congress. *Bates v. Coe*, 8 Otto, 31 (§§ 1816-30).

§ 1840. Patents issued after an application is filed by another party afford no defense for infringing the patent granted upon such an application. *Johnson v. Fassman*, 1 Woods, 138.

§ 1841. The defense that a patent was issued unintentionally, through a blunder of a subordinate in the patent office, cannot be availed of in suit on the patent. For any such alleged invalidity, the only remedy would be a direct proceeding by the United States to vacate the patent. *Doughty v. West*, 6 Blatch., 429.

§ 1842. Public employment is no defense to the employee for having converted the private property of another to the public use without his consent, and without just compensation. *Cammeyer v. Newton*, 4 Otto, 225.

§ 1843. It is well settled that even after the validity of a patent has been established, and notwithstanding the presumption of its validity thereby raised, it may always be shown, in another suit on the patent against another defendant, and even in answer to an application for preliminary injunction in such suit, that the right claimed by plaintiff in the new suit was not, either as to its nature or its extent, fairly in controversy in the former suit, or that mate-

rial facts were not known or considered when the former suit was tried, or that there are relevant matters which were not adjudicated in the former suit. *Page v. Holmes Burglar Alarm Telegraph Co.*, 18 Blatch., 118.

§ 1844. Doubted if the defense of want of utility can be made under general issue in infringement suit. *Gray v. James*, Pet. C. C., 394.

See *Accounting*, § 139. *Jurisdiction*, § 3910. *Model*, § 4198.

Defenses — *Insufficient description*, §§ 1845-1847. *Substitution of material*, §§ 1848, 1849. *License*, §§ 1850, 1851.

§ 1845. The defense of insufficiency of description, not set up in the answer, is not open to the defendant. *Jennings v. Pierce*, 15 Blatch., 42.

§ 1846. Defense of insufficient description cannot be made when not set up in the answer. *Goodyear v. Providence Rubber Co.*, 2 Cliff., 351.

§ 1847. *Query*, whether the defense of insufficient description can be set up without alleging an intent to deceive the public? *Webster Loom Co. v. Higgins*, 105 U. S., 580.

§ 1848. The objection that the patent was for a simple substitution of one material for another, involving no invention, not having been set up regularly in the answer, was overruled. *Comstock v. Sandusky Seat Co.*, 13 O. G., 230.

§ 1849. The substitution of a known equivalent for one of the ingredients of a patented invention is not a good defense for an infringer; but if the ingredient was a new one or performed a substantially different function, or was not known at the date of the patent as a proper substitute for the one omitted, there is no infringement. *Fuller v. Yentzer*, 4 Otto, 288.

§ 1850. Defense that the acts of infringement were done under a license is an affirmative defense to be established by proof. *Watson v. Smith*, 7 Fed. Rep., 350.

§ 1851. In a suit by a patentee against a licensee for license fees for use of the patented improvement, something corresponding to the eviction of the licensee must be pleaded and proved, if he would defend against an action for royalty. *White v. Lee*, 14 Fed. Rep., 789.

Defenses — *Statutory defenses*, §§ 1852-1856. *In general*, §§ 1857-1860.

§ 1852. Defenses that may be made under general issue without notice (act 1793). *Kneass v. Schuylkill Bank*, 4 Wash., 9.

§ 1853. Where the thing patented is an entirety, the statutory defenses must be addressed to the invention itself, not merely to some one or more of the separate features which it comprises. *Kelleher v. Darling*, 4 Cliff., 424.

§ 1854. But this does not prevent each patent in suit, or each invention contained therein as set forth in the distinct claims, from being made the subject of separate pleas in defense, if the party so elects. *Ibid.*

§ 1855. All the defenses which the statute authorizes may be made as well in respect to patents granted upon applications renewed under the thirty-fifth section of the act of 1870 as in respect to those issued upon original applications. Lapse of time, *per se*, does not constitute abandonment. *United States Rifle & Cartridge Company v. Whitney Arms Co.*, 14 Blatch., 94.

§ 1856. Since the passage of the act of July 8, 1870, the regulation in equity suits is that defenses such as are described in section 61 of that act may be pleaded in any equity suit for relief against an alleged infringement, and that proof of the same may be given upon like notice in the answer of the respondent, and with like effect. *Roemer v. Simon*, 5 Otto, 214.

§ 1857. Defenses not set up in the answer will not be examined, and all such may be regarded as overruled on that account. *Howes v. Nute*, 4 Cliff., 173.

§ 1858. No defense to a bill will be permitted which has not been regularly embraced in the answer. *Russell & Erwin Mfg. Co. v. Mallory*, 10 Blatch., 140.

§ 1859. Defenses alleged in the answer must be proved, to be of any effect. *Collender v. Came*, 4 Cliff., 393.

§ 1860. A patentee is entitled to the presumptions arising from the grant of his patent, and in general, where infringers rely upon a defense which attacks the validity of the patent itself, they should be apprised of that defense themselves and give the patentee notice of it before the hearing of the cause. *American Saddle Co. v. Hogg*, 1 Holmes, 177.

101. DEGREE, PATENTABILITY OF.

See PATENTABILITY, OF DEGREE.

102. DEGREE OF UTILITY.

See UTILITY, DEGREE OF.

103. DELAY

See BILL OF REVIEW, §§ 612-617. BILL, SUPPLEMENTAL, § 624. CONSTRUCTION OF PATENTS, § 1223. REISSUES, §§ 5617-5656. DISCLAIMER, DELAY IN FILING. REISSUES, REASONABLE DELAY IN; UNREASONABLE DELAY IN.

Delay—In applying for patent, §§ 1861-1869. See *Application, Abandoned*, §§ 313-327. *Disclaimer*, §§ 2004-2015. *Invention, Secret*, §§ 3725, 3726.

§ 1861. Laches in securing a patent is not allowed. *Morris v. Huntington*, 1 Paine, 348.

§ 1862. *Seem*, that a matter of defense — such as delay in filing an application for a patent — which it is the peculiar province of the jury to decide, and which is not, by the seventh section of the act of 1836, made a ground for the refusal of a patent by the commissioner, should be left by him to be decided by the jury in a subsequent *action at law*. *Heath v. Hildreth*, 1 MacA. Pat. Cases, 12.

§ 1863. An argument not filed within the time limited, and for that reason objected to, may be received if a reasonable excuse is offered in explanation of the delay. *Screw Co. v. Sloan*, 1 MacA. Pat. Cases, 210.

§ 1864. The fact that an alleged inventor neglected to apply for a patent, although he knew that other persons had filed applications for the same invention, brings him within the reason of the rule that, when a man has been silent when in conscience he ought to have spoken, he will be debarred from speaking when conscience requires him to be silent. *McCormick v. Howard*, 1 MacA. Pat. Cases, 238.

§ 1865. Poverty of the inventor, and inability to engage in the manufacture of the invention, considered as excuses for delay. *Hill v. Dunklee*, 1 MacA. Pat. Cases, 475.

§ 1866. The main object of the patent laws is to bring inventions as soon as possible into public and unrestricted use; and this forms an essential part of the consideration — the *quid pro quo*. The public has a right to the knowledge as early as possible, consistently with the rights of the inventor in using such reasonable diligence on his part as may be necessary in adapting and perfecting his invention. *Ellithorpe v. Robertson*, 1 MacA. Pat. Cases, 585.

§ 1867. The measure of poverty which one must possess before he is required to exercise any diligence to prosecute his rights is not to be found in the statute. It is an excuse very readily made, which yet should not be too readily listened to. If a man be utterly destitute of money and without friends, and incapable thereby of prosecuting an enterprise, much indulgence may be shown him; but when he has the means of carrying on sundry enterprises of a kindred sort, equally demanding money and friends, and does carry them on, his election to pursue those other enterprises will not be regarded in the law as an excuse for delay in the other, where valuable rights of others, equally meritorious with himself, and, in the outset of their successful struggles, equally poor, are to be prejudiced. *Wickersham v. Singer*, 1 MacA. Pat. Cases, 645.

§ 1868. An inventor who seeks the monopoly afforded by a patent must present his perfected invention to the patent office at once. He cannot privately use the invention for his own gain during several years, and then claim and expect protection for fourteen years longer. *Spear v. Belson*, 1 MacA. Pat. Cases, 699.

§ 1869. The right of the first and original discoverer to a patent cannot be defeated by a subsequent patentee unless the latter shows that the former has been guilty of culpable neglect and laches. *Ibid.*

See *Abandonment*, §§ 14-31, 69-92.

Delay — Diligence in prosecuting application, §§ 1870-1873.

§ 1870. A patentee may take a reasonable time to prepare his application papers and to experiment, and the question of due diligence is for the jury in all circumstances of the case. *Whitney v. Emmett*, 1 Bald., 303.

§ 1871. Where an inventor, intending to apply for a patent, was misled into belief that his invention was anticipated, kept it secret, practiced it for his own benefit, and on being undeceived, applied and obtained his patent, *held*, that he had exercised reasonable diligence. *Ayling v. Hull*, 2 Cliff., 494.

§ 1872. A caveator has a reasonable time in which to mature his invention, and if he has used due diligence he has the right to have his matured invention incorporated into his patent,

and to supersede those who have intervened between the date of his first discovery and his taking out his patent. *American Nicholson Pavement Co. v. City of Elizabeth*, 3 O. G., 522.

§ 1873. The question of diligence is not an absolute but a relative one, and must be considered in reference to the subject-matter of the experiments. *Ibid.*

See *Abandonment*, §§ 7, 8. *Use*, § 6541.

Delay — Arising from patent office errors — Should not prejudice patentee, §§ 1874-1877.

§ 1874. Delay subsequent to filing of application, owing to mistakes of public officers, or delays of courts, where gross laches cannot be imputed to applicant, cannot affect his right. *Adams v. Jones*, 1 Fish., 527.

§ 1875. Patentees should not be prejudiced by delays of the patent office. *Goodyear Dental Vulcanite Co. v. Wetherbee*, 3 Cliff., 555; *Sayles v. Chicago & Northwestern R. Co.*, 1 Biss., 468.

§ 1876. Delays in the patent office which an inventor cannot prevent will not impair his title to his invention. *Henry v. Francestown Soap-Stone Stove Co.*, 9 O. G., 408.

§ 1877. A mistake on the part of the office in its judgment upon a case which does not create a delusion in the mind of the party as to his rights does not authorize him to indefinitely delay the further prosecution of the case, either by endeavoring to convince the office on rehearing of a palpable error, or by resorting to the easy and expeditious means for revising the decision upon appeal, as the statutes provide. *Wickersham v. Singer*, 1 MacA. Pat. Cases, 585.

Delay — Diligence in reduction to practice, §§ 1878-1882. See *Inventor, Prior*, §§ 3751-3761. *Priority of Invention*, §§ 4986-5023.

§ 1878. If an inventor unreasonably delays the reduction to practice of his invention until after such reduction to practice of a subsequent inventor, his patent is void. *Ransom v. Mayor of New York*, 1 Fish., 252.

§ 1879. But the doctrine that when two men independently discover the same thing, the one who first communicates it to the public (by reducing it to practice and using) is deemed the first inventor and entitled to a patent, is not supported to that extent by the cases cited, and would be unjust if it were, as it makes no exception of the *bona fide* inventor who is “*using reasonable diligence in adapting and perfecting*” his invention, whose right is saved by the spirit if not by the letter of the fifteenth section of the act of 1836. *Heath v. Hildreth*, 1 MacA. Pat. Cases, 12.

§ 1880. Nor is it necessary that the first inventor should use “reasonable diligence in adapting and perfecting his invention.” The fifteenth section of the act of 1836, providing that the defendant may show, in order to vacate a patent *already granted*, that it was surreptitiously obtained for an invention which was being diligently prosecuted by another, does not apply to the case of contending applicants. *Perry v. Cornell*, 1 MacA. Pat. Cases, 68.

§ 1881. On the other hand, when a prior inventor has been using reasonable diligence to perfect and adapt the invention to practice, all his rights will be preserved and protected, although his success may not have been perfect. *McCormick v. Howard*, 1 MacA. Pat. Cases, 238.

§ 1882. The diligence referred to in section 15 of the act of 1836 has no application to the case of interfering applicants. It applies to the case of a prior inventor defending against a patent surreptitiously granted to a subsequent inventor, and directly only in such a case, or where it appears that analogous principles are involved, and then only by an equitable construction of the rule. *Stephens v. Salisbury*, 1 MacA. Pat. Cases, 379.

Delay — In bringing suit, §§ 1883-1900. See *Injunction, Preliminary*, §§ 3123-3130

§ 1883. Courts of equity ought to demand of patentees reasonable diligence in asserting their rights. *Goodyear v. Honsinger*, 2 Biss., 1.

§ 1884. Negligence on the part of patentees in prosecuting infringers of a patented article or method under which they have granted licenses is unfair to their licensees. But the pendency of a suit in another circuit, where the right under the patent is to be tested, is so far a sufficient justification for failure to prosecute infringers. *Ibid.*

§ 1885. The general principles of equity jurisprudence control in patent cases (R. S., secs. 629 and 4921), and the question of laches in bringing suit for infringement can be raised by demurrer, and is a good defense to a bill in equity. (Walker on Patents, sec. 597.) *McLaughlin v. People's R'y Co.*, 21 Fed. Rep., 574.

§ 1886. Parties may forfeit their claim to receive the aid of a court of equity to the extent of its powers by their laches in restraining known violations of their rights and acquiescence in the assertion of adverse rights. *Magic Ruffle Co. v. Elm City Co.*, 14 Blatch., 109.

§ 1887. A delay in bringing action against infringers, when satisfactorily accounted for, is not to be treated as laches. *Green v. French*, 16 O. G., 215.

§ 1888. A plaintiff is not guilty of laches in bringing suit, who, while his patent is being litigated, delays until at least the first decree in his favor. *Green v. Barny*, 19 Fed. Rep., 420.

§ 1889. Where prompt notice of infringement was given, and was three times repeated, suit being delayed through press of business engagements of plaintiff's counsel, during which time defendant invested money in continuing the infringement, *held*, that mere forbearance to sue, under the circumstances stated, after the notice given, cannot, in the absence of any affirmative encouragement to the defendant, be held to affect the plaintiffs' right to a preliminary injunction in such a plain case as this is. *Collignon v. Hayes*, 8 Fed. Rep., 912.

§ 1890. A patentee is not guilty of acquiescence for neglecting to proceed at once against all who infringe. *McWilliams Manufacturing Co. v. Blundell*, 11 Fed. Rep., 419.

§ 1891. Where plaintiffs have not abandoned their invention either before or after patenting, neglect to prosecute for infringement will not bar their right to recover damages actually sustained. *Ransom v. Mayor of New York*, 1 Fish., 252.

§ 1892. Mere delay in bringing suit for infringement is not sufficient to establish an abandonment or dedication of the patent. There must be an acquiescence in the appropriation of the right of such character as reasonably to induce the belief that the owner intended to relinquish it to the public use. *Williams v. Boston & Albany R. Co.*, 17 Blatch., 21.

§ 1893. Mere delay in seeking relief when there is no estoppel will not in general prevent an injunction, though it may preclude the plaintiff from the right to an account for past profits. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 Fed. Rep., 638.

§ 1894. Where infringements by various parties and for considerable periods have been shown to have taken place during the life of the patent, but the circumstances fail to establish acquiescence in the instances when the infringement was known to the owners of the patent, there exists no such laches as would defeat an accounting. *Adams v. Howard*, 19 Fed. Rep., 317.

§ 1895. *Held*, there was no laches where suit was brought within six months. *Brick v. Staten Island R'y Co.*, 25 Fed. Rep., 553.

§ 1896. Where, with full knowledge on the part of plaintiff of defendant's infringement, he acquiesced for twenty-two months therein, *held*, that it amounted to such want of diligence that a motion for preliminary injunction based on the infringement was denied. *Sperry v. Logan*, 3 B. & A., 260.

§ 1897. Where plaintiffs prayed an injunction against an action of infringement brought against them, alleging an estoppel because defendants, after notifying certain manufacturers, plaintiffs' vendors, that they were infringers, failed to bring suit until a lapse of several years, during which such manufacturers had continued the infringement and sold certain of the devices to plaintiffs, *held*, that it was not equitable estoppel, but laches, the remedy for which was found in the statute of limitations. *City of Concord v. Norton*, 16 Fed. Rep., 477.

§ 1898. Where a patentee has for thirteen years acquiesced in infringement of his patent, and in his bill shows no excuse for his delay, nor ignorance of the conduct of the defendant, nor inability on the complainant's part to assert his rights, *held*, that whatever action at law he may have for damages, his own laches prevent a court of equity from interfering by injunction. *McLaughlin v. People's R'y Co.*, 21 Fed. Rep., 574.

§ 1899. The patentee's previous laches and indifference in regard to the use of his patents by defendant corporation, *held* sufficient to prevent the enforcement by a court of equity of the pecuniary claims of his vendee against it for infringements before the purchase of the patent. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 32 O. G., 1356.

§ 1900. A delay of five years on the part of a defeated patentee in an interference in the patent office to bring suit to have the patent of his adversary, to whom priority was awarded, declared void, no explanation of the delay being offered, considered by the court as bearing on his good faith. *Sawyer v. Massey*, 25 Fed. Rep., 144.

See *Acquiescence*, §§ 144, 145. *Defenses*, § 1831.

104. DEMURRER.

§ 1901. When a demurrer is overruled, when and upon what terms the defendant may have leave to answer further. *Woodworth v. Edwards*, 3 W. & M., 120.

§ 1902. Doubted whether defendant would be permitted to argue that a patent was in good form prior to reissue, after allegations in the bill of its defective character, and which the demurrer virtually admits. *Ibid.*

§ 1903. Variations between the declaration and the writ cannot be taken advantage of on general demurrer. *Wilder v. McCormick*, 2 Blatch., 31.

§ 1904. Objection that the bill does not allege joint infringement by the defendants should be taken by demurrer. *Fischer v. O'Shaughnessey*, 6 Fed. Rep., 92.

§ 1905. Demurrer will not be overruled on argument on the ground that an answer to the whole bill was filed simultaneously therewith, the plaintiff having waived the benefit of that objection by going to argument upon the demurrer. *Hayes v. Dayton*, 18 O. G., 1406.

§ 1906. A defendant may demur to part of a complaint and answer as to the residue, when the complaint joins several causes of action, but he cannot demur and answer to the same cause of action. *Goodyear Dental Vulcanite Co. v. White*, 17 Blatch., 5.

§ 1907. A demurrer to the whole bill will be overruled, if parts of the bill are maintainable. *Perry v. Littlefield*, 17 Blatch., 272.

§ 1908. Failure on part of complainant to set down demurrer for argument or to take testimony within three months after filing replication, not ground for dismissing bill if sufficiently explained. *Adams v. Howard*, 20 Blatch., 38.

§ 1909. A bill, under section 4918, Revised Statutes, interfering patents, which, upon proper averment, prays an adjudication concerning conflicting patents, and also alleges infringement of plaintiff's patent by defendant, and prays an accounting and damages, is not demurrable for misjoinder of causes of action. *Leach v. Chandler*, 18 Fed. Rep., 262.

See *Reissues*, § 5496.

105. DESCRIPTION.

See SPECIFICATION. PUBLICATION, PRIOR, SUFFICIENT DESCRIPTION.

106. DESIGNS.

SUMMARY (*GORHAM COMPANY v. WHITE*, §§ 1910-1912) — *What constitutes the essence of a design*, § 1910. — *Identity*, § 1911. — *Infringement*, § 1912.

GORHAM COMPANY v. WHITE.

(14 Wallace, 511-531. 1871.)

ERROR to U. S. Circuit Court, Southern District of New York.

STATEMENT OF FACTS.—The Gorham Company brought a bill to enjoin White from selling certain articles on the ground of their infringing plaintiff's design patent. The bill was dismissed, and complainant sued out a writ of error.

Opinion by MR. JUSTICE STRONG.

The sole question is one of fact. Has there been an infringement? Are the designs used by the defendant substantially the same as that owned by the complainants? To answer these questions correctly, it is indispensable to understand what constitutes identity of design, and what amounts to infringement.

§ 1910. *Appearance and not utility of a design controls the issue of a patent therefor.*

The acts of congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance, and that not an abstract impression or picture, but an aspect given to those objects mentioned in the acts. It is a new and original design for a manufacture, whether of metal or other material; a new and original design for a bust, statue, *bas relief*, or composition in *alto* or *basso relievo*; a new or original impression or ornament to be placed on any article of manufacture; a new and original design for the printing of woollen, silk, cotton, or other fabrics; a new and useful pattern, print or picture, to be either worked into, or on, any article of manufacture; or a new and

original shape or configuration of any article of manufacture,—it is one or all of these that the law has in view. And the thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form. The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. It therefore proposes to secure for a limited time to the ingenious producer of those appearances the advantages flowing from them. Manifestly the mode in which those appearances are produced has very little, if anything, to do with giving increased salableness to the article. It is the appearance itself which attracts attention and calls out favor or dislike. It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense. The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly, but, in whatever way produced, it is the new thing, or product, which the patent law regards.

To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities. As the acts of congress embrace only designs applied, or to be applied, they must refer to finished products of invention rather than to the process of finishing them, or to the agencies by which they are developed. A patent for a product is a distinct thing from a patent for the elements entering into it, or for the ingredients of which it is composed, or for the combination that causes it. We do not say that, in determining whether two designs are substantially the same, differences in the lines, the configuration, or the modes by which the aspects they exhibit are not to be considered; but we think the controlling consideration is the resultant effect. Such was the opinion of Lord Chancellor Hatherly in *McCrea v. Holdsworth*, 6 Ch. App. Cas., L. R., 418. That was a suit to restrain an infringement of a design for ornamenting a woven fabric. The defense was a denial that the design used by the defendants was the same as that to which the plaintiff was entitled. The ornament on both was, in part, a star, but on one it was turned in an opposite direction from that in the other; yet the effect of the ornament was the same to the eye. The lord chancellor held the important inquiry was whether there was any difference in the effect of the designs, not whether there were differences in the details of ornament. “If,” said he, “the designs are used in exactly the same manner, and have the same effect, or nearly the same effect, then, of course, the shifting or turning round of a star, as in this particular case, cannot be allowed to protect the defendants from the consequences of the piracy.” This seems most reasonable, for, as we have said, it is the effect upon the eye which adds value to articles of trade or commerce. So in *Holdsworth v. McCrea*, 2 Appeal Cases, H. of L., 388, Lord Westbury said, “Now, in the case of those things in which the merit of the invention lies in the drawing, or in forms that can be copied, the appeal is to the eye, and the eye alone is the judge of the identity of the two things. Whether, therefore, there be piracy or not is referred to an unerring judge, namely, the eye, which takes the one figure and the other figure, and ascertains whether they are or are not the same.” This was said in a case where there was nothing but a drawing of the design.

§ 1911. *Identity of design consists in sameness of appearance.*

We are now prepared to inquire what is the true test of identity of design.

Plainly, it must be sameness of appearance, and mere difference of lines in the drawing or sketch, a greater or smaller number of lines, or slight variances in configuration, if sufficient to change the effect upon the eye, will not destroy the substantial identity. An engraving which has many lines may present to the eye the same picture, and to the mind the same idea or conception as another with much fewer lines. The design, however, would be the same. So a pattern for a carpet, or a print may be made up of wreaths of flowers arranged in a particular manner. Another carpet may have similar wreaths, arranged in a like manner, so that none but very acute observers could detect a difference. Yet in the wreaths upon one there may be fewer flowers, and the wreaths may be placed at wider distances from each other. Surely in such a case the designs are alike. The same conception was in the mind of the designer, and to that conception he gave expression.

If, then, identity of appearance, or (as expressed in *McCrea v. Holdsworth*) sameness of effect upon the eye, is the main test of substantial identity of design, the only remaining question upon this part of the case is, whether it is essential that the appearance should be the same to the eye of an expert. The court below was of opinion that the test of a patent for a design is not the eye of an ordinary observer. The learned judge thought there could be no infringement unless there was "substantial identity" "in view of the observation of a person versed in designs in the particular trade in question — of a person engaged in the manufacture or sale of articles containing such designs — of a person accustomed to compare such designs one with another, and who sees and examines the articles containing them side by side." There must, he thought, be a comparison of the features which make up the two designs. With this we cannot concur. Such a test would destroy all the protection which the act of congress intended to give. There never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like that an expert could not distinguish them. No counterfeit bank-note is so identical in appearance with the true that an experienced artist cannot discern a difference. It is said an engraver distinguishes impressions made by the same plate. Experts, therefore, are not the persons to be deceived. Much less than that which would be substantial identity in their eyes would be undistinguishable in the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give. It is persons of the latter class who are the principal purchasers of the articles to which designs have given novel appearances, and if they are misled, and induced to purchase what is not the article they supposed it to be, if, for example, they are led to purchase forks or spoons, deceived by an apparent resemblance into the belief that they bear the "cottage" design, and, therefore, are the production of the holders of the Gorham, Thurber, and Dexter patent, when in fact they are not, the patentees are injured, and that advantage of a market which the patent was granted to secure is destroyed. The purpose of the law must be effected if possible; but, plainly, it cannot be if, while the general appearance of the design is preserved, minor differences of detail in the manner in which the appearance is produced, observable by experts, but not noticed by ordinary observers, by those who buy and use, are sufficient to relieve an imitating design from condemnation as an infringement.

§ 1912. *Substantial identity of appearance to an ordinary observer of two patented designs causes infringement of the first by the second one patented.*

We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

Applying this rule to the facts of the present case, there is very little difficulty in coming to a satisfactory conclusion. The Gorham design, and the two designs sold by the defendant, which were patented to White, one in 1867, and the other in 1868, are alike the result of peculiarities of outline, or configuration, and of ornamentation. These make up whatever is distinctive in appearance, and of these the outline or configuration is most impressive to the eye. Comparing the figure or outline of the plaintiffs' design with that of the White design of 1867, it is apparent there is no substantial difference. This is in the main conceded. Even the minor differences are so minute as to escape observation unless observation is stimulated by a suspicion that there may be diversity. And there are the same resemblances between the plaintiffs' design and the White design of 1868, and, with a single addition, the minor differences are the same. That additional one consists in this: At the upper part of the handle, immediately above the point where the broader part widens from the stem with a rounded shoulder, while the external lines of both designs are first concave and then gradually become convex, the degree of concavity is greater in the White design. How much effect this variance has must be determined by the evidence. In all the designs the ornament is, in part, a rounded moulding or bead along the edge, with scrolls at the shoulders and near the top. There are, however, some diversities in this ornament, which are discoverable when attention is called to them. In the plaintiffs', the bead is interrupted at the shoulders and at the tip by the scrolls, while in both the designs of White it is continued unbroken around the scrolls. In the plaintiffs', the scrolls turn inward at the shoulders and outward at the tip. In the White design they turn inward both at the shoulders and at the upper end. But there are the same number of scrolls in all the designs, and they are similarly located, all having the appearance of rosettes. In all the external bead is formed by a depressed line running near the edge of the handle, but in the plaintiffs' there is an inner line, making a second very thin bead, nearly parallel to the external bead common to them all. In the White designs this inner line is wanting on the stem of the handle, though not on the broad part; but, as the single line is wider, it presents much the same appearance as it would present if divided into two.

There are other small differences which it is needless to specify. What we have mentioned are the most prominent. No doubt, to the eye of an expert, they are all real. Still, though variances in the ornament are discoverable, the question remains, Is the effect of the whole design substantially the same? Is the adornment in the White design used instrumentally to produce an appearance, a distinct device, or does it work the same result in the same way, and is it, therefore, a colorable evasion of the prior patent, amounting at most to a mere equivalent? In regard to this we have little doubt, in view of the evidence. Both the White designs, we think, are proved to be infringements of the Gorham patent. A large number of witnesses familiar with designs, and most of them engaged in the trade, testify that, in their opinion, there is

no substantial difference in the three designs, and that ordinary purchasers would be likely to mistake the White designs for the "cottage" (viz., that of the plaintiffs). This opinion is repeated in many forms of expression, as, that they are the same pattern; that the essential features are the same; that seven out of ten customers who buy silverware would consider them the same; that manufacturers as well as customers would consider them the same; that the trade generally would so consider them; that, though there are differences, they would not be noticed without a critical examination; that they are one and the same pattern, etc., etc.

This is the testimony of men who, if there were a substantial difference in the appearance or in the effect, would most readily appreciate it. Some think the White designs were intended to imitate the other, and they all agree that they are so nearly identical that ordinary purchasers of silverware would mistake one for the other. On the other hand, a large number of witnesses have testified on behalf of the defendant that the designs are substantially unlike; but, when they attempt to define the dissimilarity, they specify only the minor differences in the ornamentation, of which we have heretofore spoken. Not one of them denies that the appearance of the designs is substantially the same, or asserts that the effect upon the eye of an observer is different, or that ordinary purchasers, or even persons in the trade, would not be led by their similarity to mistake one for another. Their idea of what constitutes identity of design seems to be that it is the possibility of being struck from the same die, which, of course, cannot be if there exists the slightest variation in a single line. They give little importance to configuration, and none to general aspect. Such evidence is not an answer to the complainants' case. It leaves undisputed the facts that whatever differences there may be between the plaintiffs' design and those of the defendant in details of ornament, they are still the same in general appearance and effect, so much alike that in the market and with purchasers they would pass for the same thing — so much alike that even persons in the trade would be in danger of being deceived.

Unless, therefore, the patent is to receive such a construction that the act of congress will afford no protection to a designer against imitations of his invention, we must hold that the sale by the defendant of spoons and forks bearing the designs patented to White in 1867 and 1868 is an infringement of the complainants' rights.

Decree reversed and the cause remitted with instructions to enter a decree in accordance with this opinion.

JUSTICES MILLER, FIELD and BRADLEY dissented.

Designs — *Abandonment*, §§ 1913, 1914. *Aggregation*, §§ 1915, 1916. *Claim*, § 1917. *Construction of claim*, § 1918. *Joinder of claim*, § 1919. *Costs*, § 1920.

§ 1913. Evidence of the sale of devices having on them the patented design, some months prior to the application therefor, raises a question of fact as to abandonment; in this instance one of intent on the facts proved, the sale having been made within two years prior to the date of application (act 1839). *Booth v. Garrelly*, 1 Blatch., 247.

§ 1914. An inventor may stipulate for a sale of his invention, before it is completed, without vitiating his claim or constituting an abandonment. *Sparkman v. Higgins*, 1 Blatch., 205.

§ 1915. Design patents are subject to the general principles of construction applicable to mechanical patents. A combination or aggregation of old designs producing no new appearance is not patentable. *Northrup v. Adams*, 12 O. G., 430.

§ 1916. Where all that had been done was to place distinct and well known ornaments one above the other, without the production of any such combined effect as to entitle the whole to

be treated as a new and original ornament, *held*, that no new ornament had in fact been produced. *Simpson v. Davis*, 12 Fed. Rep., 144.

§ 1917. In a design patent, a claim to the design "substantially as shown" is valid, and does not invalidate the patent. *Dobson v. Hartford Carpet Co.*, 114 U. S., 439.

§ 1918. A design claim construed to be for the arrangement and not for the process. *Booth v. Garrelly*, 1 Blatch., 247.

§ 1919. The mere joinder in a design patent of a claim for the entire design with claims to each one of its various constituent members as a separate design does not *per se* invalidate the patent or any particular claim at the objection of a defendant. *Dobson v. Hartford Carpet Co.*, 114 U. S., 439.

§ 1920. Where the master reported, no profits and nominal damages for infringement of a design patent, and on exceptions by plaintiff the circuit court allowed a sum for damages, the supreme court on reversing the decree allowed plaintiff costs in the circuit court to and including the interlocutory decree, and defendant costs after such decree. *Ibid*.

Designs — Damages and profits, §§ 1921-1925. *Decree*, § 1926. *Delay in applying for patent*, § 1927. *Diligence in prosecuting application*, § 1928. *Description*, §§ 1929, 1930. *Double use*, § 1931.

§ 1921. In cases of wilful infringement respondents ought to be held to the most rigid accountability, and no intendment ought to be made in their favor founded upon the alleged inconclusiveness of the complainants' proof of loss. Such proof ought to be interpreted most liberally in favor of complainants within the limit of an approximately accurate ascertainment of their damages. *Bigelow Carpet Co. v. Dobson*, 10 Fed. Rep., 385.

§ 1922. Where in a suit for infringement of a patent for a carpet design the evidence showed the quantity of complainants' carpet sold during the season of its first introduction, its cost, the profit upon it, the quantity of the infringing carpet sold by respondents during the following season, and that there was a decline in complainants' sales, the measure of damages is the profits which would have accrued to complainants upon the quantity of carpets sold by respondents. This latter quantity must under the circumstances be presumed to have displaced an equal quantity of complainants' carpets. *Ibid*.

§ 1923. Under section 4919, when it appears in a case in equity that the defendant's profits, derived from the use of the plaintiff's invention, do not amount to so much as the plaintiff's damages arising from the infringement, the court may add to the amount of the defendant's profits a sum sufficient to make the amount awarded by the decree equal to the plaintiff's damages. *Simpson v. Davis*, 22 Fed. Rep., 444.

§ 1924. The remainder of the price realized from the sale of the plaintiff's design, after deducting the cost of making and a fair profit for manufacture, must be presumed to represent the profit realized by defendant from his adoption of plaintiff's design. And this is not dispelled by proving that defendant realized the same profit from adopting in the manufacture of the same articles sold by him a different and unpatented design. *Ibid*.

§ 1925. In a suit in equity for the infringement of a design patent for carpets, where defendant was found to have made no profits, and damages were allowed equal to the profit made on selling the carpet with the infringing design, and there was no evidence of the value imparted to the carpet by the design, *held*, that as actual damages must be proved, the award was improper, and nominal damages only should be allowed. *Dobson v. Hartford Carpet Co.*, 114 U. S., 439.

§ 1926. A decree entered by consent in a prior suit between the parties, declaring complainant to be sole owner of a certain design patent, and the same to be valid, is binding upon both parties, and, as to all questions determined by it, is *res adjudicata*. *Tomkinson v. Willets Manuf'g Co.*, 23 Fed. Rep., 895.

§ 1927. In the case of a design, as well as a mechanical patent, mere delay in applying for a patent will not forfeit the inventor's right to the same, or present any bar to a subsequent application, providing the invention had not been in public use or on sale two years before the filing of the application. *Miller v. Smith*, 5 Fed. Rep., 359.

§ 1928. Where the first application, the claim to the invention, was made February 13th, again on March 23d, and the papers were retained by the patent office until June 22d, were sent away, and corrected papers returned on July 14th, and the patent granted July 24th, *held*, there had been sufficient diligence in prosecuting the application to sustain the patent. *Sparkman v. Higgins*, 1 Blatch., 205.

§ 1929. Where the essential claim of a design patent was to the design in relief, a photograph which did not so show it, *held* not a sufficient description, in the absence of a more specific description in the specification. *Untermeyer v. Jeannot*, 20 Fed. Rep., 503.

§ 1930. Where the bill alleged that the inventor invented "a new and original design for a curtain and loop," and that letters therefor, of specified number and date, were granted, and

there was no further description, a demurrer to the sufficiency of the description of the invention was sustained. *Post v. Richards Hardware Co.*, 25 Fed. Rep., 905.

§ 1931. The use of an old design is clearly excluded from patent by the statute, and mere change or "double use" cannot receive its protection. *Niedringhaus*, 8 O. G., 279.

Designs — Estoppel, § 1932. *Exhibits*, § 1933.

§ 1932. An interference in the patent office, in which priority of invention was awarded against the patent in suit, does not conclude the complainant from maintaining his action thereon. The question before the office did not directly concern the existing patent, but whether another should issue to the contesting applicant, and however it might be were the parties the same, since the respondent here was a stranger to the former proceeding, there is no estoppel. *Perry v. Starrett*, 14 O. G., 599.

§ 1933. Exhibits introduced by a party without needful explanation do not deserve, and will not receive, much consideration. *Miller v. Smith*, 5 Fed. Rep., 359.

Designs — Identity, §§ 1934-1939.

§ 1934. While it is true that the test of infringement in respect to the claim in a design patent is the same as in respect to a mechanical patent, it is not essential to the identity of the design that it should be the same to the eye of an expert. *Miller v. Smith*, 5 Fed. Rep., 359.

§ 1935. Where the designs are of simple character, and no testimony as to infringement is submitted by the defendants, it is not improper for the court to compare the defendant's design with the patents, and determine the question of identity by such comparison. *Jennings v. Kibbe*, 10 Fed. Rep., 669.

§ 1936. The true test of identity of a design is sameness of appearance; in other words, sameness of effect upon the eye of an ordinary observer, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give. *Ibid.*

§ 1937. Two designs may be substantially identical, though differing in minor details. *Wood v. Dolbey*, 19 Blatch., 214.

§ 1938. The difference in designs necessary to take away their identity in law are understood to be such appearances as would attract the attention of an ordinary observer, giving such attention as a purchaser usually gives. *Dryfoos v. Friedman*, 18 Fed. Rep., 824.

§ 1939. Design, of course, relates solely to the appearance of the article to the ordinary purchaser; and when the question was whether the difference of design be substantial and valuable, it was determined practically by observing the effect of the two designs on the appreciating observation of the purchasing public. *Foster v. Crossin*, 23 Fed. Rep., 400.

Designs — Infringement — Test of, §§ 1940-1947. *Particular cases*, §§ 1948-1953.

§ 1940. To infringe a patent right, it is not necessary that the thing patented should be adopted in every particular; but if, as in the present case, the design and figures were substantially adopted by the defendants, they have infringed the plaintiff's right. If they adopt the same principle, they are guilty. *Root v. Ball & Davis*, 4 McL., 177.

§ 1941. The same principles which govern in determining the question of infringement in respect to a patent for an invention connected with the operation of machinery must govern in determining the question of infringement in respect to a patent for a design. *Gorham Mfg. Co. v. White*, 7 Blatch., 513. See §§ 1910-1912.

§ 1942. The test of infringement of a design patent is, as in the case of a machine patent, substantial identity in the view of the observation of a person versed in the business of designs in the particular trade in question, and not that of a casual observer. *Ibid.* (Reversed.)

§ 1943. Infringement of a design patent may exist notwithstanding that the alleged infringing article is made to carry a distinguishing name or distinguishing marks of other character. *Perry v. Starrett*, 14 O. G., 599.

§ 1944. If to the eye of the ordinary purchaser the designs are substantially the same, if the resemblance is such as to deceive such an observer, and sufficient to induce him to purchase one, supposing it to be the other, the one first patented is infringed by the other. *Miller v. Smith*, 5 Fed. Rep., 359.

§ 1945. If the resemblance of one design to another is such that a purchaser would be deceived, it will not aid the infringer to show that he has deviated slightly in details or has omitted something which an expert can discover. *Tomkinson v. Willets Mfg. Co.*, 23 Fed. Rep., 895.

§ 1946. It is not necessary that the design patented should be copied in every particular to constitute infringement. It is enough that it has the same general appearance, if the varia-

tions are slight, and to the eye of an ordinary person the two things are substantially similar. *Ibid.*

§ 1947. To constitute infringement of a design patent, it is enough if the resemblance is such as to deceive the ordinary observer. *Dryfus v. Schneider*, 25 Fed. Rep., 481.

§ 1948. Where ornaments are used for a stove, it is an infringement to adopt the design so as to produce, substantially, the same appearance. *Root v. Ball & Davis*, 4 McL., 177.

§ 1949. Design claims infringed by the unlicensed sale of a stove "having both form and ornamentation so like those to which said claims relate that whether regard be had to such form or to such ornamentation separately, or to the combined effect of the two, the stoves so sold are calculated, by reason of such resemblance, to deprive the complainants of a part of that market to which, under their patent, they are exclusively entitled." *Perry v. Starrett*, 14 O. G., 599.

§ 1950. An immaterial variation of the design—such as a slight inclination backward, hardly perceptible to the eye, of the glass constituting the front of the elevated parts of a show-case—does not relieve from the charge of infringement. *Lehnbeuter v. Holthaus*, 105 U. S., 94.

§ 1951. If a patent for a design covers the ornamentation shown in it, it is no infringement to use the principal figure without the ornamentation. *Collender v. Griffith*, 11 Blatch., 212.

§ 1952. Seems that a design patent of a series of patterns printed on a piece of fabric would not be infringed by a sale of the patterns divided. *Dryfoos v. Friedman*, 18 Fed. Rep., 824.

§ 1953. The sale of the alleged infringing article procured by and to another for the orators would not of itself probably be an unlawful infringement of which they could justly complain; yet, when made in the usual course of business, as of goods kept for sale, it might be evidence of sales of similar goods to others. *Ibid.*

Designs — Injunction, bill of, § 1954. Injunction, preliminary, § 1955; provisional, § 1956; nisi, § 1957; violation of, §§ 1958, 1959.

§ 1954. It is necessary that a bill in equity for an injunction against the infringement of letters patent for an invention should contain such a description of the invention, as patented, as will apprise the court of its nature and character, and the particulars in which the improvement consists. How this may be done. *Post v. Richards Hardware Co.*, 25 Fed. Rep., 905.

§ 1955. Where the only objection to the grant of a preliminary injunction, aside from non-infringement, was that the design patents were recent, and had not been found by any judicial decree to be void, that ground in itself was held insufficient to warrant the refusal of the injunction. *Foster v. Crossin*, 23 Fed. Rep., 400.

§ 1956. Where, on admissions of patentee, doubts arose as to the novelty of the design patent sued upon, a provisional injunction was refused until plaintiff's right should be established at law. *Booth v. Garely*, 1 Blatch., 247.

§ 1957. On application for a preliminary injunction, where defendant had copied the patented design, the validity of the patent being doubted, an injunction *nisi* was granted. *Margot v. Schnetzer*, 24 O. G., 101.

§ 1958. Where, on motion for attachment for alleged violation of injunction, it appeared that there was no sale in fact by defendants, and that plaintiffs set on foot a scheme to entrap defendants and immediately pursued them with the motion for attachment, knowing them to be innocent of any wrongful act, *held*, that plaintiffs should be charged with costs, and the motion was denied. *Sparkman v. Higgins*, 2 Blatch., 29.

§ 1959. Where plaintiff's agent entered defendant's store, and, without paying, directed the article selected by him to be sent to his address, which was not done, defendants having strictly forbidden the selling of such article, *held*, it was no sale in fact, and would not justify a motion for attachment for violation of an injunction. *Ibid.*

Designs — Invention, §§ 1960-1963; joinder of, § 1964. Inventor, § 1965.

§ 1960. A billiard-table, with sides beveled inwardly from the top, being old, a design patent for a bevel different in degree only does not involve invention, and is void. *Collender v. Griffith*, 11 Blatch., 212.

§ 1961. Mere exhibition of skill on the part of workers in enamel, in giving beautiful forms and colors to their productions, when they are the common efforts of persons ordinarily skilled in the art, is not the invention which is protected by the law. *Niedringhaus*, 8 O. G., 279.

§ 1962. When, in a design of a rectangular provision-safe, the only originality consisted in the use of two vertical panels in each wall, and a familiar molding around the top and bottom, the patent was held invalid. *Northrup v. Adams*, 12 O. G., 430.

§ 1963. Merely changing the mode of keeping and presenting an article for sale, without changing its form or appearance, *held* not to support a patent for a design. *Pratt v. Rosenfeld*, 18 Blatch., 234.

§ 1964. The same patent may include a patent for a combination and an invention of some of the parts of which the invention consists. *Root v. Ball & Davis*, 4 McL., 177.

§ 1965. To constitute an inventor, it is not necessary he should have the manual skill and dexterity to make the drafts. If the ideas are furnished by him, for producing the result aimed at, he is entitled to avail himself of the mechanical skill of others, to carry out practically his contrivance. *Sparkman v. Higgins*, 1 Blatch., 205.

Designs — *Notice*, § 1966; *judicial*, § 1967. *Novelty*, §§ 1968-1971. *Prior mechanical patent*, § 1972.

§ 1966. The defendant will not be permitted, on the hearing, to read depositions showing prior knowledge and use of the thing patented by persons whose names are not given in his answer. *Collender v. Griffith*, 11 Blatch., 212.

§ 1967. The court can from common knowledge say that the design covered by a patent is only a new use of an old and well known device. *Western Electric Mfg. Co. v. Odell*, 18 Fed. Rep., 321.

§ 1968. The same degree of originality is required in both design and functional patents—that is, the claim must not comprehend what is already in existence. *Niedringhaus*, 8 O. G., 279.

§ 1969. When the defense of want of novelty is made, it is the duty of the tribunal, whether court or jury, to give it effect; but such proof or testimony should be weighed with care and never be allowed to prevail where it is unsatisfactory, nor unless its probative force is sufficient to outweigh the *prima facie* presumption arising from the introduction of the patent. *Miller v. Smith*, 5 Fed. Rep., 359.

§ 1970. A design for jewelry-settings is not anticipated by a known design showing certain features of the patented design, but unlike it in appearance both in outline and detail. *Wood v. Dalbey*, 19 Blatch., 214.

§ 1971. It is immaterial to the patentability of a design whether it is more graceful or more beautiful than older designs. It is sufficient if it is new and useful. The patent is *prima facie* evidence of both novelty and utility. *Lehnbeuter v. Holthaus*, 105 U. S., 94.

§ 1972. A design patent issued more than two years prior to a mechanical patent, showing but not claiming a like invention, will not invalidate the mechanical patent, the claim of the design patent being to the shape, of the mechanical patent to the combination. *Collender v. Griffith*, 18 Blatch., 110.

Designs — *Patentability, what constitutes*, §§ 1973-1975. *Particular cases*, §§ 1976-1979.

§ 1973. A beautiful appearance is not of itself entitled to a design patent. The design must also be new and original, and the result of invention and genius. *Niedringhaus*, 8 O. G., 279.

§ 1974. Under section 11, act of March 2, 1861, the application of a shape which is common in many articles of manufacture to a new use cannot be secured by letters patent. *Wooster v. Crane*, 5 Blatch., 282.

§ 1975. To constitute a new design that would be patentable as such, it must be so different from all others existing before as to appear to be such to ordinary observers. *Perry v. Starrett*, 14 O. G., 599.

§ 1976. A drawing, pattern, or casting of the letter G, or any other letter of the alphabet, is not patentable of itself as a new design. To give it any novelty or usefulness, it must have some purpose in combination with something else—as when used as a frame to support the working machinery of a sewing machine. *Gibbs v. Ellithorp*, 1 MacA. Pat. Cases, 699.

§ 1977. The claim for the design in such a case would not depend on the novelty of the machinery; but to perfect the design and make it patentable, the working machinery must be applied or shown to the office to be capable of application. It is not necessary, however, to describe the machinery in the specification. *Ibid.*

§ 1978. A design consisting in a mere mottled appearance to be given to enameled iron ware is not patentable. *Niedringhaus*, 8 O. G., 279.

§ 1979. The cap of a newel post held to be a manufacture, a design for which may be patented under the statute. *Simpson v. Davis*, 12 Fed. Rep., 144.

Designs — *Patents for designs generally*, §§ 1980, 1981. *Patent prima facie evidence*, § 1982. *Particular patent construed*, § 1983; *when valid*, §§ 1984, 1985.

§ 1980. Regulations and provisions applicable to the obtaining or prohibition of patents for inventions or discoveries not inconsistent with the existing patent act apply to patents for designs, without modification or variation. *Miller v. Smith*, 5 Fed. Rep., 359.

§ 1981. Patents for designs have reference to appearance rather than utility. Their object is to encourage the arts of decoration rather than the invention of useful products; but all regulations and provisions that are applicable to the obtaining or protecting of patents for inventions are by section 4933 made applicable also to design patents. *Theberath v. Rubber & Celluloid Harness Trimming Co.*, 15 Fed. Rep., 246.

§ 1982. The introduction in evidence of letters patent affords a *prima facie* presumption that the patentee is the first and original inventor, and is sufficient to entitle the complainant to a decree, unless it is overcome by competent proof of greater weight. *Miller v. Smith*, 5 Fed. Rep., 359.

§ 1983. In a patent for "a new and improved design," the word "improved" construed in connection with the word "new" to signify original, and thus held to conform to section 4929, Revised Statutes. *Wood v. Dolbey*, 19 Blatch., 214.

§ 1984. A patent for a design consisting of letters of the alphabet having a described ornamentation is not bad because it embraces more than one letter. *Miller v. Smith*, 5 Fed. Rep., 359.

§ 1985. Where a bill founded on a design patent, with a claim for a pattern and separate claims to its separate parts, is taken as confessed, it alleging infringement of the invention, the patent will be held valid for the purposes of the suit. *Dobson v. Hartford Carpet Co.*, 114 U. S., 439.

Designs—*Use, burden of proving prior knowledge*, § 1986. *Use or sale, public*, §§ 1987, 1988. *Use and sale, plea of prior*, § 1989. *Utility*, § 1990.

§ 1986. The burden of proof is upon defendants to satisfy the court beyond a reasonable doubt that the defense of prior knowledge and use has been established. *Dryfus v. Schneider*, 25 Fed. Rep., 481.

§ 1987. A design patent is invalid if the device embraced thereby was in public use or on sale more than two years before the date of the filing of the application on which such patent was granted. *Burton v. Town of Greenville*, 3 Fed. Rep., 642.

§ 1988. A design patent may be defeated, upon proof that articles which revealed to the eye the same design which is the subject of the patent were publicly made and sold for more than two years before the application was filed. *Theberath v. Rubber & Celluloid Harness Trimming Co.*, 15 Fed. Rep., 246.

§ 1989. Under section 3, act 1839, a plea that the alleged design invention was in use and for sale prior to the application for patent is demurrable, unless it also alleges abandonment. *Root v. Ball & Davis*, 4 McL., 177.

§ 1990. The fact that the design patent has been infringed is sufficient to establish its utility as against the defendants. *Lehnbeuter v. Holthaus*, 105 U. S., 94.

See *Construction of Patents*, § 1219. *Novelty*, §§ 4394, 4395. *Patents*, § 4750.

107. DIFFERENCE.

See IDENTITY.

108. DILIGENCE.

See DELAY. DELAY, DILIGENCE IN PROSECUTING APPLICATION. DELAY, DILIGENCE IN REDUCTION TO PRACTICE. PRIORITY OF INVENTION, DILIGENCE IN REDUCTION TO PRACTICE.

109. DISCLAIMER.

See REISSUES, ACTUAL DISCLAIMER IN ORIGINAL, EFFECT ON. REISSUES, CONSTRUCTIVE DISCLAIMER IN ORIGINAL, EFFECT ON.

. Disclaimer—*In relation to costs*, §§ 1991-2003.

§ 1991. Patentee, whose specification claims too much, must disclaim the excess, in order to recover costs. *Silsby v. Foote*, 20 How., 378.

§ 1992. Act 1837, section 9, effect of filing disclaimer on the recovery of costs, considered. *Hall v. Wiles*, 2 Blatch., 194.

§ 1993. Under act 1837, section 9, plaintiff is entitled to recover for infringement of so much of his claim as is valid without filing disclaimer, and on the filing of the same under section 7 of the act, he cannot recover costs. *Tuck v. Bramhill*, 6 Blatch., 95.

§ 1994. Section 4922, denying costs in patent cases for failure to file disclaimer, does not apply to new and expanded re-issue claims abandoned by the orator for laches in applying for reissue. A decree accordingly signed without requiring a disclaimer or denying costs. *Mundy v. Lidgergood Mfg. Co.*, 20 Fed. Rep., 191.

§ 1995. The purpose of sections 4917 and 4922, Revised Statutes, taken together, is that where a proper disclaimer is entered during the pendency of a suit on a patent, there may be a recovery for the plaintiff in the suit, in respect of what is not disclaimed, provided there has been no unreasonable neglect or delay to enter a disclaimer, but the remedy is to be without costs. *Schillinger v. Gunther*, 17 Blatch., 66.

§ 1996. If there has been unreasonable negligence and delay on the part of patentee in disclaiming the invalid part of his patent, the whole patent is inoperative; if diligent in disclaiming, his patent will be good for the residue. If he has filed no disclaimer, he may recover on the valid part, but will not be allowed costs. *McCormick v. Seymour*, 3 Blatch., 209.

§ 1997. Where disclaimer was filed during pendency of suit and infringement was found, injunction and decree were for plaintiff, but without costs. *Taylor v. Archer*, 8 Blatch., 315.

§ 1998. The mere filing of a disclaimer after verdict does not show that plaintiff is not entitled to costs; neither does the mere fact of a verdict for plaintiff. *Peck v. Frame*, 5 Fish., 211.

§ 1999. When some of the claims sued upon are valid, the plaintiff is entitled to recover, notwithstanding others are found invalid, and no disclaimer thereto entered before the commencement of the suit, he not having been guilty of unreasonable neglect or delay in not making such disclaimer. If the plaintiff neglects to file a disclaimer, before the commencement of the suit, to claims that are invalid, he cannot recover costs. *Burdett v. Estey*, 15 Blatch., 349.

§ 2000. A disclaimer filed after the suit was brought ordinarily deprives the plaintiff of costs in the suit; but where the disclaimer was not necessary to sustain the patent to the extent it is held valid, was inoperative, in the view taken of it, upon the patent, and has no effect in maintaining the suit, cost may be allowed the plaintiff as though no disclaimer had been filed. *Sharp v. Tiff*, 18 Blatch., 132.

§ 2001. Where the patentee made certain claims by mistake without any wilful default or intent to mislead the public, and did not unreasonably neglect to enter disclaimer of the same, he is entitled to maintain suit, but without cost, upon entering the proper disclaimer. *Matthews v. Spangenberg*, 23 O. G., 92.

§ 2002. Where the disclaimer is not filed until after suit, although that may not prevent a decree or judgment for the plaintiff, the statute is express that in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered. *Burdett v. Estey*, 19 Blatch., 1.

§ 2003. Plaintiffs having filed disclaimer after suit brought, *held*, not entitled to costs. *Coburn v. Schroeder*, 19 Blatch., 377; *Bussey v. Wager*, 9 O. G., 300.

See *Costs*, §§ 1397-1416.

Disclaimer — Delay in filing, §§ 2004-2015.

§ 2004. Act 1837, effect of delay in filing disclaimer, construed. *Brooks v. Jenkins*, 3 McL., 432.

§ 2005. Less vigilance is required from an administrator in filing a disclaimer than from a patentee. *Ibid*.

§ 2006. Unreasonable neglect to enter disclaimer of excessive specification forfeits right to recover for infringement. *Silsby v. Foote*, 20 How., 378.

§ 2007. Where the patent sued on had been repeatedly and uniformly upheld by the courts, the court refused to consider that defendant would be guilty of negligence in filing disclaimer on the assumption that his claims were too broad. *Potter v. Whitney*, 1 Low., 87.

§ 2008. The granting of a patent for the improvement, and the opinion of the court below maintaining its validity, *held*, to repel any inference of unreasonable delay in filing disclaimer. *Seymour v. McCormick*, 19 How., 96.

§ 2009. In case of doubt, where the objectionable part of the claim is allowed by the patent office, patentee is not liable for unreasonable delay in disclaiming, until it has been passed upon by the highest court to which it could be carried, and the patent will be protected as to the valid part. *O'Reilly v. Morse*, 15 How., 62.

§ 2010. It is settled that a disclaimer need not be filed until the court has passed upon the contested claims. *Stutz v. Armstrong*, 20 Fed. Rep., 843.

§ 2011. It is not a good objection to the grant of a preliminary injunction under a valid claim that a disclaimer was not filed as to other claims before suit was brought. Such claims having the sanction of the commissioner of patents, and the question of their validity being

one of law, to be ultimately decided by the courts, it cannot be said that the plaintiffs have unreasonably neglected or delayed to enter a disclaimer. *Duff v. Calkins*, 25 O. G., 601.

§ 2012. Where the validity of a new claim in a reissue has been sanctioned by its grant by the commissioner of patents and sustained in the circuit court, there has been no unreasonable delay in entering a disclaimer, as plaintiffs were not bound to disclaim until after judgment of this (the supreme) court upon the question. *Gage v. Herring*, 107 U. S., 640.

§ 2013. Where the construction of an original claim is doubtful, the patentee is not called upon to correct it by disclaimer until its meaning has been settled by the supreme court. Until then there is no unnecessary delay in filing the disclaimer. *Mathews v. Flower*, 33 O. G., 887.

§ 2014. In determining what is unreasonable delay in filing disclaimer, the time commences when the knowledge was brought home to the party that he was not the first inventor. *Singer v. Walmesley*, 1 Fish., 558.

§ 2015. Question raised whether a disclaimer filed two years and a half after final decree in the circuit court is valid. *McMurray v. Mallory*, 111 U. S., 97.

See *Damages and Profits*, § 1491.

Disclaimer — In foreign patent, effect on domestic patent, §§ 2016-2019.

§ 2016. The presumption raised by a disclaimer in an English patent is that the matter disclaimed is not the patentee's invention. *Ashcroft v. Railroad Co.*, 7 Otto, 189.

§ 2017. A disclaimer in an English patent corresponding to the inventor's American patent of later date is properly considered in construing and limiting the latter. *Ibid.*

§ 2018. In the English patent corresponding to the domestic one upon which suit was brought, a disclaimer to certain general features of invention was entered, presumably in view of the fact that such features had already been disclosed by an antecedent patentee. *Held*, that the American patent, to be valid, must be likewise limited to the particular means set forth, even though it did not contain the restricting disclaimer. *Ibid.*

§ 2019. A disclaimer in a subsequent English patent granted patentee on his invention already patented in the United States cannot invalidate the United States patent. *United Nickel Co. v. Melchior*, 17 Fed. Rep., 340.

Disclaimer — Its purpose, §§ 2020-2029.

§ 2020. Act 1837, section 7, "disclaimer," construed. *Wyeth v. Stone*, 1 Story, 273.

§ 2021. Under section 54 of the act of July 8, 1870, chapter 230 (16 Stat., 205), a disclaimer could be made only by a patentee who had claimed more than that of which he was the original or first inventor or discoverer, and he could make a disclaimer only of such parts of the thing patented as he should not choose to claim or hold by virtue of the patent. *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 112 U. S., 624.

§ 2022. In so disclaiming or limiting a claim, descriptive matter on which the disclaimed claim was based might be erased; but if there was merely a defective or insufficient description, the only mode of correcting it was by a reissue. *Ibid.*

§ 2023. A disclaimer is necessary only where the thing claimed is a material and substantial part of the invention, and where delay in entering it shows great negligence, the jury may find the patent void. *Hall v. Wiles*, 2 Blatch., 194.

§ 2024. A disclaimer properly made, attested and recorded, becomes a part of the specification to the extent of the interest of those who make it, but will not affect any action pending at the time of its being filed, except as to unreasonable neglect or delay in filing it. *Dunbar v. Myers*, 4 Otto, 187.

§ 2025. The disclaimer has no relation to the statements of effect or result contained in the specification, but simply concedes that certain subject-matter stated is not of the invention of the patentee. *Schillinger v. Gunther*, 15 Blatch., 303.

§ 2026. Where a patentee has defectively or insufficiently described his invention, and claimed more than he has a right to claim as new, he is entitled to a reissue of his patent upon a surrender of the original; but it is not the office of a disclaimer to reform or alter the description of an invention. *Hailes v. Albany Stove Co.*, 16 Fed. Rep., 240.

§ 2027. Where there are several claims, some of which he is entitled to, and the part of the invention which is his own is definitely distinguishable from that which is not his own, a disclaimer before suit brought will put him right and enable him to recover upon his patent as though it had originally been confined to the proper claims; but he cannot convert a claim for one thing into a claim for something else, and amend the description to effectuate such claim. *Ibid.*

§ 2028. A disclaimer can add nothing to a patent. It can take away from that which has been described as the invention and claimed as such so as to be covered by the grant of the patent, but it has no office to make the patent cover anything, however clearly shown therein, which has not been described and claimed as a part of the invention. *White v. E. P. Gleason Manufacturing Co.*, 17 Fed. Rep., 159.

§ 2029. Where a patent has been judicially declared void for the reason that its claim is too broad, it would seem, under the express language of the statute, that it may be properly corrected by a disclaimer. *Mathews v. Flower*, 33 O. G., 887.

See *Errors*, § 2182. *Statutes*, § 6114.

Disclaimer — In respect to reissues, §§ 2030-2040.

§ 2030. Suggested that inadvertence and error in a disclaimer may be cured by reissue. *Poppenhusen v. Falke*, 4 Blatch., 493.

§ 2031. Where there was a disclaimer as to one division of a reissue, and the question was, whether, notwithstanding that disclaimer, the other divisions of the reissue should be sustained, *held*, that the disclaimer had no effect on the costs. *Elastic Fabrics Co. v. Smith*, 10 Otto, 110.

§ 2032. Where the statements in the specification and claim of the reissue patent which the disclaimer seeks to modify were mistakes in fact, and were founded upon experiments made after the date of the original patent, *held*, that the disclaimer was lawful both to remedy the misstatements and to save the reissue from impeachment as for a different invention, it appearing that the inventor had acted throughout in good faith. *Schillinger v. Gunther*, 17 Blatch., 66.

§ 2033. A disclaimer may embrace subject-matter set up for the first time without right in the reissue patent; and it may apply not only to the invalid claim, but to statements in the body of the specification upon which the invalid claim or part of claim is founded. The reissued specification is to be thereafter read as if the disclaimer were incorporated in it. *Ibid*.

§ 2034. It is not competent for the patentee or his assignees, by merely disclaiming all the changes made in a reissue patent, to revive and restore the original patent. This could be done only, if it could be done at all, by surrender of the reissued patent and the grant of another reissue. *McMurray v. Mallory*, 111 U. S., 97.

§ 2035. Where patentee distinctly disclaimed a certain device in his original patent, and inferentially in his reissue, *held*, that his reissue claim must be so limited and that he was estopped from construing it to cover such device. *Novelty Paper Box Co. v. Staples*, 5 Fed. Rep., 919.

§ 2036. A disclaimer of a description of an improvement in a reissue held an admission of the propriety of inserting a certain clause in the descriptive part of the specification, and not of the fact of invention; and even if not so, *held* a mere nullity and therefore not to estop patentee from recovering for its infringement. *Union Met. Cartridge Co. v. U. S. Cartridge Co.*, 7 Fed. Rep., 344.

§ 2037. A disclaimer limiting the actual invention of the patentee, the result of an error or mistake on the part of the office, may be omitted in a reissue. *American Shoe Tip Co. v. National Shoe Toe Protector Co.*, 11 O. G., 740.

§ 2038. The statement in an original specification, that certain described parts or combinations of parts "are in quite common use," amounts to a disclaimer, and is a statement of fact which prevents the reclaiming of such parts by a reissue. *Edgerton v. Furst & Bradley Mfg. Co.*, 10 Biss., 402.

§ 2039. *Held*, that the statute requires that the part of the thing patented which is claimed without right must be a material and substantial part of the invention in order to render a disclaimer necessary, and where a certain reissue claim that had been previously declared void because not in the original specification was not included in the pending suit, *held*, that the defendants should not be prejudiced for want of a disclaimer. *Worden v. Searls*, 21 Fed. Rep., 406.

§ 2040. An acquiescence and disclaimer on a decision requiring the disclaimer as a condition precedent to an extension are as operative to prevent the afterward insisting on a recovery on the invention disclaimed as to prevent a subsequent reissue to claim what was so disclaimed. *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 112 U. S., 624.

See *Errors*, § 2182. *Improvement*, § 2744. *Priority of Invention*, § 5018. *Reissues*, §§ 5389, 5606-5616.

Disclaimer — As an estoppel, §§ 2041-2045.

§ 2041. The disclaimer estops patentee from setting up any privilege to the part disclaimed. *Whitney v. Emmett*, 1 Bald., 303.

§ 2042. A disclaimer made by an attorney in the prosecution of an application does not necessarily estop the patentee from maintaining that his claim embraces the matter so referred to. *Mann v. Bayliss*, 10 O. G., 789.

§ 2043. Where a patentee disclaims so many elements of his invention as to leave no room for the exercise of invention in forming the combination which he claims, it is of no avail for him to show that he was really the first inventor of all or any of the parts thereof. *Consolidated Fruit Jar Co. v. Wright*, 12 Blatch., 149.

§ 2044. The general sense of a disclaimer embodied in the specification must be restrained to the purpose for which it was used in connection with that specification, and will not estop the inventor from subsequently maintaining a claim for the invention so disclaimed in another proceeding. *Hill v. Dunklee*, 1 MacA. Pat. Cases, 475.

§ 2045. Disclaimers, qualifications, and limitations imposed upon a patentee by the patent office are forever binding upon him, if he chooses to accept a patent containing them, and they forbid any subsequent enlargement, whether by reissue or by a broad construction of claims thus intended to be limited. *New York Belting & Packing Co. v. Sibley*, 15 Fed. Rep., 386.

Disclaimer — Generally, §§ 2046-2065.

§ 2046. A disclaimer, to be effectual to all intents and purposes of act 1837, should be filed before suit brought. *Reed v. Cutter*, 1 Story, 590.

§ 2047. A patentee may file a disclaimer after suit brought against an infringer, under act 1837, sections 7 and 9. *Smith v. Nichols*, 21 Wall., 112.

§ 2048. Under act 1837, section 7, a suit pending when the disclaimer is filed is not to be affected by such filing, so as to prevent the plaintiff from recovering under it, unless it appears that plaintiff unreasonably neglected or delayed to file the disclaimer. *Tuck v. Bramhill*, 6 Blatch., 95.

§ 2049. Under act 1837, sections 7 and 9, on failure to file disclaimer, *held*, that suit may be maintained on other parts of what is patented. *Hall v. Wiles*, 2 Blatch., 194.

§ 2050. Where the claim is to an abstract principle, an injunction will not be granted, unless a disclaimer is filed before bringing suit. *Wyeth v. Stone*, 1 Story, 273.

§ 2051. A disclaimer by the patentee alone cannot operate in favor of his assignee who was not joined in it, both being plaintiffs in the suit. *Ibid*.

§ 2052. A disclaimer indorsed on back of the patent, *held* properly rejected, when offered in evidence by defendants, for want of proof that it had been executed by patentee. *Foote v. Silsby*, 1 Blatch., 445.

§ 2053. *Semble*, that the disclaimer of all title under a prior patent to the material parts of the invention for which it was granted, would operate as an estoppel to any remedy for its violation, and that no subsequent patent could cover the matter disclaimed. *Treadwell v. Bladen*, 4 Wash., 703.

§ 2054. An unfiled, unrecorded disclaimer is not competent evidence of a disclaimer of portions of the old specification. *Hovey v. Stevens*, 3 W. & M., 17.

§ 2055. Under act 1837 it is a sufficient statement of interest in the disclaimer to state that party disclaiming is the patentee, and to refer to the patent as showing his interest. *Brooks v. Jenkins*, 3 McL., 432.

§ 2056. A patentee may file a disclaimer of part of the invention as having been claimed by mistake; and if he says he is the patentee, without more, it will be inferred that he owns the whole interest, and sufficiently states the extent of his interest. *Silsby v. Foote*, 14 How., 218.

§ 2057. Disclaimer in a patent to matter referred to in a prior patent should be construed as the prior patent itself is construed. *Wonson v. Peterson*, 13 O. G., 548.

§ 2058. The effect of an earlier invention upon the claim of a patent not avoided by a specific disclaimer in the specification when it appears that such disclaimer is based upon an unsound view of the invention to which it relates. *Buchan v. McKesson*, 18 Blatch., 485.

§ 2059. Where one claims more than he has a right to, his patent is good for what is new and original, and he can sue without first making a disclaimer. *Singer v. Walmesley*, 1 Fish., 558.

§ 2060. Matters properly disclaimed cease to be part of the invention, and render the patent the same as if such matters had never been included. *Dunbar v. Myers*, 4 Otto, 187.

§ 2061. The disclaimer must be taken into account in construing the patent, except when its effect is to enlarge the nature of the invention and prejudice the rights of the respondent. *Ibid*.

§ 2062. A reference in a disclaimer to a particular form of the device not so limited in the claim is merely descriptive of that form without taking away or adding anything thereto. *Sharp v. Tift*, 18 Blatch., 132.

§ 2063. A disclaimer filed by administrator of patentee during the pendency of a suit in which he has been substituted for patentee as plaintiff is valid. *Taylor v. Archer*, 8 Blatch., 315.

§ 2064. Where a verdict is rendered affirming the validity of all the claims of a patent, and subsequently thereto a disclaimer to some of them is filed, such disclaimer is high evidence that the verdict is wrong, and might warrant a new trial. *Peck v. Frame*, 5 Fish., 211.

§ 2065. A disclaimer cannot be filed after the expiration of the term of a patent. *Vacuum Oil Co. v. Buffalo Lubricating Oil Co.*, 23 Fed. Rep., 891.

See *Claims*, §§ 848-860. *Construction of Patents*, §§ 1193, 1234, 1235. *Damages and Profits*, § 1694. *Drawings*, § 2095. *Injunction*, §§ 3267, 3269, 3274, 3338. *New Trial*, § 4229. *Patents*, § 4751. *Process*, § 5094. *Recovery*, § 5218.

110. DISCOVERY.

See INVENTION. BILL, OF DISCOVERY.

111. DISTRICT OF COLUMBIA.

See JURISDICTION, SUPREME AND CIRCUIT COURT OF DISTRICT OF COLUMBIA. JURISDICTION, JUDGE OF CIRCUIT COURT OF DISTRICT OF COLUMBIA ON APPEAL FROM COMMISSIONER.

112. DISSOLVING INJUNCTIONS.

See INJUNCTIONS, DISSOLUTION OF. INJUNCTIONS, PRELIMINARY, DISSOLUTION OF. INJUNCTIONS, PROVISIONAL, DISSOLUTION OF.

113. DIVIDED COURT.

See PRACTICE, DIVIDED COURT.

114. DIVISIONAL REISSUES.

See REISSUES, DIVISIONAL.

115. DOUBLE CLAIM.

See CLAIM, DOUBLE.

116. DOUBLE USE.

See USE, ANALOGOUS. USE, DOUBLE.

117. DRAWINGS.

See CLAIMS, CONSTRUCTION OF, §§ 760-766. CONSTRUCTION OF PATENTS, §§ 1197-1205, 1237. SCOPE OF PATENTS, § 5982. SPECIFICATION, § 6015.

Drawings — *Are a part of the specification*, §§ 2066-2075.

§ 2066. Drawings are to be treated as part of the written specification, and may be referred to, to show the nature, and character, and extent of the claim, as well as to compose a part of the description. *Washburn v. Gould*, 3 Story, 122.

§ 2067. Drawings annexed, and referred to in the specification, constitute a part thereof. *Earle v. Sawyer*, 4 Mason, 1.

§ 2068. The drawings are a part of the specification. *Heinrich v. Luther*, 6 McL., 345.

§ 2069. The original drawings are to be regarded as part of the specification of the original patent. *Booth v. Parks*, 1 Flip., 381.

§ 2070. The drawings are a part of the description of the thing patented, and are to be considered in connection with the specification. *Foss v. Herbert*, 1 Biss., 121.

§ 2071. The entire specifications may be examined to ascertain the claim of patentee. The specifications, and also the drawings, constitute a part of the patent. *Pitts v. Edmonds*, 1 Biss., 168.

§ 2072. The drawings are a part of the description of the thing patented, but must be considered in connection with the specifications. Where the invention patented consists of a combination of old elements to produce a new result, mere matters of adjustment of the individual elements are not limited or controlled by the drawings, unless expressly so limited by the specifications, or to maintain the integrity of the specification, or as essential to produce the result claimed. *Hamilton v. Ives*, 3 O. G., 30.

§ 2073. The drawing could and should be looked at, if necessary, in order to explain an ambiguous or doubtful specification, and to make the invention capable of being understood and used. *Tinker v. Wilber Eureka M. & E. Mfg. Co.*, 1 Fed. Rep., 138.

§ 2074. The invention covered by the patent upon which suit was brought and by that set up in defense being dependent upon certain peculiarities of form and position of parts in a structure, it was found necessary to consider the drawings in connection with the specifications, and to rely upon the drawings alone to some extent to ascertain the exact form and position of some of the parts. *Banker v. Bostwick*, 3 Fed. Rep., 517.

§ 2075. Drawings not referred to in the specification held not necessarily to be a part of the patent. *Stanley v. Hewitt*, 17 Frank. Jr. (2d series), 165.

Drawings — Do not constitute invention, §§ 2076-2080.

§ 2076. Drawings alone, unaccompanied by letter-press description, will never invalidate a patent. *New Process Fermentation Co. v. Koch*, 21 Fed. Rep., 580.

§ 2077. The making of drawings of conceived ideas is not such embodiment of such conceived ideas into a practical and useful form as will defeat a patent which has been granted. *Ellithorp v. Robertson*, 4 Blatch., 307.

§ 2078. The rule that an invention may be exhibited either in a drawing or model, so as to lay the foundation of a claim to priority (*Loom Co. v. Higgins*), is to be taken with the qualification that it must be followed up with reasonable diligence. Merely making drawings is not such an embodiment of invention as will defeat a subsequent patent. *Odell v. Stout*, 22 Fed. Rep., 159.

§ 2079. Illustrated drawings of conceived ideas do not constitute an invention, and unless they are followed up by a seasonable observance of the requirements of the patent laws they can have no effect upon a subsequently granted patent to another. *Draper v. Potomska Mills Corporation*, 13 O. G., 276.

§ 2080. A mere drawing, although apparently exhibiting a perfect machine in all its parts, and sufficiently to show the combination in controversy, antedating the patentee's application, but not reduced to actual use until after such reduction by and grant of patent to patentee, held, insufficient to deprive patentee of his title to being the first and original inventor. *Detroit Lubricator Mfg. Co. v. Renchard*, 9 Fed. Rep., 293.

See *Abandonment*, § 84. *Experiment*, § 2407. *Priority of Invention*, §§ 5002-5006. *Publication*, §§ 5136, 5137.

Drawings — Reissue, §§ 2081, 2082. Signing, §§ 2083, 2084.

§ 2081. Drawings of bags, the forms of which were indicated in the patent of a paper-bag machine, by which they are produced, may be annexed to a reissue of the patent, although they were not to the original. *Union Paper Bag Company v. Nixon*, 4 O. G., 31.

§ 2082. Modifications of reissue drawings in matters which do not affect the claim are allowable. *Learl v. Appleton Co.*, 3 Fed. Rep., 153.

See *Reissues*, §§ 5448, 5524-5537.

§ 2083. Application drawings may be signed either by the inventor or by any person he may authorize. *Black's Opinion*, 9 Op., 378.

§ 2084. The patent law requires every specification of a claim for machinery to be accompanied by drawings signed by the inventor and attested by two witnesses. *In re Henry*, 1 MacA. Pat. Cases, 467.

Drawings — Act of 1837, §§ 2085, 2086. Admissibility in evidence, §§ 2087-2090. Sufficiency of, §§ 2091-2093. Mistake in, must be clearly proved, § 2094. Disclaiming a figure of, § 2095.

§ 2085. Acts 1793 and 1837 construed with reference to "drawings." *Emerson v. Hogg*, 2 Blatch., 1.

§ 2086. Patentee complies with the requirements of the act of 1837, if he files with his specification drawings and written references, without their being mentioned in the specification, and if the references required are written on the drawings. *Ibid.*

§ 2087. A drawing re-recorded under act 1837 to replace a destroyed drawing is admissible in evidence. *Ibid.*

§ 2088. An uncertified drawing admitted in evidence. *Ibid.*

§ 2089. Where, under acts 1836 and 1837, a drawing was recorded in the patent office in connection with a patent and specification, to which no drawing had been previously attached, it was held properly admitted in evidence under the act 1836. *Winans v. Schenectady & Troy R. Co.*, 2 Blatch., 279.

§ 2090. A drawing in an account book in the possession of one of the parties to the interference not of itself evidence that the invention therein shown was the invention of such party, and not taken as evidence of the existence of the invention at the date of the surrounding entries in the book, in the absence of corroborating circumstances or the positive testimony of witnesses. *Jillson v. Winsor*, 1 MacA. Pat. Cases, 136.

§ 2091. The drawings need not set forth the old machinery with which the new invention is connected. *Emerson v. Hogg*, 2 Blatch., 1.

§ 2092. To make the patent valid, the drawings should be so made that they could be used for working drawings, or that a machine made in accordance with the exact scale of the drawings which accompany the patent in the patent office, either in England or in this country, should be an operative machine. *American Hide and Leather Splitting Co. v. Tool Co.*, 1 Holmes, 503.

§ 2093. The omission of references to the drawing, unless necessary to an understanding of the improvement, cannot vitiate the patent (act 1836). *Brooks v. Bicknell*, 3 McL., 250.

§ 2094. Where the patent office model has been destroyed, an alleged mistake in the patent-drawing should be very clearly established before a court should attempt to change by decree the position of a part represented in such drawing. *Royer v. Russell*, 9 Fed. Rep., 696.

§ 2095. It is proper to disclaim one figure of a drawing and retain another figure which illustrates a distinct device, all of whose features are clearly described, although the distinctive principle of the invention is neither known nor stated. *Brush v. Condit*, 20 Fed. Rep., 826.

118. DUPLICATION, NON-INVENTION.

See INVENTION, NON-INVENTION, DUPLICATION.

119. EMPLOYEE.

See EMPLOYER AND EMPLOYEE.

120. EMPLOYER AND EMPLOYEE.

SUMMARY (*APPLETON v. BACON*, §§ 2096, 2097) — *Inventor under contract*, § 2096. — *Patent issued to wrong person*, § 2097.

APPLETON v. BACON.

(2 Black, 699-704. 1862.)

Opinion by MR. JUSTICE NELSON.

STATEMENT OF FACTS.—This is an appeal from the circuit court of the United States for the District of Columbia.

The bill was filed by the plaintiffs against the defendant, Bacon, to compel him to surrender and cancel letters patent for a new and useful machine for folding paper, granted 10th of August, 1858. Both parties set up a claim to the invention as assignees of John North, the inventor. The assignments to the plaintiffs were made under the dates of 12th of August, 1858, and 7th July, 1859. The defendant claims under an agreement made between North and the American Book & Paper Folding Company, dated 6th of February, 1854, and between the same company and Newell and John North, 2d of May, 1854, and by a subsequent verbal agreement between the defendant and John North some time in May, 1856.

According to the terms of the two written agreements between North and the American Company, the former stipulated to engage in the service of the company, and devote himself to the making of improvements in paper-folding machines for a compensation mentioned; and, further, that all improvements and inventions made or discovered should be the property of the company; and that he would take all proper steps for the purpose of procuring patents for said improvements. It was further stipulated that this agreement may be terminated by North on giving three months' notice after having served one year, and the company at any time on giving thirty days' notice.

This company, having subsequently resolved to close their business, gave a written notice to North on the 30th of May, 1857, that his services would be no longer required. And, about the same time, sold, at auction, among other things, their interest in the improvements made by North in paper-folding machines, including a patent issued 15th of April, 1856, to North, and another issued to E. N. Smith, 27th of November, 1849, and reissued 7th of January, 1851, which interests and property were purchased by one Anson Hardy. And, on the 1st of July, 1856, said Hardy assigned all his interest in the property to Bacon, the defendant.

The defendant, after his purchase of these machines, made a verbal arrangement with North to enter into his service and devote himself to making improvements in folding-machines upon the same terms and conditions as those under which he had been previously engaged with the company. This arrangement continued till about the middle of July, 1857, when he left the service of the defendant and engaged in the manufacture of sewing-machines. Now, it is claimed by the defendant that the inventions or improvements embraced in the paper-folding machine in question were the fruits of the labors of North while engaged in his, the defendant's, service, and when he was entitled to the benefit of his discoveries, or when he (North) was engaged in the service of the American Paper-Folding Company, who were entitled to the benefit of these discoveries, and which passed to him, the defendant, by assignment. The right, as thus derived, constitutes the title of the defendant to the invention and patent in controversy.

It has already been stated that, among the property which passed to the defendant from the American Company through Hardy, was the patent to North for a paper-folding machine issued 15th of April, 1856. The labors of North, while in the service of the defendant, were devoted to improvements upon this machine, and it is this machine as improved in July, 1857, when North left the service of the defendant, that it is claimed embodied the invention and improvements in question, and for which a patent was issued to the defendant 10th of August, 1858. The circumstances under which this patent was issued will be stated hereafter. For the present, our inquiry is, whether or not North made these discoveries while engaged in the service of the defendant or in the service of the American Folding Company.

North, who was made a defendant and a party on the record, was called as a witness on the part of the plaintiffs, and very fully examined on both sides. No objection is taken to the competency of his testimony before the officer taking it, nor in the brief in this court, and we must regard it, therefore, as admitted by consent. This witness, after giving a history of the machine, of its exhibition at the fair of the American Institute in the fall of 1856, and also at Appleton's bindery, in Franklin street, in the city of New York, in February, 1857, and of some improvements made upon it at that place, states that

about the 1st of June, 1857, he removed the machine to a shop in Middletown, Connecticut, and worked upon it there some six weeks endeavoring to improve it, but with no good results; gave up the effort and went into other business—making sewing-machines. This was about the middle of July, 1857.

The difficulties in the working of the machine while at Appleton's, and at Middletown, were in the adjustment to correspond with the different signatures—the register, also, was imperfect—and a fullness in the sheet which wrinkled it.

This machine was afterwards removed to Colt's armory in Hartford, Connecticut; and we have the testimony of E. K. Root—a witness for the defendant, and mechanical engineer—who examined it there, and saw it in operation. He was asked: "Of the sheets you have seen folded on that machine, what proportion were crimped or wrinkled, and to what amount?" Answer: "My impression is that about one-half were wrinkled more or less—pretty much all on one side of the machine—so much as to be objectionable." "To what extent, if at all, would you consider the amount of wrinkling you observed as affecting of itself the practical value of the machine?" Answer: "I should say it would prevent its use on all good book work."

This testimony is confirmed by two other witnesses, Gavet and Mathews.

§ 2096. *An inventor under a contract with an employer to make improvements in machines is not bound to give other improvements invented after his contract had expired.*

The machine to which these witnesses refer and speak of embodied all the improvements ever made upon it by North. Indeed, it is admitted he made none after the middle of July, 1857, and it is quite clear from the evidence that it was an unsuccessful experiment as a practical folding-machine, and abandoned by him as such.

In the spring of 1858, North, at the solicitation of Mathews, who had charge of the bindery department of the Appletons, turned his attention to the invention of a machine that would fold the size of duodecimo sheets, all the previous machines that had been constructed having been adapted only to the folding of octavo volumes. As five-sixths of the business of book folding was of the small size, the invention was regarded as a great desideratum. This is the machine afterwards produced by North, and for which he applied to the patent office for a patent. The necessary papers, model, and certificate of payment of the patent fee were forwarded to the office 27th of May, 1858. The machine will fold books of both octavo and twelve-mo size with entire success.

§ 2097. *A patent issued to the wrong person must be delivered up and canceled.*

The papers and model were filed in the patent office 10th June, 1858, and the patent issued to S. T. Bacon, the defendant, instead of to John North, the inventor, on the 10th of August following, and this without any previous notice to him. How this happened in the commissioner's office has not been explained. It was a very grave irregularity. The specification on file was in the name of North, the application in his name, and the patent fee paid by him. We have seen the defendant, to whom it was issued, had no right to it, legal or equitable. The officer must have been imposed upon by the use of the old machine of 1856, which we have seen was but an unsuccessful experiment, and abandoned. The plaintiffs, as assignees of North, having made

out a clear right to the patent, and the decree of the court below must be reversed and the cause remitted, with instructions to enter a decree for the plaintiffs, directing the defendant to surrender the patent to be canceled.

Employer and employee—*Mere fact of employment gives no title to employee's invention*, §§ 2098-2103. *Government employees*, §§ 2104, 2105. *Generally*, §§ 2106-2109.

§ 2098. Persons are not deprived of the right to their inventions while in the service of others, unless they have been hired and paid to exercise their inventive faculties for their employers. *Hapgood v. Hewitt*, 11 Fed. Rep., 422.

§ 2099. Where a workman on fixed wages made an invention applicable to purposes other than those of the special employment in which he was engaged, which was patented to his employer as assignee, who, for a half interest, paid expenses, *held*, that the workman had an equitable interest in the other half, and that employer, as owner of legal title, stood, in a court of equity, as trustee for the use of party beneficially interested. *Whiting v. Graves*, 13 O. G., 455.

§ 2100. A workman engaged to make improvements in the special machinery of a fancy dry-goods manufactory, of which his employer is to have the fullest benefit, forfeits no part of his title to letters patent for inventions which are of general applicability and not confined to the specialties of construction in the factory machinery. *Ibid.*

§ 2101. The terms of the particular contract may operate as a license to the employer to use machinery invented by the workman and put in use during his employment, but it would not of itself confer any legal title to the invention, or to letters patent protecting it. *Ibid.*

§ 2102. Hence, where the employer rested his suit for infringement on a legal title obtained under such circumstances, the court ruled that the equitable title of the workman under which the defendants justified was superior, and that there was no infringement. *Ibid.*

§ 2103. The mere fact of employment gives to the employer no title in letters patent for inventions made by the workman while in his service. *Ibid.*

See *License*, §§ 4009-4014.

§ 2104. A government workman, employed to do work for it under specific orders, cannot be held liable in a court of the United States for infringing a patent by doing such work. *Heaton v. Quintard*, 7 Blatch., 73.

§ 2105. The second section of the patent act of 1836 does not declare that a person taking employment in the patent office shall be held to have forfeited or dedicated to the public thereby any invention before made by him. It simply prevents him from acquiring an interest in a patent while he remains such employee. The disability ceases with the employment. *Page v. Holmes Burglar Alarm Telegraph Co.*, 17 Blatch., 484.

§ 2106. The servants of a municipal corporation are bound by an injunction awarded against the corporation. *Phillips v. City of Detroit*, 2 Flip., 92.

§ 2107. If one does not in person perform the work, but procures another to do it for his advantage on a machine owned by himself, he can still be restrained and is estopped from denying, *qui facit per alium facit per se*. *Woodworth v. Hall*, 1 W. & M., 648.

§ 2108. An improvement which becomes necessary in the manufacture of a patented implement in order to overcome a difficulty growing out of a departure from the form of the model, and which is introduced into it by the workmen without the knowledge of the patentee, cannot be appropriated by him as his invention. *Berdan Fire-Arms Manufacturing Co. v. Remington*, 3 O. G., 688.

§ 2109. If such an improvement is embodied by the assignees of the patentee in a reissue, they cannot recover upon it against others who use it. *Ibid.*

See *Contracts*, §§ 1313, 1314. *Infringer*, §§ 2981-2986. *Inventor and Employee*, §§ 3762-3772. *Suggestions*, § 6232. *Use*, § 6566.

121. EQUITY.

See JURISDICTION, EQUITY. PLEA IN EQUITY. PRACTICE, EQUITY. TRIAL OUT OF EQUITY.

122. EQUIVALENT.

See COMBINATION, INFRINGEMENT OF, BY SUBSTITUTION OF EQUIVALENT. SUBSTITUTION OF EQUIVALENT.

Equivalent—*In what it consists*, §§ 2110-2131.

§ 2110. The term "equivalent" has two meanings,—the results that are produced, and the mechanism by which those results are produced. *Johnson v. Root*, 1 Fish., 351.

§ 2111. By an equivalent is meant that the ingredient substituted for the one withdrawn performs the same function as the other, and that it was well known at the date of the patent securing the invention as a proper substitute for the one omitted in the patented combination. *Gill v. Wells*, 22 Wall., 1.

§ 2112. The term "equivalent," as applied to a combination of old elements, is special in its signification and somewhat different from what is meant when the term is applied to an invention consisting of a new device or an entirely new machine. *Imhaeuser v. Buerk*, 11 Otto, 647.

§ 2113. In the former case it means that the patent in respect to each of the respective ingredients comprising the invention covers every other ingredient which in the same arrangement of the parts will perform the same function, providing it was well known as a proper substitute for the one described in the specification at the date of the patent. *Ibid.*

§ 2114. An equivalent of any substance is another substance having similar properties and producing substantially the same effect. *Matthews v. Skates*, 1 Fish., 602.

§ 2115. Different devices, or devices differing in form and having different names, employed for the same purpose as those of complainant's, and in which the plan or idea, arrangement, combination and result are the same, *held* to be equivalents therefor. *Howe v. Williams*, 2 Cliff., 245.

§ 2116. Equivalents are such ingredients as will perform the same function as the one described, and which were well known at the date of the patent as proper substitutes for the ones actually described in the patent. *Storrs v. Howe*, 4 Cliff., 388.

§ 2117. A device is the equivalent of one that is patented if it performs substantially the same function in the same way, and produces the same result, though it may be of a different form and bear a different name; and the use of it will be an infringement. *Westlake v. Carter*, 4 O. G., 636.

§ 2118. To be an equivalent one device must perform the same function in substantially the same way as the other. *Peard v. Johnson*, 23 Fed. Rep., 507.

§ 2119. A device that performs all the functions of one that is patented substantially in the same way and by the same means is not the less an equivalent of it because it performs some of those functions better or performs others in addition to them. *Wheeler v. Clipper Mower & Reaper Co.*, 10 Blatch., 181.

§ 2120. *Held*, that a certain element of defendant's combination was none the less an equivalent of one of plaintiff's elements in all the functions, mode of operation and construction of the latter, although by an additional feature it had, also, a further useful function. *Sarven v. Hall*, 11 Blatch., 295.

§ 2121. When a substitute is used for one ingredient in a patented combination which has every property and performs every function of the original in the combination, it does not cease to be an equivalent because, in addition, it does something more and better. *Atlantic Giant Powder Co. v. Goodyear*, 13 O. G., 45.

§ 2122. It is not true that a device is necessarily the equivalent to another, merely because it effects the same result. *Merriam v. Drake*, 9 Blatch., 336.

§ 2123. If the construction is different, the mere producing of the same result does not make the defendant's device an equivalent, where the special construction is the distinguishing and patented feature of the thing patented. *Reckendorfer v. Faber*, 12 Blatch., 68.

§ 2124. A substance held an equivalent for an element in a patented invention on evidence in relation to such equivalency different from that in a prior case where the same substance was held a non-equivalent. *Goodyear Dental Vulcanite Co. v. Preterre*, 15 Blatch., 274.

§ 2125. Equivalents are to be known by an inference drawn from all the circumstances of the case, by attending to the consideration whether the new contrivance is used for the same general purpose, performs the same kind of duties, or is applicable to the same object as the old device. *In re Nutting*, 1 MacA. Pat. Cases, 455.

§ 2126. If the change introduced by the appellant constitutes a mechanical equivalent in reference to the means used by a patentee, and besides being such an equivalent it accomplishes some other advantages beyond the effect or purpose accomplished by the patentee, such further advantages may make it a patentable subject as an improvement upon the former invention. *In re Hebbard*, 1 MacA. Pat. Cases, 543.

§ 2127. Equivalents are allowed in every class or description of inventions. *Storrs v. Howe*, 4 Cliff., 388.

§ 2128. It has never been held that an equivalent known at the date of the invention could be used without infringing the patent; such a holding, if generally adopted, would amount practically to the destruction of the law of equivalents. *Kuhl v. Mueller*, 21 Fed. Rep., 510.

§ 2129. The substantial equivalent of a thing is where two machines do the same work in substantially the same way, and accomplish substantially the same result. *Cahoon v. Ring*, 1 Cliff., 592.

§ 2130. The substantial equivalent of a thing is the same as the thing itself; so that if two devices do the same work, in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape. *Machine Co. v. Murphy*, 7 Otto, 120.

§ 2131. The term "equivalents" in the claims, being construed with reference to the essential characteristics of the invention set forth in the specification, relieves the patent from the objection of lack of novelty. The prior devices accomplish the same result by different means, and are not "equivalents" under the limitation. *Miller's Falls Co. v. Ives & Co.*, 14 Blatch., 169.

See *Combination*, § 1010.

Equivalents — Chemical, §§ 2132-2138. See *Composition of Matter*, § 1121.

§ 2132. Where the patentee had indicated the propriety of using means to maintain a certain condition in his patented process, *held*, that he was entitled to use in carrying out his process any means then known and used in the same art for maintaining the same condition. *Tilghman v. Mitchell*, 9 Blatch., 1.

§ 2133. It has not been considered safe since the leading case of *Crane v. Price*, 1 Web. Pat. Cases, 409, to invoke the ordinary doctrine of equivalents in construing patents for new manufactures or compositions of matter. *Rumford Chemical Works v. Hecker*, 10 O. G., 289.

§ 2134. Where defendant's solution is amenable to the same laws as that of the plaintiff, and to give the same result must be used under the same conditions and be free from the same impurities, and be made according to the same principles as that of the plaintiff, it is a chemical equivalent of the plaintiff's solution. *United Nickel Co. v. Pendleton*, 15 Fed. Rep., 739.

§ 2135. The substitution in a patented mixture of an ingredient which, although not precisely the same in its action, produces all the valuable and beneficial results attending that for which it was substituted, and in substantially the same manner, is to be regarded as an equivalent and an infringement of the patent. *Atlantic Giant Powder Co. v. Mowbray*, 12 O. G., 3.

§ 2136. The substitution of chemical equivalents is an infringement of a patent, even though they form an improvement upon the patented process. *Woodward v. Morrison*, 1 Holmes, 124.

§ 2137. In order to constitute an infringement of a patent for a chemical process, the equivalent need not possess all the properties of the ingredient for which it is substituted, but it must have substantially the same effect in the process. *Ibid.*

§ 2138. Whether or not equivalents are claimed, a patentee is protected against equivalents of any part of his invention. But when a product arrived at by certain defined stages or processes is patented, only those things can be considered equivalents for the elements of the manufacture which perform the same function in substantially the same way. *Goodyear Dental Vulcanite Co. v. Davis*, 12 Otto, 222.

See § 3634.

Equivalents — In combinations, §§ 2139-2146. *Patentee's right to*, §§ 2139-2146. See *Substitution*, §§ 6203-6223.

§ 2139. *Bona fide* inventors of a combination are as much entitled to equivalents as the inventors of other patentable improvements. *Gould v. Rees*, 15 Wall., 187.

§ 2140. Inventors of new combinations of old ingredients can claim equivalents. *Gill v. Wells*, 22 Wall., 1.

§ 2141. It is now well settled that the patentee or owner of a patent for a combination is as much entitled to equivalents as the patentee or owner of any other class of inventions. By an equivalent in such a case it is meant that the element or ingredient substituted for the one withdrawn performs the same function as the other, and that it was well known at the date of the patent in question as a proper substitute for the one omitted in the patented combination. *American Whip Co. v. Lombard*, 4 Cliff., 495.

§ 2142. Inventors of a combination are as much entitled to equivalents as the inventors of other patentable improvements, if the equivalents were known to be such at the date of the patent. *Goodyear Dental Vulcanite Co. v. Preterre*, 15 Blatch., 274.

§ 2143. In a patent for a combination, the use of equivalents, known to be such at the date of the patent, may be excluded. *Burdett v. Estey*, 16 Blatch., 105.

§ 2144. Equivalents may be claimed by a patentee of an invention consisting of a combination of old elements or ingredients, as well as of any other valid patented improvement, provided the arrangement of the parts composing the invention is new and will produce a new and useful result. *Imhaeuser v. Buerk*, 11 Otto, 647.

§ 2145. The inventor of a new combination of old elements is also entitled to the benefit of all the mechanical equivalents of his several elements, known at the time of his invention, if used in the same combination. *Wicke v. Ostrum*, 13 Otto, 461.

§ 2146. Where the patentee's first combination claim was new, he was held entitled to the benefit of the doctrine of equivalents as applied to his sub-combinations. *Clough v. Gilbert & Barker*, 106 U. S., 166.

Equivalents — Doctrine of — Patentee's right to, §§ 2147-2159.

§ 2147. A patent covers all equivalent modes of carrying the invention into effect, although they are not specifically described in the specification, and the patentee is not entitled to a new patent for those equivalent modes. *Bowen v. Herriet*, 1 MacA. Pat. Cases, 310.

§ 2148. Where a party has discovered a result, as well as the machinery which produces it, he has a right to invoke the doctrine of equivalents in reference to infringers; so, also, of a new function and new machine. *Singer v. Walmesley*, 1 Fish., 558.

§ 2149. An inventor, without describing equivalents in his patent, is entitled to be protected in their use and to treat their use by others as an infringement. *Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 11 O. G., 1113.

§ 2150. Where the invention is novel and broadly claimed, the omission of a distinct claim to equivalents will not avoid the finding of an infringement where such equivalents are used. *Standard Measuring Machine Co. v. Teague*, 15 Fed. Rep., 390.

§ 2151. If he is an original inventor of the improvement he is entitled to the benefit of un-substantial variations and modifications of his invention, notwithstanding such modifications may run into and include forms of mechanism shown in the abandoned experiments of which he had knowledge, *provided*, the invention is properly claimed and set forth in his specification. *Union Paper Bag Machine Co. v. Pultz & Walkley Co.*, 15 Blatch., 160.

§ 2152. Equivalent mechanism, known at the date of the invention, which accomplishes in the same way and by the same mechanical means the same result, is protected by the patent. *Stanley Rule & Level Co. v. Bailey*, 14 Blatch., 510.

§ 2153. The right of complainant to change the form of construction from that shown in his patent, and substitute a well known equivalent for it, is fully established. *Putnam v. Hutchinson*, 12 Fed. Rep., 131.

§ 2154. When the thing complained of as an equivalent of the thing patented cannot be used as directed in the patent, and its use as there directed would render the patented thing inoperative, it is not an equivalent and not an infringement. *Couse & Blood v. Johnson*, Black & Co., 16 O. G., 719.

§ 2155. The inventor of the first improvement on a prior invention cannot invoke the doctrine of equivalents to suppress other improvements, which are not mere colorable invasions of the first. *Burden v. Corning*, 2 Fish., 477; *Seymour v. Osborn*, 3 Fish., 555.

§ 2156. An inventor who is only an improver, and not the first in the art, is not entitled to invoke broadly the doctrine of mechanical equivalents so as to cover devices not specifically claimed. *Tobey Furniture Co. v. Colby*, 34 O. G., 1276.

§ 2157. Where satin white was substituted for blanc fix in an enameled paper collar, *held*, that it was an equivalent. *Hoffman v. Aronson*, 8 Blatch., 324.

§ 2158. The doctrine of equivalents should be critically scanned where there may be a difference in relation to two machines which in some respects operate by equivalent devices, and in other respects do not, to ascertain whether one has become a practical machine and the other not. *Sayles v. Chicago & Northwestern R. Co.*, 1 Biss., 468.

§ 2159. A general reference to equivalents for one of the elements, in a reissue, *held* to be limited to those equivalents then known. *Goodyear v. Berry*, 2 Bond, 189.

See *Improvements*, §§ 2727, 2794. *Reissues*, § 5321.

Equivalents — Mechanical, §§ 2160-2178.

§ 2160. "Equivalent" as applied to machines defined by illustrations. *Burr v. Duryee*, 1 Wall., 531.

§ 2161. A mechanical equivalent, another way of doing the same thing, by means of mechanical skill, is not invention. *McCormick v. Seymour*, 2 Blatch., 240.

§ 2162. A mechanical equivalent is where one may be adopted instead of the other, by a person skilled in the art, from his knowledge of the art. *Johnson v. Root*, 1 Fish., 351.

§ 2163. A mechanical equivalent is a device which performs substantially the same office with the thing described in substantially the same way. *Conover v. Rapp*, 4 Fish., 57.

§ 2164. Any application of known mechanical powers which will produce that result, although different in form from the means employed by the original patentee, is a mechanical substitute and equivalent of the same. *Wilt v. Grier*, 5 Fed. Rep., 450.

§ 2165. It is sufficient to constitute known mechanical substitutes, that, when a skillful mechanic sees one device doing a particular thing, he knows the other devices, whose uses he is acquainted with, will do the same thing. *Carter v. Baker*, 1 Saw., 512.

§ 2166. It is not enough to show that one mechanical device is the equivalent of another, that it accomplishes the same result, that it produces the same effect, unless that effect is produced by substantially the same mode of operation. *Conover v. Roach*, 4 Fish., 12.

§ 2167. Mechanical equivalents are not those merely which produce the same result. A mechanical equivalent, as generally understood, is where one device may be adopted instead of another to perform the known function of the latter, by a person skilled in the art, from his knowledge of the art. *Smith v. Marshall*, 10 O. G., 375.

§ 2168. Whether one thing is a mechanical equivalent for another is a question of fact depending on the testimony of experts, an inspection of the machines, and it is an inference to be drawn from all circumstances of the case. *Foss v. Herbert*, 1 Biss., 121.

§ 2169. Mechanical equivalents, when and when not an infringement. *Parker v. Stiles*, 5 McL., 44.

§ 2170. *Alternative* but different mechanisms which produce in whole or in part the same or similar useful effects are not mechanical equivalents in that sense in which their use constitutes an infringement. *Wells v. Hagaman*, 29 Leg. Int., 405.

§ 2171. The various parts of the defendant's machine exhibit mechanical parts equivalent to those in complainant's machine and produce the same result, and therefore infringe, notwithstanding the two machines in various particulars are unlike in form. *Graham v. Geneva Lake Crawford Manufacturing Co.*, 11 Fed. Rep., 138.

§ 2172. Mere substitution of well known mechanical equivalents will not avoid infringement. *Conover v. Roach*, 4 Fish., 12.

§ 2173. Technical equivalents do not belong to a mere combination of old elements. *Sands v. Wardwell*, 3 Cliff., 277.

§ 2174. The doctrine of mechanical equivalents does not apply to a patent for a peculiar combination of old elements. *Crompton v. Belknap Mills*, 3 Fish., 536.

§ 2175. By equivalents in machinery is usually meant the substitution of merely one mechanical power for another, or one obvious and customary mode for another of effecting a like result. *Smith v. Downing*, 1 Fish., 64.

§ 2176. One device may be the equivalent of another in the general combination with other elements, and yet, when taken by themselves as separate pieces of machinery, they may not be the same, and the use of one not the infringement of a patent for the other. *Cochrane v. Deener*, 4 Otto, 781.

§ 2177. While the parts of machinery which go to make up a combination could not, when separately considered, be regarded as identical or conflicting with those described in a patent, yet having the same purpose in the combination, and effecting that purpose in substantially the same manner, they are the equivalents of each other in that regard. *Ibid.*

§ 2178. A rod is the known equivalent of an endless chain in machinery when it can be used for the same purpose and to accomplish the same effect, and they are not, therefore, when so used, substantially different. *Spain v. Gamble*, 1 MacA. Pat. Cases, 358.

See *Invention*, § 3635.

123. ERRORS.

See CONSTRUCTION OF PATENTS, IN CASE OF ERRORS IN PATENTS. REISSUES, ACCIDENT, INADVERTENCE OR MISTAKE, CONSTRUCTION OF STATUTES. DELAY, ARISING FROM OFFICE ERRORS. See, also, CONSTRUCTION OF PATENTS, §§ 1154, 1155. JURISDICTION, § 3892. REISSUES, §§ 5337-5814.

Errors — In patents, §§ 2179-2183. Of patent office, §§ 2184-2188.

§ 2179. The sanction of the secretary of state, to a correction of a clerical mistake in letters patent, may be given in writing afterwards; and he need not re-sign the letters themselves. And if the correction be only of a clerical error, it operates back to the original date of them, unless perhaps as to third persons who have acquired intervening rights to be affected by the alteration. *Woodworth v. Hall*, 1 W. & M., 389.

§ 2180. On correcting an error in letters patent (the length of term), it would seem unnecessary for the commissioner to re-sign or recall them; but the secretary of state should sign anew. *Woodworth v. Hall*, 1 W. & M., 248.

§ 2181. The date of a patent issued for an invention may be corrected to correspond with a patent granted by the king of Bavaria, where the mistake arose from no fraudulent or deceptive intention. *Nelson's Opinion*, 4 Op., 335.

§ 2182. A correction of a mistake as to a certain effect said to be obtained is the office of a reissue and not of a disclaimer. *Schillinger v. Gunther*, 15 Blatch., 303.

§ 2183. An obvious mistake in copying the specification of a reissue, easily corrected by reference to other parts of the patent and the machine described, held not to impair patentee's rights. *Kendrick v. Emmons*, 9 O. G., 201.

§ 2184. A patentee should not be prejudiced by the accidental omissions of the patent office. *Phelps v. Brown*, 4 Blatch., 362.

§ 2185. A clerical error and one made in the patent office held not to invalidate a reissue of letters patent. *Bignall v. Harvey*, 18 Blatch., 353.

§ 2186. Where the law allowed the refund of the balance of a fee, upon condition of the withdrawal of an application case at a certain stage, Simpson, the applicant, who received such balance upon request, but without expressly withdrawing the case or otherwise manifesting such intention, declared not to be prejudiced by the mistaken office action. *Colgate v. Western Union Telegraph Co.*, 15 Blatch., 365.

§ 2187. *Semble*, that a patent, after being corrected in a material mistake, could not operate as to third persons against whom prosecutions were pending, but only for causes accruing after the correction. Different if a clerical mistake. *Woodworth v. Hall*, 1 W. & M., 248.

§ 2188. As a court can correct the errors of its clerk in the discharge of his ministerial duties, the commissioner of patents, no doubt, may do the same as to his clerks in correcting a merely clerical error in a patent, but he cannot thus correct an error of judgment as to his power and authority under the law. *In re Cushman*, 1 MacA. Pat. Cases, 577.

See *Defenses*, § 1841. *Delay*, §§ 1874-1877. *Inventors, Joint*, § 3792. *Term*, §§ 6256, 6257. *Void Patent*, §§ 6727-6729.

124. ESTOPPEL.

See LICENSE, ESTOPPEL.

SUMMARY (*KINSMAN v. PARKHURST*, §§ 2189-2193).—*Partner cannot deny validity of title*, § 2189.—*Mutual obligations of joint owners*, §§ 2190, 2192.—*Contracts in restraint of trade*, § 2191.—*Exceptions to master's report*, § 2193.

KINSMAN v. PARKHURST.

(18 Howard, 289-295. 1855.)

Opinion by MR. JUSTICE CURTIS.

STATEMENT OF FACTS.—This is an appeal from a decree of the circuit court of the United States for the southern district of New York, in a suit in equity brought by the appellee, Parkhurst, against the appellants. The bill states, and the proofs show, that Parkhurst, being the owner of letters patent for improvements in the machine for ginning cotton and wool, on the 22d of May, 1845, entered into a written agreement with Kinsman, the substance of which was, that Parkhurst was to be the owner of two-thirds and Kinsman of one-third of the letters patent; that the business of manufacturing and selling the patented machines should be carried on by the parties on their joint account in the proportions of two-thirds and one-third, Kinsman giving his personal attention to the business, and advancing a sum not exceeding \$1,000 for the purchase of machinery, stock, etc., for which advance he was to be repaid out of the first profits of the business. Kinsman was to pay Parkhurst \$2,000 in cash, and give his note for \$1,000, payable in sixty days. Under this agreement, the manufacture and sales of the machines were begun and carried on until the 9th day of February, 1846, at which time the parties entered into a new agreement, the substantial part of which was as follows:

“Whereas the party of the first part has advanced moneys, and become responsible for various sums of money which have been expended in getting up machinery, and tools, and stock, etc., for the manufacture of burning and carding machines, which were invented by the said Parkhurst; one-third part of which he sold and assigned to the party of the first part: Now, therefore, the party of the first part, in consideration of \$1 in hand paid by the party of the second part, the receipt whereof is hereby acknowledged, hereby covenants and agrees that, as soon as the profits which have accrued, and which may hereafter arise, from the manufacture and sale of the said machines, so in-

vented by the party of the second part, and so made and sold by the party of the first part, shall be sufficient to pay all legal demands for the purchase of machinery, tools, etc., etc., and other expenses incurred by said party of the first part, then he, the said party of the first part, shall and will discontinue the manufacture and sale of said machines, invented as aforesaid, and that all machines which he shall manufacture and sell after this date should not be sold for a less profit than \$100 each, and that he will be accountable for \$100 profit on each and every machine made and sold from this day, unless he has the written consent of the party of the second part to sell at a less price."

"The party of the second part, in consideration of \$1 to him in hand paid by the party of the first part, the receipt whereof is hereby acknowledged, and also in consideration of the agreements aforesaid, hereby covenants and agrees with the party of the first part, that he will go on and manufacture the machines aforesaid as soon as the party of the first part discontinues the same, and that he will not sell any machine for a less profit than \$100, without the written consent of the party of the first part, and that he will pay over to the party of the first part one-third part and share of the said profits upon all machines which he makes and sells hereafter, and that, for any machines which he may manufacture, or have manufactured, before the discontinuing of the building of the same by the party of the first part, shall be subject to the same restrictions of selling for at least \$100 profit on each machine, one-third of which shall be paid to the party of the first part."

The original and supplemental bills aver that under this agreement Kinsman prosecuted the business, and not only reimbursed himself for the cost of the machinery, tools, etc., and all his other advances, but, in violation of his agreement, continued the manufacture and sale of the machines, so as to receive large profits, of which it prays an account, and also an injunction to restrain the further making or vending of the machines in violation of the agreement. A temporary injunction was applied for and obtained on the 3d day of July, 1847. On the 29th day of June, 1847, Kinsman made a transfer to the appellant, Goddard, who was then a clerk in his employment, of the tools, stock, etc., used in the manufacture; and, after Kinsman was enjoined, the business was carried on in Goddard's name. A supplemental bill was then filed, making Goddard a party, charging him with notice of all the complainant's rights at the time of the transfer to him, alleging the transfer itself to have been only colorable, and praying an account and decree as against him and Kinsman. The circuit court made an interlocutory decree declaring Parkhurst's right to an account, referring the cause to a master to take and state the accounts, directing the master, in taking the accounts, to ascertain and report the number of machines made and sold by Kinsman and Goddard, or either of them; the advances made by Kinsman and Goddard, or either of them; and charging a profit of \$100 on each machine sold.

The master reported; and his report, not being excepted to, was confirmed, and a final decree made that Kinsman and Goddard should pay to the complainant the amount reported by the master to be due from them. From this decree the appeal now before us was taken.

§ 2189. *A partner cannot defeat an action for an account for the profits of a patent-right on the ground of invalidity of the patent.*

The principal objection made by the appellants to the decree of the court below is, that Parkhurst was not the original and first inventor of the thing

patented. We are not satisfied that this is made out. But we have not found it necessary to come to a decided opinion upon this point, because we are all of opinion that, under the agreement of the 9th of February, 1846, the invalidity of the patent would not afford a bar to the complainant's right to an account. Having actually received profits from sales of the patented machine, which profits the defendants do not show have been or are in any way liable to be affected by the invalidity of the patent, its validity is immaterial. Moreover, we think the defendants are estopped from alleging that invalidity. They have made and sold these machines under the complainant's title and for his account; and they can no more be allowed to deny that title and retain the profits to their own use than an agent, who has collected a debt for his principal, can insist on keeping the money, upon an allegation that the debt was not justly due.

§ 2190. *Obligation of agent or joint owner to account.*

The invalidity of the patent does not render the sales of the machine illegal, so as to taint with illegality the obligation of the defendants to account. Even where money has been received, either by an agent or a joint owner, by force of a contract which was illegal, the agent or joint owner cannot protect himself from accounting for what was so received by setting up the illegality of the transaction in which it was paid to him. Thus, where a vessel engaged in an illegal trade carried freight which came into the hands of one of the part owners, and on a bill filed by the other part owner for an account the defendant relied on the illegality of the trade, but it was held to be no defense. *Sharp v. Taylor*, 2 Phil. Ch. R., 801. So in *Tenant v. Elliot*, 1 B. & P., 3, the defendant, an insurance broker, having effected an illegal insurance for the plaintiff, and received the amount of a loss, endeavored to defend against the claim of his principal by showing the illegality of the insurance, but the plaintiff recovered. See, also, *McBlair v. Gibbes*, 17 How., 236 (CONTRACTS, §§ 457-58).

Here, however, as already observed, there was no illegality; it is simply a question of failure of title, and as that does not appear in any manner to have affected the profits which the defendants received, there can be no ground to allow it to be shown in defense. *Bartlett v. Holbrook*, 1 Gray, 114; *Wilder v. Adams*, 2 Woodb. & M., 329, are in point.

§ 2191. *A contract between partners who are joint owners of a patent-right for the manufacture and sale of patented article by one only of the partners is not in restraint of trade.*

Similar views are decisive against the objection that this was a contract in restraint of trade. It was certainly competent for two persons, being joint owners of letters patent, whether valid or invalid, to enter into a copartnership for the manufacture and sale of the patented machines, and to stipulate that one of them should alone conduct the business. This was a provision for the prosecution of the business in a particular mode, and not for its restraint. It is a very common and not an illegal stipulation in partnership articles that neither party shall carry on that business for which the partnership is formed outside of the partnership and for his own account. Besides, if the contract to refrain from the manufacture could not be enforced, as being against public policy, this would afford no answer to a claim for an account of profits actually realized by prosecuting the business, there being no connection between the illegal stipulation and the profits of the business.

§ 2192. *In suit for infringement between joint owners of a patent-right, who are also partners, defendant, joint owner, cannot secretly acquire an outstanding right and set it up against his joint owner.*

It was insisted by the appellants that they did not act under the complainant's title, but under some right acquired from one Sargent. We are not satisfied that Sargent had even an inchoate right to a patent for the machines which the appellants made and sold. But even if he had, the defendant, Kinsman, could not secretly acquire the outstanding right of Sargent, if any, and set it up against his joint owner, Parkhurst, in derogation of his rights under the agreement of the 9th of February, which Kinsman entered into with knowledge of this alleged title of Sargent; and Goddard is bound by the same equities, for he not only purchased *pendente lite*, and with actual notice of the suit, but we are satisfied the sale to him was made to enable Kinsman to attempt to evade the injunction.

The appellant, Goddard, objects that he has been charged by the final decree, jointly with Kinsman, for the profits on sales of machines made before the transfer to him by Kinsman. If this be so, it arises from the report of the master, who was directed by the interlocutory decree to report the sales made by Kinsman and Goddard, or either of them, and the advances and expenditures of them, or either of them.

If his report was in this or any other particular erroneous, it was incumbent on the defendants to have pointed out the error by an exception filed pursuant to the rules of the court on that subject. But no exception was filed, the report was confirmed, and the final decree was drawn up and entered without objection by the appellant, Goddard, reciting that it appears by the report of the master that the sum of \$23,220.28 is due and owing by Kinsman and Goddard to Parkhurst, and thereupon proceeds to decree them to pay that sum.

§ 2193. *Exceptions to master's report cannot be taken on appeal.*

When a motion to dismiss the appeal was made at a former day, on the ground that the master's report not having been excepted to, and the appellants not having objected to the final decree, there was nothing open on this appeal, the appellants' counsel declared that the appeal was designed only to review the interlocutory decree which had decided the merits of the cause, and that, unless error was found therein, there was no ground for the appeal. The motion to dismiss the appeal was overruled, the court being of opinion that it was open to the appellants to review the decision made by the interlocutory decree. But the interlocutory decree does not direct the master to charge Goddard and Kinsman jointly with profits on sales made by Kinsman alone. If the master put such an interpretation on the decree, it was an erroneous interpretation, and should have been brought before the court below by an exception. It is too late to object to it here, for the first time.

The appellants also insist that they were charged with profits not actually received, by reason of the failure of the purchasers to pay, and other causes. But this was in accordance with the agreement of the 9th of February, which stipulates that Kinsman shall be accountable for \$100 profit on each machine made and sold by him. By force of this stipulation, he and Goddard, who acted with him under this agreement, took the risk of bad debts. It appears, from the master's report, that evidence, tending to show that some of these losses were attributable to the interference of Parkhurst, was offered to the master and rejected by him. But, no exception having been taken to bring this point before the circuit court, it is not open here.

We have considered all the objections to the decree of the circuit court, and, finding them untenable, we order the decree to be affirmed, with damages and costs.

Estoppel — By agreement, §§ 2194-2201.

§ 2194. A defendant under a covenant not to infringe is estopped from denying the validity of the patent. *Sargent v. Larned*, 2 Curt., 340.

§ 2195. Where defendant, with full knowledge of an alleged invention prior to plaintiff's, and after opportunity to make all inquiries respecting the merits of such claim, entered into an agreement with plaintiff respecting an interest in his patent, he was held estopped from setting up that plaintiff was not the first and original inventor. *Parkhurst v. Kinsman*, 1 Blatch., 488.

§ 2196. The plaintiffs file their bill for an account and discovery under an agreement, contract or license, granted by them to, and made with, the defendants, the latter admitting the validity of the patents owned by plaintiffs. *Held*, that defendants are estopped from denying the truth of their admissions, unless such agreement was obtained by fraud, surprise or imposition. *Magic Ruffle Co. v. Elm City Co.*, 13 Blatch., 151.

§ 2197. The defendant, in a suit at law for infringement, agreed with the plaintiff, for a valuable consideration, to discontinue the manufacture of the infringing article, and subsequently suffered interlocutory judgment to be entered against himself by default. Afterward he continued to make and sell an article differing but slightly from the former, and a clear infringement of the one patented. A bill in equity having been brought to restrain the unlicensed manufacture, and it appearing that the defenses set up in the answer were within the defendant's knowledge at the time of the action at law, *held*, his agreement cannot be repudiated. It was made for a valuable consideration, with a full knowledge of the facts, and there is nothing to show that it was either unconscientious or unreasonable. *Brooks v. Moorhouse*, 13 O. G., 499.

§ 2198. The defendant, both by the proceedings in the action at law and the agreement signed by him, is concluded from contesting the validity of the patent. *Ibid*.

§ 2199. Where, in a patent suit, defendants entered into an agreement under seal, admitting the validity of the patent, plaintiff's exclusive right, the damages to be paid, and consenting to a decree and perpetual decree, which were awarded, payment made, etc., *held*, on their application, after lapse of several terms, to file a supplemental bill to set aside the decree on the ground of mistake in fact in the agreement, that their solemn admission therein estopped them. *Pentlarge v. Beetson*, 17 Blatch., 306.

§ 2200. Where the plaintiff under a certain contract granted A. a right to use his patented process, and subsequently under said contract and as A.'s agent constructed and sold machinery to defendants to practice the process, *held*, that after notice to A. to terminate the contract, he was none the less equitably estopped as against defendants from insisting that they had infringed his patent, but that after defendants had notice of the controversy between plaintiff and A. as to termination of the contract, defendants' further purchases from A. were at their peril. *Downton v. Yaeger Milling Co.*, 3 McC., 414.

§ 2201. An agreement with a complainant not to manufacture the device of a certain firm does not work an estoppel, it being a controverted fact as to the identity of such device with that alleged to be infringed. *Roemer v. Simon*, 5 Otto, 214.

See *Answer*, § 229. *Contracts*, § 1309. *Plea, in Bar*, § 4767.

Estoppel — By agreement — Licensor and licensee, §§ 2202-2212.

§ 2202. Where plaintiff has taken a lease of a particular machine from defendant, he is estopped from asserting defendant's use of the machine without plaintiff's written consent. *Reutgen v. Kanowrs*, 1 Wash., 168.

§ 2203. The owners of a patent are estopped from prosecuting those who have worked the invention under a license from a third party, relying upon their admissions that he had an interest in it. *Gear v. Grosvenor*, 1 Holmes, 215.

§ 2204. But not from prosecuting those who have used the invention after learning that the owners claimed an exclusive right to it. *Ibid*.

§ 2205. A party cannot put an end to a contract, deny the validity of the patent and refuse to recognize the title of patentee, and, after the patent has been sustained, set up a license from patentee to vend articles on hand after date of rescinded contract. *Moody v. Taber*, 1 Holmes, 325.

§ 2206. No one can justify making and selling a patented article under a license from the patentee after he has repudiated the license and refused to pay the stipulated royalty. *Ibid*.

§ 2207. One who purchases from such licensee with knowledge of his having renounced the contract will also be liable for the sale of the articles he purchases, as well as for the sale of those he makes afterward. *Ibid.*

§ 2208. It is not permissible to the licensee, who has expressly admitted the validity of the patent in a written agreement, to deny its truth in an action for license fees which accrued before the revocation of the license, unless the recitals were introduced by fraud, imposition, mistake or accident; and a parol agreement made prior thereto, reserving the right to contest the validity of the patent, cannot be set up. *Evory v. Candee*, 17 Blatch., 200.

§ 2209. A licensee holding under a license containing acknowledgments and stipulations as to the novelty and validity of the patent is estopped from denying the validity of the patent; and so long as he continues to manufacture and sell, during the life of the license, he must pay royalties. *Washburn & Moen Mfg. Co. v. Cincinnati Barbed Wire Fence Co.*, 22 Fed. Rep., 712.

§ 2210. Doubted whether a license asked for or taken to sell certain goods which the defendants had on hand when the patent was obtained, which seemed to be rather in the nature of a compromise to save trouble than a deliberate acknowledgment of the validity of the patent, would estop defendants from denying the validity of the patent. *White v. Harris & Sons Mfg. Co.*, 3 Fed. Rep., 161.

§ 2211. Where the answer to a bill alleging infringement and praying discovery, account and injunction, denied the validity of the patent and also set up a license, *held*, that licensee was not estopped from denying the validity of the patent, and a motion to withdraw replication in order to file exceptions to answer was refused. *National Mfg. Co. v. Meyers*, 7 Fed. Rep., 355.

§ 2212. One who purchased a patented article from the licensee of the patentee, held not estopped by the license or its recitals from denying the validity of the patent from that fact alone, and that it did not establish any contractual relations between such purchaser and the patentee, and especially where complainant treated the license as no longer in force. *Baltimore Car Wheel Co. v. North Baltimore Passenger R'y Co.*, 21 Fed. Rep., 47.

See *Admissions*, §§ 165-167. *Fraud*, § 2607. *License*, §§ 4038, 4073, 4074.

Estoppel — *Patentee estopped by admissions in his patent*, §§ 2213-2217. See *Claims, Patentee Bound by*, §§ 807-834.

§ 2213. Patentee must be held to be estopped from asserting a claim which is expressly waived on the record. *Byam v. Farr*, 1 Curt., 260.

§ 2214. Where a patentee claimed a certain construction, and upon rejection by the patent office erased the claim, *held*, that he was estopped from afterward asserting such claim. *Dodds v. Stoddard*, 17 Fed. Rep., 645.

§ 2215. Where, from the language of the specification and claim and the state of the art, the inventor must be considered to have regarded a certain element as material, *held*, that those claiming under him could not show that it was immaterial, as the question was determined by the claim. *Lefever v. Remington & Sons*, 22 O. G., 1537.

§ 2216. Where it was explicitly stated in the specification that both the processes which plaintiff had united into a single process were old, and this must mean old at the date of his invention, *held*, he cannot now be heard to contradict this admission. *Moffitt v. Rogers*, 8 Fed. Rep., 147.

§ 2217. An acquiescence by the patentee and his assignees for a period of nine years in the terms of the patent as originally granted creates an equitable estoppel in favor of the public. *Sheriff v. Fulton*, 12 Fed. Rep., 136.

Estoppel — *Patentee and his assignee estopped from denying validity of patent*, §§ 2218-2230.

§ 2218. Patentee is estopped by his own act from showing his patent to be void. *Morris v. Huntington*, 1 Paine, 348.

§ 2219. A grant of a patent for an invention is an estoppel to the patentee to set up any prior grant for the same invention, which is inconsistent with the terms of the last patent. *Barrett v. Hall*, 1 Mason, 447.

§ 2220. It does not lie with patentee or his assigns to allege his own fraud on the government in procuring his extension, to avoid the effect of his prior assignment. *Ruggles v. Eddy*, 10 Blatch., 52.

§ 2221. A court would hesitate to allow a patentee, by his evidence, to render valueless a patent which he had assigned and given credit to, with the invention shown by it, and the right of reissue appurtenant to it. *National Car Spring Co. v. Union Car Spring Mfg. Co.*, 12 Blatch., 80.

§ 2222. On a motion for preliminary injunction, where the defendant was the original inventor of plaintiff's machine, upon whose application the patent was issued, and where the patent was sold to the plaintiff under certain circumstances stated in the moving papers, defendant was not allowed to dispute the novelty or utility of the invention described in the patent. *Onderdonk v. Fanning*, 4 Fed. Rep., 148.

§ 2223. The defendants in possession and enjoyment of the exclusive right under a patent assumed to sell and transfer it, and cannot now be heard to say that they had it not and did not sell it — that the patentee was not the original and first inventor — by setting up a patent subsequently acquired by them. *Faulks v. Kamp*, 17 Blatch., 432.

§ 2224. Where defendant made a full assignment of patents owned by him, including the reissue sued under, and also, as part of the settlement, had agreed to stop manufacturing and did not deny the payment of royalty for machines on hand, *held*, that he could not set up in defense the invalidity of the assigned patents. *Consolidated Middlings Purifier Co. v. Guilder*, 3 McC., 186.

§ 2225. A patentee cannot sell his patent-rights to another and then buy or obtain control of an older patent and through such older patent dispossess his assignee of the full benefit of what he purchased; and this even if the older patent anticipate that which was sold. *Curran v. Burdsall*, 27 O. G., 1319.

§ 2226. If others join with the original seller in the purchase of the prior patent, they must look to him for their compensation, for his prior sale operates as a license as against them. *Ibid.*

§ 2227. Seems that where defendant is the original patentee to whom the original patent and reissues were issued, he will not be allowed to deny their validity in a suit under them for infringement. *Burdsall v. Curran*, 27 O. G., 1320.

§ 2228. Where defendants were patentees of the invention alleged to be infringed, and had assigned it to plaintiff, they were held estopped from denying its validity, in conformity with *Rumsey v. Buck*, 20 Fed. Rep., 697. *Underwood v. Warren*, 21 Fed. Rep., 573.

§ 2229. Where a member of a firm alleged to be infringing was formerly a part owner of the patent, he would be estopped from denying its validity unless it sufficiently appeared that the conveyance of his title to the plaintiff was wholly without consideration. *Parker v. McKee*, 32 O. G., 137.

§ 2230. The plaintiff, having constructed and put up for the defendant machines under one patent, is estopped from claiming damages for infringement of a prior process patent of his, necessarily involving the use of such machine in the manner employed. The machines were supposed to have been put there for some purpose by the plaintiff under his best patent, and it cannot be maintained that they were put there merely to clog the machinery and for nothing involving a purpose. *Downton v. Yaeger Milling Co.*, 1 McC., 26.

See *Admissions*, § 164. *Construction of Patents*, § 1252. *Contract*, § 1296

Estoppel — By judgment and decree, §§ 2231-2237.

§ 2231. Decisions rendered in former cases, and introduced to prove that the patentee under whom the defendants claim title made the invention before the plaintiff's assignor, cannot act as estoppels, except in cases arising between the same parties or privies to them. *Day v. Combination Rubber Co.*, 2 Fed. Rep., 570.

§ 2232. Where the want of novelty of patentee's invention had been properly set up by plea and notice by defendant in a former suit between the same parties, and the patent was sustained, defendant was held estopped from denying the novelty of the invention in a subsequent action in which he had attempted to introduce additional evidence on the point not produced in the prior suit. *Dubois v. Philadelphia & Wilm. R. Co.*, 5 Fish., 208.

§ 2233. Complainant having made claim in his patent to an article and to a process in which that article was used, and it being uncertain whether judgment was rendered on one or both of these claims, the defendant in a subsequent suit was not estopped from setting up both the former and new defenses in his answer. *Russell v. Place*, 94 U. S., 606.

§ 2234. Where defendants pleaded in estoppel a prior decision sustaining the patent under which they were licensees, and declaring complainant's patent void, it was held bad and judgment given for complainant, it appearing that they became licensees prior to the suit, and that they were neither parties nor privies thereto. *Ingersoll v. Jewett*, 16 Blatch., 378.

§ 2235. Where the decree in a former suit against one licensee of a patentee was for a simple dismissal of the bill, a claim that the plaintiff is estopped from suing another licensee will not be entertained. *United States Stamping Co. v. Jewett*, 18 Blatch., 469.

§ 2236. Where defendants have assented to decree that the patent was valid, and to the injunction restraining them, on a motion for attachment for contempt they will not be allowed to assail its validity. *Roemer v. Newman*, 19 Fed. Rep., 98.

§ 2237. The plaintiff having elected to take judgment for his profits for the precise infringement which is the subject of this action, which judgment remains unreversed, cannot now prosecute his action for other damages arising out of the same acts of infringement. *Child v. Boston & Fairhaven Iron Works*, 19 Fed. Rep., 258.

See *Agent*, § 183. *Decree*, §§ 1764, 1775-1784. *Jurisdiction, State*, § 3959.

Estoppel — General principles — *Failure to object*, § 2238. *Silence*, § 2239. *By judgment*, §§ 2240-2247. *Equitable estoppel*, § 2248. *Assignee estopped to deny title in assignor*, § 2249.

§ 2238. A party is estopped from objecting after trial to questions and answers between the jury and the court where he could have objected at the time but did not. *Allen v. Blunt*, 2 W. & M., 121.

§ 2239. Silence does not estop a party, unless it misleads another to his injury. *Railroad Co. v. Dubois*, 12 Wall., 47.

§ 2240. The rule upon the subject of estoppel is generally that the parties and privies are concluded by the judgment. *Miller v. Liggett & Myers Tobacco Co.*, 3 McC., 375.

§ 2241. Estoppel of privies by judgment or decree considered. *Consolidated Fruit Jar Co. v. Whitney*, 2 B. & A., 30.

§ 2242. Where plaintiffs insist on a former judgment in estoppel it must be alleged in the bill. *Blandy v. Griffith*, 3 Fish., 609.

§ 2243. In order that a former judgment of a court of competent jurisdiction, obtained in an action between the same parties, shall act as an estoppel in a subsequent suit, it must be certain that the consideration and determination of the particular matter sought to be concluded was necessarily involved in the verdict and judgment. *Russell v. Place*, 12 O. G., 53.

§ 2244. If this does not clearly appear from the face of the record, extrinsic evidence consistent with the record may be admitted to establish the fact. *Ibid.*

§ 2245. Where several distinct matters may have been litigated, upon one or more of which the judgment may have passed, and it remains uncertain which of them was thus litigated, and upon which the judgment was rendered, the whole subject-matter of the action will be at large and open to a new contention. *Ibid.*

§ 2246. A person to be concluded by the judgment must be privy to the proceedings in such a sense that he may control the litigation in so far as making motions in the case, offering evidence, cross-examining witnesses or taking an appeal are concerned. *Miller v. Liggett & Myers Tobacco Co.*, 3 McC., 375.

§ 2247. It is essential to an estoppel that it be mutual, and in considering the effect of a former judgment, which is invoked as an estoppel, if it be found that it would not be conclusive upon the rights of the parties, had it been adverse to the party invoking it, instead of in his favor, this consideration will be decisive against its efficacy. *Ingersoll v. Jewett*, 16 Blatch., 378.

See *Evidence*, §§ 2363, 2364.

§ 2248. Equitable estoppel — that is, estoppel by conduct — is as valid a defense at law as in equity. *City of Concord*, 16 Fed. Rep., 477.

§ 2249. An objection that a certain company through which complainant derived title ever existed cannot be made by the latter; and moreover, if complainant proposed to rely upon such a proposition, it should have been introduced by proper averments in the complaint. *Bogart v. Hinds*, 33 O. G., 1268.

Estoppel — By abandonment, § 2250. *Acquiescence in grant of patent*, §§ 2251-2256; *of re-issue*, §§ 2257-2259. *Commissioner's action in refusing reissue, no estoppel*, § 2259. *Government may show patent is void ab initio for want of novelty*, § 2260. *Separate patents no estoppel as to joint invention*, § 2261.

§ 2250. Abandonment in fact should be construed to be an estoppel by law. *Gates v. Benson*, 3 A. L. T. (U. S.) R., 113.

See *Abandonment*, § 62.

§ 2251. Where a person stands by and hears another person describe a certain invention or improvement as his own, without asserting any claim to the invention, and at the same time seeking further information of the same, the inference will be warranted that the principles of such invention were not at that time known to him. *Ruggles v. Young*, 1 MacA. Pat. Cases, 160.

§ 2252. Where it appears that before the interference arose one of the parties was aware that the other party claimed the invention as his own, and had obtained a patent for the same, and he further acted as the patentee's agent in introducing and selling the patented machines, dis-

tributing circulars, recommending the machines, etc., without asserting any claim to the invention, but constantly repeating upon inquiry that he was not interested, *held*, that he was estopped from subsequently asserting a claim to the invention. *Carroll v. Gambrill*, 1 MacA. Pat. Cases, 581.

§ 2253. One who has constructed and put in operation a machine, because of the inventor's declaration that he would not patent it, would not be liable to patentee; the declaration would work an estoppel. *Pitts v. Hall*, 2 Blatch., 229.

§ 2254. The fact that defendant, while engaged in constructing the thing patented, described it, but without drawings or writings, in the presence of patentee, prior to the latter's application therefor, upon which the patentee remained silent and did not claim it as his invention, is not in itself evidence of fraud on the part of patentee, nor does it operate against him as an estoppel unless the other party is hurt by such silence. *Railroad Co. v. Dubois*, 12 Wall., 47.

§ 2255. A wife cognizant of the fact that the husband has applied for and obtained a patent, and a party to the sale thereof, so far concedes or admits him to be the original inventor as to be estopped from obtaining a patent to herself for the same invention. *National Feather Duster Co. v. Hibbard*, 9 Fed. Rep., 558.

§ 2256. Where on a contest as to priority of invention it appeared that defendant stood by, and not only saw patentee assert his right to a patent without objection, but directly after took out letters for a different improvement, *held*, that he was estopped from claiming priority of invention. *Fraim v. Keen*, 25 Fed. Rep., 820.

See *Abandonment*, § 24.

§ 2257. Complainants, having adopted the surrender and accepted the new patent (reissue), are estopped to deny either the authority of the applicant or that of the commissioner. *Good-year Dental Vulcanite Co. v. Wetherbee*, 3 Cliff., 555.

§ 2258. The defendant in an action on a patent cannot show in defense that it was reissued to the patentee after he had assigned it, if he assigned the reissued patent directly to the same parties. *Wing v. Warren*, 2 O. G., 342.

§ 2259. The action of the commissioner of patents in rejecting an application for reissue on a reference to a prior patent, or because it covered a different invention from that disclosed in the original patent, though unreversed, does not operate as an estoppel or as *res adjudicata* upon the parties in a judicial proceeding under the patent afterward issued. *Mathews v. Flower*, 33 O. G., 887.

§ 2260. There is nothing to estop the government from showing a patent which it has granted to have been a nullity *ab initio* owing to the non-existence of the condition precedent of novelty of the invention. *King v. United States*, 20 Law Rep., 631.

§ 2261. Patentees who patent as a joint invention, in a joint patent, subject-matter previously patented in separate patents to them as several inventors, are not estopped by the latter from asserting that the invention was joint; but they are strong evidence against it. *Barrett v. Hall*, 1 Mason, 447.

Estoppel — Particular cases, §§ 2262-2269. See *Admissions*, §§ 156-169. *Acquiescence*, §§ 140-149. *Disclaimer*, §§ 2041-2045. *Injunction, Preliminary*, § 3193. *Utility*, §§ 6663-6668.

§ 2262. Where A., in an assignment which divested him of all interest in the patent within the territory assigned, stipulated, but never insisted on the condition, that B., his assignee, should obtain his consent to the grant of licenses thereunder, *held*, that on the grant of a license without A.'s consent, B. was estopped from denying its validity, he having also received royalty for the license. *Bloomer v. Gilpin*, 4 Fish., 50.

§ 2263. Where a license was granted to five parties "for themselves, their heirs . . . and assigns respectively," and three of them surrendered their interest to the defendant licensor, *held*, that defendant, after agreeing to such severance of interest, was estopped from setting up their non-joinder in a suit upon a contract, in which upon their voluntary act and with assent of defendant, they had no further concern. *Theberath v. Celluloid Mfg. Co.*, 3 Fed. Rep., 143.

§ 2264. Defendants restrained by injunction from using an arrangement that had been held to be an infringement of plaintiff's patent, in suits against parties supplied with the same by defendants, who assumed and conducted their defense. *United States & Foreign Salamander Felting Co. v. Asbestos Felting Co.*, 10 O. G., 828.

§ 2265. A bill having been originally filed against a single defendant, answer and replication filed, proofs taken by both parties, a decree finally entered for the plaintiff by default, this decree vacated by stipulation entitled in the original suit, an amended bill filed including two additional defendants, joint answer filed but no replication, and proofs taken by defendants and rebutting proofs by plaintiff, *held*, that the putting in of proofs by the defendants to sustain the allegations of their joint answer after such answer was filed, and their allowing the

plaintiff to put in proofs in rebuttal and proofs in contradiction of the allegations of such joint answer, without entering any objection on the record that there was no replication to such joint answer, estopped the defendants from now raising such objection. *Fischer v. Wilson*, 16 Blatch., 220.

§ 2266. Where defendants contended that there was an estoppel arising from plaintiff's silence, while aware that they were manufacturing in violation of his patents and making improvements on their property, *held*, that to create such an estoppel as to prevent an injunction, the character of the improvements and the extent of the expenditure should be stated. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 Fed. Rep., 638.

§ 2267. A., B. and C., tenants in common of an interest in a patent, obtained another improvement patent thereon. Afterwards C. transferred his interest in the first patent to A. and B., who, in turn, transferred their interest in the improvement patent to C., and agreed with C. on the price each party was to charge for devices made under their respective patents. In suit brought by A. and B. to enjoin manufacture and sale under C.'s patent, *held*, that A. and B. were estopped from claiming that C.'s patent infringed their patent. *Rumsey v. Buck*, 20 Fed. Rep., 697.

§ 2268. Where the assignee of a patent derived his title from the defendant in a prior suit, who had acquired it *pendente lite*, assignee having been a principal witness in the same suit in which a certain construction was given the patent, *held*, that he was subject to the limitations which affected the title of his assignor, and was estopped by the decree in the former suit. *Pennington v. Hunt*, 20 Fed. Rep., 195.

§ 2269. When the executive officers and managers of a corporation that has been infringing a patent, having sold their stock, purchase the patent, their assignee will not be allowed in equity to make the corporation pay the profits created by their own acts of infringement. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 32 O. G., 1356.

See *Assignee*, § 539. *Infringement*, § 2951.

125. EVIDENCE.

See ABANDONMENT, EVIDENCE OF. APPEAL FROM COMMISSIONER, ADMISSIBLE EVIDENCE. DAMAGES, EVIDENCE OF. DATE OF INVENTION, EVIDENCE OF. EXPERTS, EVIDENCE OF. IDENTITY, EVIDENCE OF. INFRINGEMENT, EVIDENCE OF. INVENTION, EVIDENCE OF. NOVELTY, EVIDENCE OF. PATENTS, OF WHAT THE PATENT IS EVIDENCE. USE, PRIOR, EVIDENCE. PRIORITY OF INVENTION, EVIDENCE OF. REISSUES, EVIDENCE. STATE OF THE ART. UTILITY, EVIDENCE OF.

Evidence — Cumulative, §§ 2270-2272.

§ 2270. New evidence to a subordinate point or fact is not competent, when that subordinate point or particular fact was before gone into, because it is then cumulative or additional to that fact. *Aiken v. Bemis*, 3 W. & M., 348.

§ 2271. Where evidence, but not of a character to affect the legal rights of the parties, was exhibited in a circuit court, additional to that in a case previously determined in the supreme court on the same patents, *held*, that the supreme court decision was binding. *Richardson v. Lockwood*, 4 Cliff., 128.

§ 2272. Cumulative evidence as to a point already at issue is an insufficient warrant to grant leave to file a supplemental bill in the nature of a bill of review. *Blandy v. Griffeth*, 6 Fish., 434.

See *Bill, Supplemental*, § 625. *Decree*, § 1788. *Date of Invention*, §§ 1731-1733.

Evidence — Declarations of inventor, §§ 2273-2277. See *Admissions*, §§ 162-169.

§ 2273. *Doubted*, whether the rule laid down in *Railroad Company v. Stimpson*, that the conversations and declarations of an inventor stating that he had made an invention, and describing its details and explaining its operation, are properly to be deemed an assertion of his right at that time as an inventor to the extent of the facts and details which he then makes known and admissible in evidence, can be applied to a case where the declarations relate to an actual machine already made, which was not produced in evidence, nor its non-production accounted for. *Richardson v. Hicks*, 1 MacA. Pat. Cases, 335.

§ 2274. The exception in patent cases to the rule that the declarations and conversations of the plaintiff are not admissible in evidence is founded upon necessity and to prevent a failure of justice by reason of the impossibility of otherwise proving an invention; and such declarations, when admitted, should be free from suspicion, and accompanied by acts forming the *res gestæ*, to which the credit is to be given, and not to the declarations. *Ibid*.

§ 2275. The conversations and declarations (of the patentee), stating that he had made an invention, and describing its details, are properly to be deemed an assertion of his right at

that time as an inventor to the extent of the facts and details which he then makes known. (P. & T. R. Co. v. Stimpson, 14 Pet., 448.) Davidson v. Lewis, 1 MacA. Pat. Cases, 599.

§ 2276. The declaration of a party to an interference, that at some former time he made the invention for which he seeks a patent, is not competent evidence. Cochrane v. Waterman, 1 MacA. Pat. Cases, 52.

§ 2277. The declarations of the parties to an interference in their own behalf and in the absence of each other, incompetent evidence for any other purpose than to show when or what they have respectively claimed to have invented. Atkinson v. Boardman, 1 MacA. Pat. Cases, 80.

Evidence — *Depositions, commissioner's power to inspect*, §§ 2278-2280; *in interferences*, §§ 2281, 2282. *Machine as*, §§ 2283, 2284. *Inventor*, § 2285.

§ 2278. Where a deposition was not transmitted in due form, so that it could be considered at the day of hearing under the rules of the patent office, the commissioner was, nevertheless, at liberty to inspect the deposition and to postpone the hearing, if he deemed it essential to the ends of justice to permit an informality to be corrected. Smith v. Flickenger, 1 MacA. Pat. Cases, 46.

§ 2279. The prohibition contained in the rule is not to the commissioner's looking into the deposition thus informally transmitted, or to his reading it and ascertaining its contents, but to his considering it on the day of hearing as evidence touching the matter at issue. *Ibid.*

§ 2280. Depositions taken in an interference without notice to a party, as depositions taken before he became a party to the case, are not evidence against him, and cannot be considered by the judge upon appeal. Perry v. Cornell, 1 MacA. Pat. Cases, 68.

§ 2281. Depositions taken in a former interference may be read at the trial when the subject-matter at issue in the former case was the same, and the parties in interest, assignors of the entire right, were the same, so that the party against whom the deposition is offered has had full opportunity to cross-examine the witnesses. McCormick v. Howard, 1 MacA. Pat. Cases, 238.

§ 2282. Certificates not under oath in due form of law cannot be received as evidence in an interference proceeding. Jillson v. Winsor, 1 MacA. Pat. Cases, 136.

§ 2283. While it may be true that a machine is not written or higher evidence within the technical terms of the rule that secondary evidence will not be admitted when written or higher evidence exists and may be obtained, it is within the meaning of the larger rule of evidence that no evidence of a merely substitutionary character will be received when the original or primary evidence is producible. Richardson v. Hicks, 1 MacA. Pat. Cases, 335.

§ 2284. Testimony to the effect that the witness had been informed that a machine had been made and used at some former time is not evidence. Screw Co. v. Sloan, 1 MacA. Pat. Cases, 210.

§ 2285. The fact that an inventor has not produced as witnesses in his behalf the workmen in the same shop, who might be supposed to be most familiar with his invention, does not raise a presumption against him in a case where by publicity he might have deprived himself of the benefit of his invention. *Ibid.*

Evidence — *Depositions abroad, before whom taken*, § 2286. *General issue*, § 2287. *Notice*, §§ 2288, 2289. *Surreptitious patent*, § 2290. *Generally*, §§ 2291-2302.

§ 2286. Before whom verifications and depositions in foreign countries, before issue of patent, should be made under act 1836, section 6. Gilpin's Opinion, 3 Op., 532.

§ 2287. Admissible evidence under the general issue without notice. Evans v. Hettich, 7 Wheat., 453.

§ 2288. Objections being made to evidence on the ground that notice of it was not given in the answer, leave to amend the answer was moved for at the hearing, and the amendments were allowed as of the time when the answer was filed. Roberts v. Ryer, 11 Blatch., 11.

§ 2289. Objection to evidence in rebuttal, that owners of prior machine had taken out license under patentee sustained, the intent of the evidence not appearing. Evans v. Eaton, Pet. C. C., 322.

§ 2290. A refusal to join in an arbitration under the statute, *held*, not conclusive evidence that the defendant's patent was obtained surreptitiously and upon false suggestion. Act 1793. Stearns v. Barrett, 1 Mason, 153.

§ 2291. Where a witness testifies, after a patent has become valuable, that on some particular occasion, long past, he suggested the idea to patentee, such testimony should be received with hesitation. Spaulding v. Tucker, Deady, 649.

§ 2292. Admissibility in evidence of modifications of plaintiff's machine. Cahoon v. Ring, 1 Cliff., 592.

§ 2293. Where a motion was made for the production of defendants' books, in order to establish the quantity and value of the manufactures made by defendants charged to be in violation of the patent, it was denied, as evidence subjecting defendants to penalty under act 1836, section 14, which plaintiff had not relinquished. *Finch v. Rikeman*, 2 Blatch., 301.

§ 2294. A general remark that prior inventor had accomplished his object, without particularizing what he had invented, is not satisfactory, but should be considered as evidence so far as it agrees with the patent subsequently obtained, or with the work claimed to have been perfected. *Allen v. Hunter*, 6 McL., 303.

§ 2295. In suit for infringement, evidence that defendants were working under another patent, *held* inadmissible, there being no issue as to the novelty of the patent sued upon. *Blanchard v. Putnam*, 8 Wall., 420.

§ 2296. The models and drawings may be introduced in evidence. *Hogg v. Emerson*, 6 How., 437.

§ 2297. Evidence of value admissible under a count upon a special contract which sets forth the placing of a patented device on defendant's boat and the mode of ascertaining the saving made by it. *Steam Packet Co. v. Sickles*, 10 How., 419.

§ 2298. It is the highest evidence possible of a patentable combination, that it produces an article with a great economy of time and labor. *Pennock, Ex parte*, 1 MacArth., 531.

§ 2299. Where, on reference to master to estimate damages, one of complainants testified to the cost of manufacturing the patented articles and to the number made and sold by his firm, *held* that, on cross-examination, defendants were entitled to the production of firm books; but that complainants might withdraw witness and his testimony as far as given. *Wisner v. Dodds*, 14 Fed. Rep., 655.

§ 2300. In a suit for infringement, where validity and infringement of the patent are denied, complainant cannot, as part of his preliminary proof, compel defendant to disclose the names of his confidential customers to whom he furnished the alleged infringing articles, but he may be required to give the name of one such customer. *Roberts v. Walley*, 14 Fed. Rep., 167.

§ 2301. Where a document is introduced in evidence by a defendant to prove admissions by the inventor inconsistent with his claim, such document is legitimate evidence according to what should appear its just weight, as well as to those facts in favor of the inventor as to such as are against him. *Campbell v. James*, 17 Blatch., 42.

§ 2302. The judgment of the commissioner of patents disbarring a solicitor for surreptitiously placing a copy of a caveat in the official files extends only to the exclusion of the solicitor, and not to the effect of the paper as evidence *in pais*, although its effect upon the instrument as a caveat of record might be greater. *Ibid.*

Evidence — Office records, §§ 2303-2322.

§ 2303. File, contents and application record of patentee are evidence of patentee's intent, in construing his patent. *Trader v. Messmore*, 7 O. G., 385.

§ 2304. Certified copy of the file-wrapper and contents of an application for patent, *held* not competent or relevant to show the want of an oath. *Hoe v. Kahler*, 12 Fed. Rep., 111.

§ 2305. The file-wrapper, contents and drawings of a patent set up in defense in an action for infringement are not competent to show that the invention described in such patent was made at the date of the oath; nor is it the proper way to show reduction to practice and use of the invention, so as to invalidate the patent sued upon. *Howes v. McNeal*, 17 Blatch., 396.

§ 2306. The preliminary papers filed in the patent office are merely the declaration of third persons, not parties to the suit or connected with them in interest or title, and are incompetent, as hearsay and secondary. *Ibid.*

§ 2307. The affirmative probative force of a paper in a file-wrapper, to show the existence of its contents, is one thing, but its negative probative force, to show that a paper or a fact not shown by anything in its contents did not exist, is a different thing. The fact that papers known to have existed, and which properly belonged in a file-wrapper, are missing therefrom, is a fact of such frequent occurrence in patent suits as to have become a matter of judicial cognizance. *Hoe v. Kahler*, 25 Fed. Rep., 271.

§ 2308. Official correspondence of commissioner, properly certified, admitted to prove date of application as part of the *res gestæ*. *Allen v. Blunt*, 2 W. & M., 121.

§ 2309. The admissibility of correspondence between commissioner of patents and applicant is within the discretion of the court, and though its competency may be questioned, it will not afford ground for a new trial, where it afterwards becomes immaterial, in consequence of the introduction of other and better evidence. *Ibid.*

§ 2310. Application files for patent, as papers remaining in the office of the secretary of state, are admissible evidence. *Pettibone v. Derringer*, 4 Wash., 215.

§ 2311. In an action for damages brought against the commissioner of patents for refusing

to furnish copies of office records, plaintiff's letter to the commissioner accompanying the request for the delivery of the copies to his agent is admissible in evidence as part of the *res gestæ*. *Boyden v. Burke*, 14 How., 575.

§ 2312. The proceedings in the patent office upon the plaintiff's application for the patent are not admissible for the purpose of giving it a different construction. *Westlake v. Carter*, 4 O. G., 636.

§ 2313. The patent must be construed without reference to the previous correspondence and previously rejected applications, which cannot aid in its construction, especially as the patent issued correctly describes the complainant's invention. *Piper v. Brown*, 1 Holmes, 20.

§ 2314. By statute, "copies of any records, books or papers belonging to the patent office, and of letters patent authenticated by the seal and certified by the commissioner or acting commissioner, are made evidence where the originals would be evidence." (R. S., sec. 892.) And "copies of the specification and drawings of foreign letters patent, certified as provided in the preceding section, shall be *prima facie* evidence of the fact of the granting of such letters patent and of the date and contents thereof." *Schoerken v. Swift & Courtney and Beecher Manufacturing Co.*, 19 Blatch., 209.

§ 2315. French letters patent certified by the director of the Conservatoire National des Arts et Metiers of France, under the seal of that department, verified by the minister of agriculture and commerce and the minister of foreign affairs, under their seals, come from a proper source, properly authenticated, and are admissible as evidence under the statute. *Ibid.*

§ 2316. When a part of an applicant's statement in correspondence with the office is used, the whole of the contemporaneous statement should be received, the part which operates for him as well as that which makes against him. *In re Boughton*, 1 MacA. Pat. Cases, 278.

§ 2317. Where on suit brought against the commissioner of patents for damages for refusing to furnish copies of office records, no special damage was alleged, evidence tending to prove it was held properly excluded. *Boyden v. Burke*, 14 How., 575.

§ 2318. Office copies of correspondence in relation to granting of plaintiff's reissue held inadmissible in evidence. *Cahoon v. Ring*, 1 Cliff., 592.

§ 2319. The contents of a reissue-application file may be examined in order to determine the scope of the reissue as granted. *Hopkins & Dickinson Manufacturing Company v. Corbin*, 13 Otto, 786.

§ 2320. A certified copy of a recorded assignment is *prima facie* evidence of the genuineness of the original, and admissible in evidence. *Lee v. Blandey*, 1 Bond, 361.

§ 2321. Certified copies of assignments recorded in the patent office are admissible in evidence. *Brooks v. Jenkins*, 3 McL., 432.

§ 2322. Certified copies of recorded assignments are *prima facie* evidence at least of the genuineness of the originals on file; and absolute evidence of the correctness of the copies from the record. *Parker v. Haworth*, 4 McL., 370.

See *Claims, Construction of*, § 767. *Construction of Patents*, § 1248.

Evidence — General principles — Depositions, §§ 2323-2327. *Objections to testimony*, §§ 2328-2332.

§ 2323. Depositions taken under section 30, judicial act 1789, admissible in evidence; but must be properly certified. *Pettibone v. Derringer*, 4 Wash., 215.

§ 2324. It is no objection to the reading of a deposition of a witness who lives in another state, that he had been where the court was sitting, but unknown to the party offering the deposition. *Ibid.*

§ 2325. Depositions taken during the session of the court at which the case is to be tried are inadmissible, unless taken by order of court, consent of the parties, or *de bene esse*. *Allen v. Blunt*, 2 W. & M., 121.

§ 2326. Where deposition *de bene esse* is offered in evidence, due diligence in procuring the attendance of witness must be proved. *Pettibone v. Derringer*, 4 Wash., 215.

§ 2327. Depositions taken in chancery cannot be used in trial at law except as ordered. *Cahoon v. Ring*, 1 Cliff., 592.

§ 2328. Testimony introduced with acquiescence and consent of plaintiff cannot be afterwards objected to by plaintiff. *Evans v. Hettich*, 7 Wheat., 453.

§ 2329. On the taking of testimony before an examiner, the grounds of an objection must be stated. *Brown v. Hall*, 6 Blatch., 401.

§ 2330. Objections to the admission of testimony must be made on the record, and if not so made all objections will be considered as having been waived. If a general objection is made, but no ground of objection is specified, the objection will not be considered. If a ground of objection is stated, all grounds not specified are considered as waived. *Fisher v. Neil*, 6 Fed. Rep., 89.

§ 2331. An objection to testimony on account of incompetency of witness under laws and rules governing practice in the circuit courts of the United States, *held* waived, because not distinctly made when the evidence was taken. *Barker v. Stowe*, 15 Blatch., 49.

§ 2332. Evidence taken and filed out of time, when there had been no motion to suppress the same, and when objection was made at the hearing to its consideration, allowed to stand and be considered. *Matthews v. Spangenberg*, 23 O. G., 92.

Evidence — General principles — *Relative value of positive and negative evidence*, §§ 2333-2337.

§ 2333. Positive testimony will outweigh merely negative evidence. *Sayles v. Chicago & Northwestern R. Co.*, 3 Biss., 52.

§ 2334. The rule of law is, that if one witness swears positively that he saw or heard a fact, and another merely swears that he was present, but did not see or hear it, and the witnesses are equally faithful, the general principle would, in ordinary cases, create a preponderance in favor of the affirmative. *Cornell v. Hyatt*, 1 MacA. Pat. Cases, 423.

§ 2335. This rule, however, is to be understood with this explanation: That the principle supposes that the positive testimony can be reconciled with the negative without violence and constraint. *Ibid.*

§ 2336. Evidence of a negative nature may, under particular circumstances, not only be equal but superior to positive evidence. This must always depend upon the question whether, under the particular circumstances, the negative testimony can be attributed to inattention, error or defective memory. *Ibid.*

§ 2337. The negative testimony of a single witness, who is in a position to know the fact, may outweigh the positive testimony of two witnesses, particularly where they are shown by their answers to be unfair in their testimony. *Ibid.*

Evidence — General principles — *Admissibility*, §§ 2338-2345. *Error in admitting*, §§ 2346-2348. *State law rule*, § 2349.

§ 2338. Where evidence is offered for a certain purpose, its competency must be sustained for that purpose only, and is not admissible afterwards for a different purpose not suggested to the court at the time. *Phila. & Trenton R. Co. v. Stimpson*, 14 Pet., 448.

§ 2339. Evidence will not be admitted to contradict a witness where he has not been interrogated as to the matter. *Many v. Jagger*, 1 Blatch., 372.

§ 2340. Rule stated. Admission of supplementary evidence in reply to answer on motion for provisional injunction. *Day v. New England Car Spring Co.*, 3 Blatch., 154.

§ 2341. The parties having agreed that if the amendment were allowed the testimony might be received as if taken under the amended answer, it was admitted upon terms that the defendant should tax no cost up to the hearing. *Roberts v. Blake*, 1 Holmes, 224.

§§ 2342-3. Testimony otherwise inadmissible may be admitted upon stipulation, but the interest of the witnesses in the matter in controversy may still go to their credit and have its due weight. *Warner v. Goodyear*, 1 MacA. Pat. Cases, 60.

§ 2344. Rule 69 is imperative that no testimony taken after time shall be allowed to be read at the hearing. *Wooster v. Clark*, 21 O. G., 264.

§ 2345. There is no universal or absolute rule which prohibits the courts from allowing the introduction of newly discovered evidence under a bill of review to prove facts which were in issue on the former hearing of a patent cause; but the allowance of it is not a matter of right in the party, but of sound discretion in the court, to be exercised cautiously and sparingly, and only under circumstances which demonstrate it to be indispensable to the merits and justice of the cause. *Craig v. Smith*, 17 O. G., 145.

§ 2346. The quality which errors in the admission or rejection of evidence must have, before the verdict will be set aside by the appellate court, and a new trial granted. *Walker v. Hawxhurst*, 5 Blatch., 494.

§ 2347. If evidence that should be excluded is excluded on wrong grounds it is not error. *Silsby v. Foote*, 14 How., 218.

§ 2348. Parties to a suit in equity cannot testify in their own favor; state laws furnish the rules of evidence at common law but not in equity. *Blanchard v. Sprague*, 1 Cliff., 288.

§ 2349. Federal courts, under the judiciary act, are governed by laws of the states where held in regard to evidence and competency of witnesses. The rejection of a witness competent to testify under the state law of Ohio is error. *Vance v. Campbell*, 1 Black, 427.

Evidence — General principles, §§ 2350-2365. See *New Trials*, §§ 4230-4241.

§ 2350. Proofs must correspond with the pleadings. *Wilson v. Stolley*, 4 McL., 275.

§ 2351. In equity the court is confined to the issue made by the pleadings, and proofs without the requisite allegations are unavailing. *Rubber Co. v. Goodyear*, 9 Wall., 788.

§ 2352. Something more than the evidence of a single witness must be produced to overcome an answer under oath and responsive to the bill. *Woodworth v. Hall*, 1 W. & M., 248.

§ 2353. Where a witness refreshes his memory by reference to books, such books are not thereby made evidence. *Stanley v. Whipple*, 2 McL., 35.

§ 2354. Where the testimony which a witness, erroneously rejected as incompetent, is not stated in the bill of exceptions, the supreme court will not presume it immaterial. *Vance v. Campbell*, 1 Black, 427.

§ 2355. After a witness has been examined in chief and cross-examined, he cannot be recalled and re-examined as to new matter. The re-examination must be confined to a reaffirmance of the facts already stated, and in explanation of the facts stated upon cross-examination. A second deposition, taken in violation of this rule, suppressed. *Hill v. Dunklee*, 1 MacA. Pat. Cases, 475.

§ 2356. A witness, whether an expert or not, cannot be called to testify to the sufficiency of the secondary evidence by a party who has the original and refuses to produce it. To admit such evidence would, in principle, be a violation of the rule that no evidence of a copy, though sworn to, will be admitted until proof has been given that the original cannot be produced. *Richardson v. Hicks*, 1 MacA. Pat. Cases, 335.

§ 2357. From a principle of necessity, however, the party is a competent witness to establish the loss of an original paper, if lost out of his own custody, and not destroyed by fraud. *Yearsley v. Brookfield*, 1 MacA. Pat. Cases, 193.

§ 2358. Where the party presents copies of his memoranda, which are incomplete in important respects, it affords grounds for an unfavorable inference. *Jones v. Witherill*, 1 MacA. Pat. Cases, 409.

§ 2359. Records of memorandums and copies of letters cannot be considered as evidence *per se*. The originals might have been used to refresh the memory of the witness; but where it does not appear that this has been done, the copies cannot be used as confirmatory of the testimony of the witness. *Ibid*.

§ 2360. It would be unnecessarily oppressive to require the party, merely to gratify form, to take his testimony over again, as well as uselessly expensive. *McCormick v. Howard*, 1 MacA. Pat. Cases, 238.

§ 2361. Courts do not presume, from the mere fact of a letter's having been mailed, that it has been received, even in order to aid a party to lay the foundation for secondary evidence. *Allen v. Blunt*, 2 W. & M., 121.

§ 2362. In cases where a chaos of oral testimony exists, it is usually found that the judgment is convinced by a few leading facts and *indicia* outlined so clearly that they cannot be obscured by prevarication or the aberrations of memory. *Held*, that facts and *indicia* so cogent and persuasive are found in this case that the testimony of a myriad of witnesses cannot prevail against them. *American Bell Telephone Co. v. People's Telephone Co.*, 22 Fed. Rep., 309.

§ 2363. The record in a suit which proceeded to judgment in one circuit court is proper evidence in a suit in another when the matter in controversy is the same, and the defendant in the latter suit employed the counsel and paid the expenses in the prior, though not a party thereto. *United States and Foreign Salamander Felting Co. v. Asbestos Felting Co.*, 18 Blatch., 312.

§ 2364. The defendant in the latter suit is also concluded by the judgment in the former as to the matters therein determined. *Ibid*.

§ 2365. Where a record of naturalization of plaintiff was offered after argument had commenced, *held*, that it was not admissible as evidence of plaintiff's right at that stage without terms; but, as defendant did not elect to abandon his defense, it was admitted on terms as to payment of certain costs by plaintiff. Rule 69 does not allow the production of such proof at the hearing, as was formerly done in the English high chancery court. *Stanthorp v. Humiston*, 4 Fish., 107.

126. EXAMINER.

See OFFICERS OF THE PATENT OFFICE.

Examiner—In chancery, §§ 2366, 2367. See *Officers*, §§ 4460-4470.

§ 2366. Right of examiner on taking testimony to payment of his fees. *Frese v. Biedenfeldt*, 14 Blatch., 402.

§ 2367. The examiner has no power to rule on the admissibility of evidence, and defendant, when a witness before him, has a right, upon a question not free from doubt, to take the opinion of the court; and when he refuses to answer under the advice of counsel and appar-

ently in good faith, even though he acted mistakenly, it is not a case where he should be punished for contempt. *Roberts v. Walley*, 14 Fed. Rep., 167.

See *Bill, to Obtain Patent*, §§ 636, 637.

127. EXCEPTIONS.

See BILL, OF EXCEPTIONS. MASTER'S REPORT.

128. EXECUTOR.

See LEGAL REPRESENTATIVES, §§ 3979-3981. PARTIES, § 4525. PLEA, IN ABATEMENT, § 4776. REISSUES, §§ 5393-5395.

§ 2368. On devise of the property in an invention the patent may issue to the executor. *Stimpson v. Rogers*, 4 Blatch., 333.

§ 2369. The law of Massachusetts on the power of executors to sell personal property. *Newell v. West*, 13 Blatch., 114.

§ 2370. Neither state nor federal courts, either at equity or law, will aid an executor to obtain possession or control of his testator's estate, until he has qualified in the manner prescribed in the state statutes; and where there are several executors appointed by a will, and only one has so qualified, he alone may maintain an action as such. *Rubber Co. v. Goodyear*, 9 Wall., 788.

129. EXPENSES.

See DAMAGES AND PROFITS, ESTIMATION OF, ALLOWANCE OF EXPENSES. ACCOUNTING, APPORTIONMENT OF EXPENSES.

130. EXPERIMENTAL USE.

See USE, EXPERIMENTAL.

131. EXPERIMENTS.

See USE, EXPERIMENTAL, §§ 6378-6413.

Experiments — *Mere experiment is not patentable*, §§ 2371-2375. *Experiment in improving a machine will not defeat a patent for it*, § 2376. *What is an experiment*, § 2377; *what is not*, § 2378. *Philosophical, no infringement*, §§ 2379, 2380. *Will not show want of novelty*, § 2381.

§ 2371. A mere principle or idea, until it assumes a practical form, is not patentable; and a long course of mere fruitless experiments to reduce the principle to practice would not prevent a subsequent original inventor, who had perfected his invention without knowledge of the prior invention, from obtaining a patent. *McCormick v. Howard*, 1 MacA. Pat. Cases, 238

§§ 2372-3. If the invention be the mere speculation of a philosopher or a mechanic in his closet, and he takes no steps towards obtaining a patent, but keeps his invention secret, and another person, who is also an original but subsequent inventor of the same thing, obtains a patent for it and brings it into use, it has been held, both in England and in this country, that the patentee in a suit at law is to be considered as the first inventor. *Heath v. Hildreth*, 1 MacA., Pat. Cases, 12.

§ 2374. Crude and imperfect experiments are not sufficient to confer a right to a patent; but in order to constitute an invention, a conception must have been reduced to practice and embodied in some distinct form. *Judson v. Bradford*, 16 O. G., 171.

§ 2375. Where the proofs offered by an inventor in support of his claim to have invented and discovered a new process — as of manufacturing white oxide of zinc — indicate that he did not in his experiments observe the proper chemical conditions — as the proper admixture of the ore and fuel, the depth of the charge, the regulation of the blast, etc., — and that as a matter of fact he failed to obtain successful results, *held*, that his efforts amounted to no more than an unsuccessful experiment, and did not entitle him to a patent as against an independent inventor. *Jones v. Witherill*, 1 MacA. Pat. Cases, 409.

§ 2376. Experiments on improving the invention prior to patenting should not avoid the patent. *Morris v. Huntington*, 1 Paine, 348.

§ 2377. In most cases sufficient use must be shown of the machine or appliance to prove that it will accomplish what is claimed; otherwise it rests in the region of mere experiment. *Sayles v. Chicago & Northwestern R. Co.*, 3 Biss., 52.

§ 2378. A machine which, whether entirely satisfactory or not, has been run in the ordinary course of business for twenty or thirty years, and which is patented precisely as it was used, cannot properly be called an experimental machine. *Perkins v. Nashua Card & Glazed Paper Co.*, 2 Fed. Rep., 451.

§ 2379. Under act 1800, making a machine for philosophical experiment is no infringement. It must be a making with intent to deprive owner of the lawful rewards of his discovery to be such. *Sawin v. Guild*, 1 Gall., 484.

§ 2380. An experiment with a patented article for the sole purpose of gratifying a philosophical taste or curiosity is not an infringement. *Poppenhusen v. Falke*, 4 Blatch., 493.

§ 2381. Laboratory experiments distinguished from a practical art, and held not to anticipate the latter. *United Nickel Co. v. California Electrical Works*, 25 Fed. Rep., 475.

See *Priority of Invention*, §§ 5004, 5005. *Reissue*, § 5317.

Experiments — Abandoned.

SUMMARY (*WHITELY v. SWAYNE*, § 2382) — *Abandoned experiment*, § 2382.

WHITELY v. SWAYNE.

(7 Wallace, 685-687. 1868.)

STATEMENT OF FACTS.—In 1851-2-3, Dinsmore made and used certain harvesting machines. On February 10, 1852, he obtained a patent. On April 18, 1852, Steadman filed a caveat, in which it was stated that he was making experiments on a machine for harvesting clover and grass-seed. On May 23, 1854, he received a patent. He made and tried a machine, but the experiment seems to have been abandoned. Whitely obtained an assignment of the patent, and procured three reissues.

§ 2382. *Where a patent is issued, and the experiment is abandoned, any other person may take up the subject, complete the improvement, and obtain a patent.*

Opinion by MR. JUSTICE NELSON.

The plaintiff's title, and the one upon which he must succeed against the defendant, if he succeeds at all, rests upon a patent for improvements in a machine for harvesting clover and grass-seed; which improvements, after a full and fair trial, resulted in unsuccessful experiments, and which were finally abandoned. They never went into any useful or practical operation, and nothing more was heard of them from Steadman or any other person for a period of six years. At the end of this period the plaintiff takes an assignment of the patentee, and is, doubtless, vested with all his rights. But what were those rights? Clearly, if any other person had chosen to take up the subject of the improvements where it was left off by Steadman, he had a right thus to enter upon it, and if successful would be entitled to the merit of them as an original inventor, for he is the first inventor, and entitled to the patent, who, being an original discoverer, has first perfected and adapted the invention to actual use. *Curtis on Patents*, § 43, p. 37, and notes.

Hence, if Dinsmore's patent was later than that of Steadman, and was for similar improvements, it would constitute a perfect defense against the suit in the present case, as the plaintiff is obliged to rely wholly on this assignment of Steadman, and stands in his footsteps, and has no better title. But the fact is otherwise. Dinsmore's invention goes back to the year 1850. His first machine was successfully tried in the harvest of that year. Some twenty-one were made in the year 1851, and from fifty to sixty in 1852. Steadman's

caveat was even not filed in the patent office till after Dinsmore's patent was issued. The present defendant derives his title from Dinsmore. The case is too plain to require any extended examination.

Decree affirmed.

Experiment — Abandoned — Cannot defeat a patent, §§ 2383-2399.

§ 2383. Prior imperfect contrivances will not defeat the novelty of an invention. *Judson v. Cope*, 1 Bond, 327.

§ 2384. If the patentee was the first to make known to the public a successful process, his patent cannot be impeached because of previous experiments which failed to demonstrate the utility of the process, however suggestive they may have been. *Roberts v. Dickey*, 4 Brewster, 260.

§ 2385. An unsuccessful abandoned experiment will not invalidate a patent to a subsequent inventor who has successfully reduced his invention to practice. *Ransom v. Mayor of New York*, 1 Fish., 252.

§ 2386. An abandoned prior experiment, which was not publicly known or used, will not invalidate a subsequent patent. *Cahoon v. Ring*, 1 Cliff., 592.

§ 2387. An abandoned experiment will not defeat a patent. *Waterman v. Thompson*, 2 Fish., 461.

§ 2388. Crude and imperfect experiments, equivocal in their result, and then abandoned and given up, shall not prevail against an original inventor who has perfected his improvement and obtained his patent. *Union Sugar Refinery Co. v. Matthieson*, 3 Cliff., 639; *Parkhurst v. Kinsman*, 1 Blatch., 488.

§ 2389. Experiments made, equivocal in their results and given up for years, will not be permitted to prevail against an original inventor, who has reduced his invention to practice, and without fraud obtained a patent. *Ellithorp v. Robertson*, 4 Blatch., 307.

§ 2390. Prior abandoned experiments cannot invalidate a patented invention. *Woodman v. Stimpson*, 3 Fish., 98.

§ 2391. Abandoned experiments do not entitle their author to priority over one who has perfected the new idea and reduced it to practice. The latter is the inventor. *Winans v. New York & Harlem R. R.*, 4 Fish., 1.

§ 2392. An abandoned experiment is not sufficient to invalidate a subsequent patent to another inventor. *Hayden v. Suffolk Mfg. Co.*, 4 Fish., 86.

§ 2393. The devices employed in abortive and abandoned experiments do not become public property, and are no bar to a patent embracing them, obtained by an independent and successful inventor afterward. *Aultman v. Holley*, 11 Blatch., 317.

§ 2394. Machines which have been abandoned after being experimented upon do not prejudice a subsequent patent for a successful machine, however closely they resemble each other. *Birdsell v. McDonald*, 6 O. G., 682.

§ 2395. If an alleged prior invention was only an experiment, never perfected, but abandoned, it cannot prejudice a patent for a similar improvement obtained by a subsequent inventor. *Corn-Planter Patent*, 23 Wall., 181.

§ 2396. Where one made several devices and proposed constructing a machine embodying them, but had no definite idea of the method of doing it, and, after repeated experiments with the devices, laid them aside until they were brought forward to defeat a patent for such a machine, the whole was considered as an abandoned experiment, which did not affect the validity of the patent. *Eickemayer Hat-Blocking Machine Co. v. Pearce*, 10 Blatch., 403.

§ 2397. A patent is not invalid on account of experiments carried on by others without beneficial results and abandoned, and resumed only when the patentee had demonstrated the efficacy of the process and had reduced it to actual and successful practice. *Roberts v. Dickey*, 4 Brewster, 260.

§ 2398. Unsuccessful and abandoned experiments cannot avail to invalidate a patent to an inventor who has disclosed to the public an invention the utility of which has been demonstrated by its general adoption. *Roberts v. Schreiber*, 2 Fed. Rep., 855.

§ 2399. The cause that works successful results cannot be the same as that exhibited in abandoned experiments, and holding the latter up as anticipations of the former is but an illustration of what is very common — an attempt to defeat a meritorious invention by proof that something similar had been previously known, though it had never been perfected and had never been any useful contribution to human knowledge or convenience. *Ibid.*

See *Art, Lost*, § 390. *Invention, Prior*, §§ 3703-3713. *Novelty*, §§ 4402-4408.

Experiment — Abandoned — *Inventor's knowledge of, will not defeat his patent*, §§ 2400-2402.

§ 2400. Inventor's knowledge of the prior abandoned experiments of another, *held*, to be no evidence of want of novelty of the invention subsequently patented by him. *Latta v. Shawk*, 1 Bond, 259.

§ 2401. Experiments, even if known to patentee, will not defeat his claim to originality, if it appears that patentee prosecuted them to final success. *Judson v. Moore*, 1 Bond, 285.

§ 2402. Knowledge of prior experiments by another will not defeat the claim of a patentee to an invention if it appears that after those experiments were abandoned he first perfected the invention and adapted it to actual use; but he will not be an original inventor if his knowledge derived from abandoned models or experiments was sufficiently definite and clear to enable him to construct the improved device which was the subject of his alleged invention. *Union Paper Bag Machine Co. v. Pultz & Walkley Co.*, 15 Blatch., 160.

See *Inventor*, § 3740.

Experiment — Abandoned — *What constitutes*, §§ 2403-2419. *What is not*, §§ 2420-2423. *Presumption*, § 2424. *Is no infringement*, §§ 2425, 2426.

§ 2403. Where unsuccessful efforts to introduce a certain machine had been made twenty years before, and had not since been renewed; and the machine was imperfect and unsatisfactory, it was held to be an abandoned experiment. *American Whip Co. v. Lombard*, 4 Cliff., 495.

§ 2404. Where an apparatus was constructed to practice plaintiff's patented process, but was used only once as an experiment, and abandoned and the parts used for other purposes, and knowledge of the experiment was not communicated to plaintiff, it was held an abandoned experiment and no obstacle to a right to his patent. *Piper v. Brown*, 1 Holmes, 20.

§ 2405. Articles which were never put in market, never came into practical use, and none of which were preserved, are to be regarded as mere abandoned experiments, and will not prejudice a patent obtained by a subsequent inventor. *Murphy v. Eastman*, 1 Holmes, 113.

§ 2406. The previous production to a limited extent of goods resembling those fabricated by the plaintiff's process, and by means somewhat similar, *held*, to have amounted to no more than abandoned and unsuccessful experiments, and not to impeach the validity of his patent. *Smith v. Glendale Elastic-Fabric Co.*, 1 Holmes, 340.

§ 2407. Where a person made sketches of a number of inventions for a particular purpose, out of which he selected one and laid the rest aside for years, the latter were held to be abandoned experiments. *Reeves v. Keystone Bridge Co.*, 1 O. G., 466.

§ 2408. Where a certain machine, made from a model, never seen in practical operation by the witness testifying to it, nor used but once or twice, was packed away and only produced as evidence of prior invention, it was held an abandoned experiment. *Parham v. American Button Hole, etc., Sewing Machine Co.*, 4 Fish., 468.

§ 2409. A patent will not be set aside upon the mere testimony of a single witness that many years ago he saw a machine like the one described; it must be regarded at most as an abandoned experiment, no second machine having been known. *La Baw v. Hawkins*, 6 O. G., 724.

§ 2410. Experiments held to amount to abandoned experiments. *Decker v. Grote*, 10 Blatch., 331.

§ 2411. A machine which was taken apart and cast aside without any intention of reconstructing it, portions of which were appropriated to other objects, and the remainder of which was useless for any purpose contemplated by a subsequent patent, will not invalidate it, and is but an abandoned experiment. *Gallahue v. Butterfield*, 10 Blatch., 232.

§ 2412. A person who merely produces articles experimentally by a device — changes the structure of the device itself, and finally does nothing with it until after the grant of a patent to another inventor — has neither perfected the device nor adapted it to successful use. It is an abandoned experiment. *Albright v. Celluloid Harness Trimming Company*, 12 O. G., 227.

§ 2413. Where an alleged prior machine performed its work so imperfectly that the inventor laid no stress upon it, and preferred hand work, and soon laid aside the supplemental mechanism which had reference to part of its operation, *held*, that if it existed at all, it was as an abandoned experiment. *Spring v. Domestic Sewing Machine Co.*, 9 Fed. Rep., 505.

§ 2414. Abandonment of the use of a machine is no evidence that it was a mere abandoned experiment. *Pickering v. McCullough*, 13 O. G., 818.

§ 2415. A rude machine constructed for the purpose of experiment, and subsequently broken up, deserted, and abandoned, cannot be regarded as such a perfected invention as will defeat a patent. *Gottfried v. Phillip Best Brewing Co.*, 17 O. G., 675.

§ 2416. Where but one prior device similar to patentee's was made, but it did not appear that it was ever tested or used in any way, or that it had been heard of since, it was held an abandoned experiment. *Pickering v. Miller*, 16 Fed. Rep., 540.

§ 2417. The fact that an alleged anticipating device made no impression on the trade and was not a practical success indicates an abandoned experiment. *Hicks v. Otto*, 19 Fed. Rep., 749.

§ 2418. When a single bottle-stopper was made and used for a time, but was never sent out from the shop, and from the evidence it appeared that it had never been subjected to the strain necessary to close the bottle securely and tightly sufficient for handling and transportation, and which was afterward laid away in a trunk and the recollection of it was only stimulated by the success of another's invention, *held*, that the thing was inchoate and amounted to no more than an abandoned experiment. *Putnam v. Hollender*, 19 Blatch., 49.

§ 2419. Prior structures somewhat resembling the patented device, which have failed and been abandoned by reason of certain differences in construction, which made their action uncertain, must be regarded as falling within the category of incomplete experiments toward the invention. *Putnam v. Vom Hofe*, 19 Blatch., 63.

See *Date of Invention*, § 1718.

§ 2420. Successful experiments, when they demonstrate the merits of the invention, cannot be regarded as abandoned, although they were not resumed, nor can another inventor have a patent for them afterward. *N. W. Fire-Extinguisher Co. v. Phila. Fire-Extinguisher Co.*, 6 O. G., 34.

§ 2421. They cannot be so regarded, especially if the first inventor's application for a patent had been repeatedly and finally rejected by the patent office, and his circumstances were straitened. *Ibid.*

§ 2422. A machine temporarily disused under circumstances connected with the demand and supply of its product, and independent of the efficiency of the mechanism, is not an abandoned experiment. *Snow v. Tapley*, 13 O. G., 548.

§ 2423. Where the alleged prior process, although somewhat imperfectly applied, continued to be used for many years, *held*, that it could not be regarded as an abandoned experiment. *Miller v. Force*, 33 O. G., 1497.

§ 2424. The presumption with regard to an abandoned experiment is that it is not identical with an invention subsequently patented to another, the merits and utility of which are proved by its general use and admitted superiority over all others. *Wayne v. Holmes*, 1 Bond, 27.

§ 2425. A temporary experiment, which has been abandoned, *held* not to constitute an infringement, on which, after a lapse of considerable time, an injunction would be granted. *Byam v. Farr*, 1 Curt., 260.

§ 2426. Where plaintiff's patent was for an improvement which, after a full and fair trial, resulted in unsuccessful experiments which were abandoned, *held*, he had no title to recover for infringement. *Whiteley v. Swayne*, 7 Wall., 685 (§ 2382).

See *Equivalents*, § 2151. *Identity*, § 2670. *Invention*, § 3548.

132. EXPERTS.

Experts — *Defined*, §§ 2427, 2428. *May testify to state of art*, §§ 2429, 2430. *Identity*, §§ 2431-2434.

§ 2427. An expert is one "skilled in the art or science to which his opinion or judgment appertains, or in a business or art most nearly connected with that to which his judgment or opinion is applied." *Page v. Ferry*, 1 Fish., 298.

§ 2428. "A person skilled in the art or science" is an expert in that art or science. *Allen v. Hunter*, 6 McL., 303.

§ 2429. The interpretation of the specification is for the court. Experts are examined only to aid in interpreting the language of the art, and, *semble*, their evidence on this point is for the court and not for the jury. *Battin v. Clayton*, 2 Whart. Dig., 409.

§ 2430. Experts may be examined to explain term of the art and the state of the art at any given time. They may explain machines, models or drawings exhibited, and may point out the difference or identity of the mechanical devices involved in their construction, but they cannot prove the construction of any written instrument. *Winans v. New York & Erie R. R.*, 21 How., 88.

See *State of the Art*, § 6099.

§ 2431. The opinion of skillful witnesses as to the identity of two machines is competent evidence. *Barrett v. Hall*, 1 Mason, 447.

§ 2432. It is rather the province of experts to testify to the identity or diversity of inventions, and of "persons skilled in the art" to the sufficiency of the description. *Allen v. Blunt*, 3 Story, 742.

§ 2433. On the question of identity the testimony of experts is admissible. *Conover v. Rapp*, 4 Fish., 57.

§ 2434. The testimony of practical persons versed in the art to which the invention relates may be considered in judging of the substantial identity of the inventions. *Stephenson v. Hoyt*, 1 MacA. Pat. Cases, 292.

See *Identity*, § 2666. *Injunction, Alternative*, § 3011.

Experts — Value of their testimony, §§ 2435-2445.

§ 2435. Value of expert testimony considered. *Dixon v. Moyer*, 4 Wash., 68.

§ 2436. Great respect is due to the opinions of professional men on matters which relate to their professions. On such subjects only are the opinions of witnesses received in evidence. *Brooks v. Jenkins*, 3 McL., 432.

§ 2437. Relative value of expert to other testimony considered. *Allen v. Hunter*, 6 McL., 303.

§ 2438. Opinions of experts as to the identity of two inventions are entitled to weight, but are not binding. *Spaulding v. Tucker*, Deady, 649.

§ 2439. The opinions of experts are evidence as to matters of science within their peculiar departments of knowledge, but the value of such opinions must be tested by the value of the reasons on which they are built. *Jordan v. Dobson*, 2 Abb., 398.

§ 2440. The opinions of experts, while admissible on matters involving questions of science and artistic skill, are not to be held as conclusive. *Many v. Sizer*, 1 Fish., 17.

§ 2441. The mere opinions of experts are not entitled to much weight, unless founded on good and satisfactory reasons. *Cox v. Griggs*, 1 Biss. 362.

§ 2442. The opinions of experts that the machine described is impracticable, founded on a literal construction of the specification, are of little weight compared with evidence of its successful operation in actual use. *Seymour v. Marsh*, 2 O. G., 675.

§ 2443. The opinion of experts respecting the practical merits of the applicant's machine as compared with the reference cited does not affect the question of novelty. *In re Winslow*, 1 MacA. Pat. Cases, 123.

§ 2444. Where the opinion of an expert involves a question of law, it is not to go to the jury. *Ely v. Monson & Brimfield Mfg. Co.*, 4 Fish., 64.

§ 2445. The testimony of experts is to be considered by the jury like any other evidence; it is to be tried by the same tests, and to receive the credit the jury may deem it entitled to. *Carter v. Baker*, 1 Saw., 512.

See *Affidavits*, § 175. *New Trial*, § 4248.

133. EXPIRED PATENT.

See JURISDICTION, EQUITY, EXPIRED PATENTS. PARTIES, JOINDER OF, §§ 4543-4545. PROCESS AND PRODUCT, §§ 5116-5118.

§ 2446. If a sewing machine has acquired a name which designates a mechanism or peculiar construction, parts of which are protected by patents, other persons, after the expiration of the patents, have the right to construct the machine and call it by that name, because that only expresses the kind and quality of the machine. *Singer Mfg. Co. v. Larsen*, 8 Biss. 151.

See *Bill, Motion to Amend*, § 650. *Infringement*, §§ 2919-2968. *Injunction*, § 3400. *Jurisdiction*, §§ 3905-3931. *Marking Articles Patented*, §§ 4131, 4136, 4137.

134. EXPIRING PATENT.

See INJUNCTION, ALTERNATIVE, § 3014. INJUNCTION, PRELIMINARY, § 3146. JURISDICTION, §§ 3898-3904.

135. EXTENSION.

See ASSIGNMENT, OF EXTENDED TERM. STATUTES, §§ 6126-6130.

Extension — Construction of statutes — *Act 1836*, §§ 2447-2450. *Act 1839*, § 2451. *Revised Statutes*, section 4928, § 2452.

§ 2447. *Act 1836*, section 18, "extended term," construed. *Wilson v. Turner*, Taney, 278; *Gibson v. Harris*, 1 Blatch., 167; *Day v. Union India Rubber Co.*, 3 Blatch., 488.

§ 2448. Act 1836, section 18, "extension," "assignee's rights," construed. *Wilson v. Rousseau*, 4 How., 646; *Woodworth v. Sherman*, 3 Story, 171.

§ 2449. Act 1836, "extension of patent," reviewed. *Brooks v. Bicknell*, 3 McL., 250.

§ 2450. Act 1836, section 18, "proceedings and functions of the examining board in extension of patents," reviewed. *Brooks v. Jenkins*, 3 McL., 432.

§ 2451. Act 1839, "extended term," construed. *Wilson v. Turner*, Taney, 278.

§ 2452. A party seeking the protection of section 4928, R. S., must be a purchaser of the patented article, or protected by some agreement of sale, which the owner of the original patent could rightfully make. A mere license to use such invention would not include the extended term of the patent. *Wooster v. Siedenberg*, 13 Blatch., 88.

Extension — To whom it may be granted, §§ 2453-2458.

§ 2453. Extensions may be granted to patentee; legal representatives. *Grundy's Opinion*, 3 Op., 446.

§ 2454. The extension of a reissued patent is properly made to the original patentee, and inures to the assignees and grantees to the extent of their interests. *Crompton v. Belknap Mills Co.*, 3 Fish., 536.

§ 2455. It is no valid objection to the validity of a patent that the extension was made to the administrator. *Woodworth v. Hall*, 1 W. & M., 248.

§ 2456. An administrator is entitled to the extension of a patent under act 1836. *Washburn v. Gould*, 3 Story, 122; *Woodworth v. Sherman*, 3 Story, 171; *Brooks v. Jenkins*, 3 McL., 432; *Brooks v. Bicknell*, 3 McL., 250.

§ 2457. Under act 1836, the administrator may apply for an extension, where the patentee has, during his life, disposed of his interest in the original patent. *Wilson v. Rousseau*, 4 How., 646.

§ 2458. Act 1836, section 18, authorizes extension on the application of the executor or administrator of the patentee. *Ibid.*

Extension — To whom it inures, §§ 2459-2463.

§ 2459. Under act 1836, section 18, extension benefits inventor, not assignee. *Brooks v. Bicknell*, 4 McL., 64; *Wilson v. Turner*, Taney, 278.

§ 2460. *Held*, that under act 1836, section 18, the extension of a patent vested an absolute and complete title to it in patentee, whether or not he was possessed of the entire interest in the patent at the time of its reissue prior thereto. *Potter v. Empire Sewing Machine Co.*, 3 Fish., 474.

§ 2461. An extension does not inure to the benefit of the assignees or persons using the patented article. (Per MCLEAN, J., dissenting.) *Wilson v. Rousseau*, 4 How., 646.

§ 2462. The extension inures to the benefit of patentee's executor or administrator in his representative capacity, and to those lawfully using the patented article, and not to assignees under the original patent. *Ibid.*

§ 2463. To determine in whom the title to an extension by special act rests, the special act and the general laws — statutes *in pari materia* — must be construed together. *Bloomer v. McQuewan*, 14 How., 539.

Extension — Conclusiveness of commissioner's decision on granting, §§ 2464-2471.

§ 2464. Act 1836, section 18, as modified by act 1848, section 1, discretion of the commissioner in granting extensions, considered. *Hoar's Opinion*, 13 Op., 28.

§ 2465. The action of the commissioner in extending a patent is judicial in character and cannot be collaterally brought under review as matter of defense in a suit against an alleged infringer. *Whitney v. Mowry*, 4 Fish., 207; *American Wood Paper Co. v. Glens Falls Paper Co.*, 8 Blatch., 513.

§ 2466. The commissioner's decisions in extensions held conclusive as to informalities or irregularities that may have happened in the course of his duty. *Colt v. Young*, 2 Blatch., 471.

§ 2467. The decision of the board of commissioners (act 1836, section 18) to determine upon an extension is inconclusive as to their jurisdiction. *Wilson v. Rousseau*, 4 How., 646.

§ 2468. On suit brought on extended term granted patentee's administrator, *held*, that commissioner's decision was conclusive as to the production of letters of administration, and an objection that they were not produced was overruled. *Woodworth v. Hall*, 1 W. & M., 248.

§ 2469. The question of law as to the right of extension of a patent is not concluded by action of the board for extending patents (act 1836). *Brooks v. Bicknell*, 3 McL., 250.

§ 2470. Act of 1848, constituting the commissioner examiner in extension cases, did not repeal the provision of act 1836 granting extensions; and an extension application pending prior thereto did not, after the act, require to be begun *de novo*. *Colt v. Young*, 2 Blatch., 471.

§ 2471. It is the filing of a petition for an extension which gives the commissioner jurisdiction over the proceeding, and not the advertisements required by law; whether they have been duly published it is his province to determine. *Gear v. Grosvenor*, 1 Holmes, 215.

Extension — *Power of congress to extend the patent*, §§ 2472-2474. *The grant*, §§ 2475-2477. *Not impeachable collaterally*, §§ 2478, 2479. *Sale of term*, §§ 2480-2482. *Practice*, §§ 2483-2489.

§ 2472. Congress has power to renew or extend a patent. *Evans v. Robinson*, 1 Car. L. R. (N. C.), 209.

§ 2473. It is within the constitutional power of congress to grant a second extension of a patent. *Bloomer v. Stolley*, 5 McL., 158.

§ 2474. Special act of 1839, extending Blanchard's patent to him, and further protecting all assignees of rights and grants made by him prior to the extension, *held* to be within the constitutional power conferred on congress. The act construed to extend the exclusive right to the *invention*, and not the mere legal title under the patent. *Blanchard Gun-Stock Turning Factory v. Warner*, 1 Blatch., 258.

§ 2475. Extension of a patent under act 1836, section 18, is a new grant of the exclusive right for seven years, and vests no exclusive privilege to the grantees and assignees named therein. *Wilson v. Rousseau*, 4 How., 646.

§ 2476. An extension of a patent is a new grant, the right to which is capable of being transferred in the same manner as the inchoate right to the monopoly for the first term, by an agreement disclosing such intention, but, being contingent and personal to the inventor, it cannot be held to pass as an incident and appurtenant to the invention. *Mowry v. Grand St. R. Co.*, 10 Blatch., 89.

§ 2477. The granting of an extended patent is a judicial act. When it is granted in apparent conformity with the act of congress, the decision of the commissioner has the attributes of a final judgment, and is not subject to repeal or revision. *Dorsey Revolving Harvester Rake Co. v. Marsh.*, 6 Fish., 387.

§ 2478. As to the validity of the extension, as it is regular on its face, no question of irregularity or fraud in granting it can be raised by an infringer, in a suit against him for infringement. *Tilghman v. Mitchell*, 9 Blatch., 18.

§ 2479. The extension of a patent cannot be impeached for fraud in procuring its issue in any collateral proceeding, such as a suit on the patent, but only in one instituted directly for setting it aside. *Gear v. Grosvenor*, 1 Holmes, 215.

§ 2480. Sale of invention prior to patenting does not carry exclusive right to extended term. *Clum v. Brewer*, 2 Curt., 506.

§ 2481. Inventor's inchoate right to an extension of his patent may be the subject of a contract of sale. *Ibid.*

§ 2482. A patentee may assign his right to an extension of his patent prior to the grant of the extension. *Railroad Co. v. Trimble*, 10 Wall., 367.

§ 2483. Practice on application for extension of a patent held by an assignee (acts 1832 and 1836). *Washburn v. Gould*, 3 Story, 122.

§ 2484. When a patent is extended by act of congress, the certificate of renewal and extension need not recite the proviso of the act. *Agawam Co. v. Jordan*, 7 Wall., 583.

§ 2485. Applications for extension must be made a sufficient time before the expiration of the term to enable the notice to be given required by act 1836. *Gilpin's Opinion*, 3 Op., 595.

§ 2486. In counting the ninety days prior to expiration of a patent on which the application for extension must be filed, the day of filing is included. *Johnson v. Onion*, 3 Hughes, 290.

§ 2487. The day on which the application for extension is filed is included as one of the ninety days prior to the expiration of the patent on which such application should be filed. *Johnson v. McCulloch*, 4 Fish., 170.

§ 2488. An extension by the chief clerk of the patent office, after his power as assistant commissioner had ceased, by repeal of act 1836, section 2, by act of 1868, *held* invalid. *American Wood Paper Co. v. Glen Falls Paper Co.*, 8 Blatch., 513.

§ 2489. Deemed doubtful that the making of the decision which is indorsed on the file-wrapper is the official act which operates as a legal extension of the patent, even though it be deemed to establish the right to such extension. *Ibid.*

Extension — Who may continue use under, §§ 2490-2503.

§ 2490. Assignee of right to use during an extended term has no right to continued use during a second extended term. *Gibson v. Gifford*, 1 Blatch., 529; *Bloomer v. Stolley*, 5 McL., 158; *Gibson v. Cook*, 2 Blatch., 144.

§ 2491. Assignees, during original term of a "patented thing," whether for process, or machine for such process, or for both, have a right to its continued use on extension. *Day v. Union India Rubber Co.*, 3 Blatch., 488.

§ 2492. Right of assignee to continue use, but not to make the thing, during extended term. The rule stated. *Wood v. Michigan Southern, etc., R. Co.*, 2 Biss., 62.

§ 2493. Licensee of right to use a patented machine under the original term of the patent may continue such use under the extended term, until the machine is worn out. *Woodworth v. Curtis*, 2 W. & M., 524.

§ 2494. The only right which a lawful licensee under the patent, for the first term, of the right to use the thing patented, acquired under the extended term, by virtue of that clause in section 18, act 1836, is the right to continue to use until worn out, or as long as repairs can be made. *Hodge v. Hudson River R. Co.*, 6 Blatch., 85.

§ 2495. Where patentee had manufactured and sold his patented machine, *held*, that his vendee had the right to continue the use of it until worn out, through a term subsequently extended to patentee by special act, without any saving clause in favor of his assignees. *Blanchard v. Whitney*, 3 Blatch., 307.

§ 2496. The purchaser of a patented machine may use the same till worn out, notwithstanding the extension of the patent by act of congress. *Bloomer v. Millinger*, 1 Wall., 340.

§ 2497. The rightful owner of a patented machine may continue its use until worn out, notwithstanding the extension of the patent. *Chaffee v. Boston Belting Co.*, 22 How., 217.

§ 2498. The right of an owner of a patented machine, without any conditions attached to his ownership, to continue the use of his machine during an extended term of the patent, is well settled, and power to sell the machine and transfer the accompanying right of use is an incident of this unrestricted ownership. *Union Paper Bag Machine Co. v. Nixon*, 15 Otto, 766.

§ 2499. Under the special act of 1847, granting a further extension of Blanchard's patent, *held*, that no right to continue the use during such extended term was conferred on the maker of a machine in the interval between the expiration of the patent and the grant of the first extended term. *Blanchard v. Haynes*, 6 West. L. J., 82.

§ 2500. Machines having been constructed and used under right acquired from patentee during the first term, and being in use at the expiration thereof, *held*, there was a right to their continued use, notwithstanding the first extension. *Woodworth v. Cook*, 2 Blatch., 151.

§ 2501. Where a patent is extended, the right to use the machine, granted prior thereto, continues during the extension. (McLEAN, J., dissenting.) The right to make or sell expires with the end of the term for which such right was granted. *Bloomer v. McQuewan*, 14 How., 539.

§ 2502. A right to use a patented process during the original term of the patent does not, under section 18 of the act of 1836 (re-enacted in 1870), authorize the use of it after the patent is extended. *Wetherill v. Passaic Zinc Co.*, 2 O. G., 471.

§ 2503. The grant of a right to use a patented process, and of apparatus which, though capable of being adapted to the process, was constructed to accomplish the same object by different means, does not authorize the use of the process in that apparatus after the patent is extended. *Ibid.*

Extension — Generally, §§ 2504-2516.

§ 2504. The policy of the law seems to require that a patentee applying for an extension should have an interest in it; but an equitable interest is sufficient, although another holds the legal estate. *Gear v. Grosvenor*, 1 Holmes, 215.

§ 2505. Where the imputation of fraud arises in a proceeding between government and patentee, to set aside the patent, or between patentee and a third person whose rights of property were directly involved in the question of extension, proof of fraud in obtaining it is sufficient to defeat the patent, but must be clear and satisfactory. *Goodyear v. Providence Rubber Co.*, 2 Cliff., 351.

§ 2506. Assignee of extended term may recover for infringement commenced before and continued during such extension. *Chaffee v. Boston Belting Co.*, 22 How., 217.

§ 2507. Administrator can assign the extended term. *Brooks v. Jenkins*, 3 McL., 432.

§ 2508. The owners of an extended term of a patent take their title subject to rights of the unrestricted owners of patented machines, and their licensees take their interests subject to the same rights. *Union Paper Bag Mch. Co. v. Nixon*, 15 Otto, 766.

§ 2509. Parties claiming under an extension are to be visited with the consequences of the acts of their predecessors. *Goodyear v. Honsinger*, 2 Biss., 1.

§ 2510. On the reissue of an extended patent, the "original patent," section 13, act 1836, is the extended patent for twenty-one years, and the residue of the period unexpired of the original patent is the residue of this term. *Gibson v. Harris*, 1 Blatch., 167.

§ 2511. Where patentee, having secured his invention by a patent in proper form, assigns the entire patent for the original term only, reserving his right to apply for and obtain an extension, it is not in the power of the assignee, by surrendering and reissuing the patent without patentee's consent, to affect patentee's right to apply for and obtain an extension of the only patent which he has ever adopted or assented to. *Potter v. Braunsdorf*, 7 Blatch., 97.

§ 2512. Whatever may be the effect of an exclusive license within a district upon the right of an owner of a patented machine before the end of the original term of the patent, as that license ceases when the term expires, it follows that during the extended term no question can arise under the license. *Union Paper Bag Mch. Co. v. Nixon*, 15 Otto, 766.

§ 2513. Upon an application for an extension the alleged invention is not to be considered wanting in utility because it has been superseded by superior devices subsequently discovered. *Cook v. Ernest*, 2 O. G., 89.

§ 2514. A bill to set aside an extension of a patent, filed after the extension has expired, has no equity to support it, and a demurrer thereto will be sustained and the bill dismissed. *Bourne v. Goodyear*, 9 Wall., 811.

§ 2515. The general and broad provision for extending patents granted prior to 1861 made no discrimination against those which were limited to fourteen years from the date of a foreign patent, and there can be no reasonable doubt that congress, in the statute of 1870, intended to leave patents granted before March 2, 1831, exactly where they were before. *New American File Co. v. Nicholson File Co.*, 8 Fed. Rep., 816.

§ 2516. A patent, therefore, applied for and obtained under the circumstances named, and duly extended by the commissioner in proper time and in regular form, is valid, subject to the ordinary defenses. *Ibid.*

136. FALSE SUGGESTION.

§ 2517. Where of two or more inventors of a machine, one of them swears he is the true inventor and obtains a patent therefor, he obtains it "upon false suggestion" (act 1793). *Stearn v. Barrett*, 1 Mason, 153.

See *Burden of Proof*, § 665. *Commissioner*, § 1101. *Repeal of Patents*, § 5838.

137. FEDERAL COURTS, JURISDICTION.

See JURISDICTION, FEDERAL COURTS.

138. FILE-WRAPPER AND CONTENTS, ADMISSIBILITY IN EVIDENCE.

See EVIDENCE, ADMISSIBILITY OF PATENT OFFICE RECORDS.

139. FINAL DECREE.

See DECREE, FINAL.

140. FOREIGN KNOWLEDGE AND USE, PRIOR.

See USE, PRIOR FOREIGN KNOWLEDGE.

141. FOREIGN PATENTS.

See DISCLAIMER, IN FOREIGN PATENT. PUBLICATION, PRIOR, FOREIGN PATENT. TERM, EFFECT OF FOREIGN PATENT ON DOMESTIC PATENT.

Foreign patent — *Statute*, §§ 2518, 2519. *Its date*, §§ 2520-2532.

§ 2518. In act 1836, section 15, the word "patented" abroad means covered and made known to the world by a public patent, so as to bring home to the public generally and probably a knowledge of its existence, and deprive any one of the credit and protection of being original, if he afterwards construct a like machine. *Brooks v. Norcross*, 2 Fish., 661.

§ 2519. The expression "patented," in the statute, would seem, from the signification of the word, to mean only inventions laid open to the public and protected to the inventors, and such appears to be the construction which the expression has heretofore received. *Schoerken v. Swift, Courtney & Beecher Co.*, 19 Blatch., 209.

See *Term*, § 6270.

§ 2520. An invention is not patented in England, within the meaning of the third division of section 4920, Revised Statutes, until the completed specification has been filed. *Coburn v. Schroeder*, 11 Fed. Rep., 425.

§ 2521. The grant of a Canadian patent is to be determined by its date of issue, and not by the time of its delivery. *Bate Refrigerating Co. v. Gillett*, 22 O. G., 1205 (§§ 6264-67).

§ 2522. What is evidence of the patenting and validity of a French patent stated. *Brooks v. Norcross*, 2 Fish., 661.

§ 2523. An invention in England is not patented so as to anticipate an American patent until the enrollment of the final specification. *Howe v. Morton*, 1 Fish., 586.

§ 2524. *Semble*, that a foreign patent, to bar the domestic applicant, must have been issued before the date of the domestic invention. *Matthews v. Wade*, 1 MacA. Pat. Cases, 143.

§ 2525. By the act of 1870, a foreign patent, in order to invalidate an American patent, must antedate the invention patented. *Cochrane v. Deener*, 4 Otto, 781.

§ 2526. English patents introduced to establish priority over a United States patent must take date from time of filing the specifications. *O'Reilly v. Morse*, 15 How., 62.

§ 2527. Foreign patents are not admissible as evidence against an American patent anterior to their date of enrollment. *Willimantic Linen Co. v. Clark Thread Co.*, 4 B. & A., 133.

§ 2528. A foreign patent, in order to anticipate a United States patent, must be prior to the invention, not to the date of application. *Howe v. Morton*, 1 Fish., 586.

§ 2529. *Quære*, whether on the question of novelty the prior foreign (English) patent must be considered as taking date from the sealing of the letters patent, or from the time of enrollment of the specification. *Howe v. Williams*, 2 Cliff., 245.

§ 2530. An invention is not patented in England, so as to anticipate an invention patented in this country, until the completed specification has been filed. The date of filing the provisional specification is not to be considered. *Smith v. Goodyear Dental Vulcanite Co.*, 3 Otto, 486.

§ 2531. When a foreign patent is set up to defeat a United States patent to a different inventor, the manifest intention of the law is that the foreign patent shall apply only as of a date when the invention was published or made accessible to the public, and not, as in the case of a patent obtained by the foreign patentee, as of an earlier date from which the inventor may have enjoyed the benefit of the foreign patent as a patent. *De Florez v. Raynolds*, 17 Blatch., 436.

§ 2532. The force of English letters patent as references are overcome by evidence showing that the domestic patentee made the invention before the date of the filing of the foreign specification. *Lorillard & Co. v. Dohan, Carroll & Co.*, 9 Fed. Rep., 509.

Foreign patent—In general, §§ 2533-2540. See *Term*, §§ 6272-6303. *Interference*, § 3468. *Use*, §§ 6378, 6494. *Validity*, § 6690.

§ 2533. French secret patents are not such as will invalidate a subsequent United States patent under section 15, act 1836, for want of novelty. *Brooks v. Norcross*, 2 Fish., 661.

§ 2534-5. A patented invention cannot be defeated by a prior foreign patent proved to be inoperative, impracticable and worthless. *Harwood v. Mill River Mfg. Co.*, 3 Fish., 526.

§ 2536. It appearing that by the law of France some patents are kept secret, and it appearing that the copy of the patent in question was certified to after the manner of public records, *held*, that the patent must be taken to be an open patent. *Schoerken v. Swift & Courtney and Beecher Manufacturing Co.*, 19 Blatch., 209.

§ 2537. There is a strong, if not an irresistible, inference arising from the British statute of monopolies, that an exhibit of an English machine maker, patented at such a date, was *new* within the kingdom at that date. *Knox v. Lowree*, 6 O. G., 802.

§ 2538. The invention having been patented in England by a third person, *held*, that, in order to support the objection resting upon the issuance of a foreign patent, proof should be given connecting the complainant with its procuration. *Goodyear Dental Vulcanite Co. v. Willis*, 1 Flip., 388.

§ 2539. The validity of a patent is not impaired because the invention is embraced in a prior English patent, if, previous to the date of the latter, the American patentee had reduced the invention to practice. *National Car Spring Co. v. Union Car Spring Manufacturing Co.*, 12 Blatch., 80.

§ 2540. A prior English patent taken out surreptitiously by any person, who, without the knowledge of the American inventor, and without authority from him, endeavored to appropriate the benefits of his invention, would not thereby deprive the real inventor of any of his rights. *Kendrick v. Emmons*, 9 O. G., 201.

See *Application*, § 349. *Evidence*, §§ 2314, 2315.

142. FOREIGN STATUTES, CONSTRUCTION OF.

See STATUTES, CONSTRUCTION OF; FOREIGN STATUTES.

143. FOREIGN USE, PRIOR, IN RESPECT TO DOMESTIC PATENT.

See USE, PRIOR, FOREIGN USE IN RESPECT TO DOMESTIC PATENT.

144. FOREIGN VESSEL.

See USE, ON FOREIGN VESSEL IN DOMESTIC PORT, IN RESPECT TO INFRINGEMENT.

145. FOREIGN WORKS, AS PRIOR PUBLICATION.

See PUBLICATION, PRIOR, FOREIGN WORKS.

146. FORFEITURE OF LICENSE.

See LICENSE, FORFEITURE OF.

147. FORM.

See COMBINATION, § 927. CONSTRUCTION OF PATENTS, §§ 1221-1237. INVENTION, §§ 3558-3560. IDENTITY, §§ 2676-2700. INFRINGEMENT, §§ 2885-2891. PATENTABILITY, §§ 4568-4571. REISSUES, § 5547.

SUMMARY (*WINANS v. DENMEAD*, §§ 2541-2553)—*Construction of patent a question of law and fact*, § 2541.—*What is considered in construing a patent*, § 2542.—*Infringement of the patent*, § 2543.—*Patentability*, §§ 2544, 2545, 2548, 2549, 2551.—*Construction of a patent for a form*, § 2546.—*Claim*, §§ 2547, 2550, 2552.—*Infringement of a patent for a form*, § 2553.

WINANS v. DENMEAD.

(15 Howard, 330-348. 1853.)

The facts are stated in the opinion.

Opinion by MR. JUSTICE CURTIS.

This is a writ of error to the circuit court of the United States for the district of Maryland. The plaintiff in error brought his action in that court, for an infringement of the exclusive right to make, use and sell "an improvement in cars for the transportation of coal," etc., granted to him by letters patent, bearing date on the 26th day of June, 1847; and the judgment of that court being for the defendants, he has brought the record here by this writ of error. It appears, by the bill of exceptions, that the letters patent declared on were duly issued, and that their validity was not questioned; but the defendants denied that they had infringed upon the exclusive right of the plaintiff.

§ 2541. *What is the thing patented is a question of law; whether thing patented has been constructed, used or sold by another is a question of fact.*

On such a trial, two questions arise. The first is, what is the thing patented; the second, has that thing been constructed, used or sold by the defend-

ants? The first is a question of law, to be determined by the court, construing the letters patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to a jury. In this case, it is alleged the court construed the specification of claim erroneously, and thereby withdrew from the jury questions which it was their province to decide. This renders it necessary to examine the letters patent, and the schedule annexed to them, to see whether their construction by the circuit court was correct.

§ 2542. *Topics of inquiry in construing a patent.*

In this as in most patent cases founded on alleged improvements in machines, in order to determine what is the thing patented, it is necessary to inquire: 1. What is the structure or device, described by the patentee, as embodying his invention? 2. What mode of operation is introduced and employed by this structure or device? 3. What result is attained by means of this mode of operation? 4. Does the specification of claim cover the described mode of operation by which the result is attained?

Without going into unnecessary details, or referring to drawings, it may be stated that the structure, described by this patent, is the body of a burden railroad car, made of sheet iron, the upper part being cylindrical, and the lower part in the form of a frustum of a cone, the under edge of which has a flange secured upon it, to which flange a movable bottom is attached. This bottom is made movable in order to discharge the load through the aperture left by removing it.

To understand the mode of operation introduced and employed by means of this form of the car body, it is only necessary to state what appears on the face of the specification, and was testified to by experts at the trial as correct, that, by reason of the circular form of the car body, the pressure of the load outwards was equal in every direction, and thus the load supported itself in a great degree; that, by making the lower part conical, this principle of action operated throughout the car, with the exception of the small space to which the movable bottom was attached; that, being conical, the lower part of the car could be carried down below the truck, between the wheels, thus lowering the center of gravity of the load; that the pressure outwards upon all parts of the circle being equal, the tensile strength of the iron was used to a much greater degree than in a car of a square form; and finally, that this form of the lower part of the car facilitated the complete discharge of the load through the aperture, when the bottom was removed.

It thus appears that, by means of this change of form, the patentee has introduced a mode of operation not before employed in burden cars, that is to say, nearly equal pressure in all directions by the entire load, save that small part which rests on the movable bottom; the effects of which are, that the load, in a great degree, supports itself, and the tensile strength of the iron is used, while at the same time, by reason of the same form, the center of gravity of the load is depressed, and its discharge facilitated. The practical result attained by this mode of operation is correctly described by the patentee; for the uncontradicted evidence at the trial showed that he had not exaggerated the practical advantage of his invention. The specification states:

“The transportation of coal and all other heavy articles in lumps has been attended with great injury to the cars, requiring the bodies to be constructed with great strength to resist the outward pressure on the sides, as well as the vertical pressure on the bottom, due not only to the weight of the mass, but

the mobility of the lumps among each other tending to 'pack,' as it is technically termed. Experience has shown that cars, on the old mode of construction, cannot be made to carry a load greater than its own weight; but, by my improvement, I am enabled to make cars of greater durability than those heretofore made, which will transport double their own weight of coal," etc.

Having thus ascertained what is the structure described, the mode of operation it embodies, and the practical result attained, the next inquiry is, does the specification of claim cover this mode of operation by which this result is effected? It was upon this question the case turned at the trial in the circuit court. The testimony showed that the defendants had made cars similar to the plaintiff's, except that the form was octagonal instead of circular. There was evidence tending to prove that, considering in reference to the practical uses of such a car, the octagonal car was substantially the same as the circular. Amongst other witnesses upon this point was James Millholland, who was called by the defendants. He testified:

"That the advantage of a reduced bottom of the car was obtained, whether the car was conical or octagonal; that the strengthening of the bottom, due to the adoption of a conical form, was the same when the octagonal form was adopted, or the circular. That the circular form was the best to resist the pressure, as, for instance, in a steam boiler, and an octagonal one better than the square form; that the octagonal car was not better than the conical car; that, for practical purposes, one was as good as the other; that a polygon of many sides would be equivalent to a circle; that the octagon car, practically, was as good as the conical ones, and that, substantially, the witness saw no difference between the two."

The district judge, who presided at the trial, ruled, that while the patent is good for what [is] described therein, a conical body, in whole or in part, supported in any of the modes indicated for a mode of sustaining a conical body on a carriage or truck, and drawing the same, and to those principles which were due alone to conical vehicles, and not to rectilinear bodies, and it being admitted that the defendants' car was entirely rectilinear, that there was no infringement of the plaintiff's patent.

§ 2543. *A patent for a circular, conical body for cars, which, by a certain mode of operation, produces a certain result, is infringed by an octagonal body of conical shape in general outline, which, by the same mode of operation, produces the same result.*

The substance of this ruling was, that the claim was limited to the particular geometrical form mentioned in the specification; and as the defendants had not made cars in that particular form, there could be no infringement, even if the cars made by the defendants attained the same result by employing what was in fact the same mode of operation as that described by the patentee. We think this ruling was erroneous.

§ 2544. *A change of form of a machine without a change of mode of operation or result is not patentable; but a change of form and the introduction of a new mode and a new and useful result is patentable.*

Under our law a patent cannot be granted merely for a change of form. The act of February 21, 1793, section 2 (1 Stats. at Large, 321), so declared in express terms; and though this declaratory law was not re-enacted in the patent act of 1836 (5 Stats. at Large, 117), it is a principle which necessarily makes part of every system of law, granting patents for new inventions. Merely to change the form of a machine is the work of a constructor, not of

an inventor; such a change cannot be deemed an invention. Nor does the plaintiff's patent rest upon such a change. To change the form of an existing machine, and by means of such change to introduce and employ other mechanical principles or natural powers, or, as it is termed, a new mode of operation, and thus attain a new and useful result, is the subject of a patent. Such is the basis on which the plaintiff's patent rests.

§ 2545. *It is the new mode of operation which is the invention and patentable, and this should be set forth in the specifications.*

Its substance is a new mode of operation, by means of which a new result is obtained. It is this new mode of operation which gives it the character of an invention, and entitles the inventor to a patent; and this new mode of operation is, in view of the patent law, the thing entitled to protection. The patentee may, and should, so frame his specification of claim as to cover this new mode of operation which he has invented; and the only question in this case is, whether he has done so, or whether he has restricted his claim to one particular geometrical form.

There being evidence in the case tending to show that other forms do in fact embody the plaintiff's mode of operation, and, by means of it, produce the same new and useful result, the question is, whether the patentee has limited his claim to one out of the several forms which thus embody his invention.

§ 2546. *A patent should not be construed to cover only one form of machine, where other forms may produce the same result, if it can fairly be construed otherwise.*

Now, while it is undoubtedly true that the patentee may so restrict his claim as to cover less than what he invented, or may limit it to one particular form of machine, excluding all other forms, though they also embody his invention, yet such an interpretation should not be put upon his claim if it can fairly be construed otherwise, and this for two reasons:

1. Because the reasonable presumption is, that, having a just right to cover and protect his whole invention, he intended to do so. *Haworth v. Hardcastle*, Web. P. C., 484.

2. Because specifications are to be construed liberally, in accordance with the design of the constitution and the patent laws of the United States, to promote the progress of the useful arts, and allow inventors to retain to their own use not anything which is matter of common right, but what they themselves have created. *Grant v. Raymond*, 6 Pet., 218; *Ames v. Howard*, 1 Sumn., 482, 455; *Blanchard v. Sprague*, 3 id., 535, 539; *Davoll v. Brown*, 1 Woodb. & M., 53, 57; *Parker v. Haworth*, 4 M'L., 372; *Le Roy v. Tatham*, 14 How., 181, and opinion of Parke, Baron, there quoted; *Neilson v. Hartford*, Web. P. C., 341; *Russell v. Cowley*, id., 470; *Corning v. Burden* (decided at the present term), 15 How., 252 (§§ 5028-35, *infra*).

The claim of the plaintiff is in the following words: "What I claim as my invention, and desire to secure by letters patent, is making the body of a car for the transportation of coal, etc., in the form of a frustum of a cone, substantially as herein described, whereby the force exerted by the weight of the load presses equally in all directions, and does not tend to change the form thereof, so that every part resists its equal proportion, and by which, also, the lower part is so reduced as to pass down within the truck frame and between the axles, to lower the center of gravity of the load without diminishing the capacity of the car, as described. I also claim extending the body of the car below the

connecting pieces of the truck frame and the line of draft, by passing the connecting bars of the truck frame and the draft bar through the body of the car, substantially as described."

§ 2547. *Where the patentee describes his machine and claims it as described, it is a claim not only of the form described, but of all forms which embody his invention, and to copy the mode or principle of operation is an infringement.*

It is generally true, when a patentee describes a machine and then claims it as described, that he is understood to intend to claim, and does by law actually cover, not only the precise forms he has described, but all other forms which embody his invention; it being a familiar rule that to copy the principle or mode of operation described is an infringement, although such copy should be totally unlike the original in form or proportions. Why should not this rule be applied to this case? It is not sufficient to distinguish this case to say that here the invention consists in a change of form, and the patentee has claimed one form only.

Patentable improvements in machinery are almost always made by changing some one or more forms of one or more parts, and thereby introducing some mechanical principle or mode of action not previously existing in the machine, and so securing a new or improved result. And, in the numerous cases in which it has been held that to copy the patentee's mode of operation was an infringement, the infringer had got forms and proportions not described, and not in terms claimed. If it were not so, no question of infringement could arise. If the machine complained of were a copy, in form, of the machine described in the specification, of course it would be at once seen to be an infringement. It could be nothing else. It is only ingenious diversities of form or proportion, presenting the appearance of something unlike the thing patented, which give rise to questions; and the property of inventors would be valueless if it were enough for the defendant to say, your improvement consisted in a change of form; you describe and claim but one form; I have not taken that, and so have not infringed.

The answer is, my improvement did not consist in a change of form, but in the new employment of principles or powers, in a new mode of operation, embodied in a form by means of which a new or better result is produced; it was this which constituted my invention; this you have copied, changing only the form; and that answer is justly applicable to this patent.

§ 2548. *There are cases where patents include only the form described, but this is because only the geometrical form described is capable of embodying the invention.*

Undoubtedly there may be cases in which the letters patent do include only the particular form described and claimed. *Davis v. Palmer*, 2 Brock., 309, seems to have been one of those cases. But they are in entire accordance with what is above stated. The reason why such a patent covers only one geometrical form is not that the patentee has described and claimed that form only; it is because that form only is capable of embodying his invention; and, consequently, if the form is not copied the invention is not used.

§ 2549. *Where form and substance are inseparable it is enough to look at the form; but where they are separable it is the duty of courts and juries to look for the substance — the thing patented.*

Where form and substance are inseparable it is enough to look at the form only. Where they are separable, where the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look

through the form for the substance of the invention—for that which entitled the inventor to his patent, and which the patent was designed to secure. Where that is found there is an infringement; and it is not a defense that it is embodied in a form not described and in terms claimed by the patentee.

§ 2550. *The law interprets the claim to extend to the thing patented, however its form or proportions may be varied, without the claim stating it.*

Patentees sometimes add to their claims an express declaration to the effect that the claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. The law so interprets the claim without the addition of these words. The exclusive right to the thing patented is not secured if the public are at liberty to make substantial copies of it, varying its form or proportions. And, therefore, the patentee, having described his invention, and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim every form in which his invention may be copied, unless he manifests an intention to disclaim some of those forms.

Indeed, it is difficult to perceive how any other rule could be applied, practicably, to cases like this. How is a question of infringement of this patent to be tried? It may safely be assumed that neither the patentee nor any other constructor has made, or will make, a car exactly circular. In practice, deviations from a true circle will always occur. How near to a circle, then, must a car be, in order to infringe? May it be slightly elliptical, or otherwise depart from a true circle, and, if so, how far?

In our judgment, the only answer that can be given to these questions is, that it must be so near to a true circle as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention. It is not necessary that the defendant's cars should employ the plaintiff's invention to as good advantage as he employed it, or that the result should be precisely the same in degree. It must be the same in kind, and effected by the employment of his mode of operation in substance. Whether, in point of fact, the defendant's cars did copy the plaintiff's invention, in the sense above explained, is a question for the jury, and the court below erred in not leaving that question to them upon the evidence in the case, which tended to prove the affirmative. The judgment of the court below must be reversed.

TANEY, C. J., and CATRON, DANIEL and CAMPBELL, JJ., dissented.

Dissenting opinion by MR. JUSTICE CAMPBELL.

I dissent from the opinion of the court in this case.

The plaintiff claims to have designed and constructed a car for the transportation of coal on railroads which shall carry the heaviest load, in proportion to its own weight.

His design consists in the adoption of the "conical form" "for the body of the car," "whereby the weight of the load presses equally in all directions;" does not "tend to change the form of the car;" permits it "to extend down within the truck," lowering "the center of gravity of the load," and by its reduced size at the bottom adding to its strength and durability. He claims as his invention, and it is the whole of the change which he has made in the manufacture of cars, "the making of the body of the car in the form of the frustum of a cone."

It is agreed that a circle contains a greater area than any figure of the same perimeter; that the conical form is best suited to resist pressure from within, and that the reduced size at the bottom of the car is favorable to its strength. The introduction of the cars of the plaintiff, upon the railroad, for the transportation of coal, was attended by a great increase of the loads in proportion to the weight of the car. The merits of the design are frankly conceded. Nevertheless, it is notorious that there does exist a very great variety of vessels in common domestic use, "of a conical form," or, "of the form of the frustum of a cone," for the reception and transportation of articles of prime necessity and constant demand, such as water, coal, food, clothing, etc. It is also true that the properties of the circle, and of circular forms alluded to in the patent of the plaintiff, are understood and appreciated, and have been applied in every department of mechanic art. One cannot doubt that a requisition from the transportation companies for cars of a diminished weight, and an increased capacity, upon the machinists and engineers connected with the business, would have been answered promptly by a suggestion of a change in the form of the car. The merit of the plaintiff seems to consist in the perfection of his design, and his clear statement of the scientific principle it contains.

§ 2551. *The validity of a patent for a form whose properties are known and used in analogous cases, questioned.*

There arises in my mind a strong if not insuperable objection to the admission of the claim, in the patent for "the conical form," or "the form of the frustum of a cone," as an invention. Or that any machinist or engineer can appropriate by patent a form whose properties are universally understood, and which is in very common use, in consequence of those properties, for purposes strictly analogous. The authority of adjudged cases seems to me strongly opposed to the claim. *Hotchkiss v. Greenwood*, 11 How., 248; *Losh v. Hague*, Web. Pat. Cas., 207; *Winans v. Providence R. Co.*, 2 Story, 412; 2 id., 190; 2 Car. & Kir., 1022; 3 W. H. & Gord., 427.

§ 2552. *The precise and definite specification and claim ascertain exactly the limits of the invention.*

Conceding, however, that the invention was patentable, and this seems to have been conceded in the circuit court, the inquiry is, what is the extent of the claim? The plaintiff professes to have made an improvement in the form of a vehicle which has been a long time in use, and exists in a variety of forms. He professes to have discovered the precise form most fitted for the objects in view. He describes this form, as the matter of his invention, and the principle he develops applies to no other form. For this he claims his patent. We are authorized to conclude that his precise and definite specification and claim were designed to ascertain exactly the limits of his invention. *Davis v. Palmer*, 2 Brock., 298.

The car of the defendants is of an octagonal form, with an octagonal pyramidal base. There was no contradiction, in the evidence given at the trial, in reference to its description, nor as to the substantial effects of its use and operation. In the size, thickness of the metal employed in its construction, weight, and substantial and profitable results, the one car does not materially vary from the other. The difference consists in the form, and in that it is visible and palpable. The circuit court, acting upon these facts, of which there was no dispute, instructed the jury that an infringement of the plaintiff's patent had not taken place. I do not find the question before the court a

compound question of law and fact. The facts were all ascertained, and upon no construction of those facts was the plaintiff, in my opinion, entitled to a judgment.

In theory the plaintiff's car is superior to all others. His car displays the qualities which his specification distinguishes. The equal pressure of the load in all directions; the tendency to preserve the form, notwithstanding the pressure of the load; the absence of the cross strain; the lowering of the center of the gravity of the load,—are advantages which it possesses in a superior degree to that of the defendants'. Yet the experts say that there is no appreciable difference in the substantial results afforded by the two. The cause for this must be looked for in a source extrinsic to the mere form of the vehicles. Nor is it difficult to detect the cause for this identity in the results in such a source.

The coarse, heavy, cumbrous operations of coal transportation do not admit of the manufacture of cars upon nice mathematical formulas, nor can the loads be adjusted with much reference to exactness. There is a liability to violent percussions and extraordinary strains, which must be provided for by an excess in the weight and thickness of the material used. Then, unless the difference in the weight of the load is great, there will be no correspondent difference in the receipts of the transportation companies. The patentee, not exaggerating the theoretical superiority of the form of his car, overlooked those facts which reduced its practical value to the level of cars of a form widely variant from his own. The object of this suit is to repair that defect of observation. It is that this court shall extend, by construction, the scope and operation of his patent to embrace every form which in practice will yield a result substantially equal or approximate to his own.

In the instruction asked for by the plaintiff, "form and circumstances" are treated as more or less immaterial, but the verdict is claimed if the defendants have constructed cars "which, substantially on the same principle and in the same mode of operation, accomplish the same result."

The principle stated in the patent applies only to circular forms. The modes of operation in coal transportation have experienced no change from the skill of the plaintiff, except by the change from the rectilinear figure to the circular.

§ 2553. *A rectilinear form by the same mode and operations, producing the same result as a conical form, is not an infringement of a patent on the latter.*

The defendant adheres to the rectilinear form. The result accomplished by the use of the two cars is the same—a more economical transportation of coal. This result it is that the plaintiff desires to appropriate, but this cannot be permitted. Curtis on Patents, §§ 4, 26, 27, 86, 87, 88; 2 Story, 408, 411. In the case of *Aiken v. Bemis*, 3 Woodb. & M., 349, the learned judge said: "When a patentee chooses to cover with his patent the material of which a part of his machine is composed, he entirely endangers his right to prosecute when a different and inferior material is employed, and one which he himself, after repeated experiment, had rejected."

The plaintiff confines his claim to the use of the conical form, and excludes from his specification any allusion to any other. He must have done so advisedly. He might have been unwilling to expose the validity of his patent by the assertion of a right to any other. Can he abandon the ground of his patent, and ask now for the exclusive use of all cars which, by experiment, shall be found to yield the advantages which he anticipated for conical cars

only? The claim of to-day is, that an octagonal car is an infringement of this patent. Will this be the limit to that claim? Who can tell the bounds within which the mechanical industry of the country may freely exert itself? What restraints does this patent impose in this branch of mechanic art?

To escape the incessant and intense competition which exists in every department of industry, it is not strange that persons should seek the cover of the patent act for any happy effort of contrivance or construction; nor that patents should be very frequently employed to obstruct invention, and to deter from legitimate operations of skill and ingenuity. This danger was foreseen and provided for in the patent act. The patentee is obliged, by law, to describe his invention in such full, clear and exact terms that from the description the invention may be constructed and used. Its principle and modes of operation must be explained; and the invention shall particularly "specify and point" out what he claims as his invention. Fullness, clearness, exactness, preciseness and particularity, in the description of the invention, its principle, and of the matter claimed to be invented, will alone fulfill the demands of congress or the wants of the country. Nothing, in the administration of this law, will be more mischievous, more productive of oppressive and costly litigation, of exorbitant and unjust pretensions and vexatious demands, more injurious to labor, than a relaxation of these wise and salutary requisitions of the act of congress. In my judgment the principles of legal interpretation, as well as the public interest, require that this language of this statute shall have its full significance and import.

In this case the language of the patent is full, clear and exact. The claim is particular and specific. Neither the specification nor the claim, in my opinion, embrace the workmanship of the defendants. I therefore respectfully dissent from the judgment of the court, which implies the contrary.

148. FORMAL CHANGE.

Formal change — What constitutes, §§ 2554-2564.

§ 2554. Act 1793, "change of form," construed. *Davis v. Palmer*, 2 Brock., 298.

§ 2555. Substantial change, how determined. *Tatham v. Le Roy*, 2 Blatch., 474.

§ 2556. Substitution of a known equivalent in a combination is a formal change and will not avoid infringement. *Rice v. Heald*, 13 Pac. L. R., 33; *Rees v. Gould*, 15 Wall., 187.

§ 2557. Mere formal difference from a prior invention will not protect a patent. *Stanley v. Whipple*, 2 McL., 35.

§ 2558. Change of form is not material where the form does not contribute to the new result. *Adams v. Edwards*, 1 Fish., 1.

§ 2559. A difference merely in shape is a difference in degree only, and not in the thing itself. *Wilbur v. Beecher*, 2 Blatch., 132.

§ 2560. Formal change, such as change in proportion, mere change in form or difference in shape, is not a change within the meaning of the law. *Hall v. Wiles*, 2 Blatch., 194.

§ 2561. A change in form from the construction of an existing machine is not a substantial change, nor is a change in proportions. *Tatham v. Le Roy*, 2 Blatch., 474.

§ 2562. Where in the patent and in defendant's machine there is the same operation of the same parts acting in combination with each other and attaining the same results, a change by the defendant of the position of one element is formal and not substantial. *Blake v. McNab*, etc., Mfg. Co., 19 Blatch., 73.

§ 2563. Mere colorable or evasive differences cannot defeat the right of the original inventor. *Carter v. Baker*, 1 Saw., 512.

§ 2564. Mere change of form in the elementary parts of a combination, or in the different parts of a machine, does not change the character and principle of the machine, provided the spirit, substance and principle of the machine is retained. *Conover v. Roach*, 4 Fish., 12.

See *Claims, Construction of*, §§ 738, 739.

Formal change — Its patentability, §§ 2565-2577.

§ 2565. Mere formal difference is not patentable. *Carver v. Braintree Mfg. Co.*, 2 Story, 432.

§ 2566. A difference in form and proportions only, but not in principle, does not entitle to an improvement patent. *Evans v. Eaton*, 3 Wash., 443.

§ 2567. A change in proportions or form only is not a patentable improvement. *Pettibone v. Derringer*, 4 Wash., 215.

§ 2568. A slight alteration in the structure of a machine or in the improvement of it is not patentable. *Smith v. Pearce*, 2 McL., 176.

§ 2569. Change of form or of mechanical structure is not patentable, unless it produces new and entirely different results. *Sargent v. Larned*, 2 Curt., 340.

§ 2570. A formal difference in a combination which involves no skill, ingenuity or mind is not patentable; to be so the change must be substantial. The new article must be different from that on which it is claimed to be an improvement, not only in its mechanical contrivance and construction, but in its practical operation and effect in producing the useful result. *Buck v. Hermance*, 1 Blatch., 398.

§ 2571. Mere change of location is not patentable; but where change of location brings into existence a new combination of devices, operating by reason of such new combination to produce a new and useful result, such new combination is patentable. *Gilbert & Barker Manufacturing Co. v. Walworth Manufacturing Co.*, 9 O. G., 746.

§ 2572. The greatly improved result attending a change in the form or location of parts, when viewed in connection with the failure of the many experiments previously made to accomplish similar results by mere structural changes, has a great tendency to prove that they involve some functional difference beyond mere mechanical perfection and adjustment. *Pearl v. Ocean Mills*, 11 O. G., 2.

§ 2573. A mere change of form, resulting from a different arrangement and combination of the parts, is not patentable. *Sangster v. Miller*, 5 Blatch., 243.

§ 2574. If form is a part of the thing invented and is essential to its value, then a change from the form is a substantial change, and may be the means of producing a new manufacture. *Many v. Jagger*, 1 Blatch., 372.

§ 2575. A patentable change of form and proportion of a machine is where a new effect is produced. *Davis v. Palmer*, 2 Brock., 298.

§ 2576. Mere change of form or proportions does not constitute invention. *Lowell v. Lewis*, 1 Mason, 182.

§ 2577. Mere change in form or proportion of a known machine or instrument, however great, is often merely colorable or unessential; but if a change is effected involving invention, whereby a better and more convenient article for the same purpose is produced, it may avoid the charge of a mere constructive modification. *Miller's Falls Co. v. Backus*, 17 O. G., 852.

Formal change — Will not avoid infringement, §§ 2578-2600.

§ 2578. Formal difference does not avoid infringement, neither does difference in proportions. A difference in principle does. *Reutgen v. Kanowrs*, 1 Wash., 168.

§ 2579. A mere colorable or slight alteration of a machine, or change in its proportions, is not patentable and will not avoid infringement. *Brooks v. Bicknell*, 3 McL., 250.

§ 2580. Mere formal difference will not avoid infringement. *Dixon v. Moyer*, 4 Wash., 68.

§ 2581. Mere colorable alterations will not protect from infringement. *Foss v. Herbert*, 1 Biss., 121; *Odiorne v. Winkley*, 2 Gall., 50.

§ 2582. A substantial imitation with a mere colorable variation is an infringement. *Davis v. Palmer*, 2 Brock., 298.

§ 2583. Change of form will not avoid infringement, unless it produces a new and useful result. *Gibson v. Harris*, 1 Blatch., 167.

§ 2584. Change of form, without change of principle, will not avoid infringement. *Washburn v. Gould*, 3 Story, 122.

§ 2585. Formal difference or colorable evasions will not avoid infringement. *Roberts v. Harnden*, 2 Cliff., 500.

§ 2586. Formal changes of machinery do not evade infringement. *Sickles v. Borden*, 3 Blatch., 535.

§ 2587. A change of form and not of substance is no defense in a suit for infringement. *Morey v. Lockwood*, 8 Wall., 230.

§ 2588. Changes of form and proportion, without introduction of a new principle or mechanical power, or new mode of operation, producing a new kind of result, will not avoid infringement. *Many v. Sizer*, 1 Fish., 17.

§ 2589. A difference in form or proportion to bring about similar results, or the use of a mechanical equivalent for what is used by the other, will not avoid infringement. *Colt v. Massachusetts Arms Co.*, 1 Fish., 108.

§ 2590. Mere formal differences will not justify a third person in making, using, or vending to others to be used, the patented invention of another. *Cook v. Howard*, 4 Fish., 269.

§ 2591. Mere form, mere order of arrangement, if it makes no substantial difference in the operation and in the effect produced, is not of the substantial nature of the invention and will not protect an alleged infringer. *Hawes v. Washburn*, 5 O. G., 491.

§ 2592. Any change, merely colorable, involving no new idea, requiring not invention, but only mechanical skill, to make it, a change which retains the idea of the patentee and the substance of his invention, notwithstanding the different drapery in which that substance is clothed, cannot avail to protect a party charged with infringement. *Birdsell v. McDonald*, 6 O. G., 682.

§ 2593. Differences which are merely formal, not affecting the substantial principle of operation of the machine, *held*, not sufficient to avoid liability from unlicensed use. *Hart, Bliven & Mead Mfg. Co. v. Sargeant & Co.*, 14 O. G., 45.

§ 2594. Crevices or openings in the wooden tobacco-holder arising from defective mechanical construction, if not large enough to defeat the operation of the device, will not relieve the apparatus from the charge of infringement. *Robinson v. Sutter*, 8 Fed. Rep., 828.

§ 2595. A structural difference in form and size does not avoid infringement if the same work is done by substantially the same means. *Sewing Machine Co. v. Frame*, 24 Fed. Rep., 596.

§ 2596. An obvious change of construction not affecting the combination in its essence — a formal or colorable variation — will not avoid infringement. *Miller's Falls Co. v. Backus*, 17 O. G., 852.

§ 2597. Mere structural changes, aside from the vital operating combinations, are not such changes as will avoid infringement. *Straw Sewing Machine Co. v. Eames*, 18 Blatch., 520.

§ 2598. A mechanical change does not prevent infringement. *Fuller v. Yentzer*, 6 Biss., 203.

§ 2599. The mere variation of an angle in the position of a part of a patented machine, where no particular angle was required, *held* not to avoid infringement. *Hussey v. McCormick*, 1 Biss., 300.

§ 2600. If the principle of feeding rollers in a planing machine is substantially embraced in the specification and drawings, a mere change of form or position of the rollers will not change the character of the patentee's right (*Woodworth's patent*). *Washburn v. Gould*, 3 Story, 122.

149. FRAUD.

Fraud — In procuring patent — Generally, §§ 2601, 2602. *Defense of,* §§ 2603-2605.

§ 2601. Under act 1836, letters patent cannot be abrogated for fraud in a collateral proceeding. *Rubber Co. v. Goodyear*, 9 Wall., 788.

§ 2602. The question of fraud involved in the premature issue of a patent to one of two conflicting applicants, without notice to the other, will not be considered by the judge upon appeal in an interference between the patentee and the applicant. It must be tried by a jury in a direct suit brought for that purpose. *Burlew v. O'Neil*, 1 MacA. Pat. Cases, 168.

See *Inventor, Joint*, § 3790.

§ 2603. To sustain the defense that a patent was surreptitiously obtained, not only must the invention by a third party be established, but that he did not acquiesce in the grant to patentee. *Dixon v. Moyer*, 4 Wash., 68.

§ 2604. A defense that the original inventor fraudulently and surreptitiously obtained the patent for that which he well knew was invented by another, unaccompanied by the further allegation that the alleged first inventor was at the time using reasonable diligence in adapting and perfecting his invention, is not sufficient to defeat the patent. *Agawam Co. v. Jordan*, 7 Wall., 583.

§ 2605. Defendants, when sued for infringement, cannot set up fraud in obtaining the patent, no fraud appearing upon its face. *Railroad Co. v. Dubois*, 12 Wall., 47.

See *Contracts*, § 1296.

Fraud — In procuring reissues, §§ 2606-2608.

§ 2606. Neither reissued nor extended patents can be impeached in suits upon them for fraud in obtaining them. *Milligan & Higgins Glue Co. v. Upton*, 4 Cliff., 237.

§ 2607. In suit for infringement, fraud in obtaining the reissue cannot be set up in defense, where defendants justify under a license. *Goodyear v. Providence Rubber Co.*, 2 Cliff., 351.

§ 2608. The issue of fraud in procuring reissues can be raised only by distinct and special allegations in the plea or answer. Allegations that are insufficient. *Blake v. Stafford*, 6 Blatch., 195.

See *Reissues*, §§ 5699-5703, 5780-5785.

150. FRIVOLOUS CLAIM.

See CLAIM, FRIVOLOUS.

151. FRIVOLOUS PATENTS.

See PATENTS, FRIVOLOUS.

152. FUNCTIONAL CLAIMS.

See CLAIMS, FUNCTIONAL. CLAIMS, CONSTRUCTION OF FUNCTIONAL.

153. GENERAL ISSUE.

See PLEAS, STATUTORY, GENERAL ISSUE. NOTICE, STATUTORY, GENERAL ISSUE AND NOTICE. PLEAS, STATUTORY, GENERAL ISSUE AND SPECIAL PLEA.

154. GOVERNMENT.

Government — Private property rights, §§ 2609-2612.

§ 2609. Private property, the constitution provides, shall not be taken for public use without just compensation, and it is clear that that provision is as applicable to the government as to individuals, except in cases of extreme necessity in time of war, and of imminent and impending public danger. *Cammeyer v. Newton*, 4 Otto, 225.

§ 2610. Private property cannot be taken for public use without just compensation, except in cases of extreme necessity, in time of war or of immediate and impending public danger. *Brady v. Atlantic Works*, 4 Cliff., 408.

§ 2611. A patent is private property, and the government cannot, after it is issued, make use of the improvement, any more than a private individual, without license of the inventor, or making him compensation. *Cammeyer v. Newton*, 4 Otto, 225.

§ 2612. The government of the United States has no right to use a patented invention without compensation to the owner of the patent. *James v. Campbell*, 104 U. S., 356 (§§ 5330-36).

See *License*, § 4004.

Government — Infringement by, §§ 2613-2630. See *Contracts*, §§ 1339-1343. *Employer and Employee*, §§ 2104, 2105. *Estoppel*, § 2260. *Officers*, §§ 4459-4472.

§ 2613. Where an officer of the United States, without their authority, uses in their service a patented invention, the act being unlawful is his, not theirs, and he only is responsible. *Burns' Case*, 4 Ct. Cl., 113.

§ 2614. Officers of the United States, when they use articles manufactured in violation of the rights of patentees, are liable therefor. *Devens' Opinion*, 16 Op., 137.

§ 2615. Government officers in the performance of their duty are liable for infringement. The grant of a patent saves nothing for the use of the government. *Campbell v. James*, 17 Blatch., 42.

§ 2616. A government contractor may be the agent of the government to build a ship or dredge-boat, but he is not such to seize and appropriate whatever materials he may see fit for such purpose, and where the property seized was a patent-right, he was held liable for infringement. *Brady v. Atlantic Works*, 4 Cliff., 408.

§ 2617. A mistaken and unauthorized use of a patented machine by the warden of a penitentiary does not constitute a taking of private property for public use, such as to render the United States liable. *Pitcher's Case*, 1 Ct. Cl., 7.

§ 2618. Neither the official character of the defendant, nor the fact that he turned over to the government the savings made by the use of the patented invention, can shield him against the owner of the patent. *Campbell v. James*, 18 Blatch., 92.

§ 2619. *Query*, whether an officer of the government can be sued for using an invention only for and in behalf of the government, and whether the court of claims is not the only tribunal in which the claim for compensation can be prosecuted. *James v. Campbell*, 104 U. S., 356 (§§ 5330-36).

§ 2620. Doubted that *James v. Campbell*, 104 U. S., 356, definitely decides that a bill in equity will not lie against an officer of the United States for his unauthorized use of a patent solely in the service of the government. *Forehand v. Porter*, 15 Fed. Rep., 256.

§ 2621. Where articles are advertised for by the United States, and it is claimed that the successful bidder, in order to furnish them, must violate another's patent, it is proper that such bidder should be required to furnish a satisfactory bond of indemnity for the security of the officer against any suit for infringement by the use of the article. *Devens' Opinion*, 16 Op., 137.

§ 2622. The English rule that the patent prohibits all the subjects of the sovereign, except the patentee, from using the invention, but that it extends no further, and is not intended to deprive the government itself of the use of the invention, does not hold good under our laws. *Brady v. Atlantic Works*, 4 Cliff., 408.

§ 2623. In this country congress has legislated in pursuance to the power conferred by the constitution, and provided that persons who have made inventions such as specified in section 24 (act of July 8, 1870), may obtain a patent therefor, granting to them, for the term of seventeen years, the exclusive right to make, use and vend the said invention or discovery throughout the United States. *Ibid.*

§ 2624. No exception is made in favor of the government, and it cannot, after the patent is issued, make use of the improvement, any more than a private individual, without license of the inventor, or making just compensation to him. *Ibid.*

§ 2625. The grant of letters patent for an invention is exclusive throughout the United States, and reserves no right to the government to use the same. *Campbell v. James*, 17 Blatch., 42.

§ 2626. Neither the government, nor an agent of the government, nor a private individual, whether claiming to act under the authority of the government or otherwise, can use a patented improvement without the license of the patentee. *Colgate v. International Ocean Telegraph Co.*, 17 Blatch., 308.

§ 2627. The term "the exclusive right" in the constitution does not admit of an implication that, with regard to such patentable articles as the government may need, the right shall not be exclusive. *McKeever v. United States*, 14 Ct. Cl., 396.

§ 2628. Such right, when properly secured in the manner provided by law, becomes property in the eye of the law, and the government cannot make use of the improvement, any more than a private individual, without license of the inventor or making him compensation. *Ibid.*

§ 2629. The just and equitable right of patentee to be paid for the use of his invention by the United States must be determined by those principles and considerations which obtain in ordinary cases for the use of inventions, or infringement of patents. *Hubbell's Case*, 5 Ct. Cl., 1.

§ 2630. The question as to the right of government to use a patented invention without compensation to inventor, raised but not determined. *Fletcher v. Blake*, 19 O. G., 221.

155. GOVERNMENT CONTRACTS.

See CONTRACTS, CONSTRUCTION OF GOVERNMENT CONTRACTS RELATING TO PATENTS.

156. GOVERNMENT OFFICERS.

See OFFICERS.

157. GRANT — UNDER PATENT.

SUMMARY (*POTTER v. HOLLAND*, §§ 2631-2639) — *Who should join in reissuing*, § 2631. — *Assignment of undivided interest in a reissue*, § 2632. — *Assignment defined*, § 2633. — *Patentee's right to assign*, § 2634. — *Assignee defined*, § 2635. — *Grantee defined*, § 2636. — *Licensee defined*, § 2637. — *Right of owner of original patent on reissue*, §§ 2638, 2639.

POTTER v. HOLLAND.

(Circuit Court for New York: 4 Blatchford, 206-218. 1858.)

STATEMENT OF FACTS.—A., assignee by mesne assignment of an interest in a patent, being also the patentee of the same, reissued the patent. On application made for a provisional injunction by his assignee, the defense set up was that the reissue was invalid because of the failure of B., assignee of an undivided part of the patent in a part and portion of the United States, to concur in or ratify the surrender and reissue.

Opinion by INGERSOLL, J.

It is stated in the bill that Chapin, in his transfer to Kline, excepted from its operation the right which he had in the state of New Jersey. But the bill shows that he never had any right in the state of New Jersey. He only took a portion of the right which had been transferred to Lee; and Lee never had transferred to him any right of any kind for that state. The bill, therefore, shows that, when the surrender was made, and the reissued patent was obtained, no one had any interest of any kind in the old patent, except Wilson and Lee.

Exception is taken to the validity of the reissued patent, upon which the sufficiency of the bill depends, for the reason, as is alleged, that the surrender of the old one was not lawfully made. It is claimed that, to make that surrender lawful, Lee should have joined Wilson in making it, or should have authorized Wilson to make it, or should have ratified the surrender after it had been made by Wilson; and that, as the bill does not show, either that Lee joined Wilson in making the surrender, or authorized him to make it, or ratified the surrender after it was made, it must be held that the surrender was not lawfully made, and, consequently, that the reissued patent was not legally issued, and is, therefore, void. There being no other objection to the reissued patent, it will follow that, if the surrender of the old one was lawfully made, the new one was legally issued.

§ 2631. *Section 13, act 1836, construed as to who should join in reissuing.*

In the thirteenth section of the patent act of July 4, 1836 (5 U. S. Stat. at Large, 122), is contained all the right to make a surrender. By that section it is provided "that whenever any patent which has heretofore been granted, or which shall hereafter be granted, shall be inoperative or invalid by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification, as his own invention, more than he had or shall have a right to claim as new, if the error has or shall have arisen by inadvertency, accident or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the commissioner, upon the surrender to him of such patent, and the payment of the further duty of \$15, to cause a new patent to be issued to the said inventor, for the same invention, for the residue of the period, then unexpired, for which the original patent was granted, in accordance with the patentee's corrected description and specification. And, in case of his death, or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators or assignees." The sole right to surrender is given (1) to the patentee, if he is alive, and has made no assignment of the original patent; (2) to the executor or administrator of the patentee, after his decease, when there has been no such assignment; (3) to the assignee, when there has been an assignment of the original patent. The right to surrender is given to no one else.

§ 2632. *Reissue. Assignment of undivided interest.*

Where there has been an assignment of an undivided part of the whole original patent, the assignee of such part and the patentee become joint owners of the patent, and should join in the surrender, and, if they do not, it will be invalid, unless the part owner not joining shall ratify it. If Lee, therefore, was not an assignee of the original patent, or an assignee of an undivided part of the original patent, within the meaning of the terms assignee and assignment, as they are used in the patent law, then it will follow that he had no legal right, as assignee, to surrender, and that the surrender by Wilson without his concurrence was valid. If he was such assignee, then the surrender was invalid. It is, therefore, necessary to determine what is meant by the terms "assignee" of the original patent, and "assignment" of the original patent, as they are used in the patent law.

§ 2633. *Assignment defined.*

An assignment, as understood by the common law, is a parting with the whole property. 2 Black. Comm., 326. The fourth section of the patent act of February 21, 1793 (1 U. S. Stat. at Large, 322), provides "that it shall be lawful for any inventor, his executor or administrator, to assign the title and interest in the said invention, at any time, and the assignee, having recorded the said assignment in the office of the secretary of state, shall thereafter stand in the place of the original inventor, both as to right and responsibility, and so the assignees of assigns to any degree." Under that law it was held, in the case of *Tyler v. Tuel*, 6 Cr., 324, that a transferee of all the right secured by a patent, excepting in the counties of Chittenden, Addison, Rutland and Windham, in the state of Vermont, was not an assignee, within the meaning of the law, but was merely a grantee of a sectional interest, without power to sue at law. By that act the right to bring a suit at law was confined to the patentee and assignee. It was held, however, in the case of *Whittemore v. Cutter*, 1 Gall., 429, that the transferee of an undivided part of the whole patent was an assignee, entitled to join the patentee in a suit. It was thus held that no one was an assignee, unless the whole property in the patent, or an undivided part of such whole property, had been passed to him.

§ 2634. *Right of patentee to assign under act 1836, section 11.*

The power of the patentee, as it now exists, to make an assignment of the patent, and to create other interests in it, is contained in the eleventh section of the patent act of 1836. That section is as follows: "Every patent shall be assignable in law, either as to the whole interest or any undivided part thereof, by any instrument in writing; which assignment, and also every grant and conveyance of the exclusive right, under any patent, to make and use, and grant to others to make and use, the thing patented, within and throughout any specified part or portion of the United States, shall be recorded in the patent office, within three months from the execution thereof, for which the assignee or grantee shall pay to the commissioner the sum of \$3." And the fourteenth section authorizes suits at law to be brought in the name of the persons interested, whether as patentees, assignees or grantees of the exclusive right within and throughout a specified part of the United States. A mere licensee cannot bring an action at law for a violation of the patent.

§ 2635. *"Assignee" defined. Section 11, act 1836.*

There are three classes of persons in whom the patentee can vest an interest of some kind in the patent. They are an assignee, a grantee of an exclusive sectional right, and a licensee. An assignee is one who has had transferred to

him in writing the whole interest of the original patent, or any undivided part of such whole interest, in every portion of the United States; and no one, unless he has had such an interest transferred to him, is an assignee.

§ 2636. "*Grantee*" defined.

A grantee is one who has had transferred to him, in writing, the exclusive right, under the patent, to make and use, and to grant to others to make and use, the thing patented, within and throughout some specified part or portion of the United States. Such right must be an exclusive sectional right, excluding the patentee therefrom.

§ 2637. "*Licensee*" defined.

A licensee is one who has had transferred to him, in writing or orally, a less or different interest than either the interest in the whole patent or an undivided part of such whole interest, or an exclusive sectional interest.

Does the bill, therefore, show that Lee ever had transferred to him the whole interest in the original patent, or an undivided part of such whole interest, in every portion of the United States? It appears, by the bill, that no such interest was transferred to him. The interest transferred to him was an undivided part of the patent, in a part and portion of the United States; not the whole patent, nor an undivided part of the whole patent, in every part and portion of the United States. No interest was conveyed to him for the state of New Jersey. He had no interest in the patent for sewing leather in the state of Massachusetts. Therefore, he never was an assignee of the original patent, within the meaning of the patent act of 1836, nor would he have been an assignee within the meaning of the patent act of 1793.

The terms "assignee" and "grantee" are not used, in the patent act of 1836, as synonymous terms, though courts, without having their attention particularly called to the subject, have sometimes used them indiscriminately, and in their popular sense. They have the separate and distinct meanings above indicated. But, if they were used in the law as synonymous terms, and if the grantee of an exclusive sectional interest were an assignee, it would not aid the defendant in the exception that has been taken. For Lee was neither an assignee nor such grantee, but a licensee merely, having no legal right in the patent.

It appears clearly, by the case of *Gayler v. Wilder*, 10 How., 477 (§§ 385-96, *supra*), that his interest was an interest only of the latter description. Chief Justice Taney, in giving the opinion of the court in that case, says (page 494): "The patentee may assign his exclusive right, within and throughout a specified part of the United States, and, upon such an assignment, the assignee may sue in his own name for an infringement of his rights. But in order to enable him to sue, the assignment must undoubtedly convey to him the entire and unqualified monopoly which the patentee held in the territory specified, excluding the patentee himself as well as others. And any assignment short of this is a mere license." The action in that case was in favor of the patentee. It was for a violation of the rights granted by the patent. Previous to the commencement of the suit, there had been a contract entered into between the patentee and one Herring, which purported to grant to Herring the exclusive right to make and vend the Salamander safe in the city, county and state of New York. By the contract, Herring agreed to pay to the patentee a cent a pound for every pound the safes might weigh, to be paid monthly. There was reserved to the patentee the right to set up a manufactory or works for making these safes, in the state of New York, provided it was not within

fifty miles of the city, and to sell them in the state of New York, paying to Herring a cent a pound on each safe so sold within the state. The court say (page 495): "It is evident that this agreement is not an assignment of an undivided interest in the whole patent, nor the assignment of an exclusive right to the entire monopoly in the state or city of New York. It, is therefore, to be regarded as a license only, and, under the act of congress, does not enable Herring to maintain an action for an infringement of the patent-right. The defendant in error" (the patentee) "continues the legal owner of the monopoly created by the patent." In the case now before the court, there was no transfer of an undivided interest in the whole patent, nor the exclusive right to the entire monopoly in any specified territory, excluding the patentee from all right in such specified territory. And the language of the court is, that "any assignment short of this is a mere license." It conveys no legal right in the patent. Notwithstanding the transfer to Lee, Wilson continued "the legal owner of the monopoly created by the patent."

It has been strongly urged against the right of the patentee to surrender the old patent and take in his name a reissued one, without the assent of a third person to whom he had previously passed an interest in the patent, either as grantee or licensee, that, by such surrender and reissue, the rights of such third person would be injuriously affected; that he would be deprived, against his will, by the act of the patentee, of rights under the old patent which he had purchased; and that no construction of the law relating to the surrender of patents should be adopted which would produce so unjust a result. It is well known that, in the most important patents which have been issued, vast interests have been transferred to grantees and licensees, which interests may be injuriously affected, provided the view taken by the defendant is well founded. We have therefore given to it the most attentive consideration.

§ 2638. *Right of person holding interest under original patent on reissue by patentee.*

We adopt the rule laid down by Judge Story in the case of *Woodworth v. Stone*, 3 Story, 749, that it is not in the power of the patentee, by a surrender of his patent, to affect, without their consent, the rights of third persons to whom he has previously passed his interest in the whole or a part of the patent. This consent may be manifested either by joining in the surrender with the patentee, or by previously authorizing it, or by subsequently ratifying or approving it. To take advantage and benefit of it would be a ratification. When such consent is given, the rights of the party so consenting, in and to the old patent, are forever gone. It may, too, be considered as a sound and settled principle, that a person to whom the patentee has passed his interest in a part of the old patent is entitled, upon the surrender of the same by the patentee and the obtaining of a reissued patent, to the same right under the reissued patent that he had to the old one. The patentee cannot, by taking a reissue, deprive him of the same right to it that he had to the old one, if he wishes to take the benefit of such right. *Woodworth v. Hall*, 1 Woodb. & M., 248. But, when he does take advantage and benefit of the reissued patent, he consents to give up, and does give up, the right which he had under the old one.

It does not follow from this, however, that, because a third person, to whom a patentee has passed his interest in a part of a patent, is entitled to the same right to a reissued patent that he had to the old one, he is compelled to take under the reissued one, and thereby compelled to give up the right which he

had under the old one. If he were, his rights might be injuriously affected, without his consent. If he were so compelled, a grantee under the old patent of an exclusive territorial right would be forced, without his consent, to give up damages which he might be entitled to under the old patent for a violation of rights secured to him by that patent. And it might so happen that the old patent surrendered was a valid one, and that the reissued one was invalid; or that the rights secured by the former were important, while the rights secured by the latter were of little consequence.

To determine, then, the question, whether the rights of a third person, to whom a patentee has previously passed his interest in a part of a patent, can be affected, without his consent, by the surrender of the old patent by the patentee alone, and the taking of a reissued one, it is necessary to determine whether, after such surrender and reissue (both the surrender and the reissue being valid), such third person has the same rights under the old patent, if he chooses not to take advantage of the surrender and the reissue, that he had to that patent before such surrender and reissue. If he has, then it will follow that by the surrender and the reissue his rights have not been injuriously affected, and, consequently, that there can be no valid objection to the same.

It is insisted by the defendant that one right to an invention, in favor of one person, under a reissued patent, and a different right to the same invention, in favor of another person, under the original patent, cannot exist at one and the same time. When a patent is granted, certain exclusive rights are secured, or purported to be secured, to the inventor. The object of the reissue is to secure greater rights than were actually secured by the first patent. The subject of both patents is the same invention, and the object of both is to secure rights in the same. This is the only object in both. A less right to the invention may be secured by the first patent. A greater right to the same invention may be secured by the reissued patent. It is objected that, if the person to whom the patentee has passed his interest in a part of the patent, can hold the right so passed, under such patent, after the same has been surrendered by the patentee and a reissued one obtained, and if the patentee can, at the same time, hold the rights not so passed to such person, under and by virtue of the reissued patent, one right to an invention may exist in one person, in one part of the United States, and a different right to the same invention may exist in another person, in a different part of the United States—the one right evidenced by one patent, with the transfer of the right therein, and the other right evidenced by another patent; that there would be two or more patents to secure the different rights which different persons might have to the one whole invention; and that this would not be in accordance with the patent laws of the United States, but directly opposed to the same, because such laws authorize only one patent for one whole invention.

§ 2639. *Held, that where a patent has been surrendered and reissued by a party empowered to do so, parties interested under the original patent, and not consenting to the reissue, still hold under the old patent.*

The object of a patent is, to secure rights to an invention throughout the whole of the United States. We can discover no good reason why a portion or the whole of the invention, for a particular portion of the United States, may not be secured by one patent, and the remaining portion of the invention, for the residue of the United States, be secured by another patent. These two patents would, in effect, constitute together but one patent for the whole in-

vention, for the whole United States. Two patents for separate parts, the separate parts together comprehending only the whole, would in effect be but one patent for the whole; as two separate deeds, for two separate sections of one whole lot of land, would not be, in effect, more than one deed for the whole lot. No more would be secured by the two patents than is authorized by law to be secured, or than could be secured, by one. The two, in effect, would constitute but one.

The patent laws of the United States expressly authorize different claims of right to the same invention to be secured to different fractional or territorial owners or claimants. By the seventh section of the patent act of March 3, 1837 (5 U. S. Stat. at Large, 193), it is, among other things, provided, that whenever any patentee shall have, through inadvertence, accident or mistake, made his specification of claim too broad, claiming more than that of which he was the original or first inventor, some material and substantial part of the thing patented being truly and justly his own, the owner of a sectional interest in the patent may make disclaimer of such parts of the thing patented as he shall not claim to hold by virtue of the patent and transfer to him, stating therein the extent of his interest in the patent, which disclaimer shall thereafter be taken and considered as a part of the original specification, to the extent of the interest which may be possessed in the patent by the disclaimant, and by those claiming by or under him, and to no greater extent. The patentee may not wish to make a disclaimer. He is authorized to do it, but is not compelled to do it. If he does not do it, his patent may be void for claiming too much. The owner of a sectional interest, however, can make a disclaimer for his sectional interest, which is to be taken as a part of the original specification, for the section owned by him, and to no greater extent. After such disclaimer, a different claim of right is secured to the disclaimant, the owner of a sectional interest, from what is purported to be secured to the patentee, the owner of the remaining interest. Different claims of right in the same invention are secured to different sectional owners. There are two specifications for the same invention, one making one claim of right to an invention, for one section of country, and the other making another and different claim of right to the same invention, for another section of country. In effect, it makes two patents out of one — one securing a claim of right to one person, and the other securing a different claim of right to another person. This is expressly authorized by the patent law.

It is to be inferred from the case of *Woodworth v. Stone*, 3 Story, 749, that Judge Story was of the opinion already indicated. That case was upon the familiar Woodworth patent. The original patent was granted to the inventor for fourteen years from the 27th of December, 1828. It was subsequently renewed by the commissioner, in favor of the administrator of the inventor, for seven years from the 27th of December, 1842. It was further extended by act of congress, for seven years from the 27th of December, 1849. On the 8th of July, 1845, the administrator surrendered the patent and obtained a reissued one. The history of the patent, as appears by various reports in which the rights of parties under it were in controversy, shows that previous to the surrender and reissue, various and important rights under the original patent had been transferred to various persons in different parts of the United States. The supplemental bill was upon the reissued patent, and one to whom a right previous to the surrender had been passed in a territory in which the claimed violation took place was made a party with the administrator. No one had joined in

the surrender with the administrator. Exception was taken that the surrender and reissue were invalid, because the owner of the territorial right, who, with the administrator, was made a party to the bill, had not joined the administrator in the surrender. The supplemental bill, which was founded upon the sufficiency of the surrender and the reissue, was sustained, the judge holding that, by becoming a party to the supplemental bill, such owner of the territorial right ratified the surrender. The reports of other cases show that, when this case was before Judge Story, he knew that there were other persons in various parts of the United States who had rights under the original patent, and who had not joined in the surrender, whose rights would be affected by the surrender, against their consent, if they should not agree to it, provided he held the surrender good, and provided also they could not hold under the old patent. When, therefore, he held the surrender good and valid, and decided that it was "not in the power of the patentee, by a surrender of his patent, to affect the rights of third persons to whom he had previously, by assignment, passed his interest in the whole or a part of the patent, without the consent of such assignees," he must have been of the opinion that, notwithstanding such surrender and reissue, such third persons could hold under the old patent, if they should so choose, for otherwise their rights would be injuriously affected without their consent.

With this view of the case, the exception taken by the defendant to the sufficiency of the bill must be overruled.

Grant — Of a patent, §§ 2640-2643.

§ 2640. Sections 2 and 3, act 1793, reviewed. Essentials to the grant of a patent. *Cutting v. Myers*, 4 Wash., 220.

§ 2641. The department acts ministerially, rather than judicially, in granting patents for useful inventions. *Taney's Opinion*, 2 Op., 455.

§ 2642. The fact that a patent has been issued does not of itself prove the introduction into common use without the necessity of other testimony. *Weston v. White*, 13 Blatch., 364.

§ 2643. *Semble*, that a patent cannot be allowed to prejudice rights of innocent third parties acquired prior to the grant (act 1793). *Morris v. Huntington*, 1 Paine, 348.

See *Abandonment*, §§ 52, 53. *Commissioner*, §§ 1065-1113. *Contract*, § 1331. *Employer and Employee*, § 2097. *Identity*, § 2717. *Injunction, Interlocutory*, § 3020. *Mandamus*, §§ 4119-4127. *Patents*, §§ 4689, 4690.

Grant — Under a patent, §§ 2644-2647. See *Assignments*, §§ 419-528. *Licensees*, §§ 3986-4096.

§ 2644. An instrument conveying a license coupled with an interest (in the machines), and in the patent itself (so far as concerned these machines), construed to be a grant. *Washburn v. Gould*, 3 Story, 122.

§ 2645. Where certain terms are used in a grant which have a well known general meaning, then, in the interpretation of such grant, such well known general meaning must be given to the terms used, unless it appears that some other or different meaning was intended. *Good-year v. Cary*, 4 Blatch., 271.

§ 2646. It is not to be presumed that a grantor intends to grant more than he has a right to grant, or a grantee to receive a right that he already possesses. *Ibid.*

§ 2647. Where A. covenanted, in a license to B., that he would not grant to another a right or license to do what he had licensed B. to do, it was held to be a grant of an exclusive right. *Ibid.*

158. GRANTEE.

See *CONTRACTS*, §§ 1278-1290.

Grantee — Defined, § 2648. *Territorial*, §§ 2649-2653.

§ 2648. A *grantee* is one who has transferred to him in writing the exclusive right under the patent to make and use, and to grant to others to make and use, the thing patented, within and throughout some specified portion of the United States. *Meyer v. Bailey*, 8 O. G., 437.

See *Assignment*, § 420. *Assignee*, § 551. *Grant*, § 2636.

§ 2649. The grantee of an exclusive right to use a given number of machines within a specified territory may maintain an action in his own name for an infringement. *Wilson v. Rousseau*, 4 How., 646.

§ 2650. Where patentee has assigned the exclusive right to make, use and vend his machine in a certain territory, he is a proper party to a suit to restrain infringement in that territory. *Woodworth v. Wilson*, 4 How., 712.

§ 2651. Although the patentees have conveyed away the exclusive right to vend and use the patented device in a specified territory, they may maintain a suit against those who manufacture it within that territory. *Sandford v. Messer*, 1 Holmes, 149.

§ 2652. The owner of the exclusive right to use a patented article, and to sell it within a specified territory, but not the right to manufacture it, is a mere licensee, and cannot maintain any action for infringing the patent. *Hill v. Whitcomb*, 1 Holmes, 317.

§ 2653. A territorial grantee cannot be restrained from advertising and selling within his territory, even though the purchasers may take the patented articles outside of the vendor's territory. *Hatch v. Hall*, 30 O. G., 1096.

See *Bill*, § 584. *Damages and Profits*, § 1595.

159. GRANTEE OF EXTENSION.

See EXTENSION, GRANTEE.

160. GUARDIANS.

§ 2654. As incidental to his office and duties the guardian appointed by the probate court over the person and estate of an infant has power to sell his personal property when not restricted by special statutes. *Wallace v. Holmes, Booth & Hayden*, 9 Blatch., 65.

§ 2655. This right is not impaired by the statute of Massachusetts which confers upon the probate court and the supreme court power to require and authorize a guardian to sell the estate or effects held by him as such, and to control him generally in the management of them. *Ibid.*

161. HEIRS.

§ 2656. The heirs do not take under the special act, as if by descent from the original inventor, an estate charged with the contracts and incumbrances made by him in his life-time. They do not take from the inventor, but directly from the special act of congress. In technical phrase, assimilating their property to real estate, they take by purchase and not by descent. The reference to the beneficiaries of the act as "heirs" is mere *descriptio personæ*. *Fire Extinguishing Mfg. Co. v. Graham*, 16 Fed. Rep., 543.

162. IDENTITY.

See REISSUES, IDENTITY WITH ORIGINAL. INFRINGEMENT, SUBSTANTIAL IDENTITY. INFRINGEMENT, DIFFERENCE AND IDENTITY IN RESULT. INFRINGEMENT, §§ 2836-2891. REISSUES, §§ 5439-5458, 5686, 5695, 5709-5715.

Identity — *Defined*, §§ 2657-2659. *How determined*, §§ 2660-2665.

§ 2657. A thing is substantially the same when it is the same in all important particulars. *Adams v. Edwards*, 1 Fish., 1.

§ 2658. That is substantial identity which comprehends the application of the principle of the invention. *McComb v. Brodie*, 1 Woods, 153; *Page v. Ferry*, 1 Fish., 298.

§ 2659. To constitute identity of invention, and therefore infringement, not only must the result attained be the same, but in case the means used for its attainment is a combination of known elements, the elements combined in both cases must be the same and combined in the same way, so that each element shall perform the same function; provided, however, that the differences alleged are not merely colorable, according to the rule forbidding the use of known equivalents. *Electric R. R. Signal Co. v. Hall R'y Signal Co.*, 114 U. S., 87.

§ 2660. Identity, how determined. *Union Sugar Refinery Co. v. Matthieson*, 3 Cliff., 639.

§ 2661. Substantial identity and difference, how determined by the courts. *Bates v. Coe*, 8 Otto, 31 (§§ 1816-30).

§ 2662. A machine is the same in substance as another if the principle be the same in effect, though the form of the machine be different. *In re Nutting*, 1 MacA. Pat. Cases, 455.

§ 2663. Characteristic resemblance is the fairest test of substantial identity. *Union Paper Collar Co. v. White*, 7 O. G., 698, 877.

§ 2664. Substantial identity is a question of fact. In what substantial difference consists. *Many v. Jagger*, 1 Blatch., 372.

§ 2665. Slight differences in degree cannot be regarded as of weight in determining a question of substantial similarity or substantial difference. *Cahoon v. Ring*, 1 Cliff., 592.

See *Contempt*, § 1262. *Defenses*, § 1824. *Improvement*, §§ 2779, 2780. *Reissues*, §§ 5479-5490.

Identity — Evidence of — Admissibility, § 2666. *What is evidence of identity*, §§ 2667-2669; *what is not*, §§ 2670-2675. See *Experts*, §§ 2431-2434.

§ 2666. Where, in a suit at law upon a patent, a prior patent is offered in evidence by the defendant as embracing the same invention, and the question appears, upon a comparison of the specifications, to be doubtful, it should be submitted to the jury, and it is error to exclude from their consideration such prior patent and the testimony of experts respecting the identity of the inventions. *Tucker v. Spaulding*, 13 Wall., 453.

§ 2667. Similarity in structure, appearance and effect of two things is presumptive evidence of their being made in the same way. *Matthews v. Skates*, 1 Fish., 602.

§ 2668. A possible difference between a patented device and another known to the trade long before the date of the patent, indicated only by a statement of result in the specification, will not suffice to establish a difference in invention. *Burrall v. Rumsey*, 13 O. G., 123.

§ 2669. To establish this diversity it will not do to rely on describing the result attained; the description must show how it can be attained. *Ibid.*

§ 2670. The fact that certain articles, set up to anticipate a patented article which had gone into use, were abandoned experiments, held evidence of their want of identity with the patented article. *Many v. Jagger*, 1 Blatch., 372.

§ 2671. Greater utility may be evidence of a substantial difference between two machines, which may be so great as to amount to satisfactory evidence that a new principle is involved. *Johnson v. Root*, 1 Fish., 351.

§ 2672. The greater usefulness of a machine the jury is entitled to consider, as a circumstance tending to show a different construction, but not conclusive; and whether the new machine is substantially different from the old must be determined upon all the evidence bearing upon the point. *Carter v. Baker*, 1 Saw., 512.

§ 2673. If, in the operation of a prior machine, a greater number of persons necessarily have to be employed than in a patented machine, this tends to prove that the machines are not alike. *Coupe v. Weatherhead*, 16 Fed. Rep., 673.

§ 2674. Results considered as evidence of a different mode of operation. *Tatham v. Le Roy*, 2 Blatch., 474.

§ 2675. That two machines produce the same effect will not justify the assertion that they are substantially the same, or that the devices used by one are therefore mere equivalents for those of the other. *Burr v. Duryee*, 1 Wall., 531.

Identity — Of two machines — Principle, §§ 2676-2709. See *Principle*, §§ 4970-4979.

§ 2676. Identity and diversity in the principle of two machines. General remarks on. *Barrett v. Hall*, 1 Mason, 447.

§ 2677. Machines are substantially the same unless the combinations of mechanical parts are substantially different. *Lowell v. Lewis*, 1 Mason, 182.

§ 2678. Machines are identical if the principle on which they work is the same, and the effect similar in both. *Brooks v. Bicknell*, 3 McL., 250.

§ 2679. One machine is the same in substance as another if the principle be the same in both, although the forms may be different. *Sickles v. Borden*, 3 Blatch., 535.

§ 2680. Two machines are substantially identical if they be the same in principle, though different in manner or form. *Delano v. Scott*, Gilp., 489.

§ 2681. Two machines are the same in principle, where they are substantially the same, and operate in the same manner to produce the same result. *Gray v. James*, Pet. C. C., 394; *Evans v. Eaton*, 3 Wash., 443.

§ 2682. Where two machines produce the same effect by the same mode of operation, their principles are the same. When the same effects are produced by combinations operating differently, their principles are unlike. *Whittemore v. Cutter*, 1 Gall., 478.

§ 2683. The identity or diversity of two machines depends on whether the given effect is produced substantially by the same mode of operation and the same combination of powers in both machines. *Odiorne v. Winkley*, 2 Gall., 50.

§ 2684. The rule is, and so it has been settled, that if two machines be substantially the same, and operate in the same manner, though they may differ in form, proportion and utility, they are the same in principle. *Converse v. Cannon*, 2 Woods, 7.

§ 2685. To constitute identity, and to make out the fact of infringement, the operative principle of the two machines must be the same, and change in form or proportion will not avoid it. *Parker v. Stiles*, 5 McL., 44.

§ 2686. The law of identity as to mechanical structures does not look merely to the form, or dimensions or appearance, but the question is, whether the two involve the same mechanical principle in their operation. *Swift v. Whisen*, 2 Bond, 115.

§ 2687. When two machines are substantially the same, and operate in the same manner to produce the same result, they must be in principle the same; and it is to be understood that when the results are referred to as a test of the identity of the machines, the results must be the same in kind though they may differ in degree. *Nichols v. Harris*, 1 MacA. Pat. Cases, 362.

§ 2688. Two inventions are the same in principle when they produce the same result by substantially the same mode of operation — as protecting the rear step of an omnibus by a shield moving with the door — notwithstanding the form of the devices and their mode of attachment may be different. *Stephenson v. Hoyt*, 1 MacA. Pat. Cases, 292.

§ 2689. Where a similar effect is produced by a combination of the same mechanical powers, though the machines may be somewhat different in structure, in principle they are the same. *Brooks v. Jenkins*, 3 McL., 432.

§ 2690. Identity is not affected by colorable differences; . . . regard is had to substance, and not form; the inquiry being whether the infringing machine is the same in principle as that patented. *Phillips v. City of Detroit*, 2 Flip., 92.

§ 2691. Where the same movement is obtained in a machine by a change in the attachment of one part to another, it is not a change of principle. *Ives v. Hamilton*, 2 Otto, 426.

§ 2692. On the question of identity, the law regards substance, and not form, and the real question is, whether defendant's machine is in principle the same as that patented to plaintiff. *Latta v. Shawk*, 1 Bond, 259.

§ 2693. The question of identity is not as to the precise form and size, but whether the principle of the two things is the same or not. *Lee v. Blandy*, 1 Bond, 361.

§ 2694. In determining the question of identity, the inquiry is not whether the two things are identical in structure, form or dimensions, but whether they involve substantially the same mechanical principles. *Judson v. Cope*, 1 Bond, 327.

§ 2695. On the question of identity, the true inquiry is, whether the alleged infringing machine or process embodies the idea or conception of the original inventor, and accomplishes it by substantially the same means. *Whitney v. Mowry*, 2 Bond, 45.

§ 2696. In order to determine whether the mechanism of any other machine is the same as plaintiff's, we may not only look at the mechanism itself, but also at its mode of operation and its effects or results. *Eames v. Cook*, 2 Fish., 146.

§ 2697. Form and structure constitute the identity of machinery; and where the form and structure of one machine differs from that of another, there is no interference between them; and so if the instruments are combinations or results of combinations. *Bain v. Morse*, 6 West. L. J., 372.

§ 2698. The identity or diversity of two machines depends not on the employment of the same elements or powers of mechanics, but upon producing the given effect by substantially the same mode of operation, or substantially the same combination of powers. *Crompton v. Belknap Mills*, 3 Fish., 536.

§ 2699. The question of identity does not depend upon appearance or form, but upon whether the two machines are the same in their mode of operation, or whether one is a mechanical equivalent for the other. *Blanchard v. Puttman*, 2 Bond, 84.

§ 2700. Two devices are substantially the same in the sense of the law of patents when they perform the same functions in substantially the same way to accomplish the same result, and, except when form is of the essence of the invention, it should not be regarded in the question of infringement. *Holly v. Vergennes Machine Co.*, 18 Blatch., 327.

§ 2701. Similarities or differences are not to be judged by names. One device is substantially the same as another if it performs substantially the same functions in substantially the same way to obtain the same result, and this though they differ in name, form or shape. *Union Paper Bag Machine Co. v. Murphy*, 7 Otto, 120.

§ 2702. Formal and subtle differences are to be disregarded. Where in two devices the end to be accomplished is the same, and the substantial means to accomplish the end are the same, the devices are identical, though one may accomplish the result more effectually than the other. *Imlay v. Norwich & Worcester R. Co.*, 4 Blatch., 227.

§ 2703. If one device is employed in a similar combination as another, and performs the same function in the same way, the two are substantially the same, although they may be dif-

ferent in form and known among mechanics by different names. *Graham v. Mason*, 4 Cliff., 88.

§ 2704. When the substance and uses of two articles or products are the same, they cannot be considered as different products or manufactures, even though produced by different processes. *Wood Paper Patent*, 23 Wall., 566.

§ 2705. The question of identity is not whether by using some parts of A.'s invention we may make a machine which will produce the same result as B.'s, but whether that machine will be substantially the same as that patented by B. *Washburn v. Gould*, 3 Story, 122.

§ 2706. Where defendant is alleged to have used an infringing machine, it is necessary to show that it accomplishes the same end by substantially the same means as that of patentee. *Alden v. Dewey*, 1 Story, 336.

§ 2707. To establish identity essential to anticipate a combination, not only must the parts in their particular arrangement be found, but the combination of all the parts of the same peculiar arrangement. *Foote v. Silsby*, 2 Blatch., 260.

§ 2708. The test of identity which constitutes infringement is whether or not defendant's machine, whatever its form or mechanical construction, has incorporated within it the principle, or the combination, or the novel ideas of plaintiff's machine. *Blanchard v. Beers*, 2 Blatch., 411.

§ 2709. If the defendants have taken the same general plan and applied it for the same purpose, although they may have varied the mode of construction, it will still be substantially, and in the eye of the patent law, the same thing. *McCormick v. Seymour*, 2 Blatch., 240.

Identity — Generally, §§ 2710-2720.

§ 2710. Where the question of identity concerns the practical application of a new property (of matter), the degree of utility or success of the alleged prior invention is immaterial, provided there has been a reduction to practice. *Foote v. Silsby*, 2 Blatch., 260.

§ 2711. Upon the question of identity in relation to a machine, if the modes of operation and the result produced are both clearly and substantially different, when the material or substance brought under their operation is the same, the question must ordinarily be determined in the negative, whether the invention is a machine, an improvement on one, or new in all its parts, or a combination of old elements. *Stainthorp v. Humiston*, 4 Fish., 107.

§ 2712. Whether two patents cover the same invention must be determined by the tenor and scope of their claims, not by the description in the specifications. *McMillan v. Rees*, 1 Fed. Rep., 722.

§ 2713. If the construction of two devices is the same, a patent for one will be a bar to a patent for the other, however different the operation and effect attributed to them by the respective inventors. *In re Merrill*, 1 MacArth., 301.

§ 2714. Where a claim is construed and limited to a particular device, by reference to the specification, it is a question for the jury whether the claim so limited is substantially identical with prior existing devices admitted by the plaintiff. *Turrill v. Railroad*, 1 Wall., 491.

§ 2715. It is not the construction of the instrument, but the character of the thing invented, which is sought in questions of the identity or diversity of inventions. *Bischoff v. Wethered*, 9 Wall., 812.

§ 2716. When two devices perform the same function in substantially the same way, mere details of mechanical construction — as size, position, and mode of attachment — regarded as immaterial to the question of identity. *In re Bishop*, 1 MacA. Pat. Cases, 519.

§ 2717. It will require strong evidence to overcome the presumption that a patented machine is substantially different from one patented before, which arises from the commissioner's having not only issued the second patent with the knowledge of the other, but having afterward reissued it and extended it. *La Baw v. Hawkins*, 6 O. G., 724.

See *Commissioner*, § 1071.

§ 2718. Where the form of the defendant's device is different from the complainant's, its mode of operation is different, and the result of its operation is somewhat different, it cannot be said to be the same or substantially like the complainant's invention, and there is no infringement. *Field v. Ireland*, 19 Fed. Rep., 835.

§ 2719. A patent granted to a person of one name and reissued under a different — as granted to Deuchfield and reissued to Denchfield — is a question of identity merely, and proof is always competent in such a case. *Bignall v. Harvey*, 18 Blatch., 353.

§ 2720. If it appears from the face of the instruments that extrinsic evidence is not needed to explain terms of art or to apply the descriptions to the subject-matter, so that the court is able from mere comparison to say what are the inventions described in each, and to affirm from such mere comparison that they are not the same, but different, then the question of identity is one of pure construction and not of evidence, and consequently is matter of law for

the court, without any auxiliary matter of fact to be passed upon by a jury if the action be at law. *Heald v. Rice*, 14 Otto, 737.

See *Commissioner*, § 1071. *Composition of Matter*, § 1122. *Infringement*, § 2824. *Jury*, § 3972. *Marking Articles Patented*, § 4151. *Novelty*, § 4315. *Patents*, §§ 4709-4712. *Priority of Invention*, § 5008.

163. IMPLIED LICENSE.

See LICENSE, IMPLIED.

164. IMPROVEMENT.

See SPECIFICATION OF IMPROVEMENT. ADDITIONAL IMPROVEMENT.

Improvement — Patentability, §§ 2721-2731.

§ 2721. A new idea, distinct from the conception, engrafted on an old invention, is patentable. *Rice v. Heald*, 13 Pac. L. R., 33.

§ 2722. Where an inventor makes an addition to an existing machine, producing the same effects in a better manner, he can patent the improvement only. *Whittemore v. Cutter*, 1 Gall., 478.

§ 2723. A patentable improvement must be made on the principle of a machine, art or manufacture before known. A change of form or proportions only is not patentable. *Evans v. Eaton*, Pet. C. C., 322.

§ 2724. An improvement upon an old contrivance, to be patentable, must have some originality, and something substantial in the change, producing a more useful effect and operation; and the jury have a right to consider therewith the result produced. *Hall v. Wiles*, 2 Blatch., 194.

§ 2725. A patent may be granted for an improvement on an existing organization, that existing organization being capable of performing certain functions or producing certain results, only if that improvement in addition enables the machine to accomplish additional and different purposes. *Conover v. Roach*, 4 Fish., 12.

§ 2726. A patent for improvements in an apparatus may be valid, if they are new, and accomplish a new and useful result, even though all the elements of the same are old, provided the combination or arrangement of such elements is new and of such a character that it involved invention to construct the same. *Fuller v. Yentzer*, 4 Otto, 299.

§ 2727. When an invention is simply an improvement on a known machine by a mere change of form or combination of parts, the inventor is only entitled to the specific form of device which he produces, and he cannot invoke the doctrine of equivalents to suppress other improvements which are not colorable invasions of his own. But where an inventor precedes all the rest, and his machine performs a function never performed by any earlier machine, the court will treat as infringers all who accomplish the same result by substantially the same or substantially equivalent means. *Morley Sewing Machine Co. v. Lancaster*, 23 Fed. Rep., 344.

§ 2728. If a new and different result is obtained by a new application of an invention, such new application may be patented as an improvement on the original invention; but if the result claimed as new is the same in character as the original result, it will not be deemed a new result for this purpose. *Blake v. City and County of San Francisco*, 113 U. S., 679.

§ 2729. An inventor may not patent that which is either claimed or described as his invention in a prior patent granted to himself; but he may patent an improvement upon it. *Mathews v. Flower*, 33 O. G., 887.

§ 2730. Whether a given improvement is a patentable invention is a mixed question of law and fact, and should not in ordinary cases be disposed of on demurrer and without the intervention of a jury. *Teese v. Phelps*, 1 McAl., 17.

§ 2731. *Quære*, whether improvements in the construction of jails constitute patentable subject-matter. *Jacobs v. Baker*, 7 Wall., 295.

Improvement — As an infringement, §§ 2732-2744.

§ 2732. Improvement in form is an infringement. *Park v. Little*, 3 Wash. C. C., 196.

§ 2733. Whoever uses the principle of an invention covered by a patent will be held to have infringed it, under whatever forms and modifications he may have adopted the invention, although he may have greatly improved it. *McComb v. Brodie*, 1 Woods, 153.

§ 2734. The addition of a useless appendage to a machine, or a useless element to a process, protected by patent, does not defeat the charge of infringement. *Poppenhusen v. Falke*, 4 Blatch., 493.

§ 2735. The mere fact that the device of the defendants has a function additional to that accomplished by the patented invention will not justify the defendants in the use of the latter without liability. *Strobridge v. Lindsey*, 2 Fed. Rep., 692.

§ 2736. If a patent describes the invention as embodied in a cheap and rude form, this will not relieve those who construct the machine with more expensive fixtures from the charge of infringement, however useful they may be. (*Brown v. Guild*; *Brown v. Selby*.) *Corn-Planter Patent*, 23 Wall., 181.

§ 2737. The use of a device which performs the same office as that patented, and by the same mechanical means, constitutes an infringement, notwithstanding the fact that it embodies improvements which give it greater value. *Carstaedt v. United States Corset Co.*, 13 Blatch., 371.

§ 2738. The principle of the invention, the construction of the device by the same general mechanical means, being retained by the defendants, infringement occurs, notwithstanding they may make a more perfect instrument. *Miller's Falls Co. v. Ives & Co.*, 14 Blatch., 169.

§ 2739. It is an infringement even though other devices may be employed in conjunction to supplement the functions of the plaintiff's mechanism, aside from these the mechanism of the two parties being substantially the same. *Sprague v. Adriance*, 14 O. G., 308.

§ 2740. It is an infringement when a patented device is used for the same purpose for which it is used by the patentee, although it is made to fulfill additional functions. *Sarven v. Hall*, 9 Blatch., 524.

§ 2741. It is no defense to a suit for infringement to set up that defendant has improved upon the patented device; if the combination is used, although some of its parts may be improved, it is an infringement. *Converse v. Cannon*, 2 Woods, 7.

§ 2742. Any improvement in one element of a combination which does not affect its manner of co-operation with the remaining devices will not serve to avoid the charge of infringement. *Potter v. Stewart*, 18 Blatch., 561.

§ 2743. A patentee made improvements upon his instrument and filed an application for another patent upon them, and therein described not only his improvements, but also the mechanism previously patented to him. He sold to the defendants the patent for which he had applied, and in case he did not obtain it he granted them the exclusive right to make, use and sell all that was described in his application. The application having been rejected, they were held not guilty of infringing the patent in consequence of using the mechanism embraced in it even after it was extended. *Hammond v. Mason & Hamlin Organ Co.*, 1 Holmes, 296.

§ 2744. Where in a reissue a certain mechanism is understood by both parties to be disclaimed as insufficient to produce the desired result, although not so disclaimed in terms, it is no infringement to improve on such disclaimed part so as to cause it to produce such result. *Hatch v. Moffitt*, 15 Fed. Rep., 252.

See *Combination*, §§ 979-983.

Improvement — Confers no right to use the patented device improved on, §§ 2745-2764.

See *Improver*, §§ 2797-2809. *Process*, § 5057.

§ 2745. A patented improvement on a patented invention does not confer the right to use the original invention. *Spaulding v. Tucker*, Deady, 649.

§ 2746. A patent for an improvement upon a patented article does not confer a right to use the latter. *Chipman v. Wentworth*, 1 Holmes, 96.

§ 2747. An improvement on a patented process gives no right to use the process. *Tilghman v. Mitchell*, 2 Fish., 518.

§ 2748. A mere addition to a patented invention will not justify the use of the invention first patented. *Hays v. Sulsor*, 1 Bond, 279.

§ 2749. An improvement can give no right to the invention improved upon. *Blake v. Stafford*, 6 Blatch., 195.

§ 2750. Defendant cannot entitle himself to use plaintiff's patented invention by adding improvements or new inventions of his own or others thereto. *Carr v. Rice*, 1 Fish., 198.

§ 2751. An improvement on a patented invention may entitle the party making it to a patent, but he cannot pirate the original invention. *Goodyear v. Mullee*, 3 Fish., 420.

§ 2752. The improvement of one element of a combination, though meritorious, does not give the right to use or appropriate the original combination. *Stainthorp v. Humiston*, 4 Fish., 107.

§ 2753. Patented improvements upon an earlier patented invention cannot be used in connection with it without the consent of its owners. *American Nicholson Pavement Co. v. City of Elizabeth*, 3 O. G., 522.

§ 2754. An improvement embodying the patented device improved on gives no right to the use of such device without a license from the patentee of the original device. *Hartshorn v. Tripp*, 7 Blatch., 120.

§ 2755. Though the improvement may consist of useful differences, so long as it includes the patented device improved upon, it cannot be used without the consent of the patentee of the original device. *Cowing v. Rumsey*, 8 Blatch., 38.

§ 2756. When an original machine and an improvement upon it are both patented, neither patentee can use what does not belong to him without the requisite authority from the owner. *Robertson v. Blake*, 94 U. S., 728.

§ 2757. No one can make an improvement on, and use important portions of, an original patented invention, during the original or extended term, without license of or purchase from the original patentee. *Woodworth v. Rogers*, 3 W. & M., 135.

§ 2758. A patent for a combination involving a prior patented combination cannot confer upon the holder of it even a *prima facie* right to make the prior combination, any more than the patent to the latter can confer upon its holder the right to make, without the consent of the former, the combination covered by the patent of the former. *Goodyear v. Evans*, 6 Blatch., 121.

§ 2759. That the improved structure is of increased efficiency renders it none the less liable, if it is an equivalent of the patented device in so far as it involves the same principle or mode of operation. *Odiorne v. Denney*, 13 O. G., 965.

§ 2760. Where two machines are the same in principle, it is no defense for using the prior invention that defendant has improved it. *Gray v. James*, Pet. C. C., 394.

§ 2761. Two patents of the same kind may both be valid, where the second is an improvement upon the first, in which event, if the second includes the first, neither can lawfully use that of the other without the other's consent. *Star Salt Caster Co. v. Crossman*, 3 B. & A., 281.

§ 2762. No one having a right to the use of an original patented invention can use a patented improvement thereon without improver's license. *Woodworth v. Rogers*, 3 W. & M., 135.

§ 2763. A patented improvement does not, *per se*, give the right to use the thing improved; and patentee of the thing improved may not use the improvement. *Arkell v. Hurd Paper-Bag Co.*, 7 Blatch., 475.

§ 2764. Where several patents are issued for improvements upon the same general structure, each patentee is liable to all prior patentees to the extent to which he adopts their improvements. *Warth v. Browning*, 17 O. G., 624.

Improvement — Embodying a patented device, an infringement, §§ 2765-2784.

§ 2765. Under act of 1800, section 3, using an improvement invented by another and subsequently patented is an offense (infringement), as right to the patent relates back to the time of the first invention. *Evans v. Weiss*, 2 Wash., 342.

§ 2766. If an improvement embody the original patented invention it is an infringement. *Howe v. Morton*, 1 Fish., 586.

§ 2767. A patent which embraces as one of its elements a previously patented article is an infringement of the latter. *Cleveland v. Towle*, 3 Fish., 525.

§ 2768. Additions which are improvements, if they involve the use of the patented invention, to improve it, are none the less an infringement. *Ready Roofing Co. v. Taylor*, 15 Blatch., 94.

§ 2769. A machine embodying the patented invention is none the less an infringement because it contains improvements rendering it more effectual in operation than the machine patented. *Howes v. McNeal*, 15 Blatch., 103.

§ 2770. One who uses the combination secured by the patent is none the less an infringer because he has made changes in details of construction which might be patentable as improvements. *White v. Heath*, 10 Fed. Rep., 291.

§ 2771. In an action of infringement, where the defendant shows that devices claimed by him are valuable improvements upon the apparatus shown, and secured to plaintiffs by patents, which facts are not disputed, it is *held* that if defendant used, in addition to such improvements of his own, the devices and apparatus of the plaintiff, he is guilty of infringement, and that such improvements will not justify the defendant in appropriating that which has been patented to others. *Westinghouse v. Gardner & Ransom Air Brake Company*, 9 O. G., 538.

§ 2772. Although a man may make valuable improvements upon a patented machine and obtain patents for them, he cannot use the elements of the original machine without infringing on the first patent. *La Baw v. Hawkins*, 6 O. G., 724.

§ 2773. Although patentable improvements may be made in the separate devices constituting a combination, yet, if the improved combinations made by defendants embrace and show the elements of plaintiff's invention, operating substantially in the same manner to produce the same result, it is an infringement. *Hartshorn v. Shorey*, 9 O. G., 595.

§ 2774. A patent for an improvement on a prior invention is infringed by an improvement on a later patent which contains the distinguishing characteristic of such prior improvement. *Star Salt Caster Co. v. Alden*, 10 Fed. Rep., 555.

§ 2775. The fact that defendants may have improved on plaintiff's patent does not relieve them from the charge of infringement, in view of their use of the invention claimed. *Eickemeyer Hat-blocking Machine Co. v. Pearce*, 10 Blatch., 403.

§ 2776. Although the patent in suit contains nothing inconsistent with the claims set up in a later patent, yet a machine constructed in accordance with the later patent may be an infringement of the former. *Bachelder v. Moulton*, 11 Blatch., 304.

§ 2777. Where defendants' improvement embodied plaintiff's patented device, *held*, an infringement, and a preliminary conditional injunction was awarded until final decree. *Fales v. Wentworth*, 1 Holmes, 96.

§ 2778. Where an improvement on a shoe effects the same results in substantially the same way, it is an infringement on plaintiff's patent, although it presents great simplicity and cheapness as compared to complainant's patent. *Evory v. Burt*, 15 Fed. Rep., 112.

§ 2779. If the device or devices of defendant constitute mechanical equivalents of the means used by the patentee, and if, besides being an equivalent, they accomplish something useful beyond the effect or purpose accomplished by patentee, it will be still an infringement, as respects what is covered by the patent, although the further advantage of defendant's devices may be a patentable subject, as an improvement on the invention infringed. *Converse v. Cannon*, 2 Woods, 7.

§ 2780. The question is not whether the same elements of motion, or the same component parts, are used, but whether the given effect is produced substantially by the same mode of operation, and the same combination of powers in both machines. *Ibid.*

§ 2781. Distinction between infringement of an improvement and of original patent. *McCormick v. Talcott*, 20 How., 402.

§ 2782. It is no infringement of a patent for an original invention to use an improvement, unless it includes the original invention. *Kneass v. Schuylkill Bank*, 4 Wash., 9.

§ 2783. An improvement which produces the same effect in a different manner to that of another improvement is not an infringement. *McCormick v. Talcott*, 20 How., 402.

§ 2784. Letters patent for an improvement made to a patented invention by additional features having no material effect upon the character, operation or result produced do not confer upon the subsequent patentee a right to use the original device. *Bostock v. Goodrich*, 21 Fed. Rep., 316.

Improvement — Patent for, must point out in what it consists, §§ 2785-2787; must be limited to the improvement, §§ 2788-2790.

§ 2785. An improvement patent, to be valid, should point out in what the improvement consists. *Evans v. Eaton*, 3 Wash., 443.

§ 2786. An improvement patent, to be valid, must describe the particular improvement claimed. (LIVINGSTON, J., dissented.) *Evans v. Eaton*, 7 Wheat., 356.

§ 2787. A patent for an improved machine must state wherein the improvement consists and must be limited to it. *Barrett v. Hall*, 1 Mason, 447.

See *Claim*, § 840.

§ 2788. An improvement patent which covers more than the improvement is void. *Ibid.*

§ 2789. An improvement patent must be limited to the improvement only. *Whitney v. Emmett*, 1 Bald., 303; *Evans v. Eaton*, 7 Wheat., 356.

§ 2790. In a patent for an improvement on an old machine, it is essential to its validity that the old be distinguished from the new, else it will be void for ambiguity; and if it be clear that the whole machine in its improved state is claimed, the patent will be void by his claiming too much. *Wintermute v. Redington*, 1 Fish., 239.

Improvement — Generally, §§ 2791-2793. See *Damages and Profits, Apportionment of Profits*, §§ 1644-1662. *Interfering Patents*, § 3495. *Specification*, §§ 6071-6083.

§ 2791. A machine and an improvement thereon distinguished. *Whitney v. Emmett*, 1 Bald., 303.

§ 2792. An improvement has essential reference to the subject-matter improved on. *Page v. Ferry*, 1 Fish., 298.

§ 2793. A patent for several distinct and independent improvements in a machine protects the infringement of any one of them; but the patent is invalidated if any one of the improvements is not new. *Moody v. Fiske*, 2 Mason, 112.

§ 2794. The inventor of the first improvement cannot invoke the doctrine of equivalents to suppress all other improvements which are not mere colorable invasions of the first. *McCormick v. Talcott*, 20 How., 402.

§ 2795. The patentee of an improvement on his former patent is not bound in his new patent to refer specially to his former one. *O'Reilly v. Morse*, 15 How., 62.

§ 2796. When a patent is for an improvement, and not for an entirely new machine, the patentee, in order to entitle him to more than nominal damages, must give evidence tending to separate or apportion the defendant's profits and the patentee's between the patented feature and the unpatented features, and such evidence must be reliable or tangible, and not conjectural or speculative; or he must show by equally reliable and satisfactory evidence that the profits and damages are to be calculated on the whole machine, for the reason that the entire value of the whole machine as a marketable article is properly and legally attributable to the patented feature. *Garretson v. Clark*, 111 U. S., 120.

See *Assignee*, § 540. *Construction of Patents*, §§ 1218, 1238, 1239.

165. IMPROVER.

Improver — Acquires no right to use a patented machine improved upon, §§ 2797-2809.

See *Improvement*, §§ 2745-2764.

§ 2797. An improver cannot use the original invention without a license. *Gray v. James*, Pet. C. C., 394.

§ 2798. The inventor of an improvement, new, useful, and properly the subject of a patent, is not authorized thereby to appropriate the process improved upon. *Whitney v. Mowry*, 2 Bond, 45.

§ 2799. An improver is entitled to patent his improvement alone; and if the invention improved upon is patented, he cannot use it without the owner's license. *Colt v. Massachusetts Arms Co.*, 1 Fish., 108.

§ 2800. Inventor of a patented improvement cannot use the patented device improved upon, but both patents may be valid. *Star Salt Caster Co. v. Crossman*, 4 Cliff., 568.

§ 2801. An improver cannot use the patented machine improved upon without liability. *Waterbury Brass Co. v. New York & Brooklyn Brass Co.*, 3 Fish., 43.

§ 2802. An improver of a patented invention has no right to use the invention improved upon. *Winans v. New York & Harlem R. R.*, 4 Fish., 1; *Whipple v. Baldwin Mfg. Co.*, 4 Fish., 29.

§ 2803. An improver on a patented invention acquires no right thereby to make, use, or vend to others to use, the invention improved upon. *Cook v. Howard*, 4 Fish., 269.

§ 2804. An improver of a certain part of a known machine cannot treat as infringer another improver of the previously existing machine or machines, by using a form, construction, device or combination substantially different from that invented and patented by plaintiff, though performing the same functions. *Taylor v. Garretson*, 9 Blatch., 156.

§ 2805. Features of construction may well be and are often equivalents of prior patented features because involving their construction and mode of operation, though going further and containing their own patentable features; and for that very reason, when the question of the novelty and patentability of such further features comes up, the prior existence of such prior patented features does not make them the equivalents of the further features so subsequently patented in such sense as to anticipate the latter, but such subsequent patentee will be held liable for infringement so far as he uses the prior invention. *Loercher v. Crandal*, 11 Fed. Rep., 872.

§ 2806. The improver cannot appropriate the prior invention without being liable for infringement, even though his own improvement is useless without such appropriation of the prior patented machine or patented part of the machine. *Carter v. Baker*, 1 Saw., 512.

§ 2807. That an infringer has added something to the devices combined by a patentee does not enable him to use the combination without being answerable. *Herring v. Neson*, 14 Blatch., 293.

§ 2808. An improver who infringes is liable therefor, although he may have improved upon the patented device. *De Florez v. Raynolds*, 14 Blatch., 505.

§ 2809. A subsequent patentee of an improvement acquires no rights thereby to use the patent improved upon. *Nathan v. New York Elevated R. Co.*, 2 Fed. Rep., 225.

Improver — Cannot patent the original machine, §§ 2810-2812. Is entitled to protection for his improvements, § 2813. See *Infringer*, § 3001.

§ 2810. If the improver only patents the entire machine, the patent is void. *Evans v. Eaton*, Pet. C. C., 322.

§ 2811. Improver is entitled to patent for improvement only; under such circumstances a patent for the entire machine is void. *Woodcock v. Parker*, 1 Gall., 437.

§ 2812. Improver only cannot patent the original machine. *Odiorne v. Winkley*, 2 Gall., 50. See *Equivalents, Doctrine of*, §§ 2155, 2156.

§ 2813. A patentee is entitled to protection for improvements made by him, notwithstanding the prior existence of a device having the same capacity, but differing in structure. *Sinclair v. Backus*, 4 Fed. Rep., 539.

166. INCHOATE RIGHT.

Inchoate right—In unpatented invention, §§ 2814-2816. See *Assignment of Invention*, §§ 435-441.

§ 2814. The inchoate right to the exclusive use of an unpatented invention, and not only to the original letters patent, but to any renewal or extension which may thereafter be issued at any time and place, may be conveyed by an instrument containing apt terms to show an intention to convey all the rights springing from the invention. *Emmons v. Sladdin*, 9 O. G., 352.

§ 2815. Rights growing out of an invention, which is never patented, may be sold. *Hammond v. Mason, etc., Organ Co.*, 2 Otto, 724.

§ 2816. The inchoate right of making an apparatus embodying the invention, unexercised at date of the grant, is not property in such sense that to forbid its use by the issue of a patent is in violation of constitutional security of property rights. *Page v. Holmes Burglar Alarm Telegraph Company*, 17 Blatch., 484.

See *Abandonment*, §§ 84, 92. *Art, Lost*, §§ 385, 386. *Contracts*, § 1348. *Injunction, Preliminary*, § 3041. *Inventor*, §§ 3773-3776.

167. INCOMPLETE INVENTION.

See INVENTION, INCOMPLETE.

168. INFORMER.

§ 2817. Neither the United States, nor indeed any corporation, can be an informer, where the statute requires a *person* to act in that character. *United States v. Morris*, 2 Bond, 23.

169. INFRINGEMENT.

See EXPERIMENT, ABANDONED, INFRINGEMENT. COMBINATION, INFRINGEMENT OF, IN GENERAL; BY ADDITION TO; BY CHANGE IN LOCATION. COMBINATION OF OLD ELEMENTS, INFRINGEMENT OF. COMBINATION, INFRINGEMENT OF, BY SALE OF PART; BY SUBSTITUTION OF EQUIVALENT. COMPOSITION, INFRINGEMENT OF. FORMAL CHANGE, INFRINGEMENT. IMPROVEMENT, INFRINGEMENT. PRINCIPLE, INFRINGEMENT OF. PRODUCT, INFRINGEMENT OF. PROCESS, INFRINGEMENT OF. SUBSTITUTION OF EQUIVALENT IN RESPECT TO INFRINGEMENT. USE, ON FOREIGN VESSEL IN DOMESTIC PORT. CORPORATION, RIGHT OF ACTION FOR INFRINGEMENT. REISSUES, EFFECT IN LAW AS TO PRIOR INFRINGEMENT. AGENT, LIABILITY FOR INFRINGEMENT. CORPORATION, LIABILITY FOR INFRINGEMENT. LICENSE, IN RESPECT TO INFRINGEMENT.

Infringement—Burden of proof—*Burden of proof is on plaintiff*, §§ 2818-2823. *Of proving want of identity, on defendant*, § 2824.

§ 2818. The burden of proof is on plaintiff to show infringement after the time of his application or the date of his patent. *Dixon v. Moyer*, 4 Wash., 68.

§ 2819. The burden of proof is on plaintiff or complainant to prove infringement. *Sands v. Wardwell*, 3 Cliff., 277; *Graham v. Mason*, 4 Cliff., 88; *Forbes v. Barstow Stove Co.*, 2 Cliff., 379; *Cahoon v. Ring*, 1 Cliff., 592; *Latta v. Shawk*, 1 Bond, 259; *Bell v. Daniels*, 1 Bond, 212; *Parker v. Stiles*, 5 McL., 44; *Hudson v. Draper*, 4 Cliff., 178; *Carr v. Rice*, 1 Fish., 198; *Storrs v. Howe*, 4 Cliff., 388; *Matthews v. Skates*, 1 Fish., 602; *Hayden v. Suffolk Mfg. Co.*, 4 Fish., 84; *Johnson v. Root*, 1 Fish., 351; *Bates v. Coe*, 98 U. S., 31; *Fuller v. Yentzer*, 94 U. S., 299; *Washburn v. Gould*, 3 Story, 122; *Brooks v. Jenkins*, 3 McL., 432; *Union Sugar Refinery Co. v. Matthieson*, 3 Cliff., 639.

§ 2820. The plaintiffs must prove infringement affirmatively. *Swift v. Whisen*, 2 Bond, 115; *Judson v. Cope*, 1 Bond, 327.

§ 2821. The burden of proving infringement is on plaintiff, and must be shown beyond a reasonable doubt. *Many v. Sizer*, 1 Fish., 17.

§ 2822. It is incumbent on plaintiff to prove clearly and satisfactorily that there has been an infringement. *Royer v. Chicago Mfg. Co.*, 20 Fed. Rep., 853.

§ 2823. The burden of proving infringement is upon the plaintiff or complainant, and never shifts if the charge is denied in the plea or answer. *Imhaeuser v. Buerk*, 11 Otto, 647.

§ 2824. The burden of proof is on defendant, who sets up that his machine is a substantial departure from that of plaintiff, to prove it. *Blanchard v. Beers*, 2 Blatch., 411.

Infringement — Evidence of — *When it should be clear*, § 2825. *Admissibility*, §§ 2826, 2827. *Evidence of infringement*, §§ 2828-2833; *of non-infringement*, §§ 2834, 2835.

§ 2825. Where it is obvious defendant's device was invented for an entirely different purpose, and was not intended as an evasion of the plaintiff's patent, the infringement, if any exists, being purely accidental, it seems the evidence of actual infringement should be so clear as to admit of no other reasonable construction. *Nat. Car-Brake Shoe Co. v. D., L. & N. R. Co.*, 4 Fed. Rep., 224.

§ 2826. In deciding the question of infringement, the conduct of a defendant in relation to his machines may be considered. *Turrill v. Illinois Central R. Co.*, 5 Biss., 344.

§ 2827. Testimony tending to show that the defendant's structure existed before the patented invention, and therefore that the defendant's structure is not the same as the plaintiff's, *held*, relevant and material, and in this view no notice in the answer *held* necessary as to names, as the testimony was admissible under the issue of non-infringement. *Sutro v. Moll*, 19 Blatch., 89.

§ 2828. Evidence of using a patented article will sustain a charge of infringing by "making and using" it. *Locomotive-Engine Safety-Truck Co. v. Erie R'y Co.*, 10 Blatch., 292.

§ 2829. The testimony of a single witness, that defendant used machines substantially like complainant's, not rebutted, *held*, to be sufficient proof of infringement upon authority. *Spring v. Domestic Sewing Machine Co.*, 9 Fed. Rep., 505; *Bennet v. Fowler*, 8 Wall., 445.

§ 2830. It is regarded as sufficient evidence of infringement, where it is charged that the defendants used the machine, that a witness is introduced who saw the machine in the possession of the defendants, and the answer does not explicitly deny the infringement. *Gear v. Fitch*, 16 O. G., 1231.

§ 2831. Testimony having been taken showing that Wilson, the original defendant, had infringed the plaintiff's patent, but no direct testimony having been taken after the amendment of the bill to show that the added defendants (Ackerman and Borkel) had, together or singly, used the infringing machine, *held*, that the reference in the stipulation signed by the solicitor on behalf of Ackerman and Borkel, as well as on behalf of Wilson, and under which Ackerman and Borkel put in their answer, to the fact that they had bought "the business of said Wilson in which the infringing machine or machines were used," and that the accounting against them was to date from the time of such purchase, and that they were to be enjoined, and that they were not to object that they had not infringed jointly with Wilson, taken in connection with the fact that in the joint answer, which is sworn to by Borkel, the machine charged in the bill as infringing is spoken of as "the machine used by these defendants," is sufficient *prima facie* evidence of the use of the machine by Ackerman and Borkel. *Fischer v. Wilson*, 16 Blatch., 220.

§ 2832. Sufficient proof of infringement may be derived from the comparison of that which is used by the defendant with the description of the invention given in the specification of the patent which constitutes the foundation of the suit. *Imhaeuser v. Buerk*, 11 Otto, 647.

§ 2833. The record of a suit previously brought on the same letters patent against a defendant to whom the infringing machines had been furnished by the defendant herein, and the cost of said suit paid by the latter, is competent evidence for the plaintiff in a like action against the latter for infringement, and is also conclusive upon the question of priority or novelty of the patent. *United States & Foreign Salamander Felting Co. v. Asbestos Felting Co.*, 18 Blatch., 310.

See *Admissions*, §§ 159, 160. *Master's Report*, § 4182.

§ 2834. Evidence of one machine made only for exhibition at a mechanics fair, where none were ever made or sold, is not sufficient evidence of infringement. *Standard Measuring Machine Co. v. Teague*, 15 Fed. Rep., 390.

§ 2835. It is not sufficient, to make out a case of an infringement, that the defendant, called in rebuttal by the plaintiff, gave one answer tending to establish a particular infringement which had not been the subject of previous testimony, and which answer is inconsistent with his uniform denial of having made the infringing device during the life of the patent, without the knowledge and permission of the patentee. *Reay v. Rau*, 15 Fed. Rep., 749.

See *Invention*, § 3546. *Patents*, §§ 4686-4688.

Infringement — Identity — What is, and what is not, §§ 2836-2871. See *Identity*, §§ 2657-2720.

§ 2836. What constitutes an infringement. *Smith v. Downing*, 1 Fish., 64.

§ 2837. An infringement involves substantial identity. *Burr v. Duryee*, 1 Wall., 531.

§ 2838. An infringement is a copy made after and agreeing with the principle laid down in the patent. *Page v. Ferry*, 1 Fish., 298.

§ 2839. An infringement is a copy made after and agreeing substantially and in principle with the article described in the letters patent. *Haselden v. Ogden*, 3 Fish., 378.

§ 2840. To constitute infringement, there must be, first, similarity of design; second, substantial identity of purpose or result. *Henderson v. Cleveland Co-operative Stove Co.*, 12 O. G., 4.

§ 2841. The true question involved in infringement is, whether it embodies the same idea and its arrangement carries out the same idea. *McCormick v. Seymour*, 2 Blatch., 240.

§ 2842. To constitute infringement, patentee's devices must be substantially adopted. *Waterbury Brass Co. v. New York & Brooklyn Brass Co.*, 3 Fish., 43.

§ 2843. To constitute infringement, plaintiff's invention need only be substantially used in defendant's machine. *Cox v. Griggs*, 1 Biss., 362.

§ 2844. If the machine complained of involves substantial identity with the one patented, it is an infringement. *Sickles v. Borden*, 3 Blatch., 535.

§ 2845. The question of infringement is whether defendant's machine varies substantially from that of plaintiff. *Potter v. Schenck*, 1 Biss., 515.

§ 2846. The question of infringement is not whether one machine operates as *perfectly* as the other, but whether it is the same in principle or not. *Pitts v. Wemple*, 1 Biss., 87.

§§ 2847-8. To infringe a patent it is not necessary that the thing patented should be adopted in every particular. If the patent is adopted substantially by the defendants, they are guilty of infringement. *Sewall v. Jones*, 1 Otto, 171.

§ 2849. An infringement occurs where a party avails himself of a patented invention without such variation as will constitute a new discovery. *Foss v. Herbert*, 1 Biss., 121; *Rich v. Lippencott*, 2 Fish., 1; *Carter v. Baker*, 1 Saw., 512.

§ 2850. An infringement involves substantial identity, whether that identity is described by the terms "the same principle," "same *modus operandi*," or any other. *Ibid.*

§ 2851. Where the invention is embodied in a machine, the question of infringement is best determined by a comparison of the machine or apparatus constructed or used by the respondent with the mechanism described in the specification of complainant's patent. *Fuller v. Yentzer*, 4 Otto, 288.

§ 2852. The question of infringement must be determined chiefly by a comparison of complainant's mechanism, as described in his patent, and the machine made, used or sold by respondent. *Hudson v. Draper*, 4 Cliff., 178.

§ 2853. It is not only necessary to an infringement that the arrangement which infringes should perform the same service or produce the same effect, but it must be done in substantially the same way. *Werner v. King*, 6 Otto, 218.

§ 2854. Where the defendant in an action for infringement uses substantially the same devices as plaintiff, and produces the same result and certain other results differing from those produced by plaintiff, it will still be considered that the patent of plaintiff has been infringed, and that defendant appropriates the invention of complainant. *New York Rubber Co. v. Chaskell*, 9 O. G., 923.

§ 2855. In order to constitute an infringement it is not necessary that the arrangement and combination of the party charged with the infringement should be the same to the eye, but in point of fact. *Smith v. Higgins*, 1 Fish., 537.

§ 2856. A patented machine is infringed by a machine which incorporates in its structure and operation the substance of the invention; that is, by an arrangement of mechanism which performs the same service or produces the same effect in the same way. *Hoffheims v. Brandt*, 3 Fish., 218.

§ 2857. The question to be determined in a suit for infringement of letters patent is, whether, under a variation of form, or by the use of a thing which bears a different name, the defendant accomplishes by his machine the same purpose or effect as that accomplished by the patentee, or whether there is a real change of structure or purpose. *Converse v. Cannon*, 2 Woods, 7.

§ 2858. To constitute an infringement the thing used by the defendant must be such as to substantially embody the patentee's mode of operation, and thereby to obtain the same kind of result as was reached by his invention. *Sewall v. Jones*, 1 Otto, 171.

§ 2859. It is not necessary that the defendant should employ the plaintiff's invention to as good advantage as he employed it, or that the result should be the same in degree, but it must be the same in kind. *Ibid.*

§ 2860. In an action for infringement the first question is whether the machine used by the defendant is substantially in its principle and mode of operation like the plaintiff's. If so, it is an infringement of it. If he has taken the same plan, and applied it to the same purpose, notwithstanding he may have varied the process of the application, his manufacture will be substantially identical with that of the patentee. *Ibid.*

§ 2861. The question of infringement depends upon whether the plan which the defendant has employed is in substance the same as the plaintiff's, and whether all the differences which have been introduced are not differences in circumstances, not material, and whether it is not in substance and effect a colorable evasion of plaintiff's patent. *Ibid.*

§ 2862. In determining the question of infringement, the substantial identity to be looked to respects that which constitutes the essence of the invention, namely, *the application of the principle.* *Wintermute v. Redington*, 1 Fish., 239.

§ 2863. In a suit for infringement the question is not which is best, or most perfect, but whether one mode or combination is an infringement of the rights secured by the other mode or combination. *Howe v. Abbott*, 2 Story, 191.

§ 2864. The fact that there is to some extent an accidental result in defendant's machine similar to plaintiff's will not of itself constitute infringement, where the question is whether it operates substantially in the same way and to produce the same result. *Pitts v. Wemple*, 1 Biss., 87.

§ 2865. If the defendant has arranged his machinery on the same principle as claimed by plaintiff, he is guilty of infringement. It is not essential that defendant's water-wheel should be exactly similar in form; the force of the water must be thrown upon it in substantially the same way. *Parker v. Haworth*, 4 McL., 370.

§ 2866. The right of the inventor does not depend upon the degree of perfection of his invention, nor slight changes in arrangement, or in the finish of the parts, but upon whether the machinery, constructed as described, will or will not accomplish practically and usefully the end pointed out; and one using his principle, but with superior mechanical skill in construction and arrangement, will be guilty of infringement. *Parkhurst v. Kinsman*, 1 Blatch., 488.

§ 2867. Superior mechanical skill embodied in a form different in appearance or reality will not avoid infringement if the idea which gives the machine its value is appropriated. *Blanchard v. Beers*, 2 Blatch., 411.

§ 2868. Although several inventors might obtain substantially the same result, if it was obtained by means substantially different in character, construction, arrangement and mode of operation from any prior invention adapted to the same general purpose, the use of such means for a similar or even for the same purpose would not infringe the rights of a prior patentee. *Burden v. Corning*, 2 Fish., 477.

§ 2869. Where the construction and elemental idea and principle of the alleged infringement differ essentially from the plaintiff's patent, there is no infringement. *Turrill v. Illinois Central R. Co.*, 5 Biss., 344.

§ 2870. Where the main features of complainant's patents are involved in defendant's device, slight mechanical deviations will not avoid infringement. *Burdsall v. Curran*, 17 O. G., 1320.

§ 2871. In determining the matter of infringement, attention should be paid to such portions as really do the work, so as not to give undue importance to parts used only as a convenient mode of construction. *Holly v. Vergennes Machine Co.*, 18 Blatch., 327.

Infringement — Identity in the result, §§ 2872-2884.

§ 2872. A better result will not avoid infringement where the principle or combination is the same. *Blanchard v. Beers*, 2 Blatch., 411.

§ 2873. A patent for a device cannot be evaded by dividing the device into two parts, which produce the same result, in substantially the same way, when combined. *Wheeler v. Clipper Mower & Reaper Co.*, 10 Blatch., 181.

§ 2874. Similarity of design being established, an infringement occurs if a result incident to the construction of the device is the same as that of the complainant, even though the primary purpose of the construction is for a different object. *Henderson v. Cleveland Co-operative Stove Co.*, 12 O. G., 4.

§ 2875. Any device which secures substantially the same results as the patentee's, by the same or equivalent mechanism, is an infringement. *Vogler v. Semple*, 7 Biss., 382.

§ 2876. Where the device used by defendant was substantially the same as plaintiff's, except that a certain gauze was fastened with wire in place of solder, *held*, that it was none the less an infringement. *Craig v. Smith*, 2 Dill., 375.

§ 2877. The complainants' apparatus held infringed, although those of the defendants are portable and otherwise differ in minor details. All obtain a like result by substantially the same means. *Gottfried v. Bartholomae*, 8 Biss., 219.

§ 2878. The same result obtained by means other than that claimed by patentee is no infringement. *Carver v. Hyde*, 16 Pet., 513.

§ 2879. Where entirely different means are used it is not an infringement, although the result or end attained is the same. *Seymour v. Osborn*, 3 Fish., 555.

§ 2880. Where the patent was limited to the application of a particular device in a certain way, *held*, that it was no infringement to make or fashion articles to be so used, so long as they were not so applied. *Heaton v. Quintard*, 7 Blatch., 73.

See *Combination*, § 1037. *Infringement*, § 2920.

§ 2881. Where the distinguishing feature of a patented device consists in its peculiar construction, another which is constructed differently is no infringement of the patent, although it produces the same results. *Reckendorfer v. Faber*, 12 Blatch., 68.

§ 2882. The means employed by the defendant being different in the essential elements of organization from that of the patentee, no infringement occurs, although the several devices are alike in accomplishing a common result. *Merriam v. Van Nest*, 13 O. G., 597.

§ 2883. The fact that the same result is obtained by a later patent does not, therefore, make the latter an infringement of the other. *Fuller v. Yentzer*, 6 Biss., 203.

§ 2884. The accomplishment of the same result, but by different means, does not constitute infringement. *Dryfoos v. Wiese*, 19 Fed. Rep., 315.

See *Infringement*, §§ 2864, 2949.

Infringement — Change in degree. See *Combination*, §§ 984, 985, 1003. *Infringement*, §§ 2846, 2859, 2866. *Damages and Profits*, § 1521.

Infringement — Change in form, §§ 2885-2891. See *Form*, §§ 2541-2553.

§ 2885. Where the defendant's machine has been made to differ in form from that of the complainant, the absence of advantage suggests the thought that these differences were resorted to in the hope of escaping responsibility for infringement. *Dederick v. Cassell*, 9 Fed. Rep., 306.

§ 2886. Except where form is of the essence of an invention it has but little weight in determining the question of infringement. It is necessary to look at the mode of operation and at the result, as well as at the means by which the result is attained. *Union Paper Bag Machine Co. v. Murphy*, 7 Otto, 120.

§ 2887. A structural difference in form and size does not avoid infringement if the same work is done by substantially the same means. *Sewing Machine Co. v. Frame*, 24 Fed. Rep., 596.

§ 2888. Where form is of the essence of an invention, and inseparable from the operation of the machine, another machine of different form producing the same results is not an infringement of the former patent. *Werner v. King*, 6 Otto, 218.

§ 2889. Where the gist of the invention embodied in a patented article consists in its form, the patent is not infringed unless the form is copied. *Murphy v. Eastman*, 1 Holmes, 113.

§ 2890. When, in view of the state of the art, the patentee's claim must be construed to be for the specific arrangement of devices invented by him, the defendants do not infringe unless their devices are in the same specific form. *Matthews v. Boston Machine Co.*, 15 Otto, 54.

§ 2891. When the language of the claim explicitly imports a certain arrangement into such claim, it is unnecessary to consider whether that arrangement is essential to the combination for the purpose of producing the result desired, and a machine which does not employ such arrangement is not an infringement of the claim. *Tate v. Thomas*, 22 Fed. Rep., 660.

Infringement — Of an entirety, by use of a part, §§ 2892-2901. See *Combination*, *Infringement by Sale of Part Only*, §§ 1021-1039.

§ 2892. Where two machines are patented conjointly, the patent is infringed by the use of either. *Wyeth v. Stone*, 1 Story, 273.

§ 2893. *Query*, whether, if an invention in the aggregate be new, and a party omits one part of the machine always used by the inventor, will it deprive the inventor of his patent-right? *Washburn v. Gould*, 3 Story, 122.

§ 2894. If defendant made a substantial part of the exclusive invention of patentee, and distinguishable from other parts of the machine, it would be an infringement. *Ibid.*

§ 2895. A patent for an entire machine which is substantially new is infringed by the use of a part. *Moody v. Fiske*, 2 Mason, 112.

§ 2896. A patent for several distinct improvements, which are clearly specified, is infringed by the use of one of the improvements. *Ibid.*

§ 2897. When a machine is patented as an aggregate, third parties may not deny an infringement on the ground that they omit material parts, or use fewer of the original elements,

or substitute equivalents. The question is, Is the alleged infringement substantially the same machine? *Rich v. Close*, 8 Blatch., 41.

§ 2898. To constitute an infringement the whole of the patented machine need not be used, but only a part. *Foss v. Herbert*, 1 Biss., 121.

§ 2899. It does not constitute a new infringement to sell part of a patented device necessary to its operation, but not covered by the patent, when they have already been charged in the accountings for the sale of the patented portion. *Buerk v. Imhaeuser*, 11 O. G., 112.

§ 2900. The use of part of an invention covered by a patent may constitute an infringement, and a party so using an invention after injunction granted, adjudged guilty of contempt. *Matthews v. Spangenberg*, 15 Fed. Rep., 813.

§ 2901. It is not necessary to take the whole of a patented invention to constitute an infringement. The patent gives exclusive enjoyment of the whole patented invention, and taking one feature is an infringement *pro tanto*. Where a defendant has repudiated a license formerly held by him, and is acting in defiance of the patent and outside the license, such license is no protection against suit for infringement. *Fetter v. Newhall*, 17 Fed. Rep., 841.

Infringement — Intent, §§ 2902-2905. See *Combination*, §§ 1021-1039. *Infringement*, §§ 2921, 2947. *Infringer*, §§ 2987-2990. *New Trial*, § 4242.

§ 2902. A device constructed originally not to infringe, but with *the intent* that by wearing of its parts it should become an infringement, is one; if undesigned, it is no infringement. *Page v. Ferry*, 1 Fish., 298.

§ 2903. Where, on suit brought for injunction and account after prolonged unconscious and innocent infringement on one side and acquiescence on the other, *held*, that, both parties being innocent, diligence should be required of him who had property to protect,— the burden must be on him; and there being no want of diligence on the part of defendants, an injunction was granted, with account for profits from date of notice only, and plaintiff was left to his remedy at law for damages. *Merriam v. Smith*, 11 Fed. Rep., 588.

§ 2904. Where the infringement by defendants was neither wilful nor malicious, *held*, that it did not justify a decree against them beyond the net profits realized from the manufacture and sale of the patented articles. *Ford v. Kurtz*, 12 Fed. Rep., 789.

§ 2905. Where the infringers knew of the patent in suit, although they supposed that another patent to the plaintiff, which they owned, covered the right to make what they did, it was held a deliberate and intentional infringement. *Burdett v. Estey*, 19 Blatch., 1.

Infringement — Making, using and selling, §§ 2906-2910.

SUMMARY (*DORSEY REVOLVING HARVESTER RAKE COMPANY v. BRADLEY MANUFACTURING COMPANY*, §§ 2906-2910)— *Exclusive license to make*, § 2906; *who may grant one*, § 2907.— *Right to make and sell for export*, § 2908.— *Particular agreement construed*, § 2909.— *Refusal of injunction pendente lite*, § 2910.

DORSEY REVOLVING HARVESTER RAKE COMPANY v. BRADLEY MANUFACTURING COMPANY.

(Circuit Court for New York: 12 Blatchford, 202-209. 1874.)

Opinion by WOODRUFF, J.

STATEMENT OF FACTS.— In each of these cases motions were made by the complainants for an injunction *pendente lite*. The motions were founded upon the respective bills of complaint, and affidavits pertinent to the several suits, and upon other affidavits and papers pertinent to both; and the motions are resisted upon affidavits used for the purposes of both motions. The object of the motions respectively is to restrain the alleged infringement of patents upon which the suits respectively are founded. The defendants object, in each case, that there is an improper joinder of complainants, because the bills respectively aver that the Johnson Harvester Company have the exclusive right to make and vend the patented inventions for use in foreign countries; also, that the defendants have a right to make and sell within the territory within which they manufacture and sell, without restriction as to the use or place within which the machines in question may be used.

The respective inventions are improvements in harvesters, and especially the harvester rake, one being patented to Owen Dorsey, and assigned to the Dorsey Revolving Harvester Rake Company, upon which patent the first of the above named suits is founded; and the other being patented to Samuel Johnson, upon which the second suit is founded. That the defendants are making and selling machines embracing these inventions is not denied; and it appears, also, that they are making and selling to parties who buy them for exportation to and use in foreign countries; and this is claimed to infringe the patents.

§ 2906. *Exclusive license to manufacture for a special purpose is not an assignment.*

My conclusions upon the bills of complaint and affidavits, and upon the questions thereupon arising, may be briefly stated. However the parties differ as to the construction and effect of the transactions in question, there is little, if any, dispute about facts.

1st. The suggestion that there is an improper joinder of plaintiffs, if that were a reason for withholding an injunction to restrain an infringement of the rights of one of the complainants, will not avail here. An exclusive license to manufacture for a special use or purpose is not an assignment of the patent, which renders the joinder of the patentee, in a suit for infringement, improper. It is not within the definition of an assignment, in the statute. It does not convey the patent, or any specified territory within which the licensee has the exclusive right to make, vend or use, and is not within any case which has held even that the licensee could sue without joining the person in whom the legal title to the patent is vested, still less within any case holding that the latter may not join in the suit in equity; and, in general, one who has granted such exclusive license has an interest in sustaining the right and protecting his license. Presumptively, his own rights would be affected by an adverse adjudication, if called on by the licensee to defend his license.

§ 2907. *Patentee or assignee may give an exclusive right to make and sell for use within certain territory.*

2d. I have no doubt of the right of a patentee to grant the right to make and sell the patented invention within specified territory, and to make that right exclusive in the grantee, and yet limit the use of the thing so made and sold, within specified limits. The right to make and vend, and the right to use, are completely severable; and, while a grant of the right to make and sell to others might be deemed to imply the right in the purchasers to use the thing purchased, a patentee may restrict the use. The patent as effectually secures to him a monopoly of the right to use as it does of the right to make. The patentee, or his assignee, may, therefore, give the exclusive right to make and sell for use within certain territory; and such a restriction would be entitled to enforcement. The case of *Adams v. Burke*, 17 Wall., 453 (§§ 5186-87, *infra*), recently decided in the supreme court, is in no conflict with this. In that case, there was a complete transfer of the exclusive title to the invention within and for a specified territory. There was no qualification of the right to use, either expressed in the grant or inferable (according to the views expressed in the opinion of the court) from the nature of the subject or the circumstances of the case. It is clear that the patentee may grant the right to use within any specified place, town, city or district, and he may make such right of use exclusive; and I deem it no less clear that he may limit the right to manufacture for such use. What the terms of any particular grant or license import may be and is often a question. But the right of the patentee to confer

upon others such qualified privilege, whether of making, of selling to others, or of using, as he sees fit, whether within specified limits or under limitations of quantity or number, or restricted uses, does not seem deniable. Whether, in a given case, he has given a privilege with such qualifications, or whether his grantee or licensee has an unrestricted right, without any limitation as to quantity, number or use, must depend upon the facts existing in each case.

§ 2908. *While a patent vests no exclusive right in patentee to sell his invention in foreign countries, there is no reason why he may not retain the right to make and sell for export.*

3d. The complainants have not vested in themselves, by virtue of their patents, any exclusive right to sell their patented inventions in foreign countries; and, therefore, any one having possession of their harvesters there, may sell and use them there, and any one there may make, sell and use them. But, a patentee having the exclusive right to make them in this country, and having the right above stated to grant that right to others, may qualify the privilege which he confers. A patentee may find it greatly to his advantage, and greatly profitable, to supply a foreign demand for an article of American manufacture, and may be able successfully to compete with foreign machinists in the making. In such case, his monopoly of the right of making and selling here is of great value, because no other one can make in this country and compete with him. I know of no reason in law or in equity, why, if he give to another a right to make, or to make and sell, he is not at full liberty to retain to himself the advantage and profit of competing in foreign markets, by retaining the exclusive right to make and sell for export or use in other countries; not because the monopoly includes such other countries, but because his actual monopoly does include all making and selling here, with all the advantages which are incident thereto.

4th. The defendants in these cases are making and selling the patented harvester, and are so making and selling for the purpose of exportation, or under contracts, with knowledge and intent that the purchasers are thereby supplying, and will supply, the foreign market.

5th. In respect to the Dorsey patent, upon which the first above named suit is founded, the defendants show no assignment or license conferring upon them the right to use the patented invention. I do not discover in the papers anything which imports such a right at law or in equity. Counsel for the defendants seem to have assumed that the agreement with Johnson, the patentee named in the other suit, and the correspondence in relation to his harvester, applied to the Dorsey patent also. I do not find in either anything to warrant the assumption; and especially, I observe that the Dorsey patent expired on the 4th of March, 1870, and was, on or before that day, extended for the term of seven years. The defendants have failed to show a right under such extension.

§ 2909. *An agreement construed to convey a right to a restricted use only.*

In the first case, then, the defense rests upon a statement in the affidavit of Mr. Harding, the solicitor therein, and "agent for the Dorsey Revolving Harvester Rake Company, and for the reissued patent of Samuel Johnson, No. 2951, dated May 26, 1868," as follows: "that it was agreed that the right to build what was called single reapers, under said *patents*, should be given to C. C. Bradley & Son, to manufacture such machines as might be required for use in Minnesota, Wisconsin, Pennsylvania and New York, except the river counties, so long as, and on condition that, they kept said territory supplied with such

machines as are required therein, and paid the license fee." The defendants deny that there was any condition annexed to the privilege agreed to be given them. This statement does not discriminate, in terms, between the two patents, one to Dorsey and one to Johnson. It may refer to the Johnson original and reissued patents. The agreement produced by the defendants refers to the Johnson patent only. If, however, this statement be taken most strongly against the complainants, to include also the Dorsey patent, then it declares that the defendants were only to have the privilege of supplying the states mentioned with machines for use therein; and this is not at all inconsistent with the loose and indefinite terms of the agreement in relation to the Johnson patent, to be presently further noticed. The defendants, therefore, fail to show a right to manufacture and sell, without restriction as to the use of the harvesters at any time. Still less do they show such a right now existing under the extension of the Dorsey patent. The complainants in the first above named suit are, therefore, entitled to the injunction sought by their motion, restraining the defendants from infringing the Dorsey patent, extended as described in the bill of complaint.

6th. As to the Johnson patent, upon which the second above named suit is founded, I feel great hesitation. There was, in relation to that, a written agreement, which contemplated granting to C. C. Bradley & Son "their choice in what territory they may want, at a reasonable price, *for the right to build and sell* in said territory." Subsequent negotiations, evidenced by correspondence, indicate subsequent and continuous recognition of the right of C. C. Bradley & Son to build and sell, though the precise limits of the territory in which they were to be permitted to build and sell has been the subject of negotiation and fluctuation. As already suggested, the agreement is not very specific or determinate. It is not clear that Bradley & Son were, under this agreement, to have anything more than a license. Nor is it stated that they are to have an exclusive license in any territory. They seem, in the correspondence, to have claimed that; and yet such claim is not conceded, as appears by what they call encroachments on them. On the other hand, there is, in this agreement, no express restriction upon the right to make and sell in such territory as might be assigned to them, which in terms confines the use of the harvesters which they make and sell to the same territorial limits. Hereupon several interesting questions arise. Does the right to make and sell carry with it the right to use? If, by implication, the right to use is incident to, or implied in, the right to make and sell, does not the limitation of the right to make and sell, to specific territorial limits, operate with equal strictness upon the right of use which is incidental thereto or is so implied? Is the incident broader in its scope than the principal grant? If it be true, as claimed, that, when one who has the whole right in the invention, to make, sell and use (either for the whole or a part of the United States), sells a machine, it passes from under the dominion of the patent, and may be used anywhere, does that follow when a mere licensee to make and sell within specified limits sells the patented invention to another? Does the cautiously guarded decision of the supreme court in *Adams v. Burke*, 17 Wall., 453 (§§ 5186-87, *infra*), carefully limited to the precise case then under consideration, reasonably import an affirmative to the last question? Especially, may one having a license to make and sell within a limited territory only, deliberately contract to supply the patented invention for use in other territory, provided his manufacture and his

actual negotiation of sales are within the privileged limits, and may he practically avail himself of the markets of the whole country?

§ 2910. *Where, in view of the vague language of an instrument, it was uncertain whether it operated as an assignable license or not, and the limitations within which the license was granted being indeterminate, an injunction pendente lite was refused, without prejudice to a renewal upon further proof.*

The rights of the parties in respect to the Johnson patent are by no means clearly settled. The question whether the defendants are to be regarded as mere licensees, or as having an interest in the patent, is to be determined. Confessedly, in the present actual condition of things, their interest, of whatever extent, is equitable rather than legal; but that does not prejudice their standing in a court of equity. Again, it is claimed that the license to which C. C. Bradley & Son were entitled was personal to them and could not be assigned, and therefore the defendant, a corporation, has no right whatever, either at law or in equity, to make or sell the patented invention anywhere. The question, whether the right or privilege of C. C. Bradley & Son could be assigned, is not to be determined solely by applying to it the term "license." Whether a license is or is not assignable is to be determined not merely by the term "license," but by an inquiry into the fair meaning and intention of the parties; and it may be affected not only by the words of license, but by the nature of the transaction, the consideration paid, and other circumstances showing that an assignable right was conferred. And yet that question is here involved touching a right or privilege which was to be evidenced by writing, which, in the preliminary agreement, is not well defined, and which lies in what may be found to be equitable between the parties.

There are some expressions, in the negotiations between the parties, which would seem to contemplate the possession, by C. C. Bradley & Son, of exclusive territorial rights; and if it should be found that the defendants are so entitled, they may be within the case of *Adams v. Burke*, above referred to.

If there appeared to be danger of irreparable injury to the complainants, I might feel called upon to decide these questions above referred to, or, at least, such of them as are material to the motion. But no such danger appears; there is no allegation that the damages cannot be easily ascertained, nor that the defendants are not of sufficient pecuniary responsibility to answer for all profits realized by them, and for all damages sustained by the complainants *pendente lite*. I do not think the case depending upon the Johnson patent developed so fully, and the right so clear, that the injunction should be granted upon the papers now before me. The motion in the suit of Johnson and others against the defendants must be denied. But if the complainants deem it important, such denial may be without prejudice to a renewal upon further proofs. The motion in the suit of the Dorsey Company must be granted.

Infringement — By making, using or selling — *Making, using or selling*, §§ 2911-2913. *Making*, §§ 2914, 2915. *Using*, § 2916. *Selling*, §§ 2917-2923.

§ 2911. Infringement consists in making, using or selling a patented machine. *Whittemore v. Cutter*, 1 Gall., 429; *Brooks v. Bicknell*, 3 McL., 250.

§ 2912. May be by making, using or selling the thing patented. *Rich v. Lippencott*, 2 Fish., 1.

§ 2913. An infringement of a patent can only occur by the actual making, using or selling of the patented device. *Allis v. Stowell*, 19 O. G., 727.

§ 2914. Making alone constitutes an infringement. *Whittemore v. Cutter*, 1 Gall., 429.

§ 2915. The mere making of a patented machine, although it is neither used nor sold, is an infringement. *Bloomer v. Gilpin*, 4 Fish., 50.

§ 2916. It is an infringement to make a patented article, though never used by the maker; to use it, though made by another; to sell it to others when manufactured by another. *Haselden v. Ogden*, 3 Fish., 378.

§ 2917. Where defendants were paid by the pound, and by day's work, to put an armor on a government vessel, the application of which to such purpose was patented, and the vessel did not belong to the defendants, *held*, that it was not a vending of it as armor to the government. *Heaton v. Quintard*, 7 Blatch., 73.

§ 2918. The sale of machines embodying the patented inventions of another to one for use is an invasion of the patentee's rights, and such a conversion of his property as will render the party so selling the invention liable in an action for tort. But in such case the plaintiff may waive the tort and sue in *assumpsit* for the money received from the sale. *Steam Stone Cutter Co. v. Sheldons*, 15 Fed. Rep., 608.

§ 2919. The vending of a machine after the expiration of the term of a patent, which was built during the term in accordance with an understanding between the constructor and the patentee, is not an infringement. *Reay v. Rau*, 15 Fed. Rep., 749.

§ 2920. The manufacture and sale of an article is not a violation of a patent which claims only the use of such an article in a particular application, and disclaims the method of making it. *Keystone Bridge Co. v. Phoenix Iron Co.*, 1 O. G., 471.

See *Combinations*, § 1037. *Infringement*, § 2880.

§ 2921. The preparation and sale of an article, for the purpose of being used in a manner that will occasion a conflict with the claims of a patent, places the person so doing in the attitude of an infringer. *Rumford Chemical Works v. Hecker*, 10 O. G., 289.

§ 2922. Proof of such act establishes a *prima facie* case of infringement, and throws upon the defendant the burden of showing that the article was not, in fact, so used. *Ibid*.

§ 2923. It is an infringement of a patented machine to make and use a machine which operates, or may operate if the owner is disposed to use it so, in the manner pointed out by the patent. *Holbrook v. Small*, 10 O. G., 508.

Infringement — Use, §§ 2924-2938. Sale, §§ 2939, 2940. Making, §§ 2941, 2942.

§ 2924. Where there was a license to use a patented machine on rendering a weekly account with weekly payments and other conditions, *held*, that on failure to perform the conditions, a continued use became an infringement, for which a bill for injunction would lie. *Brooks v. Stolley*, 3 McL., 523.

§ 2925. Where an assignment was granted for a certain term, the court refused to reform it so as to extend it, because of rights of a *bona fide* purchaser having intervened; and the continued use of the machines after lapse of the term was held an infringement. *Woodworth v. Cook*, 2 Blatch., 151.

§ 2926. It is an infringement for the owner of a license under a patent restricted to a certain district to remove it into another district owned by another. *Chambers v. Smith*, 5 Fish., 12.

§ 2927. Whether a patent for the use of an article has been infringed by the sale of it in connection with the use of it by the purchasers is a question to be determined upon the evidence in taking the account of damages. *Rumford Chemical Works v. Hecker*, 10 Blatch., 136.

§ 2928. A patent is infringed by use of a machine constructed before the issuance of the patent, where there has been no abandonment of the invention to the public, and in the absence of actual or implied authority from the inventor. *Kendall v. Winsor*, 21 How., 322.

§ 2929. No recovery can be had upon a patent for using a machine which is neither described nor claimed in it, although the machine was originally devised by the patentee in the course of experiments which resulted in producing the patented machine, and although it has been the most extensively adopted. *Evarts v. Ford*, 5 O. G., 58.

§ 2930. Where a machine was licensed for use in a particular territory, *held*, that the use of it by subsequent purchasers in territory other than that for which it was licensed was unlawful. *Wicke v. Kleinklecht*, 7 O. G., 1098.

§ 2931. That the original invention has been supplanted in the trade by the improved device of the defendant is no test of non-infringement. In so far as he may use the invention, even though it be in connection with his own additions, which have rendered it of such increased value, he is liable. *Turrell v. Spaeth*, 14 O. G., 377.

§ 2932. *Held*, in view of agreement between plaintiff and patentee, its assignor, that where defendants bought certain machines of persons who themselves had a right to use them, the defendants obtained no such right, but were liable for infringement. *Union Met. Cartridge Co. v. U. S. Cartridge Co.*, 7 Fed. Rep., 344.

§ 2933. It must be presumed that the interests of a defendant were promoted by the use of an alleged infringement, and he cannot be permitted to show that he pursued a wrong policy. *Turrill v. Illinois Central R. Co.*, 5 Biss., 344.

§ 2934. A decree for injunction and account against several defendants who owned, rented or occupied premises in which were placed driven wells which were used by them, and against a defendant who purchased and rented out, but never personally occupied, premises containing a driven well. *Green v. Gardner*, 22 O. G., 683.

§ 2935. Where the article complained of was procured and used by a workman of defendants, who was paid for his labor by the piece, furnishing his own tools, and he was using the device for them in their business, it was held an infringement for which they were to some extent liable. *Wooster v. Marks*, 17 Blatch., 368.

§ 2936. Where defendants employed a man, who was paid by the piece, and who furnished his own tools, the use of one of which was the infringement complained of, although the defendants stopped the use when informed of the fact, they were held liable for infringement. *Wooster v. Marks*, 17 Blatch., 360.

§ 2937. Where the defense was that the defendants' machine was purchased of another person, who had settled with the patentee therefor, and the proof failed to show that the defendants purchased before the date of settlement, *held*, that the use by the defendants of such apparatus is an infringement. *Matthews v. Spangenberg*, 23 O. G., 92.

§ 2938. The plaintiff manufactured and sold the patented bale-ties, consisting of bands and buckles, having stamped upon them "licensed to use once only." The defendants purchased second hand these buckles and bands, and, adding new bands or splicing the old bands, sold them. *Held*, that such sale on the part of the defendants was an infringement of the patents. *American Cotton Tie Supply Co. v. Bullard*, 17 Blatch., 160.

§ 2939. Where the infringement shown was by proof of the sale by defendants of a can purchased for and by the direction of the orators, but in the usual course of defendants' business, it was held that they were dealing in the infringing cans in such a manner, that, except as to the one purchased by the orators, they were liable to account and be enjoined. *De Florez v. Reynolds*, 14 Blatch., 505.

§ 2940. Where it appears that the articles charged to have been made in infringement of the patent were not sold or made prior to the filing of the bill, there is no infringement shown before filing the bill on which to base a recovery. *Slessinger v. Buckingham*, 17 Fed. Rep., 454.

§ 2941. Where, on the sale of a patented machine, a bunch of duplicate patented articles for use therein went with it, *held*, that it was an infringement to make new articles when the others were worn out. *Aiken v. Manchester Print Works*, 2 Cliff., 435.

§ 2942. Damages will be allowed on machines made in the United States in violation of a United States patent for sale abroad. *Ketchum Harvester Co. v. Johnson Harvester Co.*, 19 Blatch., 367.

See *Infringement*, §§ 2906-2910. *Use*, §§ 6436-6438. *Process and Product*, § 5111. *Re-use*, §§ 5864-5866.

Infringement—Particular cases, §§ 2943-2952.

§ 2943. Where denial of infringement was not positive, and corroborative testimony as to admissions of infringing manufacture was strong, *held*, that there was one. *Goodyear v. Berry*, 2 Bond, 189.

§ 2944. *Held*, that where the patent was for a "hose pipe with internal radial plates," using the old plates with new pipes, when the old pipes had worn out, was not a repair, but a new machine, and a violation of an injunction granted on the patent. *Craig v. Fisher*, 2 Saw., 345.

§ 2945. Where, from facts alleged and admitted in the answer, the employer was the person responsible for the infringement, the bill was dismissed as to the two other defendants, who were his workmen, and the case referred to master to take account, etc. *Hussey v. McCormick*, 1 Biss., 300.

§ 2946. Where on trial one of two claims was abandoned and no defense was made to the other, a decree for infringement was granted. *New York Coffee Polishing Co. v. Wilson*, 2 Fed. Rep., 904.

§ 2947. Where certain devices, capable of several uses, were sold for a certain purpose which constituted an infringement, and were accompanied by directions as to the mode of using them, which involved such an infringement, to which they were specially adapted, *held*, that they infringed. *Boyd v. Cherry*, 4 McC., 70.

§ 2948. Where the fact of infringement, established by very explicit testimony, was denied by a joint affidavit of parties apparently not experts, *held*, that the infringement was established. *Odorless Excavating Co. v. Lauman*, 12 Fed. Rep., 788.

§ 2949. Where the patent of complainant and that of respondent are each for a different device, *held*, that respondent has a right to manufacture in accordance with his patent, and if by so doing, and without infringing the claim of complainant, he produces a machine which incidentally, and without the use of complainant's invention, accomplishes the useful purpose of complainant's invention, he may do so. *Toohey v. Harding*, 4 Hughes, 254.

§ 2950. Doubted as to whether a mere advertisement of the device constitutes an infringement so as to amount to a disobedience of an injunction. *Allis v. Stowell*, 19 O. G., 727.

§ 2951. Where it does not appear that the patentee led the defendants into any expenditure or course of conduct by his silence when he ought to have spoken, which they would not have made or followed if he had spoken, an infringement will not be avoided. *Reay v. Raynor*, 19 Fed. Rep., 308.

§ 2952. Where the infringement complained of consisted in the use of a specific machine, to the use of which the inventor, complainant, had consented prior to his application for patent, *held*, that so long as the use was confined to such machine it was no infringement under the provisions of section 4899, Revised Statutes. *Duffy v. Reynolds*, 33 O. G., 621.

See *Reissues*, § 5452. Table I, p. 729.

Infringement—Pleading and practice, §§ 2953-2962.

§ 2953. The infringement of a patent is a *tort*; but the form of action is that description of *tort* called trespass on the case. *Stein v. Goddard*, 1 McAl., 82.

§ 2954. To support an action on the case for infringement, the patentee must prove injury and damage. *Byam v. Bullard*, 1 Curt., 100.

§ 2955. Where plaintiff proved his title to the patent, the admission of defendants as to the sale of the device complained of, and that it was substantially that claimed by plaintiff, *held*, that the letters patent were *prima facie* good, and infringement was proved. *Thatcher Heating Co. v. Drummond*, 3 B. & A., 138.

§ 2956. The bill sets out complainants' title to the exclusive right, title and interest under the patent, to the state of Pennsylvania, excepting certain counties, and then avers that the defendants "are *now* constructing, using and vending" the infringing goods . . . "in the western district of Pennsylvania," concluding the averment as follows: "All of which acts and doings are in violation of the exclusive rights and privileges, so as *aforsaid* vested in your orators, under and by virtue of the said recited reissued letters patent." *Held*, that these averments, taken in connection with statement of complainants' title, necessarily import a charge of infringement *after the grant to the complainants*; and, also, *within the territory covered by the grant*. *Meyer v. Bailey*, 8 O. G., 437.

§ 2957. It is not a sufficient reason for allowing a defendant to continue to infringe between the interlocutory and final decree, that the patent has but a year to run, or that the defendants have made contracts, knowing their liability to the plaintiff. *Brown v. Deere*, 2 McC., 425.

§ 2958. The question of the infringement of a patent depends very much on the construction of its claims, and that depends very much on prior patents on the same subject. If such prior patents are to be put in, they ought to be set up in an answer and be put in once for all, and the issue of infringement ought to be tried but once, and under an answer, and not under a plea. *Sharp v. Reissner*, 9 Fed. Rep., 445.

§ 2959. A question of infringement raised as to an article made and sold subsequent to decree and injunction cannot be determined on motion for attachment for violation of the injunction, but in an action for infringement. *Liddle v. Cory*, 7 Blatch., 1.

§ 2960. On the violation of an injunction, it lies in the discretion of the court to determine the question of infringement for itself by comparison, or to receive the testimony of experts. *Burdett v. Estey*, 16 Blatch., 105.

§ 2961. The question of infringement cannot be tried on a motion for attachment for contempt. *Putnam v. Hollender*, 11 Fed. Rep., 75; *Onderdonk v. Fanning*, 2 Fed. Rep., 568.

§ 2962. The infringement by the manufacturer, and the infringement by the user, of an infringing machine are separate trespasses, and judgment because of one is no bar to an action for the other. To create a bar there must be satisfaction, and nominal damages is not satisfaction. *Blake v. Greenwood Cemetery*, 16 Fed. Rep., 676.

See *Bill, Allegations of Infringement*, §§ 587-591. *Bill*, § 653.

Infringement—Generally, §§ 2963-2980. See *Contracts, Government*, §§ 1339-1343. *Reissues*, §§ 5747-5761. *Sale*, §§ 5911-5944. *Substitution*, §§ 6204-6208. *Use, Experimental*, §§ 6411, 6412.

§ 2963. Act 1800, section 3, infringement, construed. *Keplinger v. De Young*, 10 Wheat., 358.

§ 2964. An *evasion* of a patent (not an invasion) is *damnum absque injuria*. *Burr v. Duryee*, 1 Wall., 531.

§ 2965. If the thing claimed by plaintiff is impracticable, and the same thing as claimed by defendant is practicable, the claim will not benefit plaintiff nor harm defendant. *Sickles v. Young*, 3 Blatch., 293.

§ 2966. Where a machine formed by a combination of old devices, as nuts, wheels, pulleys, etc., is new as a structure, new in its mode of operation, and new in the effect produced, the patent in such case is not for a mere combination; and another machine, having the like construction, operation and effect, in all that constitutes the principle of the machine and the efficient means of its operation, is an infringement of the patent, notwithstanding it may be moved by a less number of wheels. *Waterbury Brass Co. v. Miller*, 9 Blatch., 77.

§ 2967. An imperfect infringement, because the machine is imperfect, is still an infringement. *Union Paper Bag Machine Co. v. Binney*, 5 Fish., 166.

§ 2968. Although a patent has expired and the device covered by it can be used only in connection with other devices embraced in a patent still in life, the latter devices cannot be used without the consent of the patentee, even in connection with the first. *Wheeler v. McCormick*, 11 Blatch., 334.

§ 2969. Where the only new idea in common in two patents is carried out by a construction and mode of operation substantially different in each, machines made according to the later patent do not infringe the earlier one. *Stebins Hydraulic Elevator Manufacturing Co. v. Stebins*, 4 Fed. Rep., 445.

§ 2970. When the patentee has infringed his license, and, while holding the legal title of the patent in trust for his licensee, has been faithless to his trust, it is an infringement which courts of equity will relieve. *Stanley Rule & Level Co. v. Bailey*, 14 Blatch., 510.

§ 2971. The defendants, in law, have the right to take from the earlier of two inventors, if he does not complain, whatever is common to him and the later inventor (the plaintiff), if nothing more is taken, without being guilty of infringement. *Crompton v. Knowles*, 7 Fed. Rep., 204.

§ 2972. Either claim in the defendant's patent may be valid as a whole, and yet there may be no right to make the whole structure shown in its drawings without a license under plaintiff's patent. *Collignon v. Hayes*, 8 Fed. Rep., 912.

§ 2973. Section 7 of the act of 1839, which provides that every person or corporation may use, and vend to others to be used, any specific machine, manufacture or composition of matter which they have purchased or constructed prior to the application for a patent, applies, in cases of patents for substantive things, to the particular things so purchased or constructed only, and does not include the right to practice the invention without liability. *Brickill v. City of New York*, 18 Blatch., 273.

§ 2974. Where the infringement consisted in making and selling certain machines, identical in a prior equity suit, in which there had been a final decree, and in the existing suit at law, and not for their continued use, and there was no possible element of prospective or uncertain damages, *held*, that it was a single wrong for which only one action would lie and damages had been assessed once for all. *Child v. Boston & Fairhaven Iron Works*, 19 Fed. Rep., 258.

§ 2975. The doctrine of a confusion of goods has no application to a suit for infringement of a patent, especially where there is only a confusion of book-keeping, and not a confusion of the articles themselves, the articles being incapable of mixture. *National Car-Brake Shoe Co. v. Terre Haute Car & Mfg. Co.*, 19 Fed. Rep., 514.

§ 2976. If there is nothing in a reissue besides what is an expansion of the original patent which would cover anything in the defendant's structure, he does not infringe anything that is valid in the patents in suit. *National Wire Mattress Co. v. New York Braided Wire Mattress Co.*, 20 Fed. Rep., 119.

§ 2977. A structure embracing all the elements of the patented invention, and also an additional feature not found in the latter, constitutes an infringement of the patent. *Roemer v. Simon*, 20 Fed. Rep., 197.

§ 2978. The addition of certain elements to a patented construction, which does not unfit it for performing its original result, but simply adds the results due to the new elements, does not avoid infringement. *Tate v. Thomas*, 22 Fed. Rep., 660.

§ 2979. Infringement cannot be presumed. *Lehigh Valley R. Co. v. Mellon*, 104 U. S., 112.

§ 2980. If an invention, made and sold prior to the date of the patentee's invention, is not an anticipation, it is not an infringement of it. *Cook v. Sandusky Tool Co.*, 26 O. G. 1114.

170. INFRINGER.

See OFFICERS, LIABILITY AS INFRINGERS. ADMINISTRATOR. AGENT, §§ 181-194. COMMON CARRIER, §§ 1114-1116. CONTEMPT, §§ 1257-1277. CONTRACT, GOVERNMENT, §§ 1339-1343. CORPORATION, §§ 1372-1384. EMPLOYER AND EMPLOYEE, §§ 2104, 2105. INJUNCTION, § 3391. OWNERS, JOINT, §§ 4476, 4477. PARTIES, § 4495. PARTNERSHIP, § 4549. PURCHASER, § 5202. RECEIVER, § 5207.

Infringer — *Contractor*, §§ 2981, 2982. *Employee*, §§ 2983-2986. *Innocent infringer*, §§ 2987-2990. *Parent and child*, §§ 2991, 2992.

§ 2981. One who employs a contractor to furnish articles with a specified patented improvement is not liable if, in complying with his contract, the contractor infringes a patent-right, and the contractor employed to do the work or furnish the goods is not his agent. *Lightner v. Brooks*, 2 Cliff., 287.

§ 2982. A contractor for the construction of a jail is liable for the infringement of a patent used in its construction. *Jacobs v. Commissioners of Hamilton Co.*, 1 Bond, 500.

See *Government*, § 2616. *Infringement*, § 2935. *Use*, § 6384.

§ 2983. Parties actually making the infringing machine held liable for the infringement, although employed by a third party. *Bryce v. Dorr*, 3 McL., 582.

§ 2984. It may be that any workman on an infringing machine, though not interested in it, is liable to be restrained, in order to prevent evasions, by treating all as principals who are aiding. *Woodworth v. Hall*, 1 W. & M., 248.

§ 2985. Keeping and selling an infringing machine, as salesmen or agents for the owners, renders the persons selling infringers. *Potter v. Crowell*, 1 Abb., 89.

§ 2986. In an action at law for infringement of a patent, all parties who participate in the infringement are liable, although some are simply acting as officers of a corporation. All parties who participate in a tort or trespass are liable, and a man cannot retreat behind a corporation and escape liability for infringements in which he actively participates. *National Car Brake Shoe Co. v. Terre Haute Car & Manufacturing Co.*, 19 Fed. Rep., 514.

§ 2987. Parties operating a machine under one patent held not to be wanton infringers of a prior patent for the same invention, and liable in damages only to the extent of their actual gains and profits. *Livingston v. Woodworth*, 15 How., 546.

§ 2988. Where the invention was an advertising hotel register, *held*, that the keeper of a hotel who kept such a register was a user of the invention and liable as such; that he was not the less liable although he did not intend to violate the rights of the patentee, and desisted when notified. *Hawes v. Washburne*, 5 O. G., 491.

§ 2989. The plaintiff is entitled to recover as damages not only the profit he might have made upon the book if he had sold it, but what he might have obtained from those who advertised in it. *Ibid.*; *Hawes v. Gage*, 5 O. G., 494.

§ 2990. Section 4900, Revised Statutes, construed to provide that recovery shall not be had upon infringements occurring while the infringer is ignorant of the patent, arising from failure to mark it patented under such statute, but shall be limited to the infringements arising after such notice. And where the innocent infringer, on receiving notice, had offered to pay royalty for what he was then doing, and, on a refusal of its acceptance, completed the particular device, he was held not liable to prior infringements, but plaintiff was given costs. *Allen v. Deacon*, 21 Fed. Rep., 122.

See *Costs*, § 1411. *Damages and Profits*, §§ 1483-1487, 1559. *Infringement*, §§ 2902-2905. *Injunction, Preliminary*, § 3115. *Injunction*, § 3409. *Purchaser*, § 5182.

§ 2991. Where infringement was found and injunction issued against defendant, who, with his minor son, conducted the business of third parties, and the son, who had not been named in the injunction, continued the infringement, it was held that an attachment should issue against the defendant unless he obtained from his son and filed in court an agreement to refrain from further infringement. *Dunks v. Grey*, 5 B. & A., 634.

§ 2992. When an infringing machine is used by a father and son, and it is not shown that they were partners, but it appears that the son was a superintendent in the shop where the machine was used, no action for infringement will lie against the son. *McDonald v. Whitney*, 32 O. G., 1465.

Infringer — *Is trustee for the profits*, §§ 2993, 2994. *Cannot plead fraud*, §§ 2995, 2996.

§ 2993. In equity an infringer, although technically a trespasser, is treated as a trustee of the gains resulting from the use of the patented property, and is held accountable accordingly. *Wetherill v. New Jersey Zinc Co.*, 1 B. & A., 485.

§ 2994. Proceedings in equity for infringement of patents are not strictly proceedings for torts. Aside from the restraint by perpetual injunction, an infringer must account as trustee

for profits realized, and is liable for the damage of infringement; hence, where a decree had settled the question of infringement, and the case had been referred to a master to ascertain the amount for which final decree should be entered, pending which the respondent died, the action was held to survive notwithstanding. *Atterbury v. Gill*, 13 O. G., 276. See § 3913.

§ 2995. Neither reissue nor extended patents can be abrogated by an infringer in a suit against him for infringement, on the ground that they were procured by fraud in prosecuting the applications for the same before the commissioner. *La Baw v. Hawkins*, 6 O. G., 724.

§ 2996. An infringer cannot plead want of identity in the inventions covered by the original and reissued patent, in the absence of fraud, and unless it is apparent as a matter of law on comparison of the original and reissued patent. *Graham v. Mason*, 4 Cliff., 88.

Infringer — Generally — *Who may be treated as*, §§ 2997-3003. *Who is not*, § 3004. *Defenses forbidden*, §§ 3005, 3006. *Presumption of continued user against*, § 3007. *Infringing machine reached through party accountable*, § 3008. *Extent of liability*, § 3009. *Salaries of infringers*, 3010.

§ 2997. He is an infringer who uses a machine which performs the same service in substantially the same way as that patented. *Wyeth v. Stone*, 1 Story, 273.

§ 2998. Where patentee is the original inventor of the device, he can treat as infringers all who make devices which effect the same substantial purpose by substantially the same mode of operation. *Myers v. Duker*, 1 B. & A., 535.

§ 2999. Where a person procures a patent for the building of a machine which produces certain results which are novel and useful by reason of certain mechanical contrivances and appliances, any person who attempts to accomplish the same results by mere substitutions, which are equivalents of the means employed by the first patentee, is an infringer. *Wilt v. Grier*, 5 Fed. Rep., 450.

§ 3000. If the defendant has incorporated the devices covered by the plaintiff's patent into his machine, he is liable as infringer, although it contains other different features. *Buerk v. Valentine*, 9 Blatch., 479.

§ 3001. If a patentee has invented a combination of two or more old things so as to produce a new and useful result, then he has a right to treat as infringers all who have used his invention in order to accomplish something more or better, when without the aid of such invention it could not be effected. *Sayles v. Chicago & Northwestern R. Co.*, 3 Biss., 52.

§ 3002. A person who sells a patented article for another, having no interest in it himself, may be enjoined. *Maltby v. Bobo*, 14 Blatch., 53.

§ 3003. A constructor of a machine infringes, if he makes his machine with express reference to a result which he knows will happen when the machine is put to its use, and which result, if originally introduced in the machine, is an infringement. *American Diamond Rock Boring Co. v. Sullivan Machine Co.*, 14 Blatch., 119.

§ 3004. A claim to a device to be used in a certain combination is not infringed by the makers of the device alone to be used in a different way. *Campbell v. Kavanaugh*, 11 Fed. Rep., 83.

§ 3005. An infringer cannot defend against the charge of infringement by allegation and proof that his machine is not as good as the device infringed. *Roberts v. Harnden*, 2 Cliff., 500.

§ 3006. An infringer cannot take advantage of a mistake as to an assignment after it has been corrected either by the patent office or by the parties. *Wing v. Warren*, 2 O. G., 342.

§ 3007. There is a presumption of continued use of machine by infringers up to time of suit, where no defense is set up by them. This use is evidence of utility. *Stimpson v. Mad River R. Co.*, 6 McL., 603.

§ 3008. The offending machine is reached through the party legally accountable for the wrong, and without whose agency, directly or indirectly, there would have been no ground of complaint. *Wilson v. Sherman*, 1 Blatch., 536.

§ 3009. Defendants held not liable for profits of their predecessor in the absence of facts to establish such liability. *Sayles v. Dubuque & Sioux City R. R.*, 5 Dill., 561.

§ 3010. "Salaries" of infringers cannot be set up against the complainant in estimation of gains and profits. *Williams v. Leonard*, 9 Blatch., 476.

See *Assignee*, § 545. *Contracts*, § 1324. *Use*, § 6385. *Utility*, §§ 6663-6668.

171. INGREDIENTS.

172. INJUNCTIONS.

Injunction — Alternative, §§ 3011-3017.

§ 3011. *Ex parte* expert depositions, that defendants' machine differed substantially from plaintiff's, held admissible; but in the absence of more specific statement, the court refused to disregard the verdict of two juries upholding the patent, and granted an alternative injunction. *U. S. Annunciator Co. v. Sanderson*, 3 Blatch., 183.

§ 3012. Bond only can be demanded in a case in which, if it is not given, an injunction must issue. *American Middlings Purifier Co. v. Atlantic Milling Co.*, 4 Dill., 100.

§ 3013. Bonds granted as an alternative for an injunction where defendant is able to respond in damages. *American Middling Purifier Co. v. Christian*, 4 Dill., 448.

§ 3014. Where the validity of the patent had been established in the supreme court, an alternative injunction was granted, although defendants were able to respond, because, among other reasons, it was probable that the term of the patent would end before a final decision would be reached. *Ibid.*

§ 3015. In view of the pendency of the writ of error, the order for an injunction was made conditional upon the defendant's furnishing security for the profits and damages accruing from his continuing the infringement. *Wells v. Gill*, 2 O. G., 590.

§ 3016. Where, on the order for an injunction coming up for settlement, defendant expressed his willingness to take a license from the plaintiff under the extended letters patent which he had infringed, at the usual license rate, the order was made that, unless such license should be accepted and executed by defendant in ten days, the injunction should issue. *Tilghman v. Mitchell*, 9 Blatch., 18.

§ 3017. Where, on motion for preliminary injunction, doubts were raised as to validity of applicant's patent, defendants were directed to give bonds, in default of which injunction would issue. *Swift v. Jenks*, 19 Fed. Rep., 641.

Injunction — Interlocutory, §§ 3018-3022. *Pendente lite*, §§ 3023, 3024.

§ 3018. The pendency of a suit in one district, on a bill for past infringement, is no bar to the grant of an interlocutory injunction on a bill filed subsequently in another district for a subsequent infringement. *Penna. Salt Co. v. Myers*, 1 Weekly Notes, 377.

§ 3019. No interlocutory injunction should issue unless the complainant's title and the defendant's infringement are admitted, or are so palpable and clear that the court can entertain no doubt on the subject. *Parker v. Sears*, 1 Fish., 93.

§ 3020. The grant of a patent by the patent office to the defendant can, on a motion for interlocutory injunction, have no other effect than as it indicates the opinion which highly respectable and skillful officers have formed on an *ex parte* examination of the case. *Wilson v. Barnum*, 2 Fish., 635.

§ 3021. To entitle complainant to an interlocutory injunction, there is no necessity of a special prayer for such process, where the bill shows a *prima facie* case. *Goodyear v. Mullee*, 3 Fish., 420.

§ 3022. Where defendant had no interest in the patent, the validity of which was sustained, nor any right to use it, and was at no time copartner with plaintiff, and his exhibit was an infringement, an interlocutory decree and injunction was granted. *Weeks v. Buffalo Scale Co.*, 11 Fed. Rep., 901.

§ 3023. Where, on an interference proceeding instituted in the patent office between an applicant and a prior patentee, judgment of priority has been awarded the applicant and no appeal taken, and a patent issued to him, an injunction *pendente lite* should be granted against the unsuccessful party to the interference in the absence of other defense than his prior patent. *Greenwood v. Bracher*, 1 Fed. Rep., 856.

§ 3024. It appearing that the defendant had not acted in good faith, an injunction was granted contingent upon the furnishing of bond with security to account for profits and to pay amount of any final decree. *Ibid.*

See *Infringement*, § 2910. *Injunction*, § 3291.

Injunction — Preliminary — Acquiescence of public in patent as ground for, §§ 3025-3033.

§ 3025. In that acquiescence of the public in a patent necessary to the grant of a preliminary injunction, "public" means that class of persons who would be likely to use the invention. *Doughty v. West*, 2 Fish., 553.

§ 3026. There is no fixed rule as to what term of exclusive possession will entitle patentee to a preliminary injunction. *Sargent v. Seagrave*, 2 Curt., 553.

§ 3027. Evidence of inventor's claim to inchoate right in his invention, since act of 1839, and of public acquiescence therein, as basis for a preliminary injunction. *Ibid.*

§ 3028. The length of time of undisputed use of a patent on which an injunction will issue is that long enough to permit articles or machines to be constructed by the patentee in conformity to his claim and to be sold publicly and repeatedly. *Orr v. Littlefield*, 1 W. & M., 13.

§ 3029. Mere lapse of time does not constitute such public acquiescence in the validity of a patent as to entitle to grant of a preliminary injunction; it must be attended with circumstances indicating that such acquiescence would not have occurred if any fair doubt had existed as to its validity. *Guidet v. Palmer*, 10 Blatch., 217.

§ 3030. Long public acquiescence in the complainant's patent, together with the adjudications in favor of its validity, are *prima facie* sufficient reasons for the grant of a preliminary injunction when the infringement is palpable. *American Shoe Tip Co. v. National Shoe Toe Protector Co.*, 11 O. G., 740.

§ 3031. It is not the practice to grant a preliminary injunction, which often operates as a final determination of the cause when the patent has never been passed upon, unless there has been acquiescence equivalent to a general admission of its validity, or there are some other strong reasons for such summary action, if it appears that the defendant in good faith intends to litigate the validity of the patent. The rule is not so strict with respect to a disputed question of infringement, since that may sometimes be determined as well by an inspection of the two things as it ever can be by evidence of any kind. *Crowell v. Harlow*, 18 O. G., 466.

§ 3032. Where acquiescence alone is relied on as a basis for a motion for a preliminary injunction, the infringement must be palpable. *Burleigh Rock-Drill Co. v. Lobdell*, 1 Holmes, 450.

§ 3033. Submission in three suits out of many, in which the judgment made no distinction between the several patents, does not show a general acquiescence in one of the patents, that will entitle to a preliminary injunction. *Grover & Baker Sewing Machine Co. v. Williams*, 2 Fish., 133.

See *Acquiescence*, §§ 146-148.

Injunction — Preliminary — General rules as to when granted, §§ 3034-3049.

§ 3034. Where the patent is valid, and, the supposed offense being constantly repeated, the causes of action and the multiplicity of suits would probably become much extended, an injunction may properly be prayed for. *Orr v. Littlefield*, 1 W. & M., 13. See § 3139.

§ 3035. In order to obtain an injunction before trial, there must be not only proof of a patent, but also of some length of use under it, or some considerable sales under it, or some recovery establishing its validity beyond the mere issue of it. A preliminary injunction is never issued as a matter of course. *Hovey v. Stevens*, 1 W. & M., 290.

§ 3036. When a preliminary injunction will be granted in patent cases and when refused. *Potter v. Whitney*, 1 Low., 87.

§ 3037. To entitle to a preliminary injunction there must be either exclusive possession of some kind by the patentee or his assignee; or a judgment at law approved by the judge who tried the case, or a final hearing in equity with the approval of the court. *Doughty v. West*, 2 Fish., 553.

§ 3038. Where the novelty of the invention is not disproved by the references adduced in the defense, and the complainant has been a long time in exclusive possession of his patent, with the acquiescence of the public, he is entitled to a preliminary injunction against the defendants who have infringed it. *Miller v. Androscoggin Pulp Co.*, 1 Holmes, 142.

§ 3039. An injunction is seldom refused where exclusive possession is shown for some time, though not for a long period, where large and numerous sales have taken place without dispute, and where the validity of the patent is not questioned by the defendant. *White v. Heath*, 10 Fed. Rep., 291.

§ 3040. Formerly the rule was that a preliminary injunction would not be granted unless the right secured by the patent was fortified by evidence of an exclusive or recognized enjoyment of the right, or by former adjudications sustaining it. In more recent practice, this rule has been relaxed when the validity of the patent is not assailed and the proof of infringement is clear. *New York Grape Sugar Co. v. American Grape Sugar Co.*, 10 Fed. Rep., 835.

§ 3041. Inventor's claim to inchoate right in his invention, under act 1839, when acquiesced in by the public, is sufficient to support an application for a preliminary injunction, prior to the grant of the patent. *Sargent v. Seagrave*, 2 Curt., 553.

§ 3042. Allegation of fraud in procuring an extension is no bar to grant of a preliminary injunction, so long as the act granting it remains unrepealed. *Gibson v. Gifford*, 5 Blatch., 529.

§ 3043. A preliminary injunction ought never to be issued unless the right of a patentee is an established or an admitted one, and unless the alleged invasion of the right is proved be-

yond a reasonable doubt. *American Nicholson Pavement Co. v. City of Elizabeth*, 4 Fish., 189.

§ 3044. Where the validity of the patent has been sustained in a prior suit, it affords a *prima facie* case for the grant of a preliminary injunction, unless on the motion new evidence not before discovered, or doubts as to the result in the prior case, are brought forward. *Blaisdell v. Dows*, 4 B. & A., 499.

§ 3045. A former decree against other parties raises a strong presumption of the validity of the patent, and together with the fact of acquiescence in the patent-right, and the practice of the invention under it, establishes *prima facie* patentee's title and right to a preliminary injunction against a clear case of infringement, unless his title was not clearly in controversy, or some material fact not then known was not under consideration. *American Nicholson Pavement Co. v. City of Elizabeth*, 4 Fish., 189.

§ 3046. Where a patent has been a long time in existence, has been renewed by the patent office after the expiration of the original term and in the face of opposition, and has been sustained by the adjudications of several of the federal courts, the patentee is entitled to protection by a preliminary injunction, at least until the adjudication of some tribunal shall decide the patent invalid. *Putnam v. Weatherbee*, 1 Holmes, 497.

§ 3047. After one fair trial of the question of infringement of a particular patent in one court, other courts in like suits should presume the decision to be right to the extent of granting a preliminary injunction. *Sargent Mfg. Co. v. Woodruff*, 5 Biss., 444.

§ 3048. A preliminary injunction will be granted to restrain infringement of a subsequent patent, which has not been litigated, where the prior expired patent of the same patentee involved the broad principle and was frequently sustained, and the infringement was wilful, although done under cover of a patent. *Plimpton v. Winslow*, 3 Fed. Rep., 333.

§ 3049. Where a patent has been declared valid, after protracted litigation in another circuit, such decision will be followed on an application for preliminary injunction, unless new evidence is presented, such as would probably in such case have led to a different decision. *Ladd v. Cameron*, 25 Fed. Rep., 37.

Injunction — Preliminary — General rules, when refused, §§ 3050-3060.

§ 3050. When a preliminary injunction will be refused. *Hall v. Speer*, 6 Pitts. L. J., 403.

§ 3051. A preliminary injunction will not be granted on an insufficient and defective specification. *Isaacs v. Cooper*, 4 Wash., 259.

§ 3052. A preliminary injunction cannot be granted when it is conceded that the plaintiff must finally fail in his action. *Celluloid Manufacturing Co. v. Goodyear Dental Vulcanite Co.*, 13 Blatch., 375.

§ 3053. Preliminary injunction will not be granted when, upon the same proofs and allegations, final relief would be denied. *International Tooth Crown Co. v. Mills*, 22 Fed. Rep., 659.

§ 3054. A court of equity will not grant a preliminary injunction where an equitable defense and a legal defense are both relied on by the alleged infringer, though sometimes the bill will be retained until the action is tried at law. *City of Concord v. Norton*, 16 Fed. Rep., 477.

§ 3055. A fair doubt as to whether a reissue claim is broader than that of the original is sufficient to require a motion for a preliminary injunction to be claimed. *Western Union Telegraph Co. v. Baltimore & Ohio Telegraph Co.*, 25 Fed. Rep., 30.

§ 3056. Where, on motion for preliminary injunction, the only question at issue is that of infringement, and plaintiff fails to establish it beyond a reasonable doubt, the motion will be refused. *Cooper v. Matthews*, 8 Law Rep., 413.

§ 3057. Whenever, upon a motion for preliminary injunction, a fair and reasonable doubt exists upon the facts presented as to whether defendant has actually been guilty of an infringement, or when it does not satisfactorily appear that the complainant is the first and sole inventor of the improvements claimed, a preliminary injunction will be refused. *Cross v. Livermore*, 9 Fed. Rep., 607.

§ 3058. Motion for preliminary injunction will also be refused if it appears that the alleged infringer uses less than all the elements of the combination, and substitutes something for the part which he omits, unless the substitute is a mere mechanical equivalent. *Ibid.*

§ 3059. The court will not, upon the mere production of a patent, entertain a motion for a preliminary injunction founded upon *ex parte* affidavits. The patent must be strengthened by a judgment or decree after a judicial investigation or by exclusive possession for some time. *Grover & Baker Sewing Machine Co. v. Williams*, 2 Fish., 133.

§ 3060. In an application for preliminary injunction, where issues of fact are presented, supported on one side by affidavits, and contradicted by affidavits upon the other side, which thus neutralize each other, a motion for the allowance of such an injunction will be denied. *Beane v. Orr*, 9 O. G., 255.

Injunction — Preliminary — Particular cases, §§ 3061-3083.

§ 3061. Where the patents had been frequently sustained, and infringement was shown, a preliminary injunction was granted. *Goodyear v. Hullihen*, 2 Hughes, 492; *Blanchard v. Reeves*, 1 Fish., 103. See § 3139.

§ 3062. Where, on motion for preliminary injunction, defendants set up an unrecorded, unwritten assignment prior to that of plaintiff, the latter was held a *bona fide* purchaser without notice, the prior assignment was not allowed to prevail, in view of the act of 1836, and the injunction was granted. *Gibson v. Cook*, 2 Blatch., 144.

§ 3063. The patent having been frequently adjudicated upon and sustained, and the infringement being clear, a preliminary injunction was granted. *Thayer v. Wales*, 9 Blatch., 170.

§ 3064. Where the patent had been twice contested in prior suits in the same district, and the infringement was clear, a preliminary injunction was granted, although respondent, a resident of Louisiana, was served with process while passing through Philadelphia, the bill being filed in the circuit court for the eastern district of Pennsylvania. *Thompson v. Mendelsohn*, 5 Fish., 187.

§ 3065. Where the infringement was clear and the patent valid, *held*, that the preliminary injunction should not be refused, because defendant offered to give bond, with surety, to pay any damage awarded against him. *McWilliams Mfg. Co. v. Blundell*, 11 Fed. Rep., 419.

§ 3066. Where, upon motion for a preliminary injunction, the patent had been twice sustained in suits before other courts, infringement was not doubtful, and there appeared no sufficient reason in the *ex parte* affidavits for rejecting such decisions, the injunction was ordered to issue. *Cary v. Lowell Mfg. Co.*, 32 O. G., 1009.

§ 3067. A preliminary injunction was granted against the infringers of a patent upon its appearing that the invention had been largely manufactured and sold under the patent for eleven years without interference; that the patentee had successfully maintained a suit against infringers, and that he had obtained an extension of the patent. *Cook v. Ernest*, 2 O. G., 89.

§ 3068. Where plaintiffs, owners of the patent, had largely entered on the manufacture of the article and engaged in it for three years, and defendants had begun the manufacture but just before suit brought, had invested but little money and acquired no reputation, and there was *prima facie* evidence of infringement, a preliminary injunction was granted. *Irwin v. Dane*, 2 Biss., 442.

§ 3069. Preliminary injunction granted where it appears that the plaintiffs had been manufacturing under their patent for ten years, and had never been interfered with except by the defendant, whom they had promptly notified to cease infringing. *Collignon v. Hayes*, 8 Fed. Rep., 912.

§ 3070. On motion for preliminary injunction, and proof of exclusive possession for some time under the patent and infringement being found, a conditional injunction was granted, in the absence of suggestions that defendant was about to construct any other machine than that complained of, if plaintiff was made secure of receiving all the profits which might arise from its use until a final decree. *Foster v. Moore*, 1 Curt., 279.

§ 3071. The complainant having been long in the enjoyment of his patent, and there being no doubt as to infringement, a preliminary injunction was ordered restraining the defendants from infringing it, notwithstanding affidavits were filed showing that articles embodying the alleged invention had been in use before the complainant made it, there being evidence to the contrary, and none of the articles being produced. *Chase v. Wesson*, 1 Holmes, 274.

§ 3072. Where defendants, who on motion for preliminary injunction denied that patentee was the inventor of the article infringed, had prior thereto, as partners of plaintiff, advertised and sold the article as protected by patent, and there had been public acquiescence therein, and on interference in the office the patent had been awarded the plaintiff, the motion was allowed. *Pentlarge v. Beetson*, 14 Blatch., 352.

§ 3073. On motion for preliminary injunction, evidence of exclusive inchoate right for nearly two years prior to grant of patent, acquiesced in by large sales to the public, as also for some time after grant of the patent, was held such exclusive possession as to warrant the allowance of the motion, although the validity of the patent was doubted. *Sargent v. Seagrave*, 2 Curt., 553.

§ 3074. Where there was an infringement when the suit commenced, but had recently ceased, and defendants could, if so disposed, renew it, and complainants feared a continuance of the wrong, a preliminary injunction was granted. *Potter v. Crowell*, 1 Abb., 89.

§ 3075. Where in addition to other reasons defendant was estopped by express terms in his contract from setting up defenses in excuse of infringement, a preliminary injunction was allowed. *McKay v. McKnight*, 5 Fed. Rep., 593.

§ 3076. Where, upon motion for a preliminary injunction, defendant alleged facts showing the invalidity of the patent, and which he stated were known to him during a prior suit in

which he took an active interest, but in which he did not disclose them, *held*, that his affidavit on the motion was not sufficient to overcome his silence then, and the injunction was granted. *Robinson v. Randolph*, 4 B. & A., 163.

§ 3077. Where it appeared that certain of the patents, though never the subject of final adjudication, had been involved in litigation, and that the defendant, after a protracted and expensive contest and after earnest efforts at compromise, had deliberately acknowledged infringement, by the advice of skillful counsel, and had settled for a large sum, *held*, that this litigation, coupled with the opinion of a circuit judge in another case giving a broad construction to the claim of the patent, goes very far to answer the requirements of a deliberate examination and a decision by a court, and that the question has been so far settled that a preliminary injunction should not be refused on the ground of non-adjudication. *Steam Gauge & Lantern Co. v. Miller*, 8 Fed. Rep., 314.

§ 3078. The patent having been adjudged valid by the court in a former trial, a preliminary injunction decreed, even though an independent suit based upon the patent was in progress in another court of equal jurisdiction. *Atlantic Giant Powder Co. v. Goodyear*, 13 O. G., 45.

§ 3079. Injunction granted before any sales had actually been made by the defendant, where it appeared probable from the circumstances that the defendant is about to engage in the business. *White v. Heath*, 10 Fed. Rep., 291.

§ 3080. On supplemental bill filed by leave of court, a preliminary injunction was granted restraining defendant, pending the suit, from manufacturing or selling saw-mill dogs clearly equivalent to plaintiff's patented device, and denied as to other dogs, where the court was in doubt upon the question of infringement. *Allis v. Stowell*, 23 O. G., 1033.

§ 3081. A person who parts with his interest in a drama and a patented invention by contract with another cannot, upon breach of such contract by the grantee, interfere with his use of them by injunction or use them against his wishes. The proper remedy is by action for damages. Preliminary injunction, however, granted to restrain the first party from exhibiting the play and using the invention. *Mallory v. Mackaye*, 22 O. G., 945.

§ 3082. The claim of the original patent being in substance reproduced in the reissue, and the infringement of such claim being admitted, the patent also having been repeatedly sustained by the courts, a preliminary injunction will be granted even though other claims of the reissue may be invalid. *Duff v. Calkins*, 25 O. G., 601.

§ 3083. Where want of novelty of the patented invention was not proved, complainant had invested a large capital and was enabled to supply the market, and his exclusive right had been generally acquiesced in, infringement was shown, and he would be greatly injured by competition, a preliminary injunction was granted. *Covert v. Curtis*, 25 Fed. Rep., 43.

Injunction — Preliminary — *Refused; infringement not established*, §§ 3084-3094.

§ 3084. Infringement being doubtful, a preliminary injunction was refused. *Dodge v. Card*, 1 Bond, 398.

§ 3085. Where the infringement of the patent was denied, plaintiff's possession was not exclusive, and he had been guilty of laches in bringing suit, a motion for preliminary injunction was denied. *Cooper v. Matthews*, 8 Law Rep., 413.

§ 3086. Where, on construing the claim of the patent, the question of infringement was doubtful, a preliminary injunction was refused. *Hardy v. Marble*, 10 Fed. Rep., 752.

§ 3087. Where, on motion for preliminary injunction, the infringement of the patent was doubted, the injunction was refused except as the result of a final hearing. *Marks v. Corn*, 11 Fed. Rep., 900.

§ 3088. Motion for a preliminary injunction denied when the evidence furnished does not clearly show a violation of the complainant's patent. *Pullman v. Baltimore & Ohio R. Co.*, 4 Hughes, 236.

§ 3089. Where the verdicts establishing complainant's title to his patent had been obtained on inconsistent and contradictory claims, so that the question of infringement could not be determined by the court with certainty, a preliminary injunction was denied. *Parker v. Sears*, 1 Fish., 93.

§ 3090. Where the infringement complained of was a machine held in a prior suit on the same patent to be no infringement of it, a preliminary injunction was refused. *Wells v. Jaques*, 5 Fish., 136.

§ 3091. The swaging of the several parts of the sieve together being an essential element of the invention set forth in plaintiff's patent, a preliminary injunction was refused, it appearing that the defendant accomplished the joining by double-seaming. *Adams & Westlake Manufacturing Co. v. St. Louis Wire Goods Co.*, 3 B. & A., 77.

§ 3092. Where, on motion for preliminary injunction, defendants justified under a subsequent patent, *held*, that the grant of the subsequent patent raised a presumption of non-

infringement; and infringement not being clearly proved the motion was denied. *American Nicholson Pavement Co. v. City of Elizabeth*, 4 Fish., 189.

§ 3093. A preliminary injunction refused where the alleged infringement consisted in pursuing the same process of manufacture that was in use prior to the patent. *Dorlan v. Guie*, 25 Fed. Rep., 816.

§ 3094. A preliminary injunction will not be granted where defendants have manufactured under the sanction of a patent of prior date to those held by complainants, which prior patent has expired, and no proceedings having at any time been instituted by complainants to secure or protect their rights under their patents. *Whitney v. Rollstone Works*, 8 O. G., 908.

Injunction — Preliminary — Refused; validity being doubted, §§ 3095-3099; validity of re-issue doubted, §§ 3100-3104; novelty doubted, §§ 3105-3108.

§ 3095. Where the patent was recent, had never been litigated, and its validity was seriously contested, a preliminary injunction was denied. *White v. Harris & Sons Mfg. Co.*, 3 Fed. Rep., 161.

§ 3096. Where the machine complained of was not identical with that involved in a former suit in which a preliminary injunction had been granted, and had been patented to defendant since such suit, and the validity of plaintiff's patent having never been established by final hearing, a motion for a preliminary injunction was denied. *Onderdonk v. Fanning*, 5 B. & A., 562.

§ 3097. Motion for a preliminary injunction denied where validity of patents has not been established, and complainant shows only a limited acquiescence, and defendants for years openly asserted their invalidity. *Fish v. Domestic Sewing Machine Co.*, 12 Fed. Rep., 495.

§ 3098. Where the validity of the patent sued on was doubted, a preliminary injunction was refused. *Crowell v. Harlow*, 18 O. G., 466.

§ 3099. Where the patent was recent, its validity disputed, and the facts upon which the plaintiff's right to an injunction depend were not so clearly made out, there being counter-affidavits as to novelty of patent sued upon, a preliminary injunction was refused. *McGuire v. Eames*, 15 Blatch., 312.

§ 3100. Where, on motion for preliminary injunction, it was doubted whether the reissue patent was not in terms broader than the original, although obtained but fourteen months after the grant of the original, the motion was denied. *Brewster v. Parry*, 14 Fed. Rep., 694.

§ 3101. On an application for preliminary injunction, a reissued patent containing claims not in the original patent, and alleged to be infringed by the defendant, is to be treated as a new patent, so far as their standing as to acquiescence and acceptance by the public is concerned. *Irwin v. McRoberts*, 16 O. G., 853.

§ 3102. Where there was a delay of ten years between the original patent and the reissue, a controversy as to the validity of the reissue and as to the infringement, no decision of any court establishing the validity of the patent, no royalty or license fees paid to the patentee, no general use or public recognition, no present manufacturing or sale of the patented article, and no allegation of irresponsibility on the part of the defendants, a preliminary injunction will be refused. *Tillinghast v. Hicks*, 23 O. G., 739.

§ 3103. Where the only claim of the reissue sued on was held valid, but the reissue itself, which was a divisional reissue of a single prior reissue, was held to be an unjustifiable attempt to enlarge the scope of the original invention, a provisional injunction was refused. *Western Union Telegraph Co. v. Baltimore & O. Telegraph Co.*, 25 Fed. Rep., 30.

§ 3104. Where the validity of the reissue claim sued upon was doubted, a preliminary injunction was refused. *Gunn v. Savage*, 25 Fed. Rep., 101.

§ 3105. Where there were strong doubts as to the novelty of the invention patented, a preliminary injunction was refused. *Jones v. Hodges*, 1 Holmes, 37.

§ 3106. Where the novelty of the patent was in doubt, a preliminary injunction was refused, but defendant required to file bonds, infringement being shown. *New York Belting & Packing Co. v. Magowan*, 23 Fed. Rep., 596.

§ 3107. Doubts being entertained whether a patent was not invalid for want of novelty in the invention, a preliminary injunction was refused. *Fales and Chipman v. Wentworth*, 1 Holmes, 96.

§ 3108. Where, on motion for preliminary injunction, evidence of want of novelty of patent sued on was produced, sufficient to raise a doubt as to its validity, *ex parte* affidavits by plaintiff as to priority of invention over the anticipating patent cited, held insufficient to dispel the doubt, and the injunction was refused. *Illingsworth v. Spaulding*, 9 Fed. Rep., 154.

Injunction — Preliminary — Refused on ground of irreparable injury, §§ 3109-3118.

§ 3109. Where the interest of the patentee plaintiff was that his machine should be in use, and his profit was a license fee for such use, and defendant would have been irreparably in-

jured by enjoining his use of it, and the validity and continued possession of the patent not having been established, a preliminary injunction was refused, but defendant was ordered to keep an account. *Batten v. Silliman*, 3 Wall. Jr., 124.

§ 3110. Where defendants were admitted to be fully responsible for the profits and damages, did not vend but only used the machine complained of, damage to plaintiff would not be serious, but would be most serious to defendants, and the validity of plaintiff's patent, which was to expire soon, was somewhat uncertain, and there was no evidence of fraud on defendants' part, a motion for preliminary injunction was refused. *Morris v. Lowell Mfg. Co.*, 3 Fish., 67.

§ 3111. The fact that a defendant is using a machine openly made and sold under patents, and which the manufacturers have in good faith put in open competition with the machines made by complainant, honestly believing that they were not trespassing on any rights of complainant, though no defense if he is adjudged at final hearing to infringe, is a reason why the court should hesitate to interfere before the final decree in a case where there is no suggestion of any irremediable injury in the intervening time, or any want of ability to respond to any judgment which may finally be recovered. *Burleigh Rock-Drill Co. v. Lobdell*, 1 Holmes, 450.

§ 3112. Where the alleged infringing machine was a single machine, not constructed for sale, but for defendant's use, and such use could be fully compensated for in the event of a decree in favor of plaintiffs, and it appeared that an injunction would seriously affect defendant without benefiting plaintiffs, a preliminary injunction was refused. *Morris v. Shelbourne*, 8 Blatch., 266.

§ 3113. Where, on application for preliminary injunction, no exclusive possession nor acquiescence was shown, nor any verdict or judgment recognizing complainant's claim, and the injury arising not being of an irreparable nature, the motion was refused. *Earth Closet Co. v. Fenner*, 5 Fish., 15.

§ 3114. It is not a matter of course, upon the presentation of a patent which *prima facie* establishes the right of the patentee to the thing patented, accompanied by an allegation that the defendant is violating it, that a preliminary injunction will issue; but it must appear likewise that if the writ of injunction does not now issue the complainants will be irreparably injured, and that no subsequent decree of the court can sufficiently ascertain and make good their damages. *Pullman v. Baltimore & Ohio R. Co.*, 4 Hughes, 236.

§ 3115. Irreparable damage is an indispensable element upon an application for a provisional injunction; and where complainants did not desire to enjoin defendants provided they would accept a license and pay damages at the same rate as other licensees, and defendants were responsible and would be seriously injured, a preliminary injunction was refused with leave given to apply for a further order requiring defendants to enter into bond with sureties. *New York Grape Sugar Co. v. American Grape Sugar Co.*, 10 Fed. Rep., 835.

§ 3116. Where the particular use complained of, crushing stone for a cemetery, could not properly be said to be for the profit of any one, but was for the convenience of the public; and since it appears that the plaintiff derives profit not from using the machines, but by royalty dependent upon their size, which royalty the defendants tender, to abide the event of the suit, there is no irreparable injury to justify the preliminary injunction. *Blake v. Greenwood Cemetery*, 14 Blatch., 342.

§ 3117. Motion for a preliminary injunction denied where the plaintiff under his patent was making and selling the patented machines, but not using, and the damage in effect amounted to a royalty, and where the injunction would operate harshly upon the defendant, embarrassing his business, without corresponding advantage to the plaintiff. *Hoe v. Boston Daily Advertiser Corporation*, 14 Fed. Rep., 914.

§ 3118. A preliminary injunction is granted only to restrain injury in its nature irreparable; there being no such danger, the motion for a preliminary injunction was refused. *Zinsser v. Cooledge*, 17 Fed. Rep., 538.

Injunction — Preliminary — Refused for laches in bringing suit, §§ 3119-3126. See *Delay, in Bringing Suit*, §§ 1883-1900.

§ 3119. Where a motion for preliminary injunction was made a year subsequent to the beginning of the suit, just before final hearing, based on a decision sustaining the validity of the patent sued upon, made in another circuit six months prior to the bringing of the suit, held, there was no sufficient explanation of the laches, and the motion was denied. *Andrews v. Spear*, 4 Dill., 472.

§ 3120. Where, on motion for preliminary injunction, it appeared that plaintiffs, with knowledge of the infringing use, had delayed eighteen months in bringing suit, it was held sufficient laches for a refusal of the motion; and it appearing further that deprivation to plaintiffs was of the value of license to use one machine alone, while the grant of the injunction would greatly damage defendant's business, and there had been no trial establishing the validity of the patent, an injunction was refused. *Hockholzer v. Eager*, 2 Saw., 361.

§ 3121. Where, upon motion for a preliminary injunction, made nearly a year after beginning of suit, based on a decision elsewhere sustaining the validity of the patent, it appearing that such decision was rendered more than six months before the beginning of the suit, *held*, that after so long a delay, it was not a sufficient reason for the grant of the injunction. *Andrews v. Spear*, 3 B. & A., 82.

§ 3122. Where complainants had acquiesced for some time in defendant's manufacture of the infringing machine, and produced no sufficient reason therefor, and infringement being doubted, a motion for a preliminary injunction was denied. *Ballou Shoe Machine Co. v. Dizer*, 5 B. & A., 540.

§ 3123. Two years' use by defendant of the complainants' patent with the latter's knowledge, who took no steps to stop it, sufficient to defeat a motion for a preliminary injunction. *Spring v. Domestic Sewing Machine Co.*, 16 O. G., 721.

§ 3124. Motion for preliminary injunction denied, the defendant having been doing for seven years what is now complained of, and a suit at law instituted three years previous having been allowed by the plaintiff to remain unprosecuted, it also appearing that plaintiff granted licenses under his patent, and that defendant was pecuniarily responsible. *United Nickel Co. v. New Home Sewing Machine Co.*, 17 Fed. Rep., 528.

§ 3125. Where complainant had known of defendant's infringement, and had acquiesced in the same for some time, a preliminary injunction was refused in the absence of any explanation of such acquiescence, but leave was given to file affidavits explaining it. *Mundy v. Kendall*, 23 Fed. Rep., 591.

§ 3126. Where it appeared that defendant had openly used the infringing article for seven years prior to the bringing of the suit, and with the knowledge of complainant, a preliminary injunction was refused. *Ladd v. Cameron*, 25 Fed. Rep., 37.

Injunction — Preliminary — Refused; right never established at law, §§ 3127-3143.

§ 3127. Where plaintiff's right had never been established at law, and was disputed by others beside defendant, and had never been acquiesced in by the public, a motion for preliminary injunction was refused. *Serrell v. Collins*, 4 Blatch., 62.

§ 3128. Motion for preliminary injunction, *pendente lite*, denied with reference to certain of the patents in question which had never been made the subject of final adjudication. *Steam Gauge & Lantern Co. v. Miller*, 8 Fed. Rep., 314.

§ 3129. Where the patent sued on has not been established on trial, nor has the exclusive right been acquiesced in by the public, plaintiff's right must be clear and free from doubt, and the violation of his right by defendants equally so, to authorize the grant of a preliminary injunction; and defendants having acted under a patent with the knowledge and acquiescence of plaintiff for some time, the injunction was refused. *North v. Kershaw*, 4 Blatch., 70.

§ 3130. Where, on motion for a preliminary injunction brought separately against an agent, where his principal's patent had been sustained in a former suit, and it appeared that the question of infringement to be tried was very similar to a question of infringement in former suits, which was not held to be one, and such question was about to be reheard, the injunction was denied and the motion continued to final hearing. *Hayes v. Bickelhaupt*, 32 O. G., 136.

§ 3131. Where defendant justified under a patent, *held*, that, having shown a *prima facie* right to continue his manufacture, founded on a decree of the patent office and consequent public grant, the court would not decide the merits on *ex parte* affidavits, and a preliminary injunction was refused. *Goodyear v. Dunbar*, 3 Wall. Jr., 310.

§ 3132. Where defendant licensee, under a misapprehension of his rights, unwittingly entered into a contract in the performance of which he committed a breach of express conditions of his license, a preliminary injunction was refused, and held that a compensation for the damages sustained would afford a fit remedy. *Wilson v. Sherman*, 1 Blatch., 536.

§ 3133. Where the defendants were three, one only a director of the infringing corporation, but without power alone to prevent the infringement, a motion for preliminary injunction was refused. *Jones v. Osgood*, 6 Blatch., 435.

§ 3134. A preliminary injunction refused, where there was a substantial controversy as to the equities of the parties — the violation of a license — upon a simple motion which did not permit of those equities being inquired of and defined according to the approved usages of chancery. *Smith v. Cummings*, 1 Fish., 152.

§ 3135. Where A. licensed B. & Co., of New Jersey, for a certain sum paid in advance, to use a patented invention for making a given quantity of silk during the term of the patent, and subsequently, on the withdrawal of one of the two members of the firm, after assigning all his rights to the remaining member, the latter transferred the machine to defendants' works elsewhere, under agreement with him, *held*, that the license contained no limitation of time or place, but only of quantity, and in view of the consideration paid therefor, and of defend

ants' otherwise undoubted right, a preliminary injunction on the ground of change in the firm was denied. *Myers v. Dunbar*, 8 Blatch., 448.

§ 3136. Where several suits brought by the same plaintiff against different defendants for infringement of the same patent are all defended by the same parties, the fact that after the denial of motions for injunctions in some of them, and before the submission of motions for injunctions in others, the proofs for final hearing on the part of the defendants in the former were taken and the cases made ready for trial, so far as the defendants were concerned, is a sufficient reason for not granting preliminary injunctions in the latter cases. *Wooster v. Howe Machine Co.*, 16 O. G., 314.

§ 3137. Where defendant denied that patentee was the inventor of the patent sued on, a motion for a preliminary injunction was denied. *American Carpet-Lining Co. v. Beale*, 5 B. & A., 529.

§ 3138. Where a preliminary injunction to the same effect was in force in a prior suit in the same court on the same patent and between the same parties, a second preliminary injunction was refused. *Gold & Stock Telegraph Co. v. Pearce*, 19 Fed. Rep., 419.

§ 3139. The conduct of the plaintiff and its proceedings heretofore with respect to its litigations and to Dittmar do not appear to have been such as would deprive the plaintiff of the right to a preliminary injunction against Dittmar and the Dittmar Powder Manufacturing Company, and the same is granted. *Atlantic Giant Powder Co. v. Dittmar Powder Manufacturing Co.*, 17 Blatch., 531.

§ 3140. Where, on application for preliminary injunction against a licensee, it appeared on affidavits that complainant, licensor, had secretly undersold the schedule rates established by it, in fraud of the rights of defendant as licensee, and that the grant of the injunction would injure defendants more than it would benefit complainant, it was refused, but upon terms as to security, etc., in view of counter-affidavits of complainant alleging similar acts by defendant. *Washburn & Moen Mfg. Co. v. Scutt & Co.*, 22 Fed. Rep., 710.

§ 3141. Where, on application for preliminary injunction, it appeared that complainant, licensor, had fraudulently concealed certain settlements from its licensee, defendants, as well as sold below schedule rates in fraud of them, and that in view of the competition of unchecked infringers, complainant would not be benefited, the application was denied. *Washburn & Moen Mfg. Co. v. Cincinnati Barbed Wire Fence Co.*, 22 Fed. Rep., 712.

§ 3142. Where, on motion for a preliminary injunction, an attempt was made to have the court determine the question of the construction and infringement of a patent, raised for the first time, the motion was refused, although the patent was to expire shortly. *Gold & Stock Telegraph Co. v. Commercial Telegraph Co.*, 22 Fed. Rep., 838.

§ 3143. Where plaintiff claimed an equitable title by assignment, in certain patents, but the affidavits showing said title and those denying it did not leave the question free from reasonable doubt, and the question of title was at the time in course of investigation by a state court of competent jurisdiction, a preliminary injunction to restrain the alleged infringement was denied. *Continental Store Service Co. v. New York Store Service Co.*, 31 O. G., 1561.

Injunction — Preliminary — *Prior decision sustaining patent in respect to grant of*, §§ 3144-3154. See *Construction of Patents*, §§ 1213, 1216.

§ 3144. The decision of a *bona fide* contest in which the validity of a patent has been sustained is held to put the complainant so far in possession of his right as to entitle him to a preliminary injunction in a subsequent suit on the same patent. *Penna. Salt Co. v. Myers*, 1 Weekly Notes, 377.

§ 3145. Where, on motion for preliminary injunction, an objection that complainants should first establish their rights at law was overruled, the patents having been already frequently sustained in prior decisions. *Goodyear v. Hullihen*, 2 Hughes, 492.

§ 3146. Where a patent had been frequently sustained in the circuit and supreme court, the court refused to entertain any question as to its originality or validity of its reissue raised on a motion for preliminary injunction. *Gibson v. Betts*, 1 Blatch., 163.

§ 3147. The court will seldom hear any evidence, except on the question of infringement, upon a motion for a preliminary injunction, if the patent has been sustained in three previous cases, especially when the defendant was interested in the defense of one of them. *Robertson v. Hill*, 4 O. G., 132.

§ 3148. An adjudication in favor of a patent at final hearing, after full consideration, must be held controlling upon an application for a preliminary injunction, unless cogent evidence is presented in addition to that which was found insufficient upon the final hearing. *Jones v. Merrill*, 8 O. G., 401.

§ 3149. Where a case is pending in another court involving the validity of the patent which had not been adjudicated on in the court where the motion for preliminary injunction is

brought, and that case has progressed to final hearing and is before the court for adjudication in such other circuit, the court will out of courtesy probably decline to hear such motion. *Atlantic Giant Powder Co. v. Goodyear*, 13 O. G., 45.

§ 3150. Upon a motion for preliminary injunction, and in the absence of an acquiescence by the public in the validity of plaintiffs' patent, the court is confined within the limits of previous adjudications, and ought not, by granting the motion, to give a new construction to previously construed claims, unless such construction is perfectly clear. *Steam Gauge & Lantern Co. v. Miller*, 11 Fed. Rep., 718.

§ 3151. Where a motion is made for a preliminary injunction for an alleged infringement of a patent which has been held valid without collusion in a contested patent case, the validity of the patent will be considered settled for the purposes of the motion. *Coburn v. Clark*, 15 Fed. Rep., 804.

§ 3152. Where, however, the decision does not show what claims were held valid, nor what would be an infringement, the following questions are left open, viz.: (1) What are the contrivances covered by the patent? (2) Has the defendant infringed the same? *Ibid.*

§ 3153. Where a preliminary injunction on a patent was obtained in one circuit on affidavits and confirmed on rehearing, and afterwards a settlement was made and a decree entered by consent against defendant, it was held not such an adjudication upon the patent as should lay the foundation for a preliminary injunction in another circuit. *Warner v. Bassett*, 19 Blatch., 145.

§ 3154. A preliminary injunction will not be refused by reason of the fact that on a suit brought by the former owners of a patent it was declared invalid, where it also appears that it has been repeatedly sustained in other suits, and that there is important additional testimony which was not before the court rendering the adverse decision. *United States Stamping Co. v. King*, 17 Blatch., 55.

Injunction — Preliminary — *Presumption raised by grant of subsequent patent*, §§ 3155, 3156.
Decision of patent office on interference, §§ 3157-3161.

§ 3155. The grant of subsequent letters patent to another inventor is virtually a decision of the patent office that there is a substantive difference between it and a prior patent. It raises a presumption that it is no infringement of the prior patent, which presumption is not to be disregarded on a motion for preliminary injunction. *American Nicholson Pavement Co. v. City of Elizabeth*, 4 Fish., 189.

§ 3156. While the fact that the defendant has obtained a patent for his process is not controlling in proceedings for an injunction, it is entitled to some weight. *Jones v. Merrill*, 8 O. G., 401.

§ 3157. On a motion for a preliminary injunction, question being raised whether the patentee's description would make the product claimed by him, and it appearing that this point was decided in favor of the patentee by the patent office on a direct issue between him and another patentee whom the defendants represented, *held*, for the purposes of the motion, that the product claimed could be obtained by following the description of the patent. *Holliday v. Pickhardt*, 12 Fed. Rep., 147.

§ 3158. The action of the patent office upon an interference in the office is sufficient to make such a *prima facie* case as to justify the action of a court on almost any motion for a preliminary injunction. *Yuengling v. Johnson*, 1 Hughes, 607.

§ 3159. The successful party to an interference is entitled to preliminary injunction against the representatives of the defeated party in case the infringement is clear, and the decision of the patent office in an interference between the parties as to the identity of the products, sufficient proof of infringement. *Holliday v. Pickhardt*, 12 Fed. Rep., 147.

§ 3160. The decision of the patent office upon an interference proceeding is sufficient to entitle the successful party, as against the defeated party or his privies, to a preliminary injunction upon the question of priority of invention. *Smith v. Halkyard*, 16 Fed. Rep., 414.

§ 3161. The decision upon an interference is not conclusive in suits upon the patent granted in pursuance of it, but it is a sufficient foundation for a preliminary injunction against the losing parties and their privies to prevent infringement of it. *Celluloid Mfg. Co. v. Chrolithian Collar & Cuff Co.*, 32 O. G., 383.

See *Interference*, § 3435.

Injunction — Preliminary — *Is addressed to the discretion of the court*, §§ 3162-3164; *except where validity and infringement are clear*, § 3165. *On motion for, the court will not decide doubtful questions*, §§ 3166-3168. *Prior adjudications*, §§ 3169-3172. *Want of novelty must be clearly proved*, §§ 3173-3175. *Acquiescence in infringement a ground for refusal*, §§ 3176-3179.

§ 3162. The grant of a preliminary injunction lies in the discretion of the court. *Earth Closet Co. v. Fenner*, 5 Fish., 15; *Irwin v. Dane*, 2 Biss., 442.

§ 3163. Preliminary injunctions are not matters of course in patent cases, and will not be granted unless on clear proof of impending mischief; of that the defense is a mere pretense. *Batten v. Silliman*, 3 Wall. Jr., 124.

§ 3164. A motion for a preliminary injunction is always an appeal to the discretion of the court, and in patent cases should be exercised only when complainant's title and defendant's infringement are admitted, or are so clear and palpable that the court can entertain no doubt on the subject. *Bailey Wringing Machine Co. v. Adams*, 3 B. & A., 96.

§ 3165. The court has no discretion, but is bound to grant a preliminary injunction, where the validity of the complainant's patent has been established by protracted and expensive litigation and the proof of infringement clear. *Green v. French*, 16 O. G., 215.

§ 3166. On motion for preliminary injunction the court is not bound to decide doubtful and difficult questions of law, etc., before the alleged offender shall have an opportunity of a full and fair hearing. *Parker v. Sears*, 1 Fish., 93.

§ 3167. A preliminary injunction in patent cases ought not to be granted where there are new and difficult questions to be decided, or where there is anything in the position or relations of the parties which would cause it to operate unjustly. *Union Paper Bag Machine Co. v. Binney*, 5 Fish., 166.

§ 3168. The court will not decide doubtful questions as to complainant's right upon a motion for a preliminary injunction. *New York Grape Sugar Co. v. American Grape Sugar Co.*, 10 Fed. Rep., 835.

§ 3169. Where a patent has been sustained in prior adjudications, on a motion for preliminary injunction, its validity will be considered as *prima facie* established. *Goodyear v. Honsinger*, 2 Biss., 1.

§ 3170. Upon a motion for a preliminary injunction to restrain the infringement of a patent, the court will accept and follow an adjudication sustaining the patent made in another circuit on a full hearing and after a full consideration. *Cary v. Lowell Mfg. Co.*, 32 O. G., 1009.

§ 3171. The patent having been sustained after exhaustive contest and upon final hearing in a prior suit against a corporation intimately connected with the present defendant (*Colgate v. Western Union Telegraph Company*, 14 O. G., 943), it is incumbent upon such defendant, in adducing new matter in resistance of a motion for preliminary injunction, to make it extremely probable, at least, that, if the new matter had been put in evidence in the former case, a different result would have been reached by the court. *Colgate v. Gold & Stock Telegraph Co.*, 16 Blatch., 503.

§ 3172. When, upon motion for preliminary injunction, it appears that the patent upon which suit is brought has been twice sustained on final hearing in actions before different courts, in one of which the defendant in the suit in controversy was defendant, a construction will not be given the patent different from that given in such former actions, nor will the motion be denied by reason of doubts as to its validity, when the evidence in opposition to the motion might have been adduced by the defendant in such former action. *Clarke v. Johnson*, 16 Blatch., 495.

§ 3173. On a motion for preliminary injunction, plaintiff is entitled to the benefit of any doubts on the question of the novelty of his patented invention. *Onderdonk v. Fanning*, 4 Fed. Rep., 148.

§ 3174. Where there is reasonable doubt as to the novelty of the patent or its infringement, a preliminary injunction will not be granted. *Winans v. Eaton*, 1 Fish., 181.

§ 3175. Alleged anticipation of the invention, either by the defendants or by others known to them, while they were applicants for patent, must be made clearly to appear in order to prevent the grant of a preliminary injunction. *Celluloid Mfg. Co. v. Chrolithian Collar & Cuff Co.*, 32 O. G., 383.

§ 3176. It is a general principle of equity jurisprudence that the court will not lend its extraordinary aid, by way of preliminary injunction, to any claimant who has encouraged or acquiesced in an infringement of his right, or unreasonably delayed in prosecuting for its violation. Compensation for damages accrued, and protection from future damages, is all such a complainant is entitled to. This provided for by a bond. *Jones v. Merrill*, 8 O. G., 401.

§ 3177. Where, on motion for preliminary injunction, it appears that plaintiff has acquiesced in the infringement, such laches is fatal to the motion; and the loss of the patent is no excuse. *Cooper v. Mattheys*, 8 Law Rep., 413.

§ 3178. Long acquiescence of patentee in infringing use of his invention is ground for denying a preliminary injunction. *Parker v. Sears*, 1 Fish., 93.

§ 3179. The court will not lend its help by way of preliminary injunction in those cases where it appears that the complainant has acquiesced in the infringement and unreasonably delayed suit against infringers. *Green v. French*, 16 O. G., 215.

Injunction — Preliminary — Generally, §§ 3180-3196.

§ 3180. On motion for preliminary injunction, the court will not look further into the case than is necessary to establish upon principles of equity the right thereto. *Sickles v. Young*, 3 Blatch., 293.

§ 3181. In granting a preliminary injunction the court looks to the particular circumstances to see what degree of inconvenience it would work one or the other party, and whether defendant has voluntarily placed himself in the position to subject himself to such inconvenience. *Sargent v. Seagrave*, 2 Curt., 553.

§ 3182. In preliminary injunctions, the leaning in *doubtful* points must be rather against than in favor of them. *Woodworth v. Hall*, 1 W. & M., 248.

§ 3183. On a motion for preliminary injunction, an inquiry into the validity of the patent should always be avoided, if possible, until final hearing. *Sperry v. Logan*, 3 B. & A., 260.

§ 3184. On a motion for preliminary injunction, the question as to the utility of a patented invention held sufficiently established for its purposes by a prior verdict sustaining the same patent and an injunction granted thereon. *Poppenhusen v. Falke*, 4 Blatch., 493.

§ 3185. The mere assertion of the defendant in the affidavit attached to his answer, that he has no intention of making and selling any of the infringed articles during the pendency of the suit, is not a good reason for withholding an injunction. *White v. Heath*, 10 Fed. Rep., 291.

§ 3186. It is hardly proper to grant a preliminary injunction upon a theory (of mechanical equivalents amounting to infringement) which, although it may be true, is not supported by affidavits. *American Diamond Rock-Boring Co. v. Sullivan Machine Co.*, 14 Blatch., 119.

§ 3187. The suggestion, in defense, that the grant of a preliminary injunction will work injury in an indirect way to third parties, affords no ground for denying the plaintiff that which he has been adjudged entitled to. *Rumford Chemical Works v. Vice*, 14 Blatch., 179.

§ 3188. A party whose patent is about to expire, seeking a preliminary injunction against infringers, is not chargeable with laches, where, being obliged to maintain his rights in the courts, he had but recently obtained an adjudication in their favor. *Ibid.*

§ 3189. That the device patented has never been put on the market as an operative article for sale, nor the patent passed through the ordeal of litigation, nor its validity accepted by the public, are circumstances to be taken into consideration in determining the right of a party to a preliminary injunction. *Irwin v. McRoberts*, 16 O. G., 853.

§ 3190. On motion for a preliminary injunction the complainant should set out and describe what the defendant is doing or using that constitutes the infringement charged, in order that the court may determine whether there is such infringement as to warrant the granting of the motion. A general affidavit amounting to no more than a verification of the original bill will not serve this purpose, being but the opinion of the complainant that the defendant infringes — a fact of which the court should be the judge. *Kirby Bung Mfg. Co. v. White*, 1 McC., 155.

§ 3191. The mandate of the writ for preliminary injunction should go no further than the allegations of the bill. *Barker Mfg. Co. v. Washburn & Moen Mfg. Co.*, 18 Fed. Rep., 172.

§ 3192. Matters not alleged in the bill of complaint cannot be urged as grounds for preliminary injunction. *International Tooth Crown Co. v. Mills*, 22 Fed. Rep., 659.

§ 3193. A party having induced a complainant to acquire a patent and to engage in making and selling articles under it is estopped from contesting the validity of it for the purposes of a motion for a preliminary injunction, and a second party who was cognizant of all the facts and seems to have been the principal promoter of the transaction occupies no better position. *Time Telegraph Co. v. Carey*, 19 Fed. Rep., 322.

§ 3194. On grant of a preliminary injunction which may lead to serious injury, security can be required of applicant to indemnify defendant should his patent be held void. *Morse v. O'Reilly*, 6 Penn. L. J., 501.

§ 3195. Where no question is made as to infringement or priority, or as to the novelty or patentability of the invention, and where the public generally have acquiesced in the claim of the patentee to a monopoly, an adjudication by a court of law or equity is not required before a preliminary injunction will be granted. *Weston v. White*, 13 Blatch., 448.

§ 3196. Under the rules of the supreme court (1847), defendant is not bound to answer an original bill for relief in the absence of interrogatories, and on not answering he is not in default, and no decree *pro confesso* can be taken against him. On a motion for preliminary injunction he may show that the bill is defective upon its face. *Wilson v. Stolly*, 4 McL., 273.

See *Affidavits*, § 172.

Injunction — Preliminary — Violation, §§ 3197, 3198. Dissolution, §§ 3199-3202.

§ 3197. Where a preliminary injunction in a patent case is violated the respondents will not be required to pay the patentee the amount of his royalty, where they were acting in an official

capacity, deriving no personal benefit from the infringement, especially if there be any reason to believe they acted in good faith. *Phillips v. City of Detroit*, 2 Flip., 92.

§ 3198. Motion for attachment will lie against parties violating a preliminary injunction by using merely colorable variations of the patented invention. *Atlantic Giant Powder Co. v. Ditmar Powder Manufacturing Co.*, 20 O. G., 1380.

§ 3199. Courts should not be hasty or inconsiderate in granting injunctions at the instance of the holders of such patents against other manufacturers of similar goods. Preliminary injunction accordingly dissolved, leave to make motion to such effect, based on suitable affidavits, being granted at the time of the injunction. *Wilson Packing Co. v. Clapp*, 8 Biss., 154.

§ 3200. The defendant having neither made nor sold goods in the similitude of complainants' goods within the district where suit was brought, the preliminary injunction was dissolved; ordinarily such process cannot run beyond the district from whence it issues. *Ibid.*

§ 3201. Where defendants moved to dissolve a preliminary injunction, on the ground of assignment by complainant of all his rights under the patent, made since the grant of the injunction, and the facts were not denied, the motion was overruled. *Thompson v. Barry*, 2 Weekly Notes, 100.

§ 3202. Where the validity of the reissue claims for the infringement of which a preliminary injunction had been granted was not sufficiently established in view of the original patent, a motion to dissolve the injunction was granted. *Steam Gauge & Lantern Co. v. Miller*, 11 Fed. Rep., 718.

Injunction — Provisional — *When granted*, §§ 3203-3206. *When refused*, §§ 3207, 3208.

§ 3203. For the purposes of a provisional injunction under the patent law, infringement having been proved, two things, or either of two things, may exist, to wit, a final decree sustaining and upholding the validity of the patent after full consideration of the matter or proof that the patent went into use undisputed for a sufficient time to raise a *prima facie* case in the complainant's favor. *Kirby Bung Mfg. Co. v. White*, 1 McC., 155.

§ 3204. Where the validity of the patent has been established in prior adjudications as well as the title thereto, and defendants admit the use of the invention but deny the title thereto, an injunction will be granted. *Parker v. Brant*, 1 Fish., 58.

§ 3205. Where complainant has been in extensive and undisputed use of three several patents for many years past, with public acquiescence therein during all that time, a provisional injunction should be granted unless facts appear which take the case out of the ordinary rule. *McKay v. Dibert*, 5 Fed. Rep., 587.

§ 3206. If the complainant's patent has been sustained in a suit, to the defense of which the defendants contributed, he is entitled to a provisional injunction against them, although they allege in their answer that they have a witness to the prior use of the invention who was not examined on the former trial. The alleged testimony of such a witness will not prevent the issue of the provisional injunction, whatever may be its effect on the final hearing. *Birdsell v. Hagerstown Agricultural Implement Manuf'g Co.*, 6 O. G., 604.

§ 3207. A provisional injunction may not be obtained *simpliciter* without giving bond or security when a party has only some vague and indistinct right, and the order may result in injury to the business of the defendant, which is not necessary for the maintenance of the complainants' demand, and may be ruinous to the defendants. *Blake v. Boisselier*, 16 O. G., 854.

§ 3208. General consideration of grounds on which a provisional injunction will be refused. *Day v. New England Car Spring Co.*, 3 Blatch., 154.

Injunction — Provisional — *Particular cases; granted*, §§ 3209-3212.

§ 3209. Where, on application for provisional injunction, the validity of the patent was sustained, and there was evidence of continued possession thereunder, with acquiescence of the public therein, and judgments at law and decrees in equity in which parties had already been enjoined, an injunction was granted. *Potter v. Hollender*, 4 Blatch., 238.

§ 3210. Where plaintiff had established his right at law, and obtained an injunction against the use of his patent on a certain vessel, a provisional injunction was granted against its use on another, although claimed to have been adopted by defendant in good faith. *Sickles v. Tileston*, 4 Blatch., 109.

§ 3211. Where in a prior suit defendant's machine was adjudged an infringement of plaintiff's valid patent, defendant's machine was adjudged an infringement for the purposes of a provisional injunction, in the absence of an affidavit of defendant that the machine complained of was not an infringement, an affidavit to that effect by his solicitor being held insufficient. *Conover v. Mers*, 3 Fish., 386.

§ 3212. The owners of reissue No. 5,799 are not deprived of the right to ask for a preliminary injunction to restrain an infringement by the fact that they have prosecuted a suit in equity against the same defendants for an infringement of reissue No. 4,818, of which they were also owners by the use of the "rendrock powder;" have taken testimony to show an infringement of No. 4,818, but not of No. 5,799; have notified the defendants that they need not, until further notice, make proof in the latter case, and subsequently, having successfully prosecuted suits on No. 5,799 in another court, have discontinued the suit on No. 4,818 and prosecuted this on No. 5,799 alone. *Atlantic Giant Powder Co. v. Rand*, 16 Blatch., 250.

Injunction — Provisional — Particular cases; refused, §§ 3213-3219.

§ 3213. On a motion for provisional injunction, a verdict on an issue framed in the case failing to convince the court, was disregarded, evidence as to infringement considered, the infringement held not to exist and the motion denied. *Sickles v. Young*, 3 Blatch., 293.

§ 3214. A patent, though *prima facie* evidence of the validity of the grant, held insufficiently strong *per se*, without evidence of exclusive possession for some time, or an adjudication sustaining its validity, to warrant the grant of a provisional injunction; and the exclusive possession being of one month only, and that prior to the patent being no exclusive possession as against the public, a provisional injunction was refused. *Toppan v. National Bank Note Co.*, 4 Blatch., 509.

§ 3215. Where the patent on which suit was brought was in part anticipated, and the new part not sufficiently distinguished therefrom, a motion for a provisional injunction was denied. *Jones v. Osgood*, 6 Blatch., 435.

§ 3216. Where, on motion for provisional injunction, it appeared that the patent had never been established at law or in equity, there was no evidence of public acquiescence and there had been three years' delay in bringing suit, the motion was refused, although infringement was clear, but defendant was required to keep an account and give security. *Sykes v. Manhattan Elevator and Grain Drying Co.*, 6 Blatch., 496.

§ 3217. Where A., assignor of complainant, had never done anything with his patent during its extended term in the state where suit was brought, and defendants had bought machines in ignorance of his rights, held, that assignee was, for the purpose of the suit, subject to all the equities that might have been set up against his assignor; and held further, that on the above grounds, and because the existence of prior machines then set up was the subject of different issues from those in a former suit sustaining the validity of the patent, provisional injunction was refused. *Gear v. Holmes*, 6 Fish., 595.

§ 3218. Where, on motion for provisional injunction, the patent sued on was a division of the fourth reissue of the original patent, and the validity, novelty and infringement of its claims were questioned, held, that at this stage the court ought not to undertake the decision of fairly disputable questions of law and fact, and that complainant's title and defendant's infringement were not so clear and palpable that the court could entertain no doubt on the subject, and the motion was refused. *Bailey Wringing Machine Co. v. Adams*, 3 B. & A., 96.

§ 3219. Where patentee claims only a royalty or license fee for the use of his device, the rule here (E. D. of Ohio) is to require defendant to give plaintiff a bond to secure him to the full extent of his demand, and a provisional injunction will not be granted of course, although the patent has been sustained as valid against other infringers. *McMillan v. Conrad*, 16 Fed. Rep., 128.

Injunction — Provisional — In general, §§ 3220-3229. Dissolution, § 3230.

§ 3220. On a motion for provisional injunction the question of originality and validity of a patented machine which has been examined and sustained in the supreme and circuit courts was considered settled, and the only question allowed to be raised was that of infringement. *Van Hook v. Pendleton*, 1 Blatch., 187.

§ 3221. Where in prior suits there had been a verdict for each party, and on another trial a divided jury, and there was a strong denial by affidavits of the originality of the invention, the court, on motion for provisional injunction, suspended its decision, sent the questions of novelty and infringement to jury, with direction for defendants to account and report in the mean time. *Allen v. Sprague*, 1 Blatch., 567.

§ 3222. Notice to plaintiffs of defense to a motion for provisional injunction is not necessary. Defendants are entitled to make it by answer or depositions when the motion is brought on. *Day v. New England Car Spring Co.*, 3 Blatch., 154.

§ 3223. A mere decree entered *pro forma* on the merits is not sufficient of itself to require other United States circuit courts to grant a provisional injunction. *Kirby Bung Mfg. Co. v. White*, 1 McC., 155.

§ 3224. Exclusive possession prior to grant of patent must be as against the public, in order to constitute such public acquiescence as to entitle to a provisional injunction after grant of patent. *Toppan v. National Bank Note Co.*, 4 Blatch., 509.

§ 3225. Upon motion for a provisional injunction, the party who relies upon a verdict and judgment of a court of law to establish his title should aver in the bill that such proceedings have been had. *Parker v. Brant*, 1 Fish., 58.

§ 3226. On motion for provisional injunction defendant will be allowed to file his answer, and affidavits in behalf of both parties will be examined. *Wilson v. Stolly*, 4 McL., 273.

§ 3227. If the rights under the patent are clear, and the infringement by the defendant free from doubt, and particularly after a use for a considerable time, without controversy, of the invention patented, the court will not compel plaintiff in the first instance to proceed at law, on a motion for a provisional injunction. *Shelly v. Brannan*, 2 Biss., 315.

§ 3228. Where, on motion for provisional injunction in suit for infringement, defendant sought to prove laches of complainant in bringing suit, *held*, that satisfactory proof of knowledge or means of knowledge must be shown before laches can be imputed on which such motion would be refused; and such laches will not be imputed where complainant's suspicions are allayed by the direct misrepresentations of defendant. *Wortendyke v. White*, 2 B. & A., 25.

§ 3229. Under the state laws of Missouri there is but one form of a restraining order. If an injunction is asked for provisionally, it must issue as an injunction *simpliciter*. *Kirby Bung Mfg. Co. v. White*, 1 McC., 155.

§ 3230. A provisional injunction dissolved on its being shown by affidavit that the same article as that covered by the patent had been imported into this country before the patentee invented it. *Young v. Lippman*, 9 Blatch., 277.

Injunction — Temporary, §§ 3231-3236.

§ 3231. Where patentee's title has been established under letters patent, a temporary injunction will issue on an extension of the patent without further trial thereof, notwithstanding a denial by defendant of complainant's title. *Clum v. Brewer*, 2 Curt., 506.

§ 3232. If the title to a temporary injunction depends on the construction of a deed, the court will construe it and act accordingly. *Ibid.*

§ 3233. In acting on applications for temporary injunctions to restrain infringement, there is much latitude of discretion, and the application may be granted or refused unconditionally, or terms may be imposed on either of the parties, as conditions for granting or refusing the injunction. *Hodge v. Hudson River R. Co.*, 6 Blatch., 165.

§ 3234. In answering a bill for an infringement, the respondent averred that the invention had been in public use for more than two years, but took no testimony. After the testimony was closed, and the complainant had established his case, the respondent filed affidavits showing a public use, but they were not regarded by the court, and his motion to dissolve the temporary injunction was denied. *Union Paper Bag Machine Manufacturing Co. v. Newell*, 11 Blatch., 549.

§ 3235. When the testimony is closed on a bill for an injunction, if the respondent has not made out a defense the temporary injunction will not be dissolved. *Ibid.*

§ 3236. A temporary injunction will not be granted where, notwithstanding the acquiescence of the public, the defendant can show that a fair and substantial question exists with regard to the validity of the patent. *Bradley & Hubbard Manufacturing Co. v. Charles Parker Co.*, 17 Fed. Rep., 240.

Injunction — General rule as to grant of, §§ 3237-3250.

§ 3237. An injunction will be granted where the bill states a clear right, which with the alleged infringement is verified by affidavit, where there has been continued possession; but not where there is a reasonable doubt as to its validity. *Ogle v. Edge*, 4 Wash., 584.

§ 3238. As a general rule, if plaintiff has made out a clear title, and the question of infringement presents no difficulty, an injunction will be granted. *Potter v. Whitney*, 1 Low., 87.

§ 3239. Where complainant has made out not merely a grant of the patent, but possession and use and sale under it for some time undisturbed, and besides this a recovery against other persons using it, the courts have invariably held that such a strong color of title shall not be deprived of the benefits of an injunction, till a full trial on the merits counteracts or affirms it. *Orr v. Littlefield*, 1 W. & M., 13.

§ 3240. An injunction will be granted on long possession and frequent recoveries, the validity of the patent not being denied. *Woodworth v. Hall*, 1 W. & M., 248.

§ 3241. Where a trial at law had been had resulting in a verdict in favor of patentee, and his right had been fully established to the satisfaction of the court, and infringement was clear, such trial held sufficient without other proof to authorize the grant of an injunction to prevent future violations. *Poppenhusen v. New York Gutta Percha Co.*, 4 Blatch., 184.

§ 3242. Where the patent has been frequently sustained as to novelty and validity, there have been judgments on and recoveries under it, and the infringement is clear, plaintiff is entitled to an injunction under it, although great injury may thereby be caused to the infringer. *Hodge v. Hudson River R. Co.*, 6 Blatch., 165.

§ 3243. Where the validity of the patent is fully established and infringement is clear, a party has a right to an injunction, although it may cause a great injury to the infringer. *Potter v. Fuller*, 2 Fish., 251.

§ 3244. In equity, where the case is clear, the bill shows a clear right to the thing patented, verified as well as the alleged infringement by affidavit, and where there has been possession by having sold or used it in part or in whole, the court will grant an injunction and continue it till hearing or further order without sending plaintiff to law to try his right. *Motte v. Bennett*, 2 Fish., 642.

§ 3245. An injunction against infringing a patent will be granted only when the patentee shows either that he has recovered a judgment on it in a suit, or that he has used and enjoyed his right under it so long as to warrant the presumption that the public have acquiesced in it. *Brown v. Hinkley*, 3 O. G., 384.

§ 3246. While it is unquestionably true that, three things being proved — namely, a patent, long possession, and infringement,—the party is entitled *prima facie* to an injunction, yet even where this is shown the question will be, in cases of opposing evidence, whether this right has been displaced by the respondent. *Cross v. Livermore*, 9 Fed. Rep., 607.

§ 3247. An injunction should not issue when it would work great harm to one party without corresponding benefit to the other, at least where adequate protection can be afforded by other means. *Swift v. Jenks*, 19 Fed. Rep., 641.

§ 3248. If the rights of a party under a patent have been fully and clearly established, and infringement is threatened, or if, having been infringed, there is good reason to believe it will be continued, an injunction will issue. *Poppenhusen v. New York Gutta Percha Co.*, 4 Blatch., 184.

§ 3249. Equity will not enjoin the equitable owner of a patent on the application of the legal owner thereof. *Clum v. Brewer*, 2 Curt., 506.

§ 3250. Where patentee has for some time acquiesced in the use of the patented article by infringers, an absolute peremptory injunction may be denied, although the validity of the patent is established, but a conditional injunction will be issued. *Goodyear v. Honsinger*, 2 Biss., 1.

Injunctions — Granted — *Particular cases*, §§ 3251-3279.

§ 3251. Where there had been long possession, recoveries and favorable verdicts under plaintiff's patent, and defendant admitted using a similar machine, and did not question that patentee was the original inventor, an injunction was granted. *Woodworth v. Hall*, 1 W. & M., 248.

§ 3252. Where complainants had clearly established their right under the patent, by producing it, by use without infringement of the patented device, by action at law sustaining the patent, and finally by its extension, infringement being proven, an injunction was granted. *McComb v. Ernes*, 1 Woods, 195.

§ 3253. Where defendants had no property to answer in damages, plaintiff's right was clear, and there had been long possession, an injunction was granted. *Brooks v. Bicknell*, 3 McL., 250.

§ 3254. Where a clear case of infringement was shown, and long possession strengthened by frequent adjudications sustaining the validity of the patent, which defendants failed to overthrow, an injunction was granted. *Potter v. Muller*, 2 Fish., 465.

§ 3255. The validity of the patent being fully settled, and infringement found, an injunction was granted. *Gibson v. Van Dresar*, 1 Blatch., 532.

§ 3256. Where an injunction was asked to restrain defendants from delivering an infringing article manufactured by them under contract, and defendants, in their answer, alleged that they had offered the option of a reasonable sum or an accounting of profits, and filed an affidavit that, from correspondence, etc., with plaintiff, they had inferred an acquiescence in their proposition, an injunction was granted, allowing them to complete their contract, but not to manufacture further without plaintiff's consent, and forbidding them to dispute any right granted by patentee. *Smith v. Rifle Mfg. Co.*, 3 Blatch., 545.

§ 3257. Where, on motion for injunction, there was no sufficient denial of plaintiff's invention by defendant, nor allegation of knowledge and use for more than two years prior to date

of application, and use of the invention was not denied, the injunction was granted, notwithstanding other allegations of defendant. *Sickles v. Mitchell*, 3 Blatch., 548.

§ 3258. Where plaintiffs were makers but not users of the invention, and the infringement consisted in the use only, and a bill of exceptions involving the validity of the patent had been taken, and the effect of the injunction would cause great detriment to defendants, the injunction was ordered to be issued unless, in a given time, bonds and surety should be given. *Forbush v. Bradford*, 1 Fish., 317.

§ 3259. Where, on motion for injunction, the *prima facie* evidence of the patent was not overcome and the infringement was undoubted, the motion was allowed, although plaintiffs had repeatedly, and at great expense, failed to secure a verdict, owing to the disagreement of the jury. *Buck v. Cobb*, 9 Law Rep., 545.

§ 3260. Licensee of a patentee of a right to use the patented machine for one year held entitled to an injunction against an infringer. *Bramer v. Jones*, 2 Bond, 100.

§ 3261. Where there was an infringement proved, although the defendants had applied for a license, an injunction was granted on the ground that licensing defendants would injure plaintiffs, who were large manufacturers. *Baldwin v. Bernard*, 9 Blatch., 509, note.

§ 3262. Where defendants petitioned for an injunction restraining plaintiff from prosecuting or threatening to prosecute suits against defendants' vendees for the use of machines sold them by defendants, while suit was pending by plaintiff against defendants, the manufacturers, in the court, it appearing that such threats had been made, a decree to such effect was entered against plaintiff. *Birdsell v. Manufacturing Co.*, 1 Hughes, 64.

§ 3263. Where a corporate body had given the plaintiffs an exclusive license to sell machines embodying inventions of which it held the patents, and had agreed to furnish the machines at a stipulated price, it was prohibited from taking measures to dissolve its organization, and its assignee of the patents in trust for a new association was prohibited from disposing of them. *Singer M. Co. v. Union, etc., Co.*, 1 Holmes, 253.

§ 3264. But the corporation was not decreed to perform the contract. *Ibid.*

§ 3265. Where it appeared that defendant had purchased one of the articles complained of from an unlicensed vendor, and the other under a license, an injunction was issued as to the first, the patent being eight years old, and no sufficient doubt as to its validity having been raised. *Howe v. Newton*, 2 Fish., 531.

§ 3266. Where, on motion for injunction in two suits, the validity of two patents was doubted, and the plaintiffs were represented by common counsel and agent, and had common interest, but the legal interest in the two patents was held in severalty, an injunction was allowed as to one patent and refused on the other. *Goodyear v. Hills*, 3 Fish., 134.

§ 3267. A decree for a perpetual injunction awarded without any actual previous disclaimer in the patent office, where patentee signified such intention and the patent was sustained as limited; but held that a court liable to revision on appeal could not go beyond and decree an account before the disclaimer was actually filed. *Aiken v. Dolan*, 3 Fish., 197.

§ 3268. Where, on comparison of the infringing article with the patented invention, the court was satisfied as to the fact of infringement, an injunction was granted, although it appeared on affidavit that a patent was about to issue for the article complained of. *Morse Fountain Pen Co. v. Esterbrook Pen Mfg. Co.*, 3 Fish., 515.

§ 3269. Notwithstanding the use of the infringed combination was stopped upon suit brought, an injunction and account were decreed. The defendants have made no disclaimer of the right to use, nor does it appear that the previous use, though disadvantageous to themselves, was without damage to complainants. Moreover, there may be other evidence as to profits on an accounting. *Bullock Printing Press Company*, 13 O. G., 124.

§ 3270. An injunction granted restraining parties from using an arrangement which had been decided to be an infringement of the plaintiffs' patent in suits against parties supplied with the same by the defendants, who assumed and conducted their defense. *United States & Foreign Salamander Felting Co. v. Asbestos Felting Co.*, 13 Blatch., 454.

§ 3271. When the infringing articles bear the name of the defendant, and the evidence points to the defendant as the principal person engaged in their manufacture, an injunction will not be denied because the defendant holds himself out as the agent for another person. *McWilliams Manufacturing Co. v. Blundell*, 11 Fed. Rep., 419.

§ 3272. The claim in the patent was found in a prior suit to be invalid as broader than the actual invention, and a disclaimer was entered limiting the claim to the construction of the device in those particulars wherein it was found too broad, and, infringement being found, a decree for an injunction and an accounting was granted. *Terry Clock Co. v. New Haven Clock Co.*, 17 O. G., 909.

§ 3273. Where, upon a motion for injunction for infringement, opposition was withdrawn by reason of the bankruptcy of defendant, the court granted the injunction but proceeded

no further, there being no actual contest between the parties. *American Middlings Purifier Co. v. Vail*, 15 Blatch., 315.

§ 3274. The first and second claims of plaintiff's patent being found valid and infringed by the defendant, he should be entitled to a decree for a perpetual injunction and an account of profits and damages, but without costs, upon the presentation to the court of satisfactory evidence that he had filed a proper disclaimer of what is claimed by his fourth claim. *Burdett v. Estey*, 15 Blatch., 349.

§ 3275. Where the silence of plaintiffs or their assignors did not beguile the defendants into a continuation of business, or into renewed or large expenditure, the circumstances do not constitute an estoppel, and an injunction will not be refused. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 Fed. Rep., 638.

§ 3276. Not such an equity arising in favor of the defendant out of the conduct of the plaintiff as will prevent a decree for an injunction. *Ibid.*

§ 3277. Where an agreement between plaintiff and defendant, made prior to entry of final decree, provided in express terms not only for the license, but for a final decree and perpetual injunction, *held*, that the granting of a license was no acquiescence in the breach of the injunction, so as to deprive plaintiff of the right to demand a commitment of the defendants on termination of the license. *Pentlarge v. Beetson*, 18 Blatch., 38.

§ 3278. Where a patentee, who had been defeated on the question of priority as to part of his patent, had been stubbornly litigious, the court not only declared that part of his patent void, but enjoined him from bringing or threatening suits which would be vexatious and cause irreparable damage at law. *Sawyer v. Massey*, 25 Fed. Rep., 144.

§ 3279. Where, on final hearing, proofs showed that defendant had put up the infringing oven and controlled and managed it, and impliedly, if not directly, acknowledged that it was his work, injunction was granted and the case sent to a master to assess damages. *Petersen v. Simpkins*, 33 O. G., 1392. Affirmed; motion for rehearing overruled. *Petersen v. Simpkins*, 33 O. G., 1392.

Injunction — Refused — Particular cases, §§ 3280-3304.

§ 3280. Where, on motion for injunction, it was shown that defendants were residents of another jurisdiction, and carried on there the alleged infringing business, *held*, that they were beyond the process of the injunction, and the motion was denied. *Goodyear v. Chaffee*, 3 Blatch., 268.

§ 3281. Where, on application for injunction for the infringement of a patent, the affidavit of a dealer in the alleged infringing article, which went to establish infringement by its mode of manufacture, was counterbalanced by that of the manufacturer of the article showing its mode of manufacture, the application was denied. *Gutta-Percha & Rubber Mfg. Co. v. Goodyear Rubber Co.*, 3 Saw., 542.

§ 3282. Where defendant's machine infringed, but embodied also valuable non-infringing improvements, an order for account and security was substituted for an injunction. *Stainthorp v. Humiston*, 2 Fish., 311.

§ 3283. A court of equity will refuse an absolute injunction on the ground of defendant's non-performance of conditions in his contract which authorized the use of a machine, but would allow the use upon the future fulfillment of his contract; neither will a verdict founded upon such a forfeiture be sufficient to induce the court to issue an absolute injunction. *Day v. Hartshorn*, 3 Fish., 32.

§ 3284. Where the device — a hose coupling — was necessary for daily use in the city defendant, a decree with order for accounting was granted, infringement being found, but an injunction was withheld. *Bliss v. City of Brooklyn*, 8 Blatch., 533.

§ 3285. The grant of letters patent raises the presumption that the invention so patented is not an infringement of an earlier patent, and where defendants are acting under such later patent, courts will rarely grant an injunction until after final hearing. *Sargent Mfg. Co. v. Woodruff*, 5 Biss., 444.

§ 3286. Where an interference with the infringing use of the patented pavement constructed in the city of Pittsburgh would only operate injuriously on the public, without benefiting complainants, an injunction was refused, but a reference to master to ascertain profits and damages was had. *Ballard v. City of Pittsburgh*, 12 Fed. Rep., 783.

§ 3287. A motion for injunction against the user of a machine refused, because damages and profits had been recovered for the manufacture and sale of the machine from his vendor. *Perrigo v. Spaulding*, 13 Blatch., 389.

§ 3288. Where an injunction was sought against the vendee of a machine, which had been embraced in a previous suit, and recovery against the defendant's vendors, it was held that de-

defendant's rights became fixed at the date of the decree in the prior suit against his vendors, and that its force and effect, as between the parties and their privies, could not be affected by a subsequent agreement between the plaintiff in that suit and the plaintiffs in the present suit. The injunction was accordingly denied. *Ibid.*

§ 3289. An application for an injunction to prevent a junior patentee from prosecuting suits under his patent pending a suit in equity to cancel the same should be refused where it appears that the junior patent was granted after a full hearing before the patent office in an interference with the prior patent. *Asbestos Felting Co. v. United States & Foreign Salamander Felting Co.*, 13 Blatch., 454.

§ 3290. Where complainants were chargeable with knowledge of defendants' acts, but permitted them to continue their manufacture, and, in response to an inquiry as to whether they regarded defendants' process to be an infringement, returned an answer that led defendants to believe that they did not, an injunction was refused. *Jones v. Merrill*, 8 O. G., 401.

§ 3291. Where the complainants had obtained an interlocutory decree for an accounting of gains, profits and damages against the manufacturer of the infringing machines, an unqualified injunction *pendente lite* against the purchaser and user of one of the machines was refused. The defendant, however, was put under bonds. *Gilbert & Barker Mfg. Co. v. Bussing*, 12 Blatch., 426.

§ 3292. On final hearing the complainants might become entitled to a perpetual injunction against such defendant, as they cannot be compelled, against their will, to permit the defendant to use their invention. *Ibid.*

§ 3293. In a suit in which parties who had been joint owners of a patent, but one of whom had assigned his interest to a third party, sought to recover damages for infringement during their joint ownership, *held*, that an injunction could not be granted, as an adequate remedy existed at law, and the court therefore had no equitable jurisdiction. *Spring v. Domestic Sewing Machine Co.*, 22 O. G., 1445.

§ 3294. Where the parties litigant justify under adverse claimants to the same invention, and the controversy remains undetermined in the patent office, so much doubt is cast upon the title of the patentee that an injunction was refused. *National Feather Duster Co. v. Dearborn Duster Co.*, 24 O. G., 497.

§ 3295. Where the object of the bill was to enjoin defendant, plaintiff's licensee, from running the machine he had, which could only be reached by showing an abandonment of the license, and the bill failed to allege the sale relied upon as evidence of the abandonment, an injunction was refused. *Wilson v. Stolley*, 4 McL., 275.

§ 3296. *Held*, that a license with condition not to sell out of a certain territory, or to sell to others to sell out of the territory, was broken by so doing, but the contract under which the breach was committed, having been fully completed, there was no ground for an injunction. *Wilson v. Sherman*, 1 Blatch., 536.

§ 3297. Where complainants averred exclusive ownership of reissued letters patent in the state of New York, but since the filing of the bill had conveyed their title to the patent for that state, *held*, they were not entitled to an injunction against an infringement therein. *Boomer v. United Power Press Co.*, 13 Blatch., 107.

§ 3298. An injunction against infringing refused when the patent had been reissued within two months, with a claim to a combination not set up in the original, and of which there had been no use or enjoyment. *Brown v. Hinkley*, 3 O. G., 384.

§ 3299. Where the validity of the patent was doubtful, owing to insufficient specification, an injunction was refused. *Sullivan v. Redfield*, 1 Paine, 441.

§ 3300. Where defendant in his answer denies plaintiff's right, and recoveries against others and numerous sales and long possession have not been such as to raise a strong presumption of the validity of the patent, an injunction has been usually denied. *Brooks v. Norcross*, 2 Fish., 661.

§ 3301. Where, on motion for injunction, the validity of the patent and novelty of the invention were denied, and there had been no prior adjudication on either point, and exclusive possession was not shown, and defendants were able to respond in damages, the motion was denied. *Jones v. Field*, 12 Blatch., 494.

§ 3302. Where the construction of the patent contended for by plaintiff was different from that given it in prior suits, it was held that there had been no judicial inquiry into the novelty of the invention now claimed by plaintiff, and no public recognition of the validity of the patent, and its novelty, as so construed, being doubted, an injunction was refused. *Mowry v. Grand St. & Newtown R. Co.*, 10 Blatch., 89.

§ 3303. Where the validity and novelty of the patent had been frequently sustained, with judgments on and recoveries under it, and the infringement was clear, an absolute injunction was refused, in view of the fact that defendants had sought to obtain a license by the offer of a reasonable sum and for other reasons. *Hodge v. Hudson River R. Co.*, 6 Blatch., 165.

§ 3304. Although the validity of the patent had been established in another court on the merits, an injunction *simpliciter* refused, for the reason that on *ex parte* showing it did not satisfactorily appear that the defendant should be stopped from doing what was not a clear and positive infringement. *Steam Gauge & Lantern Co. v. St. Louis Railway Supplies Mfg. Co.*, 33 O. G., 889.

See *Purchaser*, § 5182.

Injunction — Undisturbed possession as ground for grant of, §§ 3305-3308.

§ 3305. It is acquiescence in the known user by the public without objection or qualification, and not the extent of the actual user, which constitutes the grounds for refusal of an injunction. *Wyeth v. Stone*, 1 Story, 273.

§ 3306. There is no fixed rule as to the length of time of the possession and enjoyment of a patent necessary to warrant an injunction. It must be sufficient to warrant a presumption in favor of its validity. *Potter v. Muller*, 2 Fish., 465.

§ 3307. The presumption in favor of the validity of a patent arising from long possession is strengthened by prior judicial decisions either at law or in equity sustaining or affirming its validity. *Ibid.*

§ 3308. A patentee may be considered to have been in undisturbed possession under his patent, although it is infringed upon after long enjoyment of it. *Cook v. Ernest*, 2 O. G., 89.

Injunction — Delay in applying for, §§ 3309, 3310.

§ 3309. *Held*, that it was not laches to defeat complainant's right to an injunction, where he waited two years subsequent to the first infringements of his patent, in order to determine its real scope, to reissue it, and then bring suit on the reissue. *American Middlings Purifier Co. v. Christian*, 4 Dill., 448.

§ 3310. A delay of three months in filing a bill for infringement, after ascertaining its existence, is no ground for refusing an injunction. *Union Paper Bag Machine Co. v. Binney*, 5 Fish., 166.

See *Infringement*, § 2903.

Injunction — Practice and pleading, §§ 3311-3323.

§ 3311. Rule of practice as to filing of affidavits by complainant and defendant on application for grant of an injunction. *Day v. Boston Belting Co.*, 16 Law Rep., 329.

§ 3312. Where a motion for an injunction was heard outside the district where the suit was pending, the order withheld until the court should be sitting within the district. *Putnam v. Weatherbee*, 1 Holmes, 497.

§ 3313. In the United States circuit courts restraining orders vary according to the circumstances of the case. Thus, in some cases, patent as well as others, there may be such circumstances as require an injunction *simpliciter*; but ordinarily a bond and order for accounting suffices, and sometimes simply an order for an accounting. *Kirby Bung Mfg. Co. v. White*, 1 McC., 155.

§ 3314. Rule as to verification of a bill for an injunction. *Woodworth v. Edwards*, 3 W. & M., 120.

§ 3315. Where, on a bill to enjoin for infringement, the evidence was conflicting, the court referred to a master to examine and report. *Parker v. Hatfield*, 4 McL., 61.

§ 3316. On motion for injunction to restrain defendant from infringing, the court will require an affidavit to the truth of the allegations in the bill, that petitioner is the original inventor, etc., and that it has not been in public use. *Rogers v. Abbott*, 4 Wash., 514.

§ 3317. On motion for injunction it should be stated and sworn to in the bill, or in an affidavit, that plaintiff is the original inventor. *Sullivan v. Redfield*, 1 Paine, 441.

§ 3318. An answer to an injunction bill, though filed without a rule, will be treated as an answer on a motion for an injunction. *Brooks v. Bicknell*, 3 McL., 250.

§ 3319. Where, on application for injunction, the bill did not allege whether the patent had been in litigation before, or whether it had been acquiesced in or recognized by the public, it was held defective in such particulars. *Gutta-Percha & Rubber Mfg. Co. v. Goodyear Rubber Co.*, 3 Saw., 542.

§ 3320. An injunction granted before a patent is reissued cannot be maintained against the reissued patent without a supplemental bill. *Woodworth v. Stone*, 3 Story, 749.

§ 3321. Where infringement was found, but no injunction was asked on the hearing, the original term of the patent having expired, but the fact of its extension since the beginning of the suit was admitted, *held*, that this needed to be set up by supplemental bill or other proceedings in order to authorize an injunction. *Booth v. Parks*, 1 Flip., 318.

§ 3322. Injunction extended so as to include a new party brought in by supplemental bill. *Parkhurst v. Kinsman*, 2 Blatch., 78.

§ 3323. Where a plaintiff moves for an injunction and it is denied on defects pointed out, it is too late for him to wait until after the defendant has closed his proofs for final hearing before renewing his motion on papers designed to cure such defects. *Wooster v. Howe Machine Co.*, 16 O. G., 314.

Injunction — Previous trial at law, §§ 3324-3333.

§ 3324. History reviewed of English and American equity practice as to trial at law of plaintiff's right prior to grant of injunction in patent cases. *Motte v. Bennett*, 2 Fish., 642.

§ 3325. To entitle a patentee to an injunction before a trial at law, he must show a clear right or exclusive possession. *Thomas v. Weeks*, 2 Paine, 92.

§ 3326. It is not essential that the validity of a patent be established at law before an injunction can be granted. *Sickles v. Mitchell*, 3 Blatch., 548.

§ 3327. It is no objection to the grant of an injunction that a jury has not passed upon the case. *Potter v. Fuller*, 2 Fish., 251.

§ 3328. Injunctions are granted without previous trial at law, where owner of patent shows a clear case of infringement and possession of exclusive right for a term of years without any successful impeachment of its validity. *Potter v. Muller*, 2 Fish., 465.

§ 3329. Section 17, act 1836, which gives the circuit courts power to grant injunctions according to the courses and principles of courts of equity does not require a prior trial at law to determine applicant's right. *Motte v. Bennett*, 2 Fish., 642.

§ 3330. Where there has been exclusive possession of some duration, an injunction will be granted, without previously putting the party to the proof of its validity. Where recently granted, its validity must first be established at law. *Sullivan v. Redfield*, 1 Paine, 441.

§ 3331. Where a patent has been granted, and there is an exclusive possession of some duration under it, an injunction will be granted, without previously establishing validity of patent at law. *Washburn v. Gould*, 3 Story, 122.

§ 3332. Where there was no conflict of evidence as to infringement, and a jury trial would have involved a delay injurious to defendant, an injunction was allowed. *Wilson v. Barnum*, 1 Wall. Jr., 347.

§ 3333. Where, in the absence of proof of exclusive possession under the patent or of public acquiescence therein, and of conclusive evidence of infringement, plaintiff's right to injunction and account was not clear, a trial at law was ordered, in which, on final judgment for plaintiff, he would be entitled to decree of injunction and account as prayed for. *Muscan Hair Mfg. Co. v. American Hair Mfg. Co.*, 4 Blatch., 174.

See *Jurisdiction*, §§ 3869, 3870.

Injunction — Expiration of patent, §§ 3334-3337.

§ 3334. Where the patent had expired between the time of filing the bill and the hearing, an account was ordered and other relief granted, but the injunction refused, owing to the expiration of the patent. *Inlay v. Norwich & Worcester R. Co.*, 4 Blatch., 227.

§ 3335. Where it appears upon the face of the pleadings and record that the patent sued upon had expired before the submission of the cause for an injunction, and no other cause for equitable relief was shown, injunction was refused and the bill dismissed. *Gottfried v. Moerlein*, 14 Fed. Rep., 117.

§ 3336. Where defendants had made machines during the term of the patent, which were an infringement of it, an injunction was granted to restrain their use or sale subsequent to its expiration. *American Diamond Rock-Boring Co. v. Sheldon*, 18 Blatch., 50.

§ 3337. A motion to enjoin the use of machines which infringe a patented invention will not be granted after the expiration of such patent, except upon allegations that they were made during the existence of said patent and that the plaintiff fears such use. *American Diamond Rock-Boring Co. v. Rutland Marble Co.*, 18 Blatch., 147.

See *Injunction, Alternative*, § 3014; *Preliminary*, § 3146. *Injunction*, § 3400. *Jurisdiction*, §§ 3898-3931.

Injunction — Grant of — *Lies in discretion of the court*, §§ 3338-3342. *In view of patent office decisions*, §§ 3343-3345. *Decree, judgment and verdict*, §§ 3346-3353. *Promise not to infringe no ground for refusal*, §§ 3354-3356. *Notice*, §§ 3357-3359. *Reissues*, §§ 3360, 3361.

§ 3338. The right of granting an injunction lies in the sound discretion of the court, and will not be exercised prior to the filing of a disclaimer, where such disclaimer should be filed. *Wyeth v. Stone*, 1 Story, 273.

§ 3339. Application for injunction is in all cases addressed to the discretion of the court. *Ayling v. Hull*, 2 Cliff., 494.

§ 3340. It lies in the discretion of the court to grant a perpetual injunction upon final hearing, although no provisional injunction has been applied for, or trial at law had to test the validity of the patent. *Buchanan v. Howland*, 5 Blatch., 151.

§ 3341. An injunction is not granted as a matter of course upon mere exhibition of the patent; there ought to be little, if any, doubt, in the minds of the court as to the validity of the patent. *Sullivan v. Redfield*, 1 Paine, 441.

§ 3342. An injunction should not be granted without full conviction on the part of the court of its urgent necessity. *Potter v. Schenck*, 1 Biss., 515.

§ 3343. Decisions on *ex parte* proceedings on an application for patent, made before the patent office and before the court, are not sufficient to prevail over the *prima facie* right of plaintiff to an injunction based on various adjudications as to his right and title in his patent. *Potter v. Stevens*, 2 Fish., 163.

§ 3344. The decision of the commissioner of patents is not final on a question of the priority of invention, but the successful applicant will not be enjoined from receiving his patent upon the mere suggestion that the commissioner was mistaken. *Whipple v. Miner*, 15 Fed. Rep., 117.

§ 3345. The granting of a patent confers upon the patentee the right to bring suits thereon for its infringement, and a court is not authorized to grant an injunction to restrain him from so doing pending a suit to invalidate his patent, especially when such patent was granted after an interference. *Asbestos Felting Co. v. U. S. & Foreign Salamander Co.*, 13 Blatch., 454.

§ 3346. An interlocutory decree granted plaintiff in a prior suit against manufacturers of the infringing article, who supplied defendant, is not sufficient ground for withholding an injunction against defendant; neither are the articles released until final decree in the prior suit has been made and satisfied. *Tucker v. Burditt*, 4 B. & A., 569.

§ 3347. Suits without collusion, honestly defended, and in which defendants only yielded to a judgment when it was evident that the contest could not be sustained, should have quite as much weight, on a motion for injunction, as if there had been a full trial and the jury had passed upon the facts. *Potter v. Fuller*, 2 Fish., 251.

§ 3348. A judgment in a suit at law upon a patent, sustaining it as valid, is a good ground for enjoining other parties who are infringing it. *Wells v. Gill*, 2 O. G., 590.

§ 3349. Although a writ of error has been brought to set aside the judgment, it will still be presumed to have been well founded, and have the same effect while the writ is pending. *Ibid.*

§ 3350. The soundness of the judgment is open to examination, however, and if found to be erroneous it will no longer be a sufficient basis for granting an injunction. *Ibid.*

§ 3351. If the judge who presided at the trial at law has granted injunctions against infringing the patent in other cases, it strengthens the presumption in favor of the judgment. *Ibid.*

§ 3352. Upon a motion for an injunction the merits of the patent will be considered anew, although it has been sustained on similar hearings before other judges, if it is alleged that new facts are in proof, and that the objections to the patent were not properly presented on those hearings. *Blake v. Rawson*, 1 Holmes, 200.

§ 3353. A verdict is not conclusive as settling the rights of a complainant in equity to an injunction. *Day v. Hartshorn*, 3 Fish., 32.

§ 3354. That a party who has infringed a patent promises to do so no more is no good reason for not enjoining him. *Rumford Chemical Works v. Vice*, 14 Blatch., 179.

§ 3355. If the infringer of the exclusive right of the owner of the patent admits the infringement, but asserts that, after notice of the injunction, he refrained from further use of the thing patented, and that he will not afterward infringe it, is no reason why a perpetual injunction should not issue. *Jenkins v. Greenwald*, 1 Bond, 126.

§ 3356. The party whose rights have been invaded may claim protection against future infringements, and is not obliged to rest on the facts that the party has ceased his acts of infringement. *Goodyear v. Berry*, 2 Bond, 189.

§ 3357. Since the act of June 1, 1872, the court may grant an injunction without previous notice. *Yuengling v. Johnson*, 1 Hughes, 607.

§ 3358. An injunction will be granted against a party who has notice of the motion and appears to oppose it, though the subpoena served upon him may have been irregular. *Thayer v. Wales*, 9 Blatch., 170.

§ 3359. An injunction against trespassing upon an exclusive license to sell a patented article may be granted against parties who are not bound by the contract, or who have no notice of it. *Singer M. Co. v. Union, etc., Co.*, 1 Holmes, 253.

§ 3360. Recoveries under the original patent are evidence after the reissue to strengthen the title of the plaintiff so as to obtain an injunction. *Woodworth v. Hall*, 1 W. & M., 248.

§ 3361. For the purposes of an injunction, the reissue must be taken to be for the same invention as the original patent. *Woodworth v. Stone*, 3 Story, 749.

Injunction — Generally, §§ 3362-3377.

§ 3362. On application for injunction, it is a question of law, and not for equity, whether complainant's patent is ultimately good and valid. *Sullivan v. Redfield*, 1 Paine, 441 (1825).

§ 3363. Former suit and recovery for violation of a patent-right will justify an injunction as evidence that patentee has not slept on his rights so as to mislead others. *Orr v. Littlefield*, 1 W. & M., 13.

§ 3364. Where a party has been enjoined from the use of a machine in one district, its use in another district by parties claiming under him will not be allowed while the injunction against him remains in full force, and the grounds of it in no way overturned. *Woodworth v. Edwards*, 3 W. & M., 120.

§ 3365. The restraining power of a court of equity cannot be invoked for a past injury, which from its nature cannot be renewed or continued. *Potter v. Crowell*, 1 Abb., 89.

§ 3366. Although courts of equity will not ordinarily, even where the title is clear, disturb the existing order of things by an injunction, they will interfere to preserve them in that condition until the rights of the parties are ascertained, notwithstanding some doubts may rest upon them, provided they are in the course of being judicially determined. *Singer M. Co. v. Union, etc., Co.*, 1 Holmes, 253.

§ 3367. An injunction should never be allowed to operate oppressively upon any one, but be used for the purpose of securing the rights of the complainant in the case pending the litigation without unnecessarily injuring the other party. *Kirby Bung Manufacturing Co. v. White*, 1 McC., 155.

§ 3368. To sustain an injunction it is not necessary that all the claims of a patent be infringed. *Potter v. Hollender*, 4 Blatch., 238.

§ 3369. An injunction will not be granted after a patent is extended upon a bill filed before and not founded on the extension. *Renwick v. Pond*, 10 Blatch., 39.

§ 3370. A patentee cannot take compensation for an infringement, including manufacture, sale and use, and thereafter enjoin that use for which he has taken compensation. *Gilbert & Barker Manufacturing Co. v. Bussing*, 12 Blatch., 426.

§ 3371. In patent cases, especially where owner depends on the use and monopoly of his invention for profits, and not on sale of license, the rule applies that where a case reveals a right in the complainant to the protection of an injunction, the defendant cannot defeat it by tendering security for damages. *Consolidated Fruit Jar Co. v. Whitney*, 1 B. & A., 356.

§ 3372. The power to prevent by injunction the violation of a right secured by a patent is conferred by section 4921 of the Revised Statutes, irrespective of any right in the given suit to recover profits or damages. *Colgate v. International Ocean Telegraph Co.*, 17 Blatch., 308.

§ 3373. May a landlord be enjoined from permitting his tools and machinery to be used for the injury of a third person, *quære*. *Starrett v. Athol Machine Co.*, 14 Fed. Rep., 910.

§ 3374. Injunctions are not deprived of their validity by the granting of a license by plaintiff to defendant, and a termination of such license makes the injunction at once available. *Pentlarge v. Beetson*, 18 Blatch., 38.

§ 3375. An injunction restrains the use or manufacture of such machines only as are an infringement upon the patent sought to be protected. *American Diamond Rock-Boring Co. v. Sutherland Falls Marble Co.*, 18 Blatch., 148.

§ 3376. If a defendant has, before suit brought, abandoned the manufacture and sale of an infringing machine, and the court is satisfied that the abandonment was in good faith and final, an injunction ought not to be granted. *Odell v. Stout*, 22 Fed. Rep., 159.

§ 3377. But if the defendant, after such abandonment, has engaged in the manufacture and sale of another machine which is also an infringing machine, and suit is brought for both infringements, the court will retain the whole cause under its control, and make the injunction and order to account to apply to the manufacture and sale of both. *Ibid*.

See *Admissions*, § 163. *Burden of Proof*, § 666. *Common Carriers*, § 1116. *Decree*, § 1309. *Marking Patented Articles*, § 4151.

Injunction — Stay of, §§ 3378-3381. Suspension of, §§ 3382-3384. Modification of, §§ 3385-3387.

§ 3378. Where the infringement was clear and the right to an injunction manifest, an application for a stay of injunction was refused. *Tracy v. Torrey*, 2 Blatch., 275.

§ 3379. It is not the established practice in the second and third circuits to stay injunctions upon application of the defendant until the coming in of the master's report. *Rumford Chemical Works v. Hecker*, 11 O. G., 330.

§ 3380. On the contrary, the ordinary practice is for an injunction, as a matter of course, to follow a decree in favor of the complainant on the merits, unless the defendant is able to show that the equities between the parties demand the withholding of the injunction until after an accounting has been had. *Ibid.*

§ 3381. Where proceedings to determine the validity of a patent and to set aside a compromise agreed upon in a prior suit have been instituted in the state court, the United States circuit court will stay its injunction founded on the agreement, the question of the validity of the patent being again raised, until the same is fully ascertained and determined. *Pentlarge v. Beetson*, 18 Blatch., 38.

§ 3382. Motion for further suspension of the issuing of an injunction denied for the insufficiency of the affidavit which stated that defendants were experimenting to make a non-infringing machine and offered to deposit an insufficient license fee in respect of other machines. *Macaulay v. White Sewing Machine Co.*, 21 O. G., 204.

§ 3383. A motion to suspend an injunction and permit defendant to give bonds to keep account until the coming in of master's report denied, there being no equities between the parties that required it. *Potter v. Mack*, 3 Fish., 428.

§ 3384. After a decree on final hearing, establishing an exclusive right, and awarding an injunction to protect the right, the injunction is not suspended unless some extraordinary cause is shown to exist outside of the rights of the parties established by the decree; and the defendant having failed to show any such grounds for the suspension of the injunction granted on the orator's patent, the motion was denied. *Munson v. Mayor, etc., of New York*, 19 Fed. Rep., 313.

§ 3385. Where there was a difference of opinion on the question of infringement between the district and the president judge, the former having granted a preliminary injunction, and the jury at the trial had disagreed, the injunction was modified by the full court. *Wilson v. Barnum*, 1 Wall. Jr., 347.

§ 3386. Where defendants moved to modify an injunction in order to allow them to fill certain contracts entered into with third parties, and alleged that they had assumed in good faith that the license under which they had been manufacturing was valid, *held*, that while they might be entitled to relief as regards contracts entered into before notice of the alleged fraudulent title of their grantors, they had no claim to relief for contracts entered into subsequent thereto. The absence of such information in their affidavits was fatal to the motion. *Consolidated Fruit Jar Co. v. Whitney*, 1 B. & A., 356.

§ 3387. Where defendant, after notice of decree against him for perpetual injunction and payment of costs awarded plaintiff, neglects for eleven months thereafter to move to open the decree, the laches is fatal to the motion. *Doubleday v. Sherman*, 6 Blatch., 513.

Injunction — Dissolution, §§ 3388-3401.

§ 3388. An injunction will not be dissolved as a matter of course upon the coming in of an answer denying the equity of the bill, if the complainant adduces auxiliary evidence of his right. *Orr v. Littlefield*, 1 W. & M., 13.

§ 3389. Where respondents deny the validity of plaintiff's patent, the court will dissolve the injunction at next term, unless a suit at law is brought to test the patent. *Woodworth v. Edwards*, 3 W. & M., 120; *Same v. Rogers*, 3 W. & M., 135.

§ 3390. Where the presumption of novelty in favor of patentee's invention was based on patentee's oath, the grant of the patent, undisputed enjoyment and public acquiescence, frequent adjudications sustaining its validity, and grants of injunctions on patentee's application, the court refused to dissolve the injunction. *Hussey v. Whiteley*, 1 Bond, 407.

§ 3391. Practice as to dissolving injunctions. *Perry v. Littlefield*, 2 Fed. Rep., 464.

§ 3392. On a motion to dissolve an injunction, where defendant denies and wishes to have properly tried the validity of plaintiff's patent, the naked denial will not be sufficient to overcome former recoveries and long possession by plaintiff, but the court will direct plaintiff to try the validity of the patent at law, else the injunction will then be dissolved. *Orr v. Merrill*, 1 W. & M., 376.

§ 3393. Where, on motion to dissolve an injunction, it appeared that one of the defendants had parted with his interest in the machine prior to the filing of the bill, *held*, that he was not an infringer at the time the bill was filed, and the injunction was dissolved as to him. *Bramer v. Jones*, 2 Bond, 100.

§ 3394. Where it appeared, on answer and affidavits on a motion to amend a bill for infringement on which injunction had issued, that the articles made by defendants were under license from plaintiff, the injunction was dissolved. *Goodyear v. Bourn*, 3 Blatch., 266.

§ 3395. Where, on motion to dissolve an injunction, the want of originality, the invalidity of the extension and reissues, as well as fraud in the patentee, were relied on in a subsequent answer under oath, it was overcome by evidence of the validity of the patent, long possession, prior recoveries under it, and special, still-pending, injunctions, and the motion was refused. *Woodworth v. Rogers*, 3 W. & M., 135.

§ 3396. A motion to dissolve an injunction on a patent subsequently reissued, denied; the assignees, parties to the original and supplemental bills, having acquiesced in the reissue. *Woodworth v. Stone*, 3 Story, 749.

§ 3397. Where, on motion to dissolve an injunction, the effect of defendant's affidavits as to want of novelty was sufficient only to render plaintiff's final success doubtful, the motion was refused, plaintiff having shown quiet possession for a reasonable time, a judgment in his favor, and the irreparable injury which he would suffer. *Orr v. Badger*, 7 Law Rep., 465.

§ 3398. Where state of facts shown by defendants' affidavits, even if allowed to be true, was not sufficient to defeat the patent the court refused to dissolve the injunction. *Richardson v. Croft*, 11 Fed. Rep., 800.

§ 3399. Where, on motion to dissolve or modify injunction, complainant, licensee of defendant, had stipulated in the license that the royalty paid by it should be reduced in case defendant granted another license at lower rates; and complainant averred that such license had been granted, and prayed for injunction to restrain any suit against it to recover the royalty provided for in the license, *held*, that its defense at law was ample, and the injunction to that extent was dissolved. Complainant having further prayed an injunction to restrain defendant from declaring a forfeiture of the license for non-payment of the royalty, it was continued. *Barker Mfg. Co. v. Washburn & Moen Mfg. Co.*, 18 Fed. Rep., 172.

§ 3400. A court of equity will enjoin the use of machines made in infringement of a patent and to be used after its expiration; and a motion made to dissolve such an injunction on account of the expiration of the term of the patent was refused. *American Diamond Rock-Boring Co. v. Rutland Marble Co.*, 18 Blatch., 146. See § 4530.

§ 3401. Dissolution of an injunction refused, where the objection to the validity of the patent related to the technical form or signature of papers connected therewith, and doubts arising from the acts of public officers and not from any neglect or wrong of the patentee. *Woodworth v. Hall*, 1 W. & M., 389.

Injunction — Violation of — *What constitutes*, §§ 3402-3413.

§ 3402. An injunction having issued against the defendant restraining it from using the invention, except the identical wires or cables used by it, "and also from selling, transferring, lending, leasing, or parting with in any manner, any wire or cable embodying said invention, or conferring upon any other person, persons or corporation, either in whole or in part, or alone or in conjunction or connection with the defendant, any use or right to use such wires or cable," an agreement giving to a certain corporation the right to use certain cables embodying the invention, although claimed to have been a mere confirmation or recognition of a pre-existing agreement with the predecessors of the new corporation, is a violation of the injunction. If the existing contract or agreement applied to the new corporation, it did so without any new arrangement, and if a new agreement was necessary to bring in the new party and confer on it the right to use the cables, the new agreement was a violation of the injunction. *Colgate v. Western Union Tel. Co.*, 17 O. G., 194.

§ 3403. An agreement involving the furnishing of the infringing device, although made before service of the injunction, if executed after such service, is a violation thereof. *Colgate v. Gold & Stock Telegraph Co.*, 17 O. G., 193.

§ 3404. It was a violation of the injunction granted against defendant company in this case to sell machines at Cleveland, whether or not they were sent within the territorial jurisdiction of the court. *Macaulay v. White Sewing Machine Co.*, 9 Fed. Rep., 698.

§ 3405. Where machines are sold prior to an injunction, and subsequently returned to the defendant, and again sold by him after service of a restraining order, there is probable ground for a claim of a technical violation of the injunction, from which the defendant can only be relieved by showing that the machines were not only included in the accounting but that they had been paid for. *Allis v. Stowell*, 19 O. G., 727.

§ 3406. Where a party used an improved machine embodying important portions of a machine which he had been enjoined from using, he was held to have violated the injunction. *Woodworth v. Rogers*, 3 W. & M., 135.

§ 3407. The defendant having been enjoined from using the patented improvements, except the identical wires and cables then used by it, and from authorizing others, "either in whole or in part, or alone or in conjunction or in connection with the defendant," from using any such wires or cables, an agreement under which the defendant furnished a wire embodying the

invention contained in a cable which had been in use by the defendant long before, and which was in actual use by it at the time of the service of the injunction, was a violation of the injunction. *Colgate v. Gold & Stock Tel. Co.*, 17 O. G., 193.

§ 3408. Where, subsequent to grant of injunction prohibiting defendant from making, manufacturing and selling a patented article, he fitted up and kept in running order machinery in a factory which he knew was making such articles, he was held to have violated the injunction. *Goodyear v. Mullee*, 5 Blatch., 429.

§ 3409. Where defendants had not wilfully violated the injunction against the infringement of the patent, and the question was submitted to the court to try a question of right, and not of wilful disobedience, they were adjudged to pay all profits made or damages occasioned by it with costs of the proceedings. *Ready Roofing Co. v. Taylor*, 15 Blatch., 94.

§ 3410. Where the violation of the injunction was established and wilful, *held*, that counsel fees, etc., necessary to establish the injunction should be paid by defendant; but as the extent of the violation was not shown, a certain sum was decreed as fine for the contempt and to indemnify plaintiff. *Doubleday v. Sherman*, 4 Fish., 253.

§ 3411. Where defendant declared he had not knowingly violated an injunction on a patent for a compound of a given percentage composition, believing he had the right to manufacture of another percentage composition, and it was proved that he had manufactured a compound having a percentage composition within the limits that he had supposed secured by the patent, he was held wilfully and knowingly to have violated the injunction. *Goodyear v. Mullee*, 5 Blatch., 463.

§ 3412. It not being shown that any of the machines sent to Cincinnati after the injunction was issued were delivered upon previous purchase, were sold, or were to be used to produce the product, or to pass away from the control of the direct agents of the company, the injunction was not violated. *McKay v. Scott Sole Sewing Machine Co.*, 20 O. G., 372.

§ 3413. It is no excuse for the violation of a preliminary injunction in a patent case that the patent is invalid or the writ improvidently granted. If the court has jurisdiction to issue the writ, it must be obeyed until it is dissolved. *Phillips v. City of Detroit*, 2 Flip., 92.

Injunction — Violation of — Attachment, §§ 3414-3425. See *Infringement*, §§ 2959-2961.

§ 3414. It is no ground for an attachment for violation of an injunction, that, prior to the use complained of, defendant altered the alleged infringing machine so as to constitute a less injurious and extensive infringement than before, by omitting a specifically claimed part of the invention; and where no use before or since is shown. *Sickels v. Borden*, 4 Blatch., 14.

§ 3415. What are the requisites for the proper service of a writ of injunction, restraining the violation of a patent, considered with reference to attachment for its violation. *Whipple v. Hutchinson*, 4 Blatch., 190.

§ 3416. Where, on motion for attachment for violation of an injunction restraining the use of the patented improvement, defendants undertook to show that it covered but one of the two claims in the patent, *held*, that they should have taken immediate measures to have it set aside, and, not having done so until this motion, the injunction must be held valid and effectual to the extent of the language employed, and to include the two claims. *Sickels v. Borden*, 4 Blatch., 14.

§ 3417. Where an injunction was served upon an engineer of a steamboat, owned by a foreign corporation, *held*, that it was no defense to a motion for attachment for its violation, that he was a mere agent of the corporation, and subject to the master of the vessel. *Ibid*.

§ 3418. Affidavits tending to show that plaintiff was not original inventor of the thing patented cannot be raised in defense to a motion for attachment for violation of an injunction, where such question has been determined when the injunction was granted. *Whipple v. Hutchinson*, 4 Blatch., 190.

§ 3419. On motion for attachment for violation of an injunction, *held*, that if the claim of the patent alleged to be violated was to be construed so as to cover the material used by defendant, the latter should have an opportunity to prove its want of novelty. *Poppenhusen v. New York Gutta-Percha Comb Co.*, 4 Blatch., 253.

§ 3420. Where a motion for attachment for violation of an injunction was denied in consequences of defect in the service of the writ, the court being of opinion that it had none the less been violated, no costs were allowed. *Whipple v. Hutchinson*, 4 Blatch., 190.

§ 3421. Where on proof of infringement it appeared that the defendants had hitherto acted in good faith to the court, and were not in wilful contempt, a rule for attachment for violation of an injunction was not enforced, but defendants were ordered to pay costs of the rule and proceedings thereon. *Strobridge v. Lindsay*, 6 Fed. Rep., 510.

§ 3422. Where defendant omitted certain patented parts of a machine, for the infringement of which he had been enjoined, but it was a question whether he did not still infringe another

patent under which he was equally enjoined, an attachment for the violation of the injunction was refused, defendant having acted under advice of counsel, but his proceeding was condemned. The correct practice for avoiding an injunction stated. *Hamilton v. Simons*, 5 Biss., 77.

§ 3423. Motion for attachment for violation of injunction, by infringement of a combination, denied, without prejudice to the same question on accounting under the interlocutory decree. *Burdett v. Estey*, 16 Blatch., 105.

§ 3424. Motion for attachment for violation of an injunction refused, no infringement being found. *Yale Lock Mfg. Co. v. Scoville Mfg. Co.*, 15 Fed. Rep., 342.

§ 3425. Where the patent had never been construed by a court, nor by the consent of parties, and the infringement depended upon construction of the claims, a motion for attachment for violation of an injunction founded upon such patent was not allowed, where the decree previously entered had been by consent. *Higby v. Columbia Rubber Co.*, 18 Fed. Rep., 601.

Injunction — Violation of — *Motion for attachment for contempt for*, §§ 3426-3434. See *Contempt*, §§ 1257-1277.

§ 3426. Practice on motion for attachment for contempt for violation of an injunction, as to plaintiff's statement of the specific act, interrogatories and right to require answer. *Parkhurst v. Kinsman*, 2 Blatch., 76.

§ 3427. Where one of the complainants accepts a lease of the machine from defendant, it operates as an equitable release of defendant; and an attachment for contempt for such use will not lie. *Smith v. Patton*, 6 Penn. L. J., 189.

§ 3428. A respondent who had been enjoined on a final hearing from infringing a patent, having afterward practiced an evasive process, was adjudged guilty of contempt. *Wetherell v. New Jersey Zinc Co.*, 5 O. G., 460.

§ 3429. Where the court is satisfied, on the hearing of a motion for an attachment in such a case, that the respondent has perpetrated such an infringement, the motion will be granted without requiring the complainant to establish the charge in a new suit. *Ibid.*

§ 3430. An attachment was awarded in this instance against the president of the respondent company, he having been served with the injunction, and having contrived the infringement and put it in practice. *Ibid.*

§ 3431. The rule is that courts of equity will never attach unless the violation of the injunction is plain and clearly proven to the court. *Birdsall v. Hagerstown Mfg. Co.*, 1 Hughes, 59.

§ 3432. Motion for attachment for contempt dismissed, it appearing that defendants omitted in their method the first step in the plaintiff's process. *Hammerschlag v. Garrett*, 10 Fed. Rep., 479.

§ 3433. Motion for attachment for contempt of court in violating an injunction must be refused when the affidavits fail to show a personal service of the motion, or a substituted service by order of the court, on the defendants. *Bate Refrigerator Co. v. Gilett*, 32 O. G., 1466.

§ 3434. Where the evidence was conflicting and left in doubt whether complainant had allowed the use by defendant of the alleged infringing device, a rule to show cause why an attachment for contempt should not issue was not made absolute, but permission was given to reopen the decree *pro confesso*, on which the injunction had issued. *Roemer v. Newman*, 19 Fed. Rep., 98.

See *Construction of Patents*, § 1214.

173. INOPERATIVE PATENTS.

See PATENTS, INOPERATIVE.

174. INSTRUCTIONS TO JURY.

See JURY, INSTRUCTIONS TO.

175. INTEREST ON DAMAGES.

See DAMAGES AND PROFITS, INTEREST ON DAMAGES.

176. INTEREST ON PROFITS.

See DAMAGES AND PROFITS, INTEREST ON PROFITS.

177. INTENT TO PROCURE INFRINGEMENT.

See INFRINGEMENT, INTENT.

178. INTERFERENCE

See APPEAL FROM COMMISSIONER IN INTERFERENCES.

Interference — *Burden of proof*, § 3435. *Estoppel*, § 3436.

§ 3435. *Held*, on motion for preliminary injunction, that the decision of the patent office on an interference awarding the patent to plaintiff, throws on defendant the burden of proving such determination to be wrong. *Pentlarge v. Beetson*, 14 Blatch., 352.

§ 3436. It is error to refuse to put a party in interference with another on the ground that the former is estopped by being a joint patentee in letters patent exactly covering his application. *Crocker's Case*, 2 A. L. T. (U. S.) R., 129.

See *Appeal*, §§ 280-293. *Jurisdiction*, §§ 3818-3826. *Mandamus*, § 4119. *Novelty*, § 4353. *Priority of Invention*, §§ 4986-5023.

Interference — In patent office — *Generally*, §§ 3437-3471. *Successive interferences*, §§ 3472-3474.

§ 3437. Cases of interfering applications, under act 1793, must be left in the first instance to arbitrators. *Rush's Opinion*, 5 Op., 701.

§ 3438. Patent office practice and mode of appeal governing applications for patents and interference cases, under acts 1836 and 1839, reviewed. *Potter v. Dixon*, 5 Blatch., 160.

§ 3439. Under the act of 1836, the commissioner's decision upon the question of interference is not conclusive. *Bain v. Morse*, 1 MacA. Pat. Cases, 90.

§ 3440. Construing the sixth, seventh and eighth sections of the act of 1836 together, it is clear that the interference referred to in the eighth section is an interference between patentable inventions. That is a preliminary question necessarily involved in the commissioner's decision upon priority of invention, and may be considered by the judge upon appeal. *Jones v. Wetherill*, 1 MacA. Pat. Cases, 409.

§ 3441. On a motion to extend the time of taking testimony in an interference proceeding in the patent office, the affidavits should state the names, competency and materiality of the witnesses to be examined. *Screw Co. v. Sloan*, 1 MacA. Pat. Cases, 210.

§ 3442. Interlocutory questions which arise in the course of the trial before the commissioner, such as the question whether the times for taking testimony shall be extended, are submitted to the sound discretion of the commissioner; and from his decision no appeal lies to the court, unless in case of gross abuse, which is not to be presumed. *Wellman v. Blood*, 1 MacA. Pat. Cases, 432.

§ 3443. The cases cited from the books are all cases in law or in equity in actions for violation of patents already granted. The proceedings before the commissioner are initiatory. The question is whether the patent shall be granted, not whether it shall be vacated; and a patent may be granted upon less evidence than would be required to sustain or amend it. *Perry v. Cornell*, 1 MacA. Pat. Cases, 68.

§ 3444. The question of priority of right or invention necessarily implies interference. If there is no interference between the parties no question of priority can arise. Both the commissioner in the premises and the judge upon appeal must pass upon the question of interference as preliminary to and as giving them jurisdiction on the question of priority. *Bain v. Morse*, 1 MacA. Pat. Cases, 90.

§ 3445. In notifying the parties to appear before him in accordance with the provisions of the eighth section of the act, the commissioner decides *pro hac vice*, and for that purpose only, that an interference exists. Upon the hearing he decides finally whether or not an interference in fact exists. From that decision either party may appeal to the judge. *Ibid.*

§ 3446. Upon appeal to the judge in an interference the question is, does the appellant claim a patent for any matter now patentable for which the other party claims a patent? *Ibid.*

§ 3447. The interference mentioned in the eighth section of the act of 1836 must be an interference with respect to patentable matters, and the claims of the applicants must be limited to the matter specifically set forth in their respective specifications, and what is not thus claimed may, for the purpose of this preliminary inquiry, be considered disclaimed. *Ibid.*

§ 3448. A question raised in connection with an application not in interference cannot be considered by the judge upon appeal. *Ruggles v. Young*, 1 MacA. Pat. Cases, 160.

§ 3449. The nature of the invention in interference is to be determined by regarding the essential principles common to the conflicting inventions, and disregarding mere formal differences and the substitution of equivalents. *Yearsley v. Brookfield*, 1 MacA. Pat. Cases, 193.

§ 3450. The question of priority of invention can only arise in such manner as to defeat an application for a patent, when there is an interference according to the principles of the patent law, by which principles there must exist substantially an identity; and in the case of interfering machines the *modus operandi* may be looked to as a test. *Tyson v. Rankin*, 1 MacA. Pat. Cases, 262.

§ 3451. The interference dissolved, it appearing that while there was a general similarity in the inventions of the respective parties, in the fact that both inventions contemplated the addition of flanges to the ends of propeller blades, the disposition of the flange with reference to the blade was different in each case, was intended for a different purpose, and accomplished a different result. *Ibid.*

§ 3452. In an interference the question is not whether one invention is better in some respects than the other, but whether there is a substantial interference in the principle of the two inventions. *Stephenson v. Hoyt*, 1 MacA. Pat. Cases, 292.

§ 3453. The fact that it is the uniform practice of the office never to raise the issue of interference until after the patentability of an invention, which is supposed to be a previous and preliminary point, has been favorably settled in the mind of the commissioner, does not raise a presumption of patentability which is conclusive in the further proceedings in the case. *Burrows v. Wetherill*, 1 MacA. Pat. Cases, 315.

§ 3454. When two applications are properly in interference upon their claims as made, it is unnecessary to consider whether there are differences between the two machines which might entitle one or the other party to a patent if the claims had been presented in a different shape. *Spain v. Gambrill*, 1 MacA. Pat. Cases, 358.

§ 3455. An interference exists between two applicants who describe in their specifications the same invention, although the claim of one of the parties is not as broad as his specification. *King v. Gedney*, 1 MacA. Pat. Cases, 443.

§ 3456. The practice of the office in determining the patentability of the invention before the interference is declared is a proper one, and should be strictly observed. *Chandler v. Ladd*, 1 MacA. Pat. Cases, 493.

§ 3457. The decision of the commissioner and the judge upon appeal can only proceed upon the evidence properly in the case. *Cochrane v. Waterman*, 1 MacA. Pat. Cases, 52.

§ 3458. In an interference between an applicant and a patentee, the question is, whether the applicant is the first inventor; for if he is not, it is immaterial to the cause who is. *Warner v. Goodyear*, 1 MacA. Pat. Cases, 60.

§ 3459. In an interference between an applicant and a patentee, the only question of importance is, whether the applicant is the first inventor; for if he is not, it is immaterial to the case who is. *Burlew v. O'Neil*, 1 MacA. Pat. Cases, 168.

§ 3460. Testimony taken in such a case, showing that the patentee made the invention before the applicant, is properly receivable in evidence, and is decisive of the cause, though the testimony might at the same time disclose valid objections to the grant of a patent to the patentee, if that question were still open for consideration. *Ibid.*

§ 3461. In an interference proceeding a patentee is not restricted in his proofs to the exact point of invention covered by his patent that is claimed therein. If he prove to be the prior inventor of anything claimed by the applicant, the commissioner may act upon such information, and his decision thereon may be reviewed by the judge upon appeal. The question is not the same as in a suit for the infringement of the patent. *Stephenson v. Hoyt*, 1 MacA. Pat. Cases, 292.

§ 3462. The presumption of invention arising out of the grant of the letters patent, and against which the defendant in an infringement suit must contend, does not exist as between contending applicants for patents; and the application of the decisions of the courts to interference cases is modified by that circumstance. *Hill v. Dunklee*, 1 MacA. Pat. Cases, 475.

§ 3463. Where an interference is declared in the patent office, the examination is to be confined to "priority of invention." (WYLIE and MACARTHUR, JJ.) *Bigelow v. Commissioner of Patents*, 2 MacArth., 24.

§ 3464. The statute confines interferences to cases where an applicant claims that for which a patent has been granted, or that which is claimed or can be claimed in a previous pending application. *Ex parte Platts*, 15 O. G., 827.

§ 3465. The decision of such a motion is wholly within the discretion of the commissioner, and will not be reviewed upon appeal to the court. *Screw Co. v. Sloan*, 1 MacA. Pat. Cases, 210.

§ 3466. The commissioner of patents may suspend, temporarily, proceedings in interferences, when the evidence used therein tends to show that the first inventor, who is also the applicant,

had abandoned his invention before applying for a patent, and to refer the application back to the primary examiner to ascertain the fact of such abandonment. *Bigelow v. Commissioner of Patents*, 2 MacArth., 24.

§ 3467. It is not the intention of the patent law that, on a question of interference, the examiner in charge of interferences should consider a question of abandonment. (WYLIE and MACARTHUR, JJ.) *Ibid.*

§ 3468. An applicant whose foreign patent is antecedent to any record date of the domestic patent cited in refusal of the application is entitled to the issue of his patent without interference, the domestic patent making no claim to the common subject-matter. *Ex parte Bland*, 15 O. G., 828.

§ 3469. No interference can lie except as between claimants of the same invention. *Marvin v. Lillie*, 27 O. G., 299.

§ 3470. Where A. claimed a combination not claimed by B., but the construction given B.'s claim embraced features shown but not claimed by A., *held*, there was no interference. *Ibid.*

§ 3471. *Held*, where in two inventions the power applied was the same, the subject the same, but the effect was produced by means entirely different, that there was no interference, and the question of priority of invention did not arise. *Bain v. Morse*, 1 MacA. Pat. Cases, 90.

See *Admissions*, §§ 168, 169. *Appeal*, §§ 273-279. *Evidence*, §§ 2281, 2282. *Injunction*, *Interlocutory*, §§ 3023, 3050, 3051. *Reissues*, §§ 5798, 5799.

§ 3472. The withdrawal and filing of a new application by one applicant in an interference, after a favorable decision as to priority awarded the other applicant, *held*, allowable, and no bar to issue of a patent on such new application. *Johnson's Opinion*, 5 Op., 220.

§ 3473. The dissolution of a prior interference by the supreme justice of the United States district court of District Columbia does not prevent the declaration of a second interference upon the application of a different set of patentees. *Potter v. Dixon*, 5 Blatch., 160.

§ 3474. There is nothing in section 8 of the act of 1836 which makes it imperative upon the commissioner to declare as many interferences between the same parties as the defeated party may seek by filing successive applications. The words of the law are satisfied by giving one trial between the same parties upon the same subject-matter. *In re Rouse*, 1 MacA. Pat. Cases, 286.

179. INTERFERING APPLICATIONS.

See INTERFERENCE, IN PATENT OFFICE.

180. INTERFERING PATENTS.

SUMMARY (FOSTER *v.* LINDSAY, §§ 3475-3478) — *Construction of section 4918, R. S.*, §§ 3475, 3476.—*Jurisdiction of circuit court*, §§ 3477, 3478.

FOSTER *v.* LINDSAY.

(Circuit Court for Missouri: 3 Dillon, 126-131. 1875.)

Opinion by TREAT, J.

STATEMENT OF FACTS.—This is a suit in equity, under section 4918 of the Revised Statutes of the United States, concerning alleged interfering patents. The defendant's patent was prior in date to the plaintiff's; also the application therefor. The plaintiff claims that the invention was by him; that he had, previous to any knowledge thereof by the defendant, not only invented the patented composition, but actually reduced it to a practical and successful test; that he had shown to the defendant the manufactured article, and when, as their foreman in the brick business, he was consulted thereafter about manufacturing fire-brick, by means of which they could obtain a large and profitable order, he called their attention to the fact that he had exhibited to them, before entering upon their service, a specimen brick of the needed quality; that thereupon he, as their foreman, directed various experiments to be made at defendant's brick yard; that when the defendant suggested subsequently that they proposed to obtain a patent for that mode of making an improved

fire-brick, he remonstrated against their doing so, claiming that he was the original inventor, and alone entitled to a patent, if one was obtainable. On the other hand, the defendant claims that it was only after a series of experiments under his direction and supervision, in his own establishment, that the success of the mode patented was ascertained.

§ 3475. *Section 4918 of the Revised Statutes of the United States, in respect of interfering patents, construed, and held to vest the power in the circuit court to adjudge either of the interfering patents void in whole or in part, and upon proper issues and proof to authorize a decree that both patents are void.*

Without analyzing the testimony with the view of determining whether the plaintiff, in his isolated experiment, prior to entering into the service of defendant, had invented the patented mode of securing the desired result, or had merely experimented so far as to ascertain that the use of sand-rock would furnish the needed glazing in his pottery business, and without inquiring further, whether he had not abandoned all purpose of pushing his experiments to ultimate success for fire-bricks, and also without determining to what extent he and the defendant, respectively, suggested the experiments made in the defendant's establishment, which first resulted in an ascertained and definite value from the compound, whereby the rights of the respective parties as employer and employee would arise, we will first consider the true construction of the act of congress.

§ 3476. *Section 4918, Revised Statutes, construed. "Interfering patents."*

The language of the section is peculiar, and the object designed by it is not free from doubt. The section is as follows: "Wherever there are interfering patents, any person interested in any one of them, etc., may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court on notice may adjudge and declare either of the patents void in whole or part, or inoperative or invalid in any particular part of the United States, according to the interest of the parties, etc. But no such judgment or adjudication shall affect the right of any person except the parties to the suit," etc. R. S., sec. 4918.

So far as known, this section has not received any express adjudication. In *Mowry v. Whitney*, 14 Wall., 434, an allusion is made to a somewhat similar provision in the act of 1836. The latter act in the section referred to covered two distinct classes of cases, viz.: 1st, where there were interfering patents; and 2d, where the examiners refused to issue a patent applied for, on the ground of interference with a prior patent. In each of those cases a bill of equity would lie at the instance of either of the parties, and the court could determine, in the latter class of cases, whether the applicant should have a patent issued to him; and in the former, might adjudge either of the patents void in whole or in part, etc.

In ordinary cases, where a patentee brings suit for infringement, the defendant can assail the validity of the patent in the manner described; and the decree of the court is binding on the parties. It is contended that, inasmuch as this suit is not for an infringement, the defendant must be confined to the respective merit or claims of the patentees *inter sese*, irrespective of the validity of either. The defendant in this case, among other defenses, has set up that the patented compound or process had been anticipated and in use before either of the interfering patents had been claimed or issued. The evidence fully establishes the fact. In a suit for an infringement, a defense for want of novelty would, under the evidence in this case, be successful, whether the one or the

other of the interfering patents was the basis of the action. The case of *Mowry v. Whitney* goes no further than to hold that if a patent is to be annulled *ab initio*, the proceeding must be at the direct instance of the government, but it does not decide that the question between conflicting patents may not be fully and finally determined as to the parties to suit for interfering patents.

§ 3477. *The authority of the circuit court, under section 4918.*

The plaintiff in this case contends that he has the prior and better right, although his application and patent are of subsequent date, and that the court is bound to adjudicate solely as between his and the interfering patent, leaving one of the patents to stand for subsequent adjudication when assailed in a proper suit. The act of congress provides for a suit in equity against the owners of the interfering patent for such relief as equity would furnish. If the action stopped there, would a court of equity grant relief to a complainant who had no equity? If it would not, could not the court inquire, through proper pleadings and evidence, into the equities of the complainant? But the section proceeds to authorize the court to adjudge *either* of the interfering patents void in whole or part. If it adjudged the plaintiff's patent void, should not a decree to that effect be entered, instead of a simple decree dismissing his bill? If it ascertains that the defendant's patent is void, and the plaintiff's also, must the decree be restricted to a judgment against the defendant's patent, leaving the plaintiff's patent as if in full force, and of established validity; so that if a new suit were brought by the same plaintiff, against the same defendant, for an infringement of plaintiff's patent, the defendant would then for the first time be able to dispute the validity of plaintiff's patent for want of novelty, etc.? Why two suits between the same parties to adjust the controversies between them, when one suit would accomplish the end according to the well-known purposes of equity proceedings? Unless the terms of the statute restrict the court sitting in equity, so that it cannot do full and complete justice between the parties, and end the litigation between them, it would seem to be its duty to pass upon the whole controversy when fairly and fully presented. The statute says that the court may adjudge *either* void in whole or part. How can it do so, consistently with law and equity, unless each of the patents is under consideration in all respects? It may conclude that in some respects there is an interference, and in others none, so that the decree would be only for an annulment in part; or it may decree that there is an interference *in toto*, and consequently annul one of the interfering patents, leaving the other to stand as valid. But what would be the position of one who had previously used the patent declared void, when suit was subsequently brought against him by the other patentee for an infringement? Could he assail the validity of the patent which had already, as between the same parties, been adjudged, at least impliedly, to be valid? It seems that the suits in equity authorized in cases of interfering patents should not be restricted to the narrow limits urged. The controversy is between two patentees or those claiming under them.

§ 3478. — *the section, further construed, gives the court power to adjudge both patents void.*

If neither has a valid patent, the court should adjudge both void, and thus end the strife. It is on this theory that the defendant was permitted to set up in his answer the lack of novelty, not of plaintiff's patent alone, but of his own. True, he might voluntarily have surrendered his patent, and contested the plaintiff's right in a suit for infringement; but why should he not, when

sued, insist upon a full defense, whereby a second suit could be avoided? The power vested in the court to adjudge either of the interfering patents void, in whole or part, is held to confer full authority, where the evidence justifies, on issues fairly made, to decree, not one of the patents alone, but both, to be void. The court so adjudges in this case, and the decree will be accordingly at the costs of the plaintiff.

Decree accordingly.

Interfering patents, §§ 3479-3498.

§ 3479. Two patents interfere, within the meaning of act of 1836, section 16, only when they claim in whole or in part the same invention. *Gold & Silver Ore Separating Co. v. U. S. Disintegrating Ore Co.*, 6 Blatch., 307.

§ 3480. Where alleged interfering patents had been granted to two different inventors, *held*, that the grant by the patent office of the latter patent was not conclusive as to its novelty, especially where there had been no notice to the second patentee. *Wilson v. Barnum*, 1 Wall. Jr., 347.

§ 3481. Section 58 of the patent act of 1870 authorizes the court, in a suit thereunder, to review both patents on their merits, and to decree the cancellation of either or both; and this on the ground of lack of novelty as to either or both, or any other ground that in an action for infringement would affect the validity of either. *Foster v. Lindsay*, 7 O. G., 514. See §§ 3475-78.

§ 3482. In a suit brought under section 58 of the act of 1870, to repeal an interfering patent, motion was made to strike out such part of defendants' answer as related to an alleged lack of novelty in the invention covered by complainant's patent, on the general ground that the object of the statute was merely to enable the complainant to determine the question of priority as between himself and his adversary prior to going before the public to test the validity of the patent on its merits. *Held*, that this allegation of the answer was admissible. The motion was overruled. *Ibid.*

§ 3483. This was a contest between two patentees of an improvement in lubricators. The bill was founded upon the act of congress of July 8, 1870 (16 Statutes at Large, 207), re-enacted in the Revised Statutes, section 4918. By the pleadings an interference of the patents was substantially admitted; but, if not, it was held that the patents were for the same invention, the arrangements of devices producing the same results in substantially the same manner. *Held*, therefore, that the only remaining question was, Which of the patentees was the prior inventor? Ruled, upon the evidence, that Seibert was the first and original inventor, and that consequently the patent of Garrett was invalid. *Garrett v. Seibert*, 8 Otto, 75.

§ 3484. Actions under the patent laws can only be sustained for the purpose of protecting the right of the patentee to exclude others from the sale or manufacture of the patented article. *Celluloid Manufacturing Co. v. Goodyear Dental Vulcanite Co.*, 13 Blatch., 375.

§ 3485. No action can be sustained by a junior private patentee, who alleges that his patent does not conflict with the prior patent, and who asks the court to so adjudge. *Ibid.*

§ 3486. Such an action is a suit to limit the effect of a patent, and can only be sustained by the attorney-general in the name and on behalf of the United States. *Ibid.*

§ 3487. The statute respecting interfering patents (section 4918, R. S.) cannot be invoked unless it is asserted that the two patents are substantially for the same invention; that the patentee, in whose behalf the statute is pleaded, is the real discoverer of the invention therein set forth, and that the defendant has wrongfully appropriated the fruits of his invention. *Ibid.*

§ 3488. The proceedings contemplated by section 4918 of the Revised Statutes, touching interfering patents, contemplate an ordinary proceeding in chancery. *Liggett & Myers Tobacco Co. v. Miller*, 1 McC., 31.

§ 3489. It is an adversary proceeding, in which the party must file the usual bill in chancery and issue the subpoena required by the chancery practice. *Ibid.*

§ 3490. No law of the United States makes provision for the service of any process outside of the district, and section 4918 does not permit the circuit courts, by the issuing of a notice of the filing of a bill, to declare an interfering patent invalid, or by any other process to bring before it citizens from any and every part of the United States to have their rights adjudicated there. *Ibid.*

§ 3491. Such section clearly contemplates that the ordinary course of equity proceedings shall be pursued, and that the judgment shall operate only so far as the jurisdiction of the court shall extend. *Ibid.*

§ 3492. *Held*, that under section 4918, Revised Statutes, courts have jurisdiction over all the interfering patents, upon a bill filed, and that on proper issues formed by the pleadings, with-

out the intervention of a cross-bill, affirmative relief could be granted to either of the parties entitled to it, by declaring one or the other, or all, the patents void or valid; a cross-bill filed for such purpose on an interference was accordingly dismissed. *Lockwood v. Cleaveland*, 6 Fed. Rep., 721.

§ 3493. Where, in an action under section 4918, Revised Statutes, plaintiff seeks to have defendant's patent declared void, as being in interference with his own patent, *held*, that the proceeding is to be confined to a determination of the questions of interference and priority, and where a plea was set up alleging want of novelty in plaintiff's patent, it was overruled. *Pentlarge v. Pentlarge*, 19 Fed. Rep., 817.

§ 3494. *Held*, under section 4918, the sole question that can be litigated is that of priority between the two interfering patents, and in the patent act, as it now stands, we find no authority given the courts to set aside or annul a patent for mere want of novelty; a motion to open a decree founded on a bill under such section in order to introduce a defense of want of novelty, and praying that complainant's patent be also declared void, refused for the above reason, and also for laches. *Lockwood v. Cleveland*, 20 Fed. Rep., 164.

§ 3495. Where two patents cover distinct things they do not interfere, within the contemplation of section 4918, Revised Statutes, even though one inventor takes the invention of the other to improve upon, and thereby infringes the patent of the latter. *Pentlarge v. New York Bung & Bushing Co.*, 20 Fed. Rep., 314.

§ 3496. Where application was made by defendants to set up in answer matter already set up in their plea, which had been adjudged not to constitute a defense, the action being under section 4918, Revised Statutes, on interfering patents, *held*, that it had become *res adjudicata*, and could not be permitted either under equity rule 39, nor the practice of equity courts outside of the rules. *Pentlarge v. Pentlarge*, 22 Fed. Rep., 412.

§ 3497. In suits between interfering patentees, under section 4918, Revised Statutes, the decision of the patent office in favor of one of the parties is not *res adjudicata* upon the question of priority of invention between them, and a bar to further litigation. *Hubel v. Tucker*, 24 Fed. Rep., 701.

§ 3498. The preliminary statement which a party to an interference makes in pursuance of the rules of the patent office does not estop him from showing in a suit at law that he made the invention at an earlier date than he there assigned it. *Union Paper Bag Machine Co. v. Crane*, 1 Holmes, 429.

See *Bill to Obtain Patent*, §§ 638, 639, 644-647. *Decree*, § 1794. *Demurrer*, § 1909. *Jurisdiction*, § 3895. *Priority of Invention*, §§ 4986-5023. *Repeal of Patents*, § 5859. *Secretary of Interior*, § 5989.

Interfering patents — Priority of invention — Patent office decision not conclusive, §§ 3499-3504.

§ 3499. The decision of the patent office is never final upon the question of the novelty or priority of the invention. *Union Paper Bag Machine Co. v. Crane*, 1 Holmes, 429.

§ 3500. The decision of the patent office upon the question of priority of invention will be binding upon a party and his privies where it appears that such party had filed in the patent office an application which had been placed in interference with the application of the original patent upon the reissue of which suit is brought, and had received and acquiesced in an adverse judgment of priority of invention, and had disclaimed the invention at issue in the interference, which is also that involved in the suit for infringement, and had taken out a more limited patent. *Peck, Stow & Wilcox Co. v. Lindsay, Sterritt & Co.*, 2 Fed. Rep., 688.

§ 3501. Such decision cannot bar the defense of prior invention by others, but the action of the office in granting the patent and the *prima facie* case made thereby should have great weight where the matters set up in such defense were known to the party under whose patent the defendants claim title at the time of making his application, and that a claim was made by him, notwithstanding, to the invention for the infringement of which suit is brought. *Ibid.*

§ 3502. The decision of the patent office on the question of priority of invention between two interfering patents, while not conclusive, nevertheless casts the burden of proof on the plaintiff. *Wire Book Sewing Machine Co. v. Stevenson*, 11 Fed. Rep., 155.

§ 3503. The party who is defeated upon interference in the patent office is not prevented by the decision, nor by the patent issued upon it to the adverse party, from contesting the question of priority anew in a suit at law. *Union Paper Bag Machine Co. v. Crane*, 1 Holmes, 429.

§ 3504. The question of priority of invention having been determined in favor of the complainants in an interference proceeding in the patent office, it is *res adjudicata* as between the parties to it. *Shuter v. Davis*, 16 Fed. Rep., 564. See § 3497.

See *Commissioner*, §§ 1081, 1082. *Injunction, Preliminary*, §§ 3155-3161. *Injunction*, §§ 3289, 3294, 3344, 3345.

181. INTERLOCUTORY ACTIONS IN THE PATENT OFFICE.

See PRACTICE IN THE PATENT OFFICE.

182. INTERLOCUTORY DECREE.

See DECREE, INTERLOCUTORY.

183. INTERLOCUTORY INJUNCTION

See INJUNCTION, INTERLOCUTORY.

184. INVALID PATENT.

See VALIDITY. VOID PATENT.

185. INVENTION.

See ASSIGNMENT OF INVENTION. DATE OF INVENTION. USE, DOUBLE. PRINCIPLE OF AN INVENTION. PRIORITY OF INVENTION. SUBSTITUTION OF MATERIAL INVOLVING INVENTION; NOT INVOLVING INVENTION. PURCHASER, OF INVENTION, PRIOR TO APPLICATION.

Invention — Defined, §§ 3505-3514. Classification of, §§ 3515-3517.

§ 3505. A mere naked discovery, in the sense of bringing to light something which existed before, but was not known, is not the proper subject of a patent. The word "discovery," as used in the constitution and laws of the United States relating to patents, is synonymous with the word "invention." *In re Kemper*, 1 MacA. Pat. Cases, 1.

§ 3506. "Invention," in the sense of the patent law, is the finding out, contriving, devising or creating something new and useful, which did not exist before, by an operation of the intellect. *Ransom v. Mayor of New York*, 1 Fish., 252.

§ 3507. That which a person perfects, or invents and applies to a practical use, is to be regarded as the invention. *Swift v. Whisen*, 2 Bond, 115.

§ 3508. An invention in mechanics consists not in discovery of new principles, but in new combinations of old principles. *Tyler v. Devil*, 1 Am. L. J., 248.

§ 3509. Invention generally (as distinguished from discovery) consists in new modes of applying what was before known, so as to produce thereby effects either not produced before, or not produced in that manner, or not produced so usefully. *Hailes v. Van Wormer*, 7 Blatch., 443.

§ 3510. Invention consists in perfected conception. It is sufficient to describe it with sufficient accuracy, even orally, that an expert may be enabled to make the thing conceived. *Woodbury v. Wilcox*, 2 A. L. T. (U. S.) R., 129.

§ 3511. An invention in the sense of the patent law means the finding out—the contriving, the creating of something which did not exist and was not known before, and which can be made useful and advantageous in the pursuits of life, or which can add to the enjoyment of mankind. *Conover v. Roach*, 4 Fish., 12.

§ 3512. If one who discovers a new mode of doing a particular thing that another has already invented has introduced a new element or principle into the subject-matter of invention, he is entitled to a patent and there is no infringement; but if he has only varied the invention of the other in certain particulars without affecting the principle, the subject-matter remains the same. *Pitts v. Wemple*, 1 Biss., 87.

§ 3513. If a new or improved useful result is effected by means before known, or any useful result is produced by a new mechanical device or combination of old mechanical devices, in both cases the exercise of invention must be necessarily presumed, because both are the proper subjects of a patent. *McMillin v. Barclay*, 5 Fish., 189.

§ 3514. An invention consists primarily in finding out what mechanical operation is necessary to produce the practical result arrived at. *Wooster v. Blake*, 8 Fed. Rep., 429.

§ 3515. Patentable inventions pertaining to machines may be divided into four classes: first, entire machines; second, separate devices of a machine; third, new devices of a machine in combination with an old element; fourth, combinations of old devices or elements. *Sanford v. Merrimac Hat Co.*, 4 Cliff., 404.

§ 3516. Inventions of improvements relating to machines are divided into four classifications: first, an entire machine; second, one or more elements of a machine; third, a new element and new combination of elements; fourth, a new combination of old elements. *Union Sugar Refinery Co. v. Matthieson*, 3 Cliff., 639.

§ 3517. Statement of what constitutes an infringement of each. *Ibid.*

Invention — *In what it may consist*, § 3518. *New use of old thing*, §§ 3519, 3520. *New result from old thing*, §§ 3521-3524. *New combination*, §§ 3525, 3526. *Substitution in old arrangements*, §§ 3527-3529. *Change of location*, §§ 3530-3532. *Simplifying*, §§ 3533-3537. *Addition*, § 3538. *Change*, §§ 3539-3541. *What degree of skill*, §§ 3542, 3543. See *Substitution of Material*, §§ 6209-6216.

§ 3518. What constitutes invention considered. *Earle v. Sawyer*, 4 Mason, 1.

§ 3519. Invention may consist in the new application of old elements. *Park v. Little*, 3 Wash., 196.

§ 3520. Application of an old thing to a new use, which requires experiment, is not a double use, and is patentable invention. *Strong v. Noble*, 6 Blatch., 477.

§ 3521. A patentable invention may consist of the use of an old thing in a known manner, to produce effects already known, when the result is new and better in the sense that the effects are more economically or beneficially enjoyed by the public. *In re Seely*, 1 MacA. Pat. Cases, 248.

§ 3522. In this class of cases the result is considered all-important. There must, however, be thereby evolved a principle such as will regularly, and not merely occasionally, in the use thereof produce a like effect. *Jones v. Witherill*, 1 MacA. Pat. Cases, 409.

§ 3523. If an inventor, by the dint of his own genius and discovery, has found out a new and appropriate manner of operating an old machine to produce a new result, he is entitled to a patent therefor, but he is not entitled to claim the machine itself. Where the invention is a machine or substantial thing, which has been completed so as to be capable of use, it is not essential to the validity of the claim that the success of the means made use of should be complete, or that the thing invented should supersede anything else used for the same purpose. The law looks only to the fact that the invention is capable of use. *Burrows v. Witherill*, 1 MacA. Pat. Cases, 315.

§ 3524. The use of anthracite coal as a fuel with a blast to produce a diffused heat around the smelting pots in a glass furnace, *held*, not to be a mere analogous or double use of anthracite coal and a blast, as previously used to produce a concentrated heat for various purposes; but a specification which failed to particularly describe and point out the mode of thus regulating the diffusion of the heat, *held* to be too vague and indefinite. *Yearsley v. Brookfield*, 1 MacA. Pat. Cases, 193.

§ 3525. A novel organization of co-operative elements, whether they are old or new, is an invention within the meaning of the statute. *Gould*, 1 MacArth., 410.

§ 3526. When a certain particular combination of old instruments or devices produces a new and useful effect in the art — as the combination for the first time in a machine for making corrugated or shirred India-rubber goods of calenders, rollers, endless apron, and a stitching frame — that combination becomes the lawful subject of a patent. *Warner v. Goodyear*, 1 MacA. Pat. Cases, 60.

§ 3527. Substitution of a new element in an old combination constitutes invention. *Earle v. Sawyer*, 4 Mason, 1.

§ 3528. When there is a palpable difference of construction — as in the substitution of an entire graduated circle for a graduated semi-circle in a pendulum level — which is shown to fit the new instrument for use in situations where the old form of instrument could not be used, there is a patentable invention. *Chandler v. Ladd*, 1 MacA. Pat. Cases, 493.

§ 3529. The omission of certain elements of the old machine and insertion of certain additional features, if an improvement results, constitutes a patentable invention. *Coupe v. Weatherhead*, 16 Fed. Rep., 673.

§ 3530. A simple change in location which others failed to discover, and which remedied a grave defect, *held*, to constitute a patentable difference. *Adams v. Howard*, 19 Fed. Rep., 317.

§ 3531. Where the change in location of a lever in a device made it a success, where prior efforts had been failures, it was held to involve invention and not mechanical skill only. *Brown Mfg. Co. v. Deere Co.*, 21 Fed. Rep., 709.

§ 3532. Any change in the position of old elements, whereby new and better results are accomplished, is a sufficient exercise of the inventive faculty to warrant the issuing of letters patent. *Stockton v. Maddock*, 10 Fed. Rep., 132.

§ 3533. Rearranging the parts of a machine so as to dispense with several expensive pieces before considered necessary, thereby simplifying the machine and improving its operation, is a patentable invention. *Wellman v. Blood*, 1 MacA. Pat. Cases, 432.

§ 3534. Where the change in the faucet made it more simple and economic, and was not formal, but in a certain degree structural, patentable invention was exercised, notwithstanding the general principle of operation was old. *Zane v. Peck Brothers & Co.*, 12 O. G., 518.

§ 3535. It was not simply the "carrying forward or new or more extended application of the original thought," and was not a "change only in form, properties or degree." (*Smith v. Nichols*, 21 Wall., 112.) *Ibid.*

§ 3536. A change made in an old device which, though simple, is effective, and produces a new and useful result, *held*, to involve the exercise of invention. *Sewing Machine Co. v. Frame*, 24 Fed. Rep., 596.

§ 3537. When an inventor merely brings an old element into his machine, he makes no invention; but where he does more — dispenses with certain parts, duplicates others, rearranges and simplifies the machine — he must be held to have made an invention. *Mundy v. Lidgerwood Mfg. Co.*, 20 Fed. Rep., 114.

§ 3538. The addition of corrugations to a smooth shoe nail held to involve invention, although shoe nails had been previously corrugated. *Dunbar v. Albert Field Tack Co.*, 4 Fed. Rep., 543.

§ 3539. Whenever the change and its consequences, taken together and viewed as a sum, are considerable, there must be a sufficiency of invention to support a patent. (*Webster on Subject-matter*, p. 29.) *In re Jackson*, 1 MacA. Pat. Cases, 485.

§ 3540. Where the invention was of an enameled collar, a new article of manufacture, and all its elements were old, the paper, the enamel, the composition of enamel, an enameled paper, *held*, that it involved invention of a new material to make an enameled paper collar capable of being turned down without cracking. *Hoffman v. Aronson*, 8 Blatch., 324.

§ 3541. When the change in the construction and mode of operation is slight, but the consequences of that change are considerable, as established by the affidavits of persons who have made actual tests of the devices in question, there is sufficient invention to support a patent. *In re Walsh*, 1 MacA. Pat. Cases, 530.

§ 3542. It is no answer to such a patent to say that the combination required no invention — that any mechanic might have selected the parts and combined them. The fact that no mechanic did before select and combine the parts and produce such a machine, notwithstanding the great need of it, is a sufficient reply to such a suggestion. *Dederick v. Cassell*, 9 Fed. Rep., 306.

§ 3543. The degree of skill and ingenuity required in making or applying an alleged improvement must be more than is possessed by an ordinary mechanic acquainted with the business, in order to constitute invention. *Dunbar v. Myers*, 4 Otto, 187.

Invention — *Complete*, §§ 3544-3548. *Perfect*, §§ 3549-3553. *Incomplete*, §§ 3554-3557. See *Experiment*, §§ 2371-2426. *Reduction to Practice*, §§ 5248-5258.

§ 3544. Where the invention consisted in merely substituting a volute spring of a described character for the springs before used in steam-pressure gauges, and the inventor had actually constructed such a spring with the surrounding parts, and had declared that the apparatus was designed as an improvement in steam-pressure gauges, *held*, that he had sufficiently manifested his invention to those skilled in the art, and that it was not necessary to the completeness of the invention that he should have actually put the device upon an engine. *Farley v. National Steam Gauge Co.*, 1 MacA. Pat. Cases, 618.

§ 3545. Although the description in a rejected application may be so full and precise as to enable any one skilled in the art to which it appertains to construct what it describes, it does not contain the proportions and character of a complete invention until it is embodied in a form capable of useful operation. *Lyman Ventilating & Refrigerator Co. v. Lalor*, 12 Blatch., 303.

§ 3546. A patentee held to have made his invention when he had a machine embodying it completed and in operation and actual use, though the use was private. *Knox v. Loweree*, 6 O. G., 802.

§ 3547. Although the description may be so full and precise in the application for a patent as to enable one skilled in the art to which it appertains to construct what is described, it does not attain the proportions or the character of a complete invention until it is embodied in a form capable of useful operation. *Lyman Ventilating & Refrigerating Co. v. Chamberlain*, 10 O. G., 588.

§ 3548. Where the alleged prior device was proved to be capable of producing the result sought to be accomplished, although another device was substituted for it and patented, *held*, that it was a complete invention, and the fact of abandonment by no means compelled the conclusion that it was never completed. *Stephenson v. Brooklyn Cross-Town R. Co.*, 19 Blatch., 473.

§ 3549. A perfected invention signifies that the invention should be completed so as to be of some practical utility; it need not be of any high degree if it is of any practical utility. *Johnson v. Root*, 1 Fish., 351.

§ 3550. To constitute a perfected invention which will entitle a party to a patent, it is not necessary that he should have actually constructed the machine which is the subject of his invention. If, having conceived a valuable idea, he has manifested it before the world, in any form which evidences the completeness of the idea, and which is sufficient, when communicated to others, to enable those skilled in the particular art to reproduce his invention, he has done enough to entitle himself to a patent, and this whether such evidence consist of written description, drawings, models, or a complete machine. *Farley v. National Steam Gauge Co.*, 1 MacA. Pat. Cases, 618.

§ 3551. A perfected invention is one that is brought to such a condition as to be capable of practical use. *Hayden v. Suffolk Mfg. Co.*, 4 Fish., 86.

§ 3552. A perfect machine, in that sense of the word "perfect," means a perfected invention; not a perfectly constructed machine, but one so constructed as to embody all the essential elements of the invention in a form that would make them practical and operative so as to accomplish the result. *American Hide & Leather Splitting Co. v. Tool Co.*, 1 Holmes, 503.

§ 3553. Where a device did such practical work as might reasonably be expected in the then state of the art, and was put to ordinary though not constant use for a short time in the presence of employees of a factory, and though but one device was made and was soon laid aside, it was held a perfected invention and not an abandoned experiment, and the use was held a public use. *Brush v. Condit*, 20 Fed. Rep. 826.

See *Abandonment*, § 114. *Application, Rejected*, § 370.

§ 3554. The making of a model capable of experimental use only, or of drawings from which machines might be constructed, are incomplete inventions, which cannot invalidate a subsequent patent. *Cahoon v. Ring*, 1 Cliff., 592.

§ 3555. A written description of a machine, although illustrated by drawings, which has not been given to the public, does not constitute an invention within the meaning of the patent law. *Lyman Ventilating & Refrigerator Co. v. Lalor*, 12 Blatch., 303.

§ 3556. A written description of a machine, although illustrated by drawings, which has not been given to the public, does not constitute an invention within the meaning of the patent laws; it must be embodied in a form capable of useful operation to obtain the character of a complete invention. *Northwestern Fire Extinguisher Co. v. Phila. Fire Extinguisher Co.*, 6 O. G., 34.

§ 3557. An imperfect and incomplete invention resting in mere theory, or in intellectual notion, or in uncertain experiments, and not actually reduced to practice, and embodied in some distinct machinery, apparatus, manufacture or composition of matter, is not patentable. *Draper v. Potomska Mills Corporation*, 13 O. G., 276.

See *Abandonment*, § 84. *Assignee*, § 541.

Invention — Form, §§ 3558-3560. See *Form*, §§ 2541-2553.

§ 3558. Where the difference in form was productive of new and valuable results, *held*, it was not a matter of fancy or the exercise of mechanical skill. Invention is evidenced from the long existing evil which was thereby remedied, and which would have been cured long since in the art had it depended simply on mechanical skill. *Eppinger v. Richey*, 14 Blatch., 307.

§ 3559. When form is of the substance of the invention it is not to be disregarded. *New York Bung & Bushing Co. v. Hoffman*, 9 Fed. Rep., 199.

§ 3560. Where a claim is not limited to a particular form or construction of device, and the specification does not assign any peculiar merit or claim any new result as the product of its conformation, such form cannot be considered as an essential part of the invention. *Couse v. Johnson, Black & Co.*, 16 O. G., 719.

Invention — *Not a question of accident or design*, §§ 3561, 3562. *Is property*, § 3563. *Assignable*, § 3564. *Degree of invention is immaterial*, §§ 3565-3573. *Process and product*, §§ 3574, 3575.

§ 3561. An invention is not like a will, depending on intention. It is a fact; and, if the fact exists, it does not appear to be material whether it came by design or accidentally, without being bidden. *Badische Anilin & Soda Fabrik v. Cochrane*, 16 Blatch., 155.

§ 3562. Where the utility of the change and the consequences resulting therefrom (in case of a machine) are such as to show that the inventive faculty has been exercised, though in point of fact the change was the result of accident, the requisite test of a sufficient amount of invention may exist. *Stephens v. Salisbury*, 1 MacA. Pat. Cases, 379.

§ 3563. The invention secured by letters patent is property, and as such is entitled to the same protection as any other property. *Brady v. Atlantic Works*, 4 Cliff., 408.

§ 3564. Inventions secured by letters patent are property in the holder of the patent. Such holder may sell, assign, lease or give away the property, or enter into any arrangement or agreement respecting the same, not enlarging the right granted, as the same might make with any other personal property. *Star Salt Caster Co. v. Crossman*, 3 B. & A., 281.

§ 3565. The law gives no monopoly to industry, to wise judgment or to mechanical skill in the case of known means, nor to the product of either, if it be not new. *Smith v. Elliott*, 9 Blatch., 400.

§ 3566. The law protects, as exclusive property, the invention of what is new; not comparative superiority or greater excellence in what was before known. *Ibid.*

§ 3567. Changes in the use of a known fabric, in its color, in its material, in the degree of fineness, or in the firmness of its parts, involving nothing new in construction, in the relation of its parts, nor in the functions of either part, do not involve invention, although they may result in greater excellence. *Ibid.*

§ 3568. There must be some inventive skill to sustain a patent, but the degree of that skill is not material. *Clark Patent P. Steam & Fire Regulator Co. v. Copeland*, 2 Fish., 221.

§ 3569. The validity of the grant is not to be determined by the amount of invention that was required. If novel, useful, and not before known, there is a sufficient amount of invention to sustain the patent. *Potter v. Holland*, 4 Blatch., 238.

§ 3570. It is of no consequence to the validity of the patent how much or how little labor, study or thought the invention cost. *Many v. Sizer*, 1 Fish., 17.

§ 3571. It is no objection that a combination appears to be simple, and the invention not very great, if it be not frivolous and foolish. *In re Smith*, 1 MacA. Pat. Cases, 252.

§ 3572. In determining the question whether there was invention in any particular combination, the important point is to ascertain whether novelty and utility existed. It is true that these requisites may result from mere mechanical skill, and a new and useful combination may be formed by the mere mechanical addition of an old element to an old set of members; but when a device has a new mode of operation which accomplishes beneficial results, "courts look with favor upon it," and are not exacting as to the degree of inventive skill which was required to produce the new result. There must be some, but a little will suffice. *Hoe v. Cottrell*, 17 Blatch., 546.

§ 3573. Invention appearing, the law does not attempt to measure its extent or degree. *Washburn & Moen Manufacturing Co. v. Haish*, 10 Biss., 65.

§ 3574. The process detailed in the description of a patent antecedent to the claim, and referred to thereby, is as much a part of the invention as are the materials of which the product is composed. Both are necessary elements of the invention, and both the material of which the product is composed or its equivalent, and the process of constructing the product, or an equivalent process, must be employed to constitute an infringement. *Goodyear Vulcanite Company v. Davis*, 12 Otto, 222.

§ 3575. The separate parts of a process being all old, the only field left for invention was either a new order in which the steps were to be applied, or some new method of using one or more of the devices by which the process was accomplished, or both these combined, so as to produce some new product, or some old product in a cheaper or otherwise more advantageous manner. *Downton v. Yaeger Milling Co.*, 25 O. G., 697.

Invention — Right to protection, §§ 3576-3583. What is, §§ 3584-3589.

§ 3576. Act 1793, chapter 11, "invention," reviewed. *Earle v. Sawyer*, 4 Mason, 1.

§ 3577. No discovery will entitle the discoverer to a patent which does not in effect amount to the contrivance or production of something which did not before exist, or, in other words, to an invention. *In re Kemper*, 1 MacA. Pat. Cases, 1.

§ 3578. When a party has invented some mode of carrying into effect a law of natural science, or a rule of practice, it is the application of that law or rule which constitutes the peculiar feature of the invention. He is entitled to protect himself from all other modes of making the same application, and every question of infringement will present the question whether the different mode, be it better or worse, is in substance an application of the same principle. *Sewall v. Jones*, 1 Otto, 171.

§ 3579. Where one inventor precedes all others in a particular department, and invents a new machine never used before, and procures a patent for the same, he acquires a monopoly as against all merely formal variations thereof; but if the advance toward the thing desired is gradual, and proceeds step by step, so that no one can claim the complete thing, each inventor is entitled only to his own specific form of device. *Railway Co. v. Sayles*, 7 Otto, 554.

§ 3580. Because the inventor first applied an old device to a new use, he is not therefore entitled to the exclusive use of the device when it is applied in other and not analogous mechanisms to produce a new effect. *Judd v. Babcock*, 8 Fed. Rep., 605.

§ 3581. The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. It was never their object to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. *Atlantic Works v. Brady*, 107 U. S., 192.

§ 3582. It is the invention of what is new, and not the arrival at comparative superiority or greater excellence in that which was already known, which the law protects as exclusive property, and which it secures by patent. *Putnam v. Yerrington*, 9 O. G., 689.

§ 3583. All improvement is not invention and entitled to protection as such. Thus to entitle it, it must be the product of some exercise of the inventive faculties, and it must involve something more than what is obvious to persons skilled in the art to which it relates. *Pearce v. Mulford*, 12 Otto, 112.

§ 3584. In deciding whether the patent covers an article the making of which requires invention, we are not required to shut our eyes to matters of common knowledge or things in common use. *King v. Gallun*, 109 U. S., 99.

§ 3585. An improvement on a machine, to constitute invention, must be new, not known or in use before, and must be useful. This novelty, worked out by the mind of an inventor, connected with utility, constitutes the essence of a patentable subject. *McCormick v. Seymour*, 3 Blatch., 209.

§ 3586. A patentable invention is a mental result. It must be new and shown to be of practical utility. Everything within the domain of the conception belongs to him who conceived it. The machine, process or product is but its material reflex and embodiment. *Smith v. Nichols*, 21 Wall., 112.

§ 3587. A question of patentable invention raised on demurrer examined and determined upon mere inspection of the patent. *Dick v. Oil Well Supply Co.*, 25 Fed. Rep., 105.

§ 3588. Opportunities for experiment considered in respect to time occupied in perfecting invention. *McCormick v. Seymour*, 3 Blatch., 209.

§ 3589. Where the defense set up is a substantial departure in defendant's machine from that of complainant, he must show, or it must appear, that the departure involved invention and not mere mechanical skill. *Forbes v. Barstow Stove Co.*, 2 Cliff., 379.

Invention — Non-invention — *Change in form*, §§ 3590-3594; *of location*, §§ 3595, 3596; *of degree*, §§ 3597-3599; *in application*, §§ 3600-3605; *of material*, §§ 3606, 3607. *Duplication*, §§ 3608, 3609. See *Aggregation*. *Formal Change*, §§ 2566-2577. *Mechanical Skill*, §§ 4187-4191. *Substitution of Material*, §§ 6217-6223. *Use, Analogous*, §§ 6351-6353. *Use, Double*, §§ 6354-6357.

§ 3590. Mere change in the form of machinery (unless a particular form is specified as the means by which the effect described is produced), or an alteration in some of its unessential parts, or in the use of known equivalent powers, not varying essentially the machine, or its mode of operation or organization, will not make the new machine a new invention. It may be an improvement of the former, but that will not justify its use without the consent of the first patentee. *O'Reilly v. Morse*, 15 How., 62.

§ 3591. Formal difference between two machines whose mode of operation is the same does not amount to invention. *Gray v. James*, Pet. C. C., 394.

§ 3592. A mere carrying forward, or new or more extended application of an old idea, a change only in form, proportions or degree, the substitution of equivalents doing substantially the same thing in the same way, by substantially the same means, with better results, is not such an invention as will sustain a patent. *Smith v. Nichols*, 21 Wall., 112.

§ 3593. The mere carrying forward of an original conception patented — a new and more extended application of it — involving change only of form, proportions or degree, the substitution of equivalents doing the same thing as did the original invention, by substantially the same means, with better effects, is not such invention as will sustain a patent. *Putnam v. Yerrington*, 9 O. G., 689.

§ 3594. Mere change of form of the machinery, or the means specified by which the result is produced, or an alteration in some of the unessential parts, or a substitution or use of a known equivalent not essentially varying the machine or its mode of operation or organization, will not make a new invention. *American Pin Co. v. Oakville Co.*, 3 Blatch., 190.

§ 3595. Mere change of form or location in a mechanical structure is not the subject of a patent without showing that some new or materially-improved result is obtained. *Pearl v. Ocean Mills*, 11 O. G., 2.

§ 3596. It is not invention to place an old thing in a new location without change of result. *Stephenson v. Brooklyn Cross-Town Railroad Co.*, 19 Blatch., 473.

§ 3597. Change in degree does not constitute invention. *Woodman v. Stimpson*, 3 Fish., 98.

§ 3598. There is no invention in reducing an article of bulk to minute fragments, when it is not improved by adding some new ingredient, or by subtracting one or more. *Milligan and Higgins Glue Co. v. Upton*, 4 Cliff., 237.

§ 3599. A mere reduction in size of an old device, so as to make it small enough for a new use, cannot support a claim to a patent. *Double Pointed Tack Co. v. Mann*, 5 B. & A., 465.

§ 3600. The application of old mechanical devices, without material change, to a use in which they were not employed before, but which was known and had been practiced, does not constitute a patentable invention. *Couse v. Johnson, Black & Co.*, 16 O. G., 719.

§ 3601. The application to a device of a feature which had already been in use for the same purpose in another form of tool lacks the invention requisite to support a patent within the decisions of the supreme court. *Collins Company v. Coes*, 21 Fed. Rep., 38.

§ 3602. Merely applying old and well-known mechanical contrivances to a new purpose will not support a claim for a patentable invention or process. *Gottfried v. Crescent Brewing Co.*, 9 Fed. Rep., 762.

§ 3603. If an old machine or process is put to a new use, invention is positively excluded, although the new use may apparently be very remote from the old, requiring experiment to ascertain its practicability, and though the actual operation of the machine or process may not be exactly the same in the new as in the old application, provided no new means are, in fact, employed. *Dunbar v. Albert Field Tack Co.*, 4 Fed. Rep., 543.

§ 3604. A new or more perfect effect produced by well known agents in well known ways on well known subjects is not a patentable invention. *Morton v. New York Eye Infirmary*, 5 Blatch., 116.

§ 3605. It is not invention if all the parts in a combination have been applied to a different object before, and they were now only applied to a new object. *Hovey v. Henry*, 3 West. L. J., 153.

§ 3606. Within the range of materials known to possess the proper qualities for the purpose, it is not invention to select that one which exhibits these qualities in a more marked degree, and thereby make a better article than had before been made. *In re Maynard*, 1 MacA. Pat. Cases, 536.

§ 3607. The mere selection of a superior material, which is so by reason of its well-known qualities — as substituting steel or case-hardened iron for sheet metal in constructing the firing end of a cartridge — is not invention. *Ibid.*

§ 3608. Duplication which does not constitute invention. *Bigelow v. Matthews*, 7 Blatch., 77.

§ 3609. A simple duplicate of an old device, without alteration of its mode of action or change in the result, does not constitute patentable invention. *Stephenson v. Brooklyn Cross-Town R. Co.*, 19 Blatch., 473.

See *Abandonment*, § 11.

Invention — Non-invention — In general; particular cases, §§ 3610-3643. See *Drawings*, §§ 2076-2080. *Experiment*, §§ 2371-2426.

§ 3610. A function or mode of operation of a machine is not patentable apart from the machinery. *Reay v. Raynor*, 19 Fed. Rep., 308.

§ 3611. A difference of construction perfectly obvious to any competent mechanic does not constitute a patentable invention. *National Wire Mattress Co. v. New York Braided Wire Mattress Co.*, 20 Fed. Rep., 119.

§ 3612. Where certain properties are known to belong generally to classes of articles, there can be no invention in putting a new species of the class in a condition for the development of its properties similar to that in which other species of the same class have been placed for similar development; nor can the changed form of the article from its condition in bulk to small pieces, by breaking, or other similar mechanical means, make it a new article in the sense of the patent law. *Milligan & Higgins Glue Co. v. Upton*, 7 Otto, 3.

§ 3613. The arrangement of an old combination in a new and closer form does not constitute invention. *Tift v. Sharp*, 18 Blatch., 138.

§ 3614. Omitting from a combination an element which performed a distinct office therein, and leaving the remaining ones to perform the same offices or functions without the omitted element that they did with it, does not constitute a patentable invention. *Stow v. City of Chicago*, 8 Biss., 4.

§ 3615. There is no novelty or invention in such alterations of a combination as is the necessary consequence of the practical use of the machine by a man of ordinary skill and judgment. *Wilbur v. Beecher*, 2 Blatch., 132.

§ 3616. Where the combination is old, the elements old, the mode of combining them old, and a material in common use is substituted for the material of one of the elements, if the substitution involves nothing beyond the ingenuity and skill of an ordinary mechanic acquainted with the business, a patent for the same is void. *Hotchkiss v. Greenwood*, 4 McL., 456.

§ 3617. Where the inventor, having struck out his idea, procured from a mechanic the mechanical power to put in operation his combination, *held*, these mere contrivances, consisting of various modes of producing the power, such as any mechanic can supply, were no part of the invention. *Blanchard's Gun-Stock Turning Factory v. Warner*, 1 Blatch., 258.

§ 3618. The accidental making of an improved article, in a single instance, without knowledge on the part of the producer of how to accomplish it, or to produce another like it, is not invention. *Pelton v. Waters*, 7 O. G., 425.

§ 3619. A direction to workmen to use a known tool in a skilful mode, well known in other arts, and in the art in question, as applied to a somewhat different tool, to effect an old result, is not a patentable invention. *Walker v. Rawson*, 4 B. & A., 128.

§ 3620. It is not invention to combine a known tool with a known machine, if the combination requires nothing more than mechanical skill, especially if the combination has already been suggested. *Bailey Washing & Wringing Machine Co. v. Lincoln*, 4 Fish., 379.

§ 3621. The specification of the alleged invention does not describe such an advance in the art as should exist to sustain a patent. The patentee selected certain well known materials and combined them in proportions that were within the range of the common knowledge of the art. Such a selection did not, in the absence of a new result, involve invention, and could not properly be made the subject of a patent. *Welling v. Crane*, 14 Fed. Rep., 571.

§ 3622. Applying tubular legs to a portable furnace held not to involve invention in view of the state of the art. *In re Baxter*, 1 MacArth., 520.

§ 3623. To attach advertisements permanently to balloons does not come within the purview of the patent law. *Gould*, 1 MacArth., 410.

§ 3624. The insulation of the oil-holder of a stove, by making the legs of the stove long enough to allow the lamp to be placed under it without touching, is not invention, and does not require ordinary mechanical skill to devise. *Couse & Blood v. Johnson, Black & Co.*, 16 O. G., 719.

§ 3625. Combining with one form of machine a device or element well known in other forms of machines of the same class — as arranging in a fire-place heater of a well-known type a fuel-receptacle common in ordinary cook-stoves — is not broadly patentable. It is a mere aggregation of old devices, each performing its ordinary function in the ordinary way, and not co-operating to produce any new result. *Thatcher Heating Co. v. Burtis*, 12 Fed. Rep., 569.

§ 3626. The invention, if any, resides in the means employed to adjust the parts into efficient relations with each other in the new organization. *Ibid.*

§ 3627. Where a person has invented a machine for sewing together the soles and uppers of boots and shoes by a chain-stitch without any welt, the stitch itself and the manner of forming it being well known, and the only new effect being the forming of the well-known seam in the well-known manner in a difficult place, theretofore inaccessible by any means that had then been discovered, and the inventor had taken out separate patents for the machine, the process and the product, *held*, that the entire invention lay in the machine, and that the patents for the process and product were invalid for lack of invention. *MacKay v. Jackman*, 12 Fed. Rep., 615.

§ 3628. After knowledge of a machine to make a shoe in a particular manner, there would be no room for an invention of that manner of making a shoe, or of a shoe made in that manner, and there would be no more room for the inventor of the machine than for any one else. It may be doubtful whether such a process or product as this is by itself patentable. *Ibid.*

§ 3629. Mere mechanical operations, like the looping and drawing threads to form stitches in sewing, either by machinery or by hand, do not amount to arts or processes; and such operations, apart from the means of performing them, do not appear to be within the reach of protection by the patent laws. *Ibid.*

§ 3630. Shawl-straps with handles attached to a leather cross-piece having loops at the ends being old, it is no invention to stiffen by artificial means the leather cross-piece, which had before been made as rigid as it could be by thickness, doubling and stitching. The use of known equivalents for some of the elements of former structures, to make them somewhat better, is not invention. *Crouch v. Roemer*, 13 Otto, 797.

§ 3631. Where the invention was of a roller for pebbling leather, *held*, that if the roller and every part of its construction were old, except the figures and designs on the roller, it was not patentable invention; *held*, also, that the stamping of designs upon an old smooth roller, or their substitution for those on an old figured roller, involved mere mechanical skill, and not patentable invention. *Stimpson v. Woodman*, 10 Wall., 117.

§ 3632. *Held*, that increasing the curve of a wagon reach, so that the front wheels, which had partially gone under it, could do so entirely, was mere mechanical expedient, formal change, and not invention. *Flood v. Hicks*, 2 Biss., 169.

§ 3633. The change of a raker's seat on a harvesting machine, so that it might face any particular angle, *held* to be manual adjustment, and not a patentable invention. *Kirby v. Beardsley*, 5 Blatch., 438.

§ 3634. Where the patent was for a composition of matter consisting of gutta-percha, oxide of iron, and oxide of antimony in described proportions, which was shown by the testimony to be the preferred form of the invention, *held*, that the patentee could not prosecute a new application for a composition in which the oxides of iron and antimony were replaced by a variety of substances which operated in the same manner, but with less success, and were at best but equivalents of the ingredients named in the patent. *Pomeroy v. Connison* cited and approved. *Bowen v. Herrick*, 1 MacA. Pat. Cases, 310.

§ 3635. In a steam-boiler water gauge, merely lengthening the pipe within the chamber connected with the boiler by coiling the same, or by uniting several straight lengths of pipes for the purpose of increasing the effect, is not a patentable invention. It is an ordinary expedient for multiplying the heating surface, and in this sense is a mechanical equivalent of the straight pipe. *In re Nutting*, 1 MacA. Pat. Cases, 455.

§ 3636. A claim for a composition of matter — a metallic paint — possessing no new ingredient or quality in itself, and obtained by well known methods of treatment from a refuse or waste material which was known to contain the elements of the composition in suitable proportions, is not rendered patentable by the fact that the applicant was the first to utilize the waste in that manner. *In re Maule*, 1 MacA. Pat. Cases, 171.

§ 3637. A claim for a new principle or process of manufacturing cotton, by carding and spinning the cotton in its fleecy state as it comes from the gin in a continuous operation, and before the fibres are disturbed by baling, and the other treatment before used in the process of manufacture to restore it to its original state, *held*, to be anticipated as a process by Bryant's improvement on the Columbian spinner. *In re Henry*, 1 MacA. Pat. Cases, 467.

§ 3638. When an alleged invention — which in this case consisted in surrounding the part of a lightning-rod embedded in the earth with a galvanic battery, to facilitate the discharge of the electricity — appears to be on principle wholly incapable of effecting the desired result, *held*, that the application should be rejected as not sufficiently useful and important. *In re Cushman*, 1 MacA. Pat. Cases, 569.

§ 3639. It being impossible to determine upon principle what would be the final result of substituting polygonal glasses of an inverted pyramidal form, for the lens-shaped glasses previously used in illuminated vault covers, and the applicant having offered no evidence of the actual results in practice, *held*, that the change appeared to be one of form merely, and not patentable. *In re Jackson*, 1 MacA. Pat. Cases, 485.

§ 3640. The endless screw and wheel is a common mechanical power applicable to an indefinite number of machines, and the mere application of it to the segmental-rack or quadrant on the rudder-head for the first time is not an invention, although it enables the helmsman to hold and stay the rudder with more ease. *Cochrane v. Waterman*, 1 MacA. Pat. Cases, 52.

§ 3641. The discovery of a beneficial effect, resulting from doing a thing in the same manner in which it has been done before — as when a person discovered or found out by observation that blocks of ice placed edgewise kept longer than when placed differently — is not the invention of something which did not before exist; it is not an invention. *In re Kemper*, 1 MacA. Pat. Cases, 1.

§ 3642. The alleged invention examined in connection with affidavits offered to show that the consequences of the proposed change are of great practical importance and found to be devoid of patentable novelty. *In re Littlefield*, 1 MacA. Pat. Cases, 574.

§ 3643. Where the claim was to a series of two pairs of old dies, the two pairs of which were not combined in one machine and did not co-operate to one result, and if used in succession operated separately and distinctly unaffected the one by the other, *held*, that there was no combination and no patentable invention. *Beecher Mfg. Co. v. Atwater Mfg. Co.*, 114 U. S., 523.

Invention — Evidence of — *Commercial success is evidence of*, §§ 3644-3652.

§ 3644. That a device has gone into general use, displacing all other devices, is evidence that it is patentable. *Smith v. Goodyear Dental Vulcanite Co.*, 3 Otto, 486.

§ 3645. Letters patent themselves *prima facie* establish the fact that a patentable invention is embraced thereby, and strongly confirmatory of this will be evidence tending to show the favorable acceptance by the public of the improvement and its recognition by the trade as something new and meritorious. *Strobridge v. Lindsay*, 2 Fed. Rep., 692.

§ 3646. If one paper-file holds the paper better than another which is patented, and has

driven it out of market, that is *prima facie* evidence that the mechanism is different, and is a new invention, and that the use of it does not violate the patentee's monopoly. *Smith v. Woodruff*, 1 MacArth., 459.

§ 3647. Where it is shown that several inventors have given their attention to the same matter, and that the device has gone into general use, it is evidence that it involves more than mere mechanical skill. *Western Electric Mfg. Co. v. Chicago Electric Mfg. Co.*, 14 Fed. Rep., 691.

§ 3648. The fact of success and acceptance by the public, in a field where so many others had tried and failed, held sufficient evidence that patentee's device was both new and useful and involved invention. *Ward v. Grand Detour Plow Co.*, 14 Fed. Rep., 696.

§ 3649. As between a patentable invention and the result of mechanical skill, the circumstances that the value of the new article was immediately recognized, and that it supplied a want long felt but not before met, should have due weight in favor of the sufficiency of invention. *Shuter v. Davis*, 16 Fed. Rep., 564.

§ 3650. Commercial success held evidence of patentable invention, and of validity of a patent. *United States Stamping Co. v. King*, 17 Blatch., 55.

§ 3651. Although from the standpoint of after time it might seem difficult to see that a particular combination of old elements should have required the exercise of invention, still the fact that in the multiplicity of prior machines in the same line of invention a combination of such value had not been hit upon, and that when introduced its utility was universally recognized, renders it evident that in order to make such combination changes were necessary which the skill of the mechanic would not suggest, and that the work was practically more difficult than to the theorist it might now seem. *Hoe v. Cottrell*, 17 Blatch., 546.

§ 3652. The fact that a patented article, immediately on its introduction, was successful in the trade is evidence of invention. *Hicks v. Otto*, 19 Fed. Rep., 749.

Invention — Evidence of — Generally, §§ 3653-3662.

§ 3653. It is *prima facie* evidence of invention to make and exhibit an article never before seen or heard of by the witnesses who prove the fact. *Pennock v. Dialogue*, 4 Wash., 538.

§ 3654. But slight evidence of invention is required when the nature of the invention is pointed out and where proof is given of its practical utility. *In re Fultz*, 1 MacA. Pat. Cases, 178.

§ 3655. It is not necessary that a witness should qualify as an expert to testify to the fact and date of an invention, if his knowledge and memory are sufficient to enable him to truly relate the facts on the subject which he had heard and seen. *Screw Co. v. Sloan*, 1 MacA. Pat. Cases, 210.

§ 3656. If an invention has been evidenced by oral description, it is not necessary that it should be reduced to the form of drawings or models until the application is filed. *Stephens v. Salisbury*, 1 MacA. Pat. Cases, 379.

§ 3657. A new or improved or more economical effect attributable to the change made by the patentee in the mode of operation of existing machinery, proves that the change has introduced a new mode of operation. *Forbush v. Cook*, 2 Fish., 668.

§ 3658. A new combination of known devices, producing a new and useful result (as that of greatly increasing the effectiveness of a machine), is evidence of invention, and may be the subject of a patent. *Webster Loom Co. v. Higgins*, 105 U. S., 580.

§ 3659. Because the invention has been used in an imperfect condition, or altered slightly in one particular without serious loss, it is no proof that it was no invention, or that the use of it in its altered condition was no infringement. *Cawood Patent*, 4 Otto, 695.

§ 3660. Where a circular, describing and recommending the patented compound, and concluding: "*We do not claim it as any specialty of ours*," etc., was issued prior to patenting the compound, it was held strong evidence of want of invention. *Boykin v. Baker*, 4 Hughes, 282.

§ 3661. It may be inferred that sufficient invention was exercised in producing a given change to sustain a patent for it if its utility is demonstrated by the results. *Roberts v. Dickey*, 4 Brewster, 260.

§ 3662. When the subject of investigation is an alleged invention of complex mechanism, both new and useful, in the construction of which alterations had been made in previous structures, of which their authors had not apparently conceived, and the alleged invention relates to mechanism in which advances have been made since its date, the conclusions of witnesses as to non-invention, if admissible at all, are to be received with hesitation. *Yale Lock Mfg. Co. v. Norwich Nat. Bank*, 19 Blatch., 123.

See *Caveat*, § 672. *Novelty*, §§ 4326-4328. *Patentability*, §§ 4604-4606.

Invention — Joinder of — *Patent for one improvement only*, § 3663. *Distinct improvements may be joined*, §§ 3664, 3665; *when for common purpose*, §§ 3666-3672. *Invention may be subdivided*, §§ 3673-3675. *Combination patents*, §§ 3676, 3677. *Quære, as to joinder*, §§ 3678, 3679; *a matter of discretion with patent office*, § 3680. *Joinder not allowed, when*, §§ 3681-3683. *Process and product*, §§ 3684-3690.

§ 3663. A patent cannot embrace more than one improvement or invention. *Barrett v. Hall*, 1 Mason, 447.

§ 3664. Act 1837, section 9, chapter 45, joinder of inventions, construed. *Wyeth v. Stone*, 1 Story, 273.

§ 3665. Patents should embrace but one subject; but where they relate to the same subject, or are in nature or operation connected, several may be embraced in one patent. *Hogg v. Emerson*, 6 How., 437.

See *Use*, § 6578.

§ 3666. A patent for more than one invention is valid if they are connected in their design and operation. *Hogg v. Emerson*, 11 How., 587.

§ 3667. Where the claims of the patent related to a like subject, and were in their nature and operation connected together, they were held properly joined in one patent. *Fire Extinguisher Case*, 21 Fed. Rep., 40.

§ 3668. Inventions connected together by being appropriate for use in the same article, for the common purpose of making the article, may be joined in one patent. *Maxheimer v. Meyer*, 9 Fed. Rep., 460.

§ 3669. There can be no question that there may be a claim for two inventions in the same patent, if they both relate to the same machine or structure; and an action can be sustained for the infringement of either one or the other of the separate inventions, when claimed as separate and distinct in their character. *Lee v. Blandy*, 1 Bond, 361.

§ 3670. As regards joinder of invention, the principle seems to be, that the inventions should be capable of being used in connection, and to subserve a common end, although their actual employment together does not seem to be required to sustain the validity of the patent in which they may be united. Accordingly the wrongful use of either separate machine is a violation of the patent-right *pro tanto*. *Emerson v. Hogg*, 2 Blatch., 1.

§ 3671. Distinct improvements in one machine may be joined in one patent. *Moody v. Fiske*, 2 Mason, 112.

§ 3672. Two distinct and independent inventions, to be used for the same common purpose, and auxiliary to the same ends, may be joined in one patent. *Wyeth v. Stone*, 1 Story, 273.

§ 3673. The United States courts having held divisional patents valid, there can be no objection to subdividing an invention into distinct claims. *Brown v. Deere & Co.*, 2 McC., 422.

§ 3674. If an inventor claims two distinct improvements in one machine, he may apply for them jointly, and have a single patent for both. If he has made a mistake as to one of the improvements claimed, but is clearly entitled to the other, he cannot be said to have abandoned either during a litigation as to his right to both. *Adams v. Jones*, 1 Fish., 527.

§ 3675. A patentee may take out a valid patent for a machine combining several distinct improvements, and also for each distinct improvement contained in the same machine. Such is the intent of act 1837, section 9. *Pitts v. Whitman*, 2 Story, 609.

§ 3676. Combination patents mentioned as an example where more than one invention may be secured by a single patent. *Bates v. Coe*, 8 Otto, 31 (§§ 1816-30).

§ 3677. A patent may embrace both a combination consisting of several elements, which, together compose an organized machine, and sub-combinations consisting of fewer members of the same elements. *Stevens v. Pritchard*, 4 Cliff., 417.

§ 3678. Doubted whether, under the general patent law, improvements on different machines could regularly be comprehended in the same patent. *Held* to be authorized by the special act. *Evans v. Eaton*, 3 Wheat., 454.

§ 3679. Where it was doubted whether, in the light of the judicial decisions on the subject, a patent could rightfully be granted containing claims covering several distinct and independent improvements in one trunk, and therefore it is made a condition upon which the relief prayed in the bill will be granted, that the patentee shall disclaim all but one of the said improvements. *Sessions v. Romadka*, 21 Fed. Rep., 124.

§ 3680. Whether two or more inventions or improvements should be included in one patent is a matter of discretion with the patent office. *Bennett v. Fowler*, 8 Wall., 445.

§ 3681. Distinct improvements in two different machines having distinct and independent operations cannot be joined in one patent. *Moody v. Fiske*, 2 Mason, 112.

§ 3682. Combinations of different machines and distinct improvements in each cannot be joined in one patent. *Ibid.*

§ 3683. An inventor of certain improved machines, capable of distinct operation, and who

has also invented a combination of the same, cannot in the same patent protect the combination and the individual machines. *Barrett v. Hall*, 1 Mason, 447.

§ 3684. There cannot be in the same patent a claim for a machine and a claim for the process of using that machine. *Gage v. Kellogg*, 23 Fed. Rep., 891.

§ 3685. Where the discovery consists in a new compound, substance or manufacture, both process and product are patentable, not severally, but as one invention. *Goodyear v. The New Jersey Central Railroad*, 2 Wall. Jr., 356.

§ 3686. Separate claims for process and product may properly be embraced in one patent. *Goodyear v. Wait*, 5 Blatch., 468.

§ 3687. The process of making and the article made are, in legal contemplation, distinct inventions. Both may be included in a single patent, but none the less the need of a full, clear and exact description, according to the statute, is indispensable in each case. *Kelleher v. Darling*, 4 Cliff., 424.

§ 3688. Both the process and the product may be included in one patent; but in such case the description of the invention in the specification and claims should disclose that the inventor had both results in his mind. *Welling v. Rubber Harness Trimming Co.*, 7 O. G., 608.

§ 3689. A product cannot properly be embraced as an article of manufacture in the same claim with the process. *Merrill v. Yeomans*, 1 Holmes, 331.

§ 3690. It is doubtful whether claims to the process and to the instrumentalities of the process constitute two subjects of patents. It would seem that the process is not patentable at all. *United States ex rel. Gorton v. Butterworth*, 27 O. G., 717.

See *Claim*, § 847. *Commissioner*, § 1108. *Defenses*, § 1829. *Product*, § 5125. *Reissue*, §§ 5666, 5667.

Invention — Joint, §§ 3691-3697. See *Inventors, Joint*, §§ 3790-3800.

§ 3691. One may have letters patent issued to him individually for what he has claimed as a joint invention with another. *Crocker's Case*, 2 A. L. T. (U. S.) R., 129.

§ 3692. A patent on a joint invention should not be granted to one of the inventors on the assignment of the other; all concerned therein should join in the petition. *Taney's Opinion*, 2 Op., 571.

§ 3693. If the facts show that a patent is the result of the mutual contributions of two persons, they should be treated as joint inventors and a joint patent should be taken out. Such patent stands for and must be supported by a joint invention; but the court would not be justified in annulling such patent without clear proof that the patentees are not joint inventors. *Worden v. Fisher*, 11 Fed. Rep., 505.

§ 3694. A mere suggestion, not acted upon by the person making it, but carried out and perfected by another, will not entitle the former to be considered a joint inventor. Nor is it necessary that exactly the same idea should have occurred to two persons at the same time, and that they should work out together the embodiment of this idea in a perfected machine to constitute them joint inventors. If an idea is suggested to one, and he even goes so far as to construct a machine embodying this idea, but it is not a completed and working machine, and another person takes hold of it, and by their joint labors, one suggesting one thing and the other another, a perfect machine is made, a joint patent may properly issue to them. If, upon the other hand, one person invents a distinct part of a machine and another person invents another distinct and independent part of the same machine, then each should obtain a patent for his own invention. *Ibid.*

§ 3695. Joint invention is the result of mutual contributions of the parties; and if one suggests an idea in a general way and the other falls in with it, and by his aid develops and gives definite practical embodiment to it, the two may be considered joint inventors. *Gottfried v. Phillip Best Brewing Co.*, 17 O. G., 675.

§ 3696. To overthrow the presumption of joint invention raised by the filing of a joint application upon a joint oath the evidence must be clear and unequivocal. *Ibid.*

See *Estoppel*, § 2261.

Invention — Prior — *Reduction to practice constitutes prior invention*, § 3697; *and is necessary to defeat a patent*, §§ 3698-3702; *experiment will not*, §§ 3703-3713. See *Priority of Invention*, §§ 4986-5023.

§ 3697. To constitute prior invention it is not sufficient to have conceived the idea, but it must have been proceeded with so far as to entitle the prior inventor to a patent had he applied. *Allen v. Hunter*, 6 McL., 303.

§ 3698. To constitute such prior invention as will avoid a patent it must be made to appear that some one before the patentee not only conceived the idea, but also reduced it to practice and embodied it in some practical and useful form. *Ellithorp v. Robertson*, 4 Blatch., 307.

§ 3699. To constitute a prior invention the party alleging to have produced it must have proceeded so far as to have reduced his idea to practice and embodied it in some distinct form. *Union Sugar Refinery Co. v. Matthieson*, 3 Cliff., 639.

§ 3700. To invalidate a patent it is essential that the alleged prior invention should have been reduced to practice. *Poppenhusen v. New York Gutta-percha Comb Co.*, 2 Fish., 62; *Case v. Brown*, 1 Biss., 382.

§ 3701. To defeat a patent it is not necessary that the prior inventor should have worked the invention with the same degree of skill and success as the patentee has attained, provided he employed substantially patentee's method and attained a degree of success which demonstrated its utility. *Waterman v. Thompson*, 2 Fish., 461.

§ 3702. The evidence must clearly establish the priority of a completed and useful machine over complainant's patent in order to defeat it; doubt on this point is to resolve it in the negative. *Parham v. American Button Hole, etc., Sewing Machine Co.*, 4 Fish., 469.

§ 3703. The conception of an idea and the attempt to produce it, ending in unsuccessful experiment, is not sufficient to defeat a subsequent patent. *Many v. Sizer*, 1 Fish., 17.

§ 3704. Prior machines resting in experiment alone do not constitute prior invention; they must have been brought into actual use. *Singer v. Walmesley*, 1 Fish., 558.

§ 3705. The use contemplated by the statute in order to constitute prior invention is not one for experimental purposes only, but a practical use. *Ibid.*

§ 3706. Where the alleged prior inventor was shown to be very near the realization of the invention, but could not, at a period long subsequent, make a practical machine embodying the invention, *held*, that his operations were not sufficient to defeat a patent, although witnesses testified that they were successful. *American Bell Telephone Co. v. People's Telephone Co.*, 25 Fed. Rep., 725.

§ 3707. The existence of a single prior machine, subsequently destroyed and dispersed, not known to the public through the memory of the alleged inventor, and unknown to the patentee, will not invalidate his patent. *Cahoon v. Ring*, 1 Cliff., 592.

§ 3708. The continued use of a prior improvement or machine is not necessary in order to defeat a subsequent inventor, provided it was practical. *Sayles v. Chicago & Northwestern R. Co.*, 1 Biss., 468.

§ 3709. Whether the alleged prior invention is a practicable machine is a question of fact for the jury. Actual use is not necessary, but a capacity for such use. *Pitts v. Wemple*, 1 Biss., 87.

§ 3710. If one originates certain devices which work well without alteration in the machine for which they are intended after it is completed, a subsequent inventor cannot claim them, although he perfect the machine in which he employs them before the other perfects his. (*Brown v. Guild*; *Brown v. Selby*) *Corn-Planter Patent*, 23 Wall., 181.

§ 3711. But he may claim them in a new combination of them with devices of his own which result in a useful machine. *Ibid.*

§ 3712. Although the weight of evidence might be in the defendant's favor if the question as to prior use of the invention were to be determined upon a fair balance of proof and upon the parol evidence alone, still, in order to defeat the patent by showing an invention prior to a clearly established one of the patentee, it must be as clearly established to the extent at least of removing all fair and reasonable doubts. *Campbell v. James*, 17 Blatch., 42.

§ 3713. Under acts 1836 and 1839, the earliest invention prevails over the subsequent one, unless abandoned. *Allen v. Blunt*, 2 W. & M., 121.

See *Application, Rejected*, § 371.

Invention — Prior — Burden of proving prior invention rests on defendant, §§ 3714-3717.

§ 3714. The burden of proving prior invention, knowledge or use is on defendant. *Whitney v. Emmett*, 1 Bald., 303.

§ 3715. The burden of proof rests upon defendant to establish beyond a reasonable doubt invention prior to the patent. *Washburn v. Gould*, 3 Story, 122.

§ 3716. The burden of proof is on the defendant to show a prior invention, and, if the evidence is too vague and unsatisfactory to establish affirmatively, as against the patent, that the patentee was later in time of invention, the patent must stand. *Taylor v. Wood*, 12 Blatch., 110.

§ 3717. Where the complainant's patent was granted before the date at which the defendants' application was filed, it is incumbent upon the latter to prove beyond a reasonable doubt that theirs was the prior invention; and, this being done, the burden is transferred to the complainant to satisfy the court, by proof as convincing as that required of the defendants, that his invention preceded theirs. *Thayer v. Hart*, 20 Fed. Rep., 693.

Invention — Abandoned, §§ 3718-3722.

§ 3718. Where an invention has been abandoned an inventor can claim it only in combination. *Stanley v. Hewitt*, 17 Frank. Jr., 165.

§ 3719. Abandonment of the use of a mechanical structure which has been brought to such a degree of maturity, and whose operative merit has been demonstrated by trial, will inure to the benefit of the public and not to that of even an original but subsequent inventor. *Pickering v. McCullough*, 13 O. G., 818.

§ 3720. Where, after two rejections in the same year of the filing of an application, nothing was done until twelve years after, and five years after the inventor's death, when it was revived by his administrator and put into interference with a patent already issued; and it appeared that in the interval the inventor had secured four other patents, but had done nothing in perfecting the invention, the invention was held abandoned, and the application was not allowed to be revived. *Gates v. Benson*, 3 A. L. T. (U. S.) R., 113.

§ 3721. Where between the first and final application there was an interval of thirteen years, during which applicant employed himself with other inventions, and the final application was made by the administrator, five years after applicant's death, *held*, that the invention was abandoned. *Gates v. Benson*, Com'r's Decisions for 1870, p. 65.

§ 3722. Cummings applied for a patent on April 12, 1855. His application was rejected twice, and on February 3, 1856, a third rejection followed a reconsideration. From that time until the patent was finally granted the applicant was in ill health and poor. He did not withdraw his application, nor acquiesce in the action of the patent office. He made frequent applications to his friends for advances to enable him to prosecute his application. In February, 1859, an attempt was made for an appeal to the board, but the commissioner refused to allow it. On March 1, 1864, he presented a petition for the grant of a patent for the same invention. The patent was granted on June 7, 1864. The invention went into public use in 1859. *Held* (Justices Bradley, Miller and Field dissenting), that the proceeding to obtain a patent was a continuous one from 1855 until it was granted; that the application of 1855 not being severable from that of 1864, there was no foundation for the allegation that the invention was abandoned to the public, and that it was in public use or on sale for more than two years prior to the inventor's application. There was no abandonment, actual or constructive. *Smith v. Goodyear Dental Vulcanite Co.*, 3 Otto, 486 (§§ 5105-10, *infra*.)

See *Abandonment*, § 86.

Invention — Secret, §§ 3723-3726.

§ 3723. The statutory bar, in section 7 of the act of 1839, to the inventor who sells his invention more than two years before his application, would seem by analogy properly applicable to the inventor who secretes his invention more than two years, and thereby injures the public. *Spear v. Belson*, 1 MacA. Pat. Cases, 699.

§ 3724. S. perfected his invention in 1854, and kept it secret until August, 1858, when he filed his application, and in the meantime, in June, 1858, L. independently made the invention, introduced it into public use with the knowledge of S., and filed an application for a patent March, 1858. *Held*, that S. was debarred from receiving a patent. *Savary v. Lauth*, 1 MacA. Pat. Cases, 691.

§ 3725. Although an inventor has a right to keep his inchoate title to his invention concealed from the public as long as he pleases, yet when he desires to perfect his right by a patent he must proceed with vigilance to secure his protection by filing his application as early as practicable. *Ellithorp v. Robertson*, 1 MacA. Pat. Cases, 585.

§ 3726. Where an inventor keeps his invention secret for years, and suffers a subsequent and independent inventor to engage extensively in the manufacture and sale of the same invention without protest or notice of his prior claim, he thereby forfeits his right to a patent. Under such circumstance, his delay will not be excused by the fact that his application was filed before the patent issued to the rival inventor. *Savary v. Lauth*, 1 MacA. Pat. Cases, 691.

See *Defenses*, § 1826.

186. INVENTOR.

See *ART, LOST*, § 395.

Inventor — Original — Defined, §§ 3727-3729. Patentee must be, §§ 3730-3735; in order to recover, §§ 3736-3743.

§ 3727. Original inventor means first inventor (act 1793). *Evans v. Eaton*, Pet. C. C., 322.

§ 3728. Although the individual elements in patentee's invention are old, if he first brought them together in a whole, different from any whole that existed before, then he is the first and original inventor, and entitled to a patent. *Many v. Sizer*, 1 Fish., 17.

§ 3729. He who first discovers that a law of nature can be applied to the production of a particular result, and, having devised machinery to make it operative, introduces it in a practical form, is a discoverer and inventor of the highest grade, and is entitled to the protection not only of the formal device, but of the essential principle which his machine was the first to embody. This is not to patent an abstraction. *Parker v. Hulm*, 1 Fish., 44.

See *Reissues*, § 5318.

§ 3730. Patentee must be first and original inventor. *Thomas v. Weeks*, 2 Paine, 92.

§ 3731. The expression in our statute means that the patentee must have been the inventor first in point of time before all others. *Wellman v. Blood*, 1 MacA. Pat. Cases, 432.

§ 3732. No one who is not the first and original inventor by whom an invention has been perfected and put into use is entitled to a patent. *Reed v. Cutter*, 1 Story, 590.

§ 3733. It is not sufficient to show, as against a contending applicant, that the invention was original, and that the inventor had no notice of the rival invention. The law requires that the patentee should not only be an original but the first original inventor. *Spain v. Gambrill*, 1 MacA. Pat. Cases, 358.

§ 3734. To entitle a person to a patent, he must be the original and first inventor of the arrangement, whatever it is, of the invention which he claims. *Woodman v. Stimpson*, 3 Fish., 98.

§ 3735. To sustain his patent, the plaintiff must show that he is the first and original inventor. *Allen v. Hunter*, 6 McL., 303.

§ 3736. Patentee cannot recover unless he is the original inventor. *Evans v. Eaton*, Pet. C. C., 322.

§ 3737. To entitle plaintiff to recover for an infringement, he must satisfy the jury that he is the original inventor with respect to the whole world. *Dawson v. Follen*, 2 Wash., 311.

§ 3738. To entitle a plaintiff to recover for the violation of a patent he must be the original inventor, not only in relation to the United States, but to other parts of the world. Even if the plaintiff did not know that the discovery had been made before, still he cannot recover if it has been in use, or described in public prints, and if he be not in truth the original inventor. *Sewell v. Jones*, 91 U. S., 171.

§ 3739. In the absence of proof of plaintiff's knowledge of a discovery prior to his, he cannot recover, if he is not the original inventor. *Dawson v. Follen*, 2 Wash., 311.

§ 3740. If patentee's improvements are shown to exist in prior machines, that is sufficient to show that he was not the first inventor of these improvements, although such prior machines were abandoned experiments. *McCormick v. Seymour*, 3 Blatch., 209.

§ 3741. One person may have suggested to another the idea of some new machine, and yet that other person may be the inventor of that peculiar combination of mechanical principles which is the real invention. *Atkinson v. Boardman*, 1 MacA. Pat. Cases, 80.

§ 3742. In determining who is the original inventor, it is immaterial whether experimental tests of the object invented were made by the inventor or other parties. *Pennock v. Dialogue*, 4 Wash., 538.

§ 3743. Defendant's offer to take a license from plaintiff may be evidence of his knowledge that patentee was the original inventor, and no more. It does not entitle plaintiff to a verdict. *Evans v. Eaton*, Pet. C. C., 322.

Inventor — Prior — *He is first who first reduces to practice*, §§ 3744-3750; *who uses reasonable diligence*, §§ 3751-3756; *is not he who suggests only*, §§ 3757-3761.

§ 3744. The first inventor alone is entitled to a patent, if he reduce his invention to practice. *Woodcock v. Parker*, 1 Gall., 437.

§ 3745. The first inventor is he who has reduced the invention to practice, and he only is entitled to a patent. *Bedford v. Hunt*, 1 Mason, 302.

§ 3746. Of two inventors of the same thing, the one first to perfect his invention is entitled to a patent. *Allen v. Hunter*, 6 McL., 303.

§ 3747. He is entitled to a patent, who, being an original inventor, has first perfected the invention and adapted it to practical use. *Parkhurst v. Kinsman*, 1 Blatch., 488.

§ 3748. He is the inventor and entitled to the patent who first brought the machine to perfection and made it capable of useful operation. *Washburn v. Gould*, 3 Story, 122.

§ 3749. Although an idea of an application of the principle had been before suggested, but had never been made prior to that of patentee, *held*, that he who first reduced the idea to practical application and use was the first and original inventor, and entitled to a patent. *Foote v. Silsby*, 1 Blatch., 445.

§ 3750. He is the first inventor in the sense of the act of 1836, and entitled to a patent for his invention, who has first perfected and adapted the same to use. *Reed v. Cutter*, 1 Story, 590.

§ 3751. He is the first and original inventor who first perfects a machine and makes it capable

of useful operation, and is entitled to a patent, provided he uses reasonable diligence in perfecting the same. *White v. Allen*, 2 Cliff., 224.

§ 3752. He who first conceives of an invention, and uses reasonable diligence in perfecting the same, and does perfect it, is entitled to the patent as against an inventor who was later to conceive but first to reduce the invention to practice. *Marshall v. Mee*, 1 MacA. Pat. Cases, 229.

§ 3753. He who invents first shall have the prior right, if he is using reasonable diligence in adapting and perfecting the invention, although the second inventor has in fact perfected the same and reduced it to practice in positive form. (*Reed v. Cutter*, 1 Story, 590.) *Chandler v. Ladd*, 1 MacA. Pat. Cases, 493.

§ 3754. An invention being an intellectual process or conception, for the purpose of showing who, in point of time, is the prior inventor, he who first makes it known sufficiently by describing it in words or drawings will be considered to be the first discoverer, and vested with an inchoate right to its exclusive use, which he may embody, perfect and make absolute by proceeding to mature it in the manner which the law requires. *Hill v. Dunklee*, 1 MacA. Pat. Cases, 475.

§ 3755. The first inventor is not necessarily the one who made and perfected the first machine or instrument, but he who appears from the evidence to have been the first to conceive the idea, and to so describe it by words or drawings that a skilful workman would be enabled to bring it into useful, practical operation; for such a person shall be said to have made the first claim, and will be protected against the claim of any subsequent inventor who may have been first in adapting a machine or instrument to the invention, provided such first discoverer has been using due diligence in effecting the same end, and that, although he may have been unsuccessful in some of his experiments, if, by following them up, he at length succeeds. *Davidson v. Lewis*, 1 MacA. Pat. Cases, 599.

§ 3756. It is the right and privilege of a party to perfect, by experiment and reasonable diligence, his original idea, so as not to be deprived of the fruit of his labor and skill, by a prior patent, if he is the first inventor. *Cox v. Griggs*, 1 Biss., 362.

§ 3757. He is the inventor and entitled to a patent who first perfected the idea and made it capable of practical use, though others may have had similar ideas and have experimented upon them. Neither does the fact of hints or suggestions from others preclude his being such. *Matthews v. Skates*, 1 Fish., 602.

§ 3758. Where an inventor has conceived of the improvement and its principle, and is using reasonable diligence to perfect the mechanical details, he will not be deprived of his patent by the fact that another, during the construction of the machine, suggested a merely auxiliary and mechanical device to improve its operation, not requiring the exercise of invention, and capable of being made and applied by any skilful machinist. *Marshall v. Mee*, 1 MacA. Pat. Cases, 229.

§ 3759. When the invention is "suggested" by one of the parties to the interference, and is reduced to practice by the other in accordance with such suggestion, the party first named is the first and only inventor, and the second party can acquire no title to the invention by the failure of the real inventor to follow up and perfect his invention with reasonable diligence. In such a case the invention would be forfeited, if at all, to the public. *Stearns v. Davis*, 1 MacA. Pat. Cases, 696.

§ 3760. The fact that a person had an idea of an improvement in his head, or had sketched it on paper and then neglected it, does not constitute him an original inventor. It is not the person who has only produced the idea that is entitled to protection as the inventor, but the person who has embodied the idea into a practical machine and reduced it to practical use. *Winans v. New York & Harlem R. R.*, 4 Fish., 1.

§ 3761. Where a person has devised a new machine — as a furnace for manufacturing white oxide of zinc — but, having adopted an erroneous plan for using the same — mixing the ore and fuel in improper proportions — has failed to produce good results, another person with a full knowledge of this fact, who shall then discover and apply the proper method of using the machine, is not entitled to a patent for such machine. It would be giving to him the whole invention for the merit of discovering a subordinate part of the same. *Burrows v. Witherill*, 1 MacA. Pat. Cases, 315.

See *Delay*, §§ 1879, 1881.

Inventor — *And employee*, §§ 3762-3769; *and suggestor*, §§ 3770-3772. See *Employer and Employee*, §§ 2096-2109.

§ 3762. Where the original inventor had filed a caveat prior to employing the party, who set up as joint inventor, and the latter had made but one experiment prior to his employment, and in his agreement relative to his services acknowledged his employer as original inventor,

Held, that he was such, and that employee was not joint inventor. *Goodyear Dental Vulcanite Co. v. Wetherbee*, 3 Cliff., 555.

§ 3763. If a paper maker devises a paper possessing certain qualities at the instance of one who merely requested that such a paper should be made for him, the latter can be considered at most only as a joint inventor with him. *Union Paper Collar Co. v. Van Deusen*, 10 Blatch., 109.

§ 3764. The relations of employer and employee, in regard to the origin of inventions, stated. *Union Paper-Collar Co. v. Van Dusen*, 23 Wall., 530.

§ 3765. An inventor under a contract with an employer to make improvements in machines is not bound to give other improvements invented after his contract has expired. *Appleton v. Bacon*, 2 Black, 699.

§ 3766. If the conception of the invention be practically complete in the mind of the inventor, the artisan who gives it reflex and embodiment in a machine is no more the inventor than the tools with which he wrought. *Blandy v. Griffeth*, 3 Fish., 609.

§ 3767. If an employer conceives the result embraced in an invention, or the general idea of a machine upon a particular principle, and then, to carry his conception into effect, it is necessary to employ manual dexterity or even inventive skill in the mechanical details and arrangements requisite for carrying out the original conception, in such cases the employer will be the inventor and the servant will be a mere instrument through which he realizes his ideas. *King v. Gedney*, 1 MacA. Pat. Cases, 443; *Wellman v. Blood*, 1 MacA. Pat. Cases, 432.

§ 3768. The *prima facie* evidence of inventorship, arising out of the fact that the machine in controversy was made by one of the parties to the interference, is rebutted by evidence showing that such party was at the time in the employ of the other party as a machinist, and that he made the machine at his employer's request and for his benefit, and made no claim to the invention until long afterwards, but, on the contrary, stood by and saw his employer apply for and obtain a patent without objection. *Warner v. Goodyear*, 1 MacA. Pat. Cases, 60.

§ 3769. Under such circumstances, the presumption is that the machine was made according to the directions of the party beneficially interested, and in pursuance of his invention. *Ibid.*

§ 3770. *Held*, that he was the inventor to whose inventive suggestiveness the invention was due, and not the mechanic, whose only function was to materialize it. *Yoder v. Mills*, 25 Fed. Rep., 821.

See *Article of Manufacture*, §§ 404, 405.

§ 3771. It is not the man who may form an imperfect machine which may suggest to a higher and more practical order of mind valuable ideas, but it is the one who embodies these ideas in a practical and working form whom the law protects. *Pitts v. Edmonds*, 1 Biss., 168.

§ 3772. One who made a valuable suggestion to the conceiver of the idea of substituting in a feather duster feathers of the common domestic fowls in place of ostrich feathers, while he was engaged in a series of experiments with a view to discover some means whereby such feathers might be made pliable, did not thereby become the inventor of the duster. *National Feather Duster Co. v. Hibbard*, 9 Fed. Rep., 558.

Inventor — *Rights arise under statute only*, §§ 3773-3775. *His inchoate right*, § 3776. *Is entitled to protection*, §§ 3777, 3778. *Inventor of combination*, §§ 3779, 3780.

§ 3773. An inventor has no legal rights or immunities under a patent, except such as are conferred by statute. *Moffitt v. Garr*, 1 Bond, 315.

§ 3774. An inventor has no property in his invention on which he can maintain a suit, unless he obtains a patent. *Brown v. Duchesne*, 19 How., 183.

§ 3775. The right to his invention which inventor has is a creature of statute and of grant, and therefore he has no rights except in compliance with the terms and conditions incorporated in such statutes and grants. *American Hide & Leather Splitting Co. v. Tool Co.*, 1 Holmes, 503.

§ 3776. Inventor, from moment of invention, has an exclusive, indefeasible, inchoate right therein, completed by patent. *Evans v. Jordan*, 1 Brock., 248.

§ 3777. The first and original inventor is entitled to protection against all other means of carrying the principle into effect. *Nichols v. Harris*, 1 MacA. Pat. Cases, 362.

§ 3778. An inventor is entitled to protection in all the functions which his invention may perform, whether claimed or not. *Ingels v. Mast*, 6 Fish., 415.

§ 3779. Inventor of a combination is entitled to the same rights and protection as any other class of inventors. *Sayles v. Chicago & Northwestern R. Co.*, 3 Biss., 52.

§ 3780. Inventors of new and useful compositions of matter, duly patented, are entitled to the same protection as patentees of new and useful arts, machines, and manufactures, and the rules and regulations for suits for infringement are substantially the same in the several cases. *Cahill v. Brown*, 15 O. G., 697.

Inventor — Generally, §§ 3782-3789.

§ 3781. Applicant for a patent must show how the principle is to be used and applied to some useful purpose. *Evans v. Eaton*, Pet. C. C., 322.

§ 3782. An inventor's acts in ascertaining the value, utility and success of his invention should be liberally construed as experimental. *Jones v. Sewall*, 3 Cliff., 563.

§ 3783. Inventor's rights at common law. *Morton v. New York Eye Infirmary*, 5 Blatch., 116.

§ 3784. A patent cannot be sustained for a process or method which consists in employing an old machine for the very purpose for which it was made. If any person discovers how to use an old machine to the best advantage, he is only a skilful workman, not an inventor. *Moffitt v. Rogers*, 8 Fed. Rep., 147.

§ 3785. One person receiving from another a full and accurate description of a useful improvement cannot appropriate it to himself, and a patent obtained by him therefor will be void. *Atlantic Works v. Brady*, 107 U. S., 192.

§ 3786. The laws of congress give the right to a patent to the inventor, whether *sui juris* or under disability, or to the assigns of the inventor. As inventor or assignee of a patented invention, a married woman, an infant, or a person under guardianship obtains a vested right to the patent. Married women could always take by assignment under the common law. *Fetter v. Newhall*, 17 Fed. Rep., 841.

§ 3787. An inventor may not be aware of the full value of his invention, but under the patent laws the fact of invention, and not a knowledge of the degree of its utility, is the proper subject of inquiry. If an inventor omits to test the value of his invention, and fails to bring it into use, and remains ignorant of the extent of its value, he is yet entitled to a patent as against a subsequent discoverer. *Farley v. National Steam Gauge Co.*, 1 MacA. Pat. Cases, 618.

§ 3788. It is a presumption of law that all mechanics interested in upholding or defeating a patent were fully acquainted with the state of their art when they took out their patent, or when they built their machine. *Crampton v. Knowles*, 7 Fed. Rep., 199.

§ 3789. If the first inventor keeps his invention secret until the second has discovered it and given it to the public, the latter will be protected, as it is to him that the public is indebted. *Boyd v. Cherry*, 4 McC., 70.

See *Defenses*, §§ 1837-1839. *Evidence*, §§ 2273-2277, 2285. *Experiment*, §§ 2400-2402. *Patents*, §§ 4630, 4632, 4649-4677.

Inventors — Joint, §§ 3790-3800. See *Invention, Joint*, §§ 3691-3696. *Inventor and Employee*, §§ 3762-3769. *Suggestions*, § 6237.

§ 3790. Where a patent is taken out in the name of one of two joint inventors, the other inventor not having relinquished his right to the joint interest, the patentee has perpetrated a fraud in taking it in his name alone. *Reutgen v. Kanows*, 1 Wash., 168.

§ 3791. The man who reduces to practice the theory of another, who assists in the reduction of it to practice, cannot be considered as the sole inventor of the machine. The invention consists both of the discovery of the principle and the reduction of it to practice; in such a case neither party can be considered as sole inventor. *Arnold v. Bishop*, 1 MacA. Pat. Cases, 27.

§ 3792. A joint inventor cannot take a patent in his own name. By the sixth section of the act of 1836 the applicant must be the inventor. But one of several joint inventors cannot with propriety be called *the* inventor; and if he applies for a patent the commissioner is bound to refuse it, although that is not expressly named in the seventh section as one of the grounds upon which he is authorized to refuse a patent. *Arnold v. Bishop*, 1 MacA. Pat. Cases, 36.

§ 3793. A patent to two as joint inventors, which is the invention of one alone, is void. *Ransom v. Mayor of New York*, 1 Fish., 252.

§ 3794. Where a patent was issued to joint inventors, and it afterwards appeared to be the sole invention of one of them, and that the others were assignees, *held*, that it was an error beyond the power of the department to correct, the patent being invalid; that the remedy was for the parties to file a new application, which, if seasonably done, may be made the basis of a new patent. *Devens' Opinion*, 16 Op., 117.

§ 3795. Where the caveat was sworn to and filed by one of two joint inventors, under the belief that he was sole inventor, and the patent was subsequently issued to both jointly, *held*, that the caveat did not interfere with the validity of the patent, or prevent the carrying back of the invention claimed as joint to the date of the original filing of the caveat. *Hoe v. Kahler*, 12 Fed. Rep., 111.

§ 3796. The scope of a joint invention, and of a patent founded thereon, ascertained and

limited in view of pre-existing devices which had been produced by one of the joint inventors. *Hopkins & Dickinson Manufacturing Co. v. Corbin*, 14 Blatch., 396.

§ 3797. Even though they may be equivalents, the joint invention should not be made to relate back and include the pre-existing devices, which were the sole invention of one of the joint patentees. *Ibid.*

§ 3798. The case might be different were the joint invention, like those preceding, made by but one of the parties, and there was nothing in the language of his patent or in his actions, as to public use, etc., to preclude their acceptance as equivalents. *Ibid.*

§ 3799. When one of the two persons claiming as joint inventors had transferred his interest in the invention to the defendants, who also owned, by assignment from the rival inventor, the patent upon which the joint application is rejected, and when the bill treats the defendants as wrongful and fraudulent holders of the rival patent, and ignores wholly their rights to any interest in the alleged joint invention, *held*, that the patent should not be issued to the joint inventors. *Runstaler v. Atkinson*, 23 O. G., 940.

§ 3800. The testimony of a witness to the effect that he was a joint inventor with one of the applicants is competent evidence as against that applicant, though it would not, it seems, be admissible in his own behalf if he were a party to the record. *Yearsley v. Brookfield*, 1 MacA. Pat. Cases, 193.

Inventor — Burden of proof, §§ 3801-3813.

§ 3801. The presumption of law is, that patentee is the first and original inventor, and the burden to prove the contrary is on defendant. *Pitts v. Hall*, 2 Blatch., 229.

§ 3802. In the absence of all evidence to the contrary, the presumption is that the person who constructed the first machine is the real inventor; and where another person claims to be the author of such machine, the burden of proof rests on him to show not merely that he suggested the abstract idea of the machine, but that he invented the improvements which entitle it to a patent. *Atkinson v. Boardman*, 1 MacA. Pat. Cases, 80.

§ 3803. The presumption of law is that a patentee is the original inventor of that for which he has obtained a patent; and the burden of proof is on the party who denies it, and his evidence must be clear and convincing. *McMillin v. Barclay*, 5 Fish., 189.

§ 3804. The burden of proving that patentee was a joint, in place of a sole, inventor is on defendant. *Ashcroft v. Cutter*, 6 Blatch., 511.

§ 3805. The burden of proof is upon the defendant to show that the complainant is not the first inventor, and a mere preponderance of the evidence in that direction is not enough. The proof must be of such a convincing character as to satisfy the court beyond a reasonable doubt. *Worswick Mfg. Co. v. City of Buffalo*, 20 Fed. Rep., 126.

§ 3806. The burden of proving that patentee was not first to conceive the invention is upon defendant, and must be borne by the exhibition of preponderating and satisfactory evidence. *Patterson v. Duff*, 20 Fed. Rep., 641.

§ 3807. The presumption of law is that a patentee is the inventor of that for which letters patent are granted to him. Whoever alleges the contrary must assume the burden of proof. Evidence of doubtful probative force will not overthrow this legal presumption. *American Bell Telephone Co. v. People's Telephone Co.*, 22 Fed. Rep., 309.

§ 3808. The burden of proof is upon the defendants to overcome the *prima facie* case made by the patent, and to establish affirmatively that the party upon whose application a patent was granted was not the sole inventor of the improvement covered thereby. *Hoe v. Cottrell*, 17 Blatch., 546.

§ 3809. When in a suit for infringement it is set up as a defense that complainant derived his idea of the patented invention from some third party, who first conceived it, the burden of proof is on defendant, and any doubt respecting the evidence is fatal to the defense. *Duffy v. Reynolds*, 33 O. G., 621.

§ 3810. In a suit for the infringement of letters patent the burden of proof is upon the patentee to show that he is the original and first inventor, and that the defendant has infringed. *Brady v. Atlantic Works*, 4 Cliff., 408.

§ 3811. In a suit for infringement of a patent the burden of proof is upon the plaintiff or complainant to show that the patentee was the first and original inventor of the improvement, and that the patent has been infringed by the party against whom the suit is brought. *Storrs v. Howe*, 4 Cliff., 388.

§ 3812. A reissue patent being valid on its face, the presumption is that the patentee is the first inventor of that which the patent purports to secure. *Herring v. Nelson*, 14 Blatch., 293.

§ 3813. The presumption is not a mere formal one, but if to be overthrown by parol testimony it must be done upon clear and satisfactory proof. A case of doubt upon the evidence is not enough, for that leaves the presumption operative. *Ibid.*

PATENTS.

187. INVENTOR'S DECLARATIONS, ADMISSIBILITY IN EVIDENCE.

See EVIDENCE, ADMISSIBILITY OF INVENTOR'S DECLARATIONS.

188. JOINDER OF CLAIMS.

See INVENTION, JOINDER OF.

189. JOINDER OF INVENTION.

See INVENTION, JOINDER OF.

190. JOINDER OF PARTIES.

See PARTIES, JOINDER OF.

191. JOINT INVENTION.

See INVENTION, JOINT.

192. JOINT INVENTORS.

See INVENTORS, JOINT.

193. JOINT OWNERS.

See OWNERS.

194. JOINT PATENTS.

See PATENTS, JOINT.

195. JUDGES.

See PRACTICE, JUDGES.

196. JUDGMENT, SALE TO SATISFY.

See SALE, TO SATISFY JUDGMENT.

197. JUDICIAL NOTICE.

See NOTICE, JUDICIAL.

198. JUDICIAL OPINIONS, CONSTRUCTION OF.

See PRACTICE, CONSTRUCTION OF JUDICIAL OPINIONS.

199. JUDICIAL SALE.

See SALE, JUDICIAL.

200. JURISDICTION.

See COMMISSIONER, JURISDICTION. REISSUES, COMMISSIONER'S POWERS IN GRANTING.

Jurisdiction — Court of claims, §§ 3814-3817.

§ 3814. *Held*, that where the infringement consisted in the use of a patented machine by the warden of a penitentiary, the court of claims had no jurisdiction, either under the patent act or on an implied agreement to compensate for its use. *Pitcher's Case*, 1 Ct. Cl., 7.

§ 3815. The court of claims has jurisdiction over a suit brought on a special contract with a patentee for the use, at a fixed price, of his invention by the government. *Burns' Case*, 4 Ct. Cl., 113.

§ 3816. Where, as in this case, there is clearly an implied contract between the government and the citizen, and the suit is brought entirely upon that agreement, and the claimant is without judicial redress elsewhere, the court of claims of the United States has exclusive jurisdiction. *McKeever v. United States*, 14 Ct. Cl., 396. Affirmed, 23 O. G., 1530.

§ 3817. If the right of the patentee is acknowledged, and, without his consent, an officer of the government, acting under legislative authority, made use of the invention in the discharge of his official duties, it would seem a clear case on which an action would lie within the jurisdiction of the court of claims; and it might be even if the exclusive right of the patentee was contested. *Hollister v. Benedict Mfg. Co.*, 113 U. S., 59.

Jurisdiction — Of judge of circuit court of District of Columbia on appeal from commissioner, §§ 3818-3826. See *Appeal*, §§ 280-312.

§ 3818. The power and jurisdiction given by the patent laws to the board of examiners and to the judge are special and limited, and must be construed and exercised strictly. The judge can only decide such questions and render such judgment as he is expressly authorized by the statutes to decide and render. In the case stated in the eighth section of the act of 1836, the judge is only to determine "which, or whether either, of the *applicants* is entitled to receive a patent as prayed for." *Pomeroy v. Connison*, 1 MacA. Pat. Cases, 40.

§ 3819. Under the act of 1836, the judge has jurisdiction on appeal from both the questions of priority of invention and of interference. *Bain v. Morse*, 1 MacA. Pat. Cases, 90.

§ 3820. The judge is not precluded by the action of the commissioner from considering upon appeal, in interference cases, whether the thing in controversy is patentable. He is by law directed to determine in all such cases which, or whether either, of the applicants is entitled to receive a patent as prayed for. *Yearsley v. Brookfield*, 1 MacA. Pat. Cases, 193.

§ 3821. By limiting the jurisdiction of the judge to the points involved in the reasons of appeal, the law has affirmed it to that extent. *Bain v. Morse*, 1 MacA. Pat. Cases, 90.

§ 3822. The jurisdiction of the judge on appeal is limited and confined to the reasons of appeal; and whatever weight the judge may think is due to the arguments of counsel, he must disregard them if not within the reasons. *Burlew v. O'Neil*, 1 MacA. Pat. Cases, 315.

§ 3823. The judge upon appeal has jurisdiction of the question of patentability of the invention, and may reverse the decision of the commissioner on this point. *Burrows v. Witherill*, 1 MacA. Pat. Cases, 315.

§ 3824. By the eleventh section of the act of March 3, 1839, the judge is to confine his revision of the commissioner's decision to the points involved in the reasons of appeal, and the commissioner is to lay before the judge the grounds of his decision touching the same points. *In re Kemper*, 1 MacA. Pat. Cases, 1.

§ 3825. By the eleventh section of the act of 1839 the revision of the decision of the commissioner is to be "confined to the grounds of his decision, fully set forth in writing, touching the points involved by the reasons of appeal." *Cochrane v. Waterman*, 1 MacA. Pat. Cases, 52.

§ 3826. By the eleventh section of the act of 1839, in case of an appeal from the decision of the commissioner rejecting an application for a patent, the revision of the judge is confined to "the points involved in the reasons of appeal" filed in the office. *In re Winslow*, 1 MacA. Pat. Cases, 123.

Jurisdiction — Supreme court of District of Columbia, § 3827. See *Bill in Equity to Obtain Patent*, §§ 631-648.

§ 3827. The powers of the supreme court of the District of Columbia, in patent cases, are the same as those of the circuit courts of the United States. *Cochrane v. Deener*, 4 Otto, 781.

See *Reissue*, § 5357.

Jurisdiction — Of federal courts in patent cases — *Citizenship*, §§ 3828-3835.

§ 3828. The jurisdiction of the circuit court of the United States in patent cases extends to cases where all the parties are citizens of the same state. *Evans v. Eaton*, 3 Wheat., 518.

§ 3829. Under act 1836, sections 14 and 17, and judiciary act 1789, section 11, circuit courts have jurisdiction without regard to citizenship. *Allen v. Blunt*, 1 Blatch., 480.

§ 3830. In patent causes the jurisdiction of the federal courts is not dependent on the residence of the parties, except that the defendant must reside or be found in the district in which suit is brought. *Blunt v. Allen*, 8 N. Y. Leg. Obs., 107; *Brooks v. Stolley*, 3 McL., 523.

§ 3831. The circuit courts have jurisdiction of all questions concerning the title to a patent and the right to recover for infringement of the same under the patent laws of the United States, irrespective of whether the parties to a suit are citizens of the same or different states. *Campbell v. James*, 18 Blatch., 92.

§ 3832. The United States circuit court has jurisdiction of suits in equity relating to patents between citizens of different states. It is doubted whether the circuit court has jurisdiction in patent cases, except by injunction, where the parties are citizens of the same state. *Sayles v. Richmond, Fredericksburg & Potomac R. Co.*, 3 Hughes, 172.

§ 3833. Where the pleadings raise not merely the questions arising out of the construction of a contract entered into with reference to a patent, but also the question of infringement, the suit is one arising under the patent laws, and may be prosecuted in a circuit court of the United States by citizens of the same state. *Smith v. Standard Laundry Machinery Co.*, 22 O. G., 587.

§ 3834. The circuit court of the United States has jurisdiction of a suit in equity brought by the assignee of a patent, against the patentee, to restrain infringement, although all the parties are citizens of the same state. *Littlefield v. Perry*, 21 Wall., 218.

§ 3835. The citizenship of the defendant within the district where suit is brought gives the right to proceed against him personally to prevent infringement elsewhere. *Hatch v. Hall*, 30 O. G., 1096.

See *Marking Articles Patented*, § 4149. *Parties*, § 4496.

Jurisdiction — Of federal courts.

SUMMARY (*ALBRIGHT v. TEAS*, § 3836) — *Bill to recover royalties reserved in contract*, 3836.

ALBRIGHT v. TEAS.

(16 Otto, 613-620; 23 O. G., 829. 1882.)

APPEAL from U. S. Circuit Court, District of New Jersey.

STATEMENT OF FACTS.—This was a suit in equity originally brought in the court of chancery of the state of New Jersey by Andrew Teas, the appellee, against the appellants, Andrew Albright, Edwin R. Cahoone and Samuel E. Tompkins. The bill alleged that Teas was the inventor and patentee of certain improvements in coach-pads, harness-saddles and saddle-trees covered by three certain letters patent issued to him; that on February 1, 1876, he made an agreement in writing of that date with Albright and Cahoone, which was in substance as follows:

Teas agreed on his part to make assignments of said letters patent to Albright and Cahoone, and also of certain other letters patent, for which he had made application to the patent office, and also of any other patents which he might obtain for improvements in gig-saddles and coach-pads for harness. In consideration whereof Albright and Cahoone agreed that they would "use their best endeavors to have the aforesaid inventions worked, goods manufactured and sold to the best advantage of themselves and said Teas," and to pay Teas certain specified royalties for the use of the patented improvements, and pay "all just and necessary expenses for the purpose of procuring and sustaining all of said letters patent against infringers," provided it be for the mutual interests and financial benefits to all the parties to the agreement. The bill further alleged that Teas did assign the patents as stipulated in the agree-

ment, and that the agreement was in full force; that a large amount of goods, in which the improvements covered by the patents of complainant were used, had been manufactured by Albright and Cahoone under the name of the Cahoone Manufacturing Company, and by Tompkins, Albright and Cahoone, under the firm name of Samuel E. Tompkins, Cahoone & Co.; that the defendants had failed to render proper statements of the quantity of goods manufactured by them; that complainant believed there was a large amount due him under said contract for royalties, and that he had tried, without success, to obtain an inspection of the account-books of defendants to ascertain what was so due him. The bill prayed for discovery, for an account of the sums due the complainant for royalties under said contract, and for a decree against Albright and Cahoone for the amount found to be due from them to him on said account, and for general relief.

Albright and Cahoone filed a joint and several answer, and Tompkins a several answer to the bill.

Albright and Cahoone, in their answer, neither admitted nor denied that Teas was the original inventor of the patents assigned to them, but they denied that he had not free access to their books of account. They averred that they had rendered full accounts and made all payments due to Teas under the agreement set forth in the bill; that if any disputes existed between Teas and defendants, they arose from a wrong construction put in the agreement by Teas, and from unfounded claims by him as to his rights under it; that at the time of the agreement they were in litigation with Tompkins in respect to certain patents held by him for improvements in saddle-trees; that the litigation and rivalry impaired the business of all three, and that in October, 1877, they settled their differences with Tompkins and united their business with his, and it had since been carried on by the firm of Tompkins, Cahoone & Co., which had been entitled to use all the patents of both parties, and that the new firm had manufactured many goods without employing any of the improvements described in the patents of Teas, and had manufactured many to which they had applied the improvements covered by the Teas patents in connection with those covered by patents of Tompkins and others; that Tompkins had always disputed the value and validity of the Teas patents, but that they, Albright and Cahoone, had always been anxious to fulfil their agreement with Teas, and had paid royalties on all goods to the manufacture of which it could, by any reasonable construction, be claimed that the improvements covered by the Teas patents had been applied, and that if Teas claimed more, it was because he insisted that goods made under the patents of Tompkins were infringements on his patents.

Tompkins made substantially the same denials and averments in his answer. He also averred that he was not a party to the agreement with Teas, and denied all obligations under it. He alleged that though he had always disputed the validity of the Teas patents, he had desired to enable his partners, Albright and Cahoone, fairly to fulfil their agreement with Teas, and that it had been fulfilled, and all moneys had been paid him to which he was entitled for goods made under his patents.

Replications were filed to these answers, and the parties proceeded to take testimony. While the taking of the testimony was going on, some correspondence took place between the counsel of the parties, in which counsel for defendants specified a large number of articles which they admitted that the defendants were manufacturing under the Teas patents, and gave a list

of nineteen other articles manufactured by the defendants, which they contended were not made under the Teas patents, and did not, therefore, fall within the agreement between Teas and Albright and Cahoone. Thereupon the defendants filed a petition for the removal of the cause to the circuit court of the United States, in which they alleged that all the parties to the suit were citizens of the state of New Jersey, but that the suit was one arising under the patent laws of the United States, and exclusively within the cognizance of the courts of the United States, and removable under the act of March 3, 1875 (18 Stat., 470). Upon this petition the cause was removed to the circuit court of the United States for the district of New Jersey. By consent of parties an interlocutory order was made in the circuit court referring the cause to a master to report the amount due the complainant, if anything, for royalty upon the articles, enumerating them, in the manufacture of which the patented improvements of the complainant were used.

Upon final hearing, the testimony having been closed, the counsel for the complainant moved the circuit court to remand the cause to the state court of chancery, and the court declaring its opinion to be that the suit was not one arising under any of the laws of the United States, but was one over which the United States courts had no jurisdiction, and that it was a suit for an accounting and relief for the settlement of controversies under a contract of which the state courts had full cognizance, ordered the cause to be remanded to the state court. To obtain a review of this order the present appeal was taken by Tompkins, Albright and Cahoone, defendants in the circuit court.

§ 3836. *A bill to recover royalties reserved in a transfer of complainant's patents, and alleged to be wrongfully withheld, is not on its face a case arising under the patent laws of the United States. It is a suit upon the contract.*

Opinion by MR. JUSTICE WOODS.

The contention of the appellants is that the case is one "arising under the . . . laws of the United States," and was therefore properly removable from the state to the United States courts, and should not have been remanded. It is clear, from an inspection of the bill and answers, that the case is founded upon the agreement in writing between the appellee and the appellants, Albright and Cahoone, by which the former, for a consideration therein specified, transferred to the latter his interest in certain letters patent. The suit was brought to recover the consideration for this transfer, and was not based on the letters patent. The appellants insist, however, that evidence was taken in the cause by the appellee, for the purpose of proving that they were using his patented improvements in the manufacture of goods for which they paid him no royalty, and which they contended did not embody the improvements covered by his patents; that the testimony developed a controversy between the parties on the question whether the goods manufactured by the appellants under the Tompkins and other patents owned by them were or were not infringements on the patents of appellee; consequently that questions of infringement and of the construction of the claims of appellee's patents were necessarily involved in the case, and therefore it was one arising under the patent laws of the United States. We search the bill of complaint in vain to find any averments raising these questions. It makes no issue touching the construction of the patents granted the appellee, or their validity, or their infringement. The only complaint made in the bill is that the appellants were fraudulently excluding the appellee from an inspection of their books of account, and refusing to pay him the sums due for royalties

under his contract; and the prayer of the bill was for a discovery, an account of what was due appellee under his contract, and a decree for the amount found to be due him. On the face of the bill, therefore, the case is not one arising under the patent laws of the United States. *Wilson v. Sanders*, 10 How., 99.

The testimony on which appellants rely to show the jurisdiction of the circuit court is not before us, but, conceding that it discloses the controversy which appellants assert it does, the question arises, does this fact give the courts of the United States jurisdiction of the case? Tompkins is the only one of the appellants who questions the validity of the appellee's patents; but he is not a party to the contract between appellee and Albright and Cahoon, and no relief is prayed against him by the bill; and though he says in his answer that he had always disputed the value and validity of the patents of appellee, he raises no issues thereon. The fact that he is made a party defendant to the bill can, therefore, have no effect on the question in hand.

In passing on the question of jurisdiction the case is to be considered as if Albright and Cahoon were the only defendants. The appellee before the commencement of the suit sold and transferred to Albright and Cahoon all his title and interest in the inventions covered by his patents. The transfer was absolute and unconditional. No right, therefore, secured to the appellee in the patent by any act of congress remained in him. He had no right to prosecute any one for infringements of his patents or to demand damages therefor or an account of profits. He was entitled to the royalties secured by his contract, and nothing more; and the only question raised by the bill of complaint and the answer of Albright and Cahoon was simply this: What is the sum due the appellee from Albright and Cahoon for his royalties under his contract? In ascertaining this amount it of course became necessary to inquire what goods were manufactured by the appellants under the patents of the appellee. In prosecuting this inquiry an incidental question might arise, namely: What goods were manufactured by the appellants under other patents of which they were the owners or licensees? But this incidental and collateral inquiry does not change the nature of the litigation. The fact that Albright and Cahoon had licenses to use other patents, under which they were manufacturing goods, does not give them the right to litigate their cause in the United States courts because certain goods, which they asserted were made under the other patents, the appellee asserted were really made under his. The suit, notwithstanding the collateral inquiry, still remains a suit on the contract to recover royalties, and not a suit upon the letters patent. It arises solely upon the contract, and not upon the patent laws of the United States. In fact, it does not appear that there is any dispute whatever between the parties in reference to the construction of the patents of the appellee. The controversy between them, as stated by the appellants themselves, is, whether certain goods manufactured by them embody the invention covered by the appellee's patents. This does not necessarily involve a construction of the patents. Both parties may agree as to what the patented invention is, and yet disagree on the question whether the invention is employed in the manufacture of certain specified goods. The controversy between the parties in this case is clearly of the latter kind. The case cannot, therefore, be said to be one which grows out of the legislation of congress. Neither party asserts any right, privilege, claim, protection, or defense founded, in whole or in part, on any law of the United States. We are therefore of opinion that, even if we

go outside the pleadings and look into the testimony, the case is not one arising under the laws of the United States, and consequently that the courts of the United States had no jurisdiction to entertain it. The cases adjudged by this and other courts of the United States sustain this conclusion. In the case of *Wilson v. Sanders*, *ubi supra*, the object of the bill was to set aside a contract made by the appellant with the appellees, by which he had granted them permission to use and vend to others to be used one of Woodworth's planing machines in the cities of New Orleans and Lafayette, and also to obtain an injunction against the further use of the machine on the ground that it was an infringement of his patent-rights. Upon this cause the court, speaking by Mr. Chief Justice Taney, said:

"The dispute in this case does not arise under any act of congress, nor does the decision depend upon the construction of any law in relation to patents. It arises out of the contract stated in the bill, and there is no act of congress providing for or regulating contracts of this kind. The rights of the parties depend altogether upon common law and equity principles."

The case of *Hartell v. Tilghman*, 99 U. S., 547, is also in point. In that case Hartell, the complainant, alleged that he was the original patentee and inventor of a process for cutting and engraving stone, glass, metal and other hard substances by what is known as the "sand-blast process;" that the defendants had paid him a considerable sum for machines necessary in the use of his invention, and had also paid him during several months the royalty which he asked for the use of the invention described in and secured by his patent; that the defendants refused to do certain other things, which the complainant charged to have been a part of the consideration of the contract between them, whereupon he had forbidden them further to use his invention, and that the defendants had disregarded his prohibition. The bill prayed for an injunction, an account of profits and damages. The defendants admitted the validity of the patent, their use of it, and their liability for its use under their contract with the complainant, and offered to perform all that the contract required them to perform. All the parties were citizens of the same state. Upon this case the question of the jurisdiction of the United States courts was raised, and this court, after a review of several cases bearing on the subject, held that the suit was not one arising under the laws of the United States, and that the circuit court had no jurisdiction of the case, and reversed its decree, and remanded the cause, with directions to dismiss the bill.

The argument against the jurisdiction in the case under consideration is stronger than in the two cases above referred to. In each of these cases the object of the complainant in filing the bill was to go behind the agreement under which the defendant had contracted for the right to use the complainant's invention, and to obtain an injunction against the defendant as an infringer. In this case, the appellee admits the contract to be in force, and simply seeks to compel its performance.

The following cases cited by this court in *Hartell v. Tilghman* are in accord with the views we have expressed: *Goodyear v. India Rubber Co.*, 4 Blatch., 63; *Merserole v. Union Paper Collar Co.*, 6 id., 356; *Blanchard v. Sprague*, 1 Cliff., 288; *Hill v. Whitcomb*, 1 Holmes, 317.

From the conclusions reached by us, it follows that the decree of the circuit court, remanding the cause to the state court, must be affirmed.

Jurisdiction — Of federal courts in patent cases — *Contracts*, §§ 3837-3863.

§ 3837. Where the subject-matter was a contract for the transfer of patent, *held*, that the court had no jurisdiction arising from the patent law; but jurisdiction was maintained on the ground of citizenship. *Nesmith v. Calvert*, 1 W. & M., 34.

§ 3838. Courts of the United States have no jurisdiction over suits for the specific performance of contracts because the subject-matter of the contract is a patent-right. *Burr v. Gregory*, 2 Paine, 426.

§ 3839. Circuit courts have no jurisdiction in suit between citizens of the same state under a license. *Brooks v. Stolley*, 3 McL., 523.

§ 3840. Where the object of the bill is merely to enforce a specific execution of the contract to use the patent-right, circuit courts have no jurisdiction; but where the bill is founded on the infringement of the patent, they have. *Ibid*.

§ 3841. The fact that the subject-matter of a contract concerns a patent-right does not confer jurisdiction on United States courts under the patent act, where the suit is brought for violation of the contract. *Goodyear v. Day*, 1 Blatch., 565.

§ 3842. It is no ground of jurisdiction under the patent law that the contract between the parties relates to a patent-right. But if an infringement is proved, jurisdiction is conferred; and having power to protect the rights of a party under a patent, the court will take cognizance of other matters, as incidental to the infringement. *Bloomer v. Gilpin*, 4 Fish., 50.

§ 3843. Where neither party was citizen of the state in which suit on the contract was brought, *held*, that under act 1789, section 11, the court had no jurisdiction, although the parties were citizens of different states. *Goodyear v. Day*, 1 Blatch., 565.

§ 3844. If a patentee parts with the whole right secured by his patent, either for cash or upon the purchaser covenanting to pay or do certain things, after such sale he has no right vesting in him secured by any act of congress. A suit to enforce the covenants would not be a case arising under the laws of the United States. And when a portion of the right is parted with, the rule must be the same as regards that right. *Goodyear v. Union Rubber Co.*, 4 Blatch., 63.

§ 3845. Where the defendant admits the validity and use of the complainant's patent, and a subsisting contract is shown governing the rights of the parties in the use of the invention, on which the controversy in the bill wholly turns, the case is not one arising under the patent laws of the United States. *Ingalls v. Tice*, 14 Fed. Rep., 352.

§ 3846. Where a bill was brought by a licensor against the licensee to enforce the performance of certain covenants thereunder, and for an injunction restraining the use of the patent until they were performed, *held*, that the suit was one to prevent the violation of rights secured by covenant, and that the court had no jurisdiction. *Goodyear v. Union Rubber Co.*, 4 Blatch., 63.

§ 3847. Whenever a contract is made in relation to patent-rights which is not provided for and regulated by an act of congress, the parties, if any dispute arises, stand upon the same grounds as other litigants in respect to the jurisdiction of the court. Hence when the matter in dispute was whether the complainant in a bill in equity was entitled to an extra half cent for the use of his patents under a license, express or implied, and it appeared that the decision did not depend in any way upon the construction of any law of congress relating to patents, and it also appeared that the parties were citizens of the same state, the court held that it did not have jurisdiction of the suit. *Blanchard v. Sprague*, 1 Cliff., 288.

§ 3848. Where, on a division of opinion between the judges of the circuit court, the question was certified up as to whether, according to the true construction of the patent, it was infringed by defendant's machine, *held*, that it was a question of fact as to the substantial identity of two machines, over which the court had no jurisdiction under the act of 1802, which extends to divisions on points of law only. *Wilson v. Barnum*, 8 How., 258.

§ 3849. A bill in equity to set aside an assignment of a patent-right upon the ground of assignee's non-compliance with the conditions of the contract, is not a case arising under the patent laws of the United States, and therefore, under act 1836, section 17, not subject to appeal when the matter in dispute is less than \$2,000. *Wilson v. Sanford*, 10 How., 99.

§ 3850. Where, in a patent suit, after a mandate issued to the court below, a writ of error was allowed relating to the taxation of costs only, *held*, that, as the writ brought nothing but costs before the court, and less than \$2,000 in amount, it did not come under act 1836, section 17, which is confined to cases involving the construction of patent laws, and the court had no jurisdiction. *Sizer v. Many*, 16 How., 98.

§ 3851. The supreme court can exercise no appellate jurisdiction in a case for the specific performance of a contract in relation to patent-rights, when the amount involved is less than \$2,000; while it may lawfully exercise such jurisdiction in a case of infringement involving a far less amount. *Brown v. Shannon*, 20 How., 55.

§ 3852. In a suit for infringement, *held*, that the court, being by the sworn allegations of the bill fully vested with jurisdiction in the cause, was not ousted of it by the unproved plea of respondent that he had rights under contract in the use of the patents emanating from one of the complainants; that the other complainants were without interest, and that the parties in interest were both citizens of Louisiana. *Lilienthal v. Washburn*, 8 Fed. Rep., 707.

§ 3853. Where A. brought suit in equity in the circuit court, praying that B.'s patent be sold for the payment of an unsatisfied judgment of \$50 obtained in a state court, on which execution had issued, but B. having no property in the state subject to execution, *held*, that it was not a suit under section 629, Revised Statutes, "arising under the patent laws," and the court had no jurisdiction. *Ryan v. Lee*, 10 Fed. Rep., 917.

§ 3854. When the parties to the suit are citizens of the same state, a bill to compel the execution of further transfers under an agreement is not maintainable in the United States circuit court. *Perry v. Littlefield*, 17 Blatch., 272.

§ 3855. One using a patented invention under a license from the owner, and keeping within its terms, can violate no right secured by the patent laws, thus giving the federal courts jurisdiction. A breach of his covenants is merely a violation of common law rights, and the case, aside from the question of citizenship, is cognizable only by the state courts. *Goodyear v. Union India Rubber Co.*, 4 Blatch., 63.

§ 3856. On a bill in equity by licensees to have the defendants enjoined from commencing any suit on the license or alienating the license pending this action; to have the patents declared void for want of novelty; and the license canceled and the tariffs paid by the plaintiffs returned, *held*, that the court had no jurisdiction of a suit to declare a patent void, except under the sixteenth section of the act of July 4, 1836 (5 U. S. Stat. at L., 123), and the tenth section of the act of March 3, 1859 (*id.*, 354), in the cases therein specially provided, under none of which this suit came. And that the court did not have jurisdiction of this suit by virtue of section 17, act of July 4, 1836, because the rights of the defendant, by virtue of the license, arose out of the license, and not, in any proper or legal sense, out of or under the patents or the law under which they were granted. *Merserole v. Union Paper Collar Co.*, 6 Blatch., 356.

§ 3857. Where the owner of a patent granted defendants an exclusive license, with conditions as to payment, and retained the right to terminate it by notice, on failure to comply with the conditions, *held*, on an action for infringement in which defendant set up in answer that the license was not legally terminated, and that it did not sell, and had not sold, the patented articles, that a question of infringement was raised, over which a federal court had jurisdiction. *Smith v. Standard Laundry Machinery Co.*, 19 Fed. Rep., 825.

§ 3858. Where in a suit for infringement defendants justified under a license, which complainant claimed was revoked, but which was held to be irrevocable, *held*, further, that the only thing which could be recovered was the royalty agreed upon, and that being simply a suit on the license — the contract — the court had no jurisdiction. *Kelly v. Porter*, 17 Fed. Rep., 519.

§ 3859. The parties who own the exclusive right to use and sell a patented invention within a specified territory, with a guaranty for its enjoyment from the patentees, cannot maintain a bill in the United States courts for an injunction and for an account against the patentees and parties who, with knowledge of the contract, have purchased the article from them without the territory, and are using it within it. *Hill v. Whitcomb*, 1 Holmes, 317.

§ 3860. The federal courts have no jurisdiction over a suit brought to enforce such a contract against the patentees, and the purchasers from them, where all the parties are citizens of the same state. *Ibid.*

§ 3861. Where complainant has parted with his patent-rights under contract, reserving no interest, absolute or contingent, in the patents assigned, suit to enforce the contract is not one arising under statutes of the United States relating to patents, and the court has no jurisdiction. *Teas v. Albright*, 22 O. G., 2069.

§ 3862. The subject-matter of contracts made in relation to patents, where neither the validity of the patent nor its infringement is concerned in the controversy, does not give the courts of the United States jurisdiction. The rights of the patentee under the patent laws of the United States must be directly, and not collaterally, brought in issue to give jurisdiction. *Ibid.*

§ 3863. Where the defendants admit the validity of the plaintiff's patent, their use of it, and liability to him for its use under the contract, which latter the defendants plead, and the tender of all that is due thereunder, and their readiness to perform, it is a case not cognizable in the United States court, as arising under the patent law. (Three judges dissenting.) *Hartell v. Tilghman*, 99 U. S., 547.

Jurisdiction — Of federal courts in patent cases — *Generally*, §§ 3864-3881. See *Interfering Patents*, §§ 3475-3498. *Repeal of Patents*, §§ 5840-5859.

§ 3864. Act 1819, United States courts' jurisdiction in patent cases, reviewed and construed. *Sullivan v. Redfield*, 1 Paine, 441.

§ 3865. Statute February 15, 1819, gave the circuit courts "original cognizance, as well, in equity as at law, of all actions, suits and controversies" arising under the patent laws; to this the grant of an injunction is an incident only. *Atwood v. Portland Co.*, 10 Fed. Rep., 283.

§ 3866. All suits arising under patent-rights are within the jurisdiction of the circuit court of the United States, but the suit must be brought in the circuit court for that district where the defendant resides, or is served personally with process; and this fact of personal service within the district of the court should appear plainly on the record. *Allen v. Blunt*, 1 Blatch., 483.

§ 3867. The circuit courts of the United States have jurisdiction of controversies arising under the patent laws by direct grant from congress. They do not act merely as ancillary to courts of law, and, therefore, do not require the patentee to establish his legal right in a court of law and by the verdict of a jury. *Sanders v. Logan*, 2 Fish., 167.

§ 3868. The court having acquired jurisdiction on the ground of infringement may decide other matters between the parties, which, of themselves, might not afford ground for the original exercise of jurisdiction. *Brooks v. Stolley*, 3 McL., 523.

§ 3869. United States courts are authorized to take up a patent, and upon final hearing to pass upon it without reference to the fact whether it has been before a jury or not. *Doughty v. West*, 2 Fish., 553.

§ 3870. The United States circuit court has jurisdiction in equity of cases for infringement of patents, without previously sending the parties to try the patent at law. Ordering a law trial is discretionary with the court and does not affect its jurisdiction. The supreme court of the District of Columbia has the same powers. *Cochrane v. Deener*, 4 Otto, 782.

§ 3871. The grant of jurisdiction under act 1836, in patent causes, is as full in equity as at law. *Hoffheims v. Brandt*, 3 Fish., 218.

§ 3872. Act 1836, section 13, conferring jurisdiction on United States circuit courts in all cases arising under any law on the United States granting or conferring to inventors the exclusive right to their inventions or discoveries, extends to and includes the assignees of such inventors. *Jenkins v. Greenwald*, 1 Bond, 126.

§ 3873. Under act 1836, section 17, re-enacted 1870, circuit courts may rightfully take cognizance of every controversy arising under the patent laws; and where prevention of the violation of an inventor's rights is sought, the equity jurisdiction of the court must be invoked, as alone competent to furnish adequate relief. *McMillin v. Barclay*, 5 Fish., 189.

§ 3874. The act of March 3, 1875, in relation to the jurisdiction of the circuit courts of the United States, alters the rule laid down by the act of 1789, which made the jurisdiction of the circuit courts dependent upon the character of the parties, by giving to that court jurisdiction in all cases in law and equity arising under the laws and constitution of the United States. *Celluloid Manufacturing Co. v. Goodyear Dental Vulcanite Co.*, 13 Blatch., 375.

§ 3875. The jurisdiction of the circuit courts in cases arising under the patent and copyright laws is not changed by the Revised Statutes, and consequently the original cognizance of the circuit courts sitting as courts of equity in patent cases is retained. *Cochrane v. Deener*, 4 Otto, 781.

§ 3876. If an infringement by use is established the complainant is entitled to an account for all infringements by making, using or vending, and to an injunction against making, using or vending throughout the district over which the court has jurisdiction. *Locomotive-Engine Safety-Truck Co. v. Erie R'y Co.*, 10 Blatch., 292.

§ 3877. Although a corporation has a legal existence throughout the entire state, it can be prosecuted for an infringement only in the court of the district in which it was perpetrated, and can be enjoined by that court from infringing only in that district; relief against infringements in another district of the state can be obtained only in the court of that district. *Ibid.*

§ 3878. In patent causes the circuit court will not review the findings of another court of co-ordinate jurisdiction except in a case of clear mistake of law or fact, of newly discovered testimony, or upon some question not considered by such court. *Searls v. Worden*, 11 Fed. Rep., 501.

§ 3879. Where a bill is filed in one district and defendant goes to another and begins an infringement there, where he is beyond the jurisdiction of the court and out of reach of its process, *held*, that the power exists in such other district to bring him to punishment, and complainant, by bill in the proper court, may restrain him from violating the patented rights in such other jurisdiction. *Wheeler v. McCormick*, 8 Blatch., 268.

§ 3880. Courts of the southern district of New York have no original jurisdiction over infringements of patents committed in the northern district of New York. *Hodge v. Hudson River R. Co.*, 6 Blatch., 85.

§ 3881. So long as an act extending a patent exists in the statute book, the court will regard it as the law of the land, and as governing, so far as it applies, the rights of the parties, although it may have been obtained by fraud and misrepresentation. *Gibson v. Gifford*, 1 Blatch., 529.

See *Assignee*, § 534. *Common Carrier*, § 1116.

Jurisdiction — Federal courts — Citizenship, §§ 3882-3884. *Objections to jurisdiction*, § 3885; *when court may consider*, § 3886. *Concurrent legal and equitable*, § 3887. *Foreign courts*, § 3888. *Act of 1818*, § 3889.

§ 3882. The proper citizenship of the parties must appear on the face of the bill to give a federal court jurisdiction. *Merserole v. Union Paper Collar Co.*, 6 Blatch., 356.

§ 3883. If jurisdiction is given by the subject-matter, any issue as to the citizenship of the plaintiff raised by the pleadings is immaterial. *Fisher v. Neil*, 6 Fed. Rep., 89.

§ 3884. Where, after the removal of a cause wherein the requisite conditions of citizenship and amount in controversy do not exist, and it is found upon the pleadings that the subject-matter is one in which the statute of the United States is only incidentally brought into question, the court will of its own motion remand the case. *Teas v. Albright*, 22 O. G., 2069.

§ 3885. Objections to jurisdiction are usually taken at the first instance, but a plain defect of jurisdiction may be insisted on at the hearing. *Burdell v. Comstock*, 15 Fed. Rep., 395.

§ 3886. A court may consider the question of its jurisdiction at any time during the pendency of the proceedings, especially the federal courts, where it has long been the practice of the judges, *sponte sua*, to decline jurisdiction and dismiss the case where the want of authority to act becomes apparent. *Spring v. Domestic Sewing Machine Co.*, 22 O. G., 1445.

§ 3887. Notwithstanding section 723 of the Revised Statutes, there remains a limited range of cases in which legal and equitable jurisdiction are concurrently exercised. *Ibid.*

§ 3888. Effect of proceedings in the common pleas at Westminster Hall can have no validity in the United States, even of a *prima facie* character. *Bischoff v. Wethered*, 9 Wall., 812.

§ 3889. Act 1818, section 6, construed as to jurisdiction of the circuit court for the southern district of New York, and held not to exclude from its jurisdiction causes of action arising out of the state of New York. *Wheeler v. McCormick*, 8 Blatch., 267.

Jurisdiction — In patent cases — Generally, §§ 3890-3897. See *Commissioner*, §§ 1065-1113. *Practice*, §§ 4845-4857.

§ 3890. Patent laws have no extraterritorial operation. *Brown v. Duchesne*, 19 How., 183.

§ 3891. Under act 1836, section 17, a party is at liberty to select his forum, although he seeks a recovery of money only, and neither seeks nor requires a discovery or other ancillary or further relief. *Perry v. Corning*, 7 Blatch., 195.

§ 3892. The court cannot correct mistakes in letters patent, but can merely construe the specification and claim and determine the general effect thereof. *Kittle v. Merriam*, 2 Curt., 475.

§ 3893. The record of a judgment of a judicial tribunal may be in all cases examined to see whether such tribunal had jurisdiction of the subject-matter and of the person of the defendant, and if such jurisdiction be wanting the judgment is ineffectual for any purpose. *Atlantic Giant Powder Co. v. California Vigorit Powder Co.*, 6 Saw., 508.

§ 3894. The authority of the commissioner of patents to issue grants is not of the nature of *jurisdiction* in its common law and technical acceptation. *Wilder v. McCormick*, 2 Blatch., 31.

§ 3895. When the sections of act 1836 are construed together, it is held that when there are two interfering patents the circuit court of the district whereof the defendant is an inhabitant, or where he may be found, is the court "having cognizance." *Prentiss v. Ellsworth*, 27 O. G., 623.

§ 3896. Void license and agreement, because the patents are void, do not confer jurisdiction under the patent act. *Merserole v. Union Paper Collar Co.*, 6 Blatch., 356.

§ 3897. Suit on licenses does not confer jurisdiction, whether the suit be one by a licensor to enforce the covenants contained in a license granted under a patent, or one by a licensee to destroy and annul a license and its covenants. *Ibid.*

Jurisdiction — Equity — Expiring patent, §§ 3898-3904. See *Injunction*, §§ 3334-3337.

§ 3898. Where a bill was filed five days prior to the expiration of the patent, praying for an injunction and account, which, on the facts stated, no court would grant, and it was apparent that the prayer for injunction was a mere device to transfer the jurisdiction, *held*, that the court never had jurisdiction of the case. *Burdell v. Comstock*, 15 Fed. Rep., 395.

§ 3899. Where a bill for profits and damages was filed one day before the patent expired, a demurrer thereto for want of equity was sustained, and the bill dismissed with costs. *Davis v. Smith*, 19 Fed. Rep., 823.

§ 3900. Where the bill for injunction and account was filed twenty-six days before the patent expired, and set forth special grounds of equitable relief, and prayed for an injunction restraining the sale of machines both before and after the expiration of the patent, which machines had been made during its existence, a demurrer to the bill was overruled with costs. *Toledo Mower & Reaper Co. v. Johnston Harvester Co.*, 32 O. G., 1010.

§ 3901. Where the bill for injunction and account was filed six days before expiration of the patent, the rules of the court required eight days' notice of a motion for an injunction, and the bill failed to show *bona fide* ground for equitable relief, demurrer was allowed with costs. *Mershon v. Pease Furnace Co.*, 32 O. G., 1011.

§ 3902. Where suit was brought on a patent a little over a month prior to its expiration, service was made on defendant, but no effort made to secure a preliminary injunction, and the bill disclosed on its face a case cognizable in equity, *held*, that the bill would not be dismissed on the sole ground of the expiration of the patent. *Dick v. Struthers*, 25 Fed. Rep., 103.

§ 3903. Where a bill, after charging infringement of three certain patents, stated that they were all applicable to the same process and were so used by defendant, a motion to dismiss the bill as to one of the patents on the ground that it was soon to expire refused, it appearing that it might be essential in estimating the damages for the infringement of the other two patents; and it appearing also that a decree might be rendered before its expiration. *New York Grape Sugar Co. v. Peoria Grape Sugar Co.*, 21 Fed. Rep., 878.

§ 3904. A bill in equity was filed January 15, 1882, and after various amendments were made, the last of which, October 4, 1882, brought in the heirs at law of one of the patentees. On July 28, 1882, the patent had expired; *held*, that the court could not acquire jurisdiction until the entire right in the patent was represented, namely, until October 4, 1882; at that time plaintiff's right to equitable relief by injunction, etc., was gone, owing to the expiration of the patent. As the last amendment was allowed without full knowledge of the facts, its filing must be regarded as the commencement of the suit, and as the patent had expired prior thereto, the court is without jurisdiction and the bill must be dismissed. *Hewitt v. Pennsylvania Steel Co.*, 24 Fed. Rep., 267.

See *Bill, Motion to Amend*, § 650.

Jurisdiction — Equity.

SUMMARY (*ROOT v. RAILWAY COMPANY*, §§ 3905-3913) — *Equity jurisdiction; statutes reviewed*, §§ 3905, 3906. — *Rule; actual damages*, § 3907. — *Damages; act of 1870*, § 3908. — *Revised Statutes, section 4919, reviewed*, § 3909. — *Defenses pleadable in equity*, § 3910. — *Law and equity jurisdiction*, § 3911. — *Bill for naked accounting, jurisdiction*, § 3912. — *Infringer as trustee*, § 3913.

ROOT v. RAILWAY COMPANY.

(15 Otto, 189-217. 1881.)

APPEAL from U. S. Circuit Court, Northern District of Illinois.

Opinion by MR. JUSTICE MATTHEWS.

STATEMENT OF FACTS.—Thomas Sayles, as assignee of the letters patent originally granted to Henry Tanner for an improvement in railroad car brakes, dated July 6, 1852, and which, on July 5, 1866, were renewed and extended for the additional term of seven years, which expired July 6, 1873, filed his bill in the court below on December 9, 1878, against the Lake Shore & Michigan Southern Railway Company. He avers that, by virtue of the assignments to him, he was invested with all rights of action for infringements of the patent which had occurred, and particularly those of which it was alleged the defendant had been guilty from August 6, 1869, to July 6, 1873, having, as is averred, during that period, used upon its railroad cars the patented brakes, but how many, the bill states, the complainant is ignorant and cannot set forth, but avers that the number so used was large, and that defendant had derived, received and realized great gains and profits therefrom, but to what

amount he is ignorant, and cannot set forth. The prayer of the bill is that the defendant may be compelled to account for and pay to the complainant all the gains, profits and savings which it derived, received or realized from or by reason of the use of said brakes.

To this bill a general demurrer was filed, alleging, as grounds thereof, that the bill does not contain any matter of equity on which the court could grant any relief, and that the complainant is not entitled to the relief prayed for, because he had a plain, adequate and complete remedy at law, and also because it appeared on the face of the bill that the causes of complaint were barred by the statutes of limitation both of the United States and of the state of Illinois. This demurrer was sustained and the bill dismissed. The decree of the circuit court was brought here for review. Sayles having died, Charles T. Root was, as his executor, substituted in this court as the appellant.

The propositions mainly relied upon by the appellee in support of the decree are: *First*, that after the expiration of a patent, equity has no jurisdiction to entertain a bill, merely for an account and the recovery of the profits of an infringer, during its existence, the remedy being at law for damages; and *second*, that even if, in certain cases, such a jurisdiction exists, the present does not fall within it.

On the other hand, it is contended on the part of the appellant that, in cases for the enforcement of the rights of patentees, resort may be had, as matter of right, to a court of equity, as a distinct head of its jurisdiction, for the mere purpose of establishing an infringement and ascertaining and recovering the profits of the infringer, upon the independent equity that he is for that purpose a trustee of his gains for the use of the true owner of the patent and liable to account as such. In support of this contention, we are referred by his counsel to numerous decisions of the circuit courts, many of which, it is claimed, are directly upon the point, and to several cases in this court, in which, it is alleged, the same doctrine is either virtually decided or assumed; which, it is further argued, though not supported by the modern decisions of the English chancery, is found in its earlier precedents.

An examination of the practice and opinions of the circuit courts undoubtedly shows much diversity, incapable of reconciliation, and makes it necessary, as far as it can be done, by a deliberate judgment of this court, to remove the question out of its present uncertainty, by a settlement upon some basis of principle, in harmony with our system of equity jurisprudence, developed and modified by legislation. To effect this satisfactorily and intelligently, it will be necessary to review the course of legislation, and judicial decision in this court, so far as it bears upon the question, from the beginning.

§ 3905. *Equity jurisdiction in patent cases; statutes and decisions reviewed.*

Prior to the passage of the act of February 15, 1819, chapter 19 (3 Stat., 481), congress had passed three laws, in execution of the power conferred by the constitution itself, and in furtherance of the policy thereby indicated, to secure to inventors an exclusive right of property in their inventions. The first of them, the act of April 10, 1790, chapter 7 (1 Stat., 109), gave as a remedy for its violation an action at law upon the case for damages, and forfeited the infringing article. The next was the act of February 21, 1793, chapter 11 (1 Stat., 318), which fixed the rule and measure of damages recoverable in an action at law upon the act at three times the price at which the patentee had usually sold or licensed to other persons the use of the invention. This was changed by the act of April 17, 1800, chapter 25 (2 Stat., 37), to three times

the actual damage sustained by the patentee by reason of the infringement. By neither of these acts, however, was any jurisdiction conferred upon the courts of the United States in equity. In *Livingston v. Van Ingen*, 1 Paine, 45, Mr. Justice Livingston held that to vest such jurisdiction by reason of the subject-matter, as a case arising under the laws of the United States, to be exercised in controversies between parties, without regard to their citizenship, it required the express authority of an act of congress; and the parties to that suit being citizens of New York, the bill was dismissed. The controversy was thereupon renewed in the courts of that state; and the chancellor having refused the injunction asked for, it was brought by appeal into the court for the correction of errors. 9 Johns. (N. Y.), 507. It was there objected that the right in question rested upon statute alone, which prescribed remedies at law for its violation, which, it must be deemed, were intended to be exclusive. But the decision affirmed the jurisdiction. "The principle is," said Kent, C. J. (p. 587), "that statute privileges, no less than common law rights, when in actual possession and exercise, will not be permitted to be disturbed until the opponent has fairly tried them at law and overthrown their pretension." The same learned judge refers also to the practice of the federal courts in granting injunctions under the patent law, mentioning two instances,—one, the case of *Morse v. Reid*, an injunction bill filed in 1796 to restrain the invasion of a copyright; the other, *Whitney v. Fort*, in which an injunction was granted to restrain the violation of the patent for the cotton-gin. Of course, in those cases, the jurisdiction of the court depended on the citizenship of the parties.

Congress then passed the act of February 15, 1819, chapter 19, which enacted "that the circuit courts of the United States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions and discoveries; and upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors secured to them by any law of the United States, on such terms and conditions as the said courts may deem fit and reasonable."

In the case of *Sullivan v. Redfield*, 1 Paine, 441, which was decided in 1825, Mr. Justice Thompson, who in the *Livingston* case had sat as one of the judges of the state court, had occasion to consider the nature of the equity jurisdiction in patent suits. "The equity jurisdiction," he said, "exercised by the court over patents for inventions is merely in aid of the common law, and in order to give more complete effect to the provisions of the statute under which the patent is granted." And in answer to the argument that the act of 1819 gave a peremptory right to an equitable remedy by virtue of the patent itself, he said: "This act does not enlarge or alter the powers of the court over the subject-matter of the bill or the cause of action. It only extends its jurisdiction to parties not before falling within it. Before this act it had been held that a citizen of one state could not obtain an injunction in the circuit court for a violation of a patent-right against a citizen of the same state, as no act of congress authorized such suit. This act removed that objection and gave the jurisdiction, although the parties were citizens of the same state. But in the exercise of the jurisdiction in all cases of granting injunctions to prevent the violation of patent-rights, the court is to proceed according to the course and principles of courts of equity in such cases. So that the questions

presented in the present case are precisely where they would have been without this act."

The substance of the act of 1819 was incorporated into the seventeenth section of the act of July 4, 1836, chapter 357 (5 Stat., 117), so far as it related to inventors, but remained in force, after the passage of the latter act, so far as it gave cognizance to the courts of the United States of cases of copyright. It was under that provision of the act of 1819 that the case of *Stevens v. Gladding* arose and was decided. 17 How., 447. That was a bill for an injunction to restrain the violation of a copyright, and prayed for the recovery of the penalties given by the seventh section of the act of February 3, 1831, chapter 16, and for general relief. Mr. Justice Curtis, delivering the opinion of the court, said: "There is nothing in this act of 1819 which extends the equity powers of the courts to the adjudication of forfeitures; it being manifestly intended that the jurisdiction therein conferred should be the usual and known jurisdiction exercised by courts of equity for the protection of analogous rights. The prayer of this bill for the penalties must, therefore, be rejected. The remaining question is whether there ought to be a decree for an account of the profits. The complainant has not prayed for such an account, nor have the defendants stated one in their answer; but the bill does pray for general relief. The right to an account of profits is incident to the right to an injunction in copy and patent-right cases;" citing *Colburn v. Simms*, 2 Hare, 554; 3 Dan. Ch. Pr., 1797. "And this court has held, in *Watts v. Waddle*, 6 Pet., 389, that where the bill states a case proper for an account, one may be ordered under the prayer for general relief."

The seventeenth section of the act of 1836 differs from the act of 1819 in one other particular only. It makes the jurisdiction, in patent causes, of the court of the United States exclusive.

§ 3906. *Under act of 1836, account in equity was restricted to actual gains and profits.*

It was under the act of 1836 that the question arose for the first time, in *Livingston v. Woodworth*, 15 How., 546, as to the rule for computing the profits of an infringer, upon a decree for such an account. The bill was for an injunction and account. The validity of the patent and the fact of infringement were both admitted by the defendant, who consented to a decree requiring him to account for and pay over the gains and profits made by him, during the infringement, in accordance with the prayer of the bill. The decree confirmed the report of the master, who awarded, not actual gains and profits, but such as he estimated the defendant might have made by due diligence. It was argued, in support of the decree, that where the court has jurisdiction to give the principal relief sought, it will make a complete decree, and give compensation for the past injury, as in bills for specific performance and injunction bills for waste; and that it was a correct rule to hold the party accountable, as an involuntary trustee, for what the patentee might have realized by the same exercise of the right, as a court of equity sometimes forces the character of a trustee upon an intruder, or wrong-doer, or one in possession under color of right, or who takes rents or profits belonging to another, or might have taken them, as in cases of mortgagees; but it was admitted that the case was of first impression. The decree, upon this point, was reversed. The court said: "We are aware of no rule which converts a court of equity into an instrument for the punishment of simple torts. . . . If the appellees, the plaintiffs below, had sustained an injury to their legal rights, the courts of law

were open to them for redress; and in these courts they might, according to a practice which, however doubtful in point of essential right, is now too inveterate to be called in question, have claimed not compensation merely, but vengeance, for such injury as they could show they have sustained. But, before a tribunal which refuses to listen even to any save those whose acts and motives are perfectly fair and liberal, they cannot be permitted to contravene the highest and most benignant principle of the being and constitution of that tribunal. There they will be allowed to claim that which, *ex æquo et bono*, is theirs, and nothing beyond this." Page 559. The account was therefore restricted to the actual gains and profits of the appellants during the time their machine was in operation.

This rule in relation to the profits recoverable in such suits was followed in *Dean v. Mason*, 20 How., 198, which was a case of a bill for an injunction and account, in which a decree *pro confesso* had been taken. The final decree was entered, on the report of the master, for the estimated amount of profits which the defendant, with reasonable diligence, might have realized; not what, in fact, he did realize. This was held to be erroneous. The court said: "The rule in such a case is, the amount of profits received by the unlawful use of the machines, as this, in general, is the damage done to the owner of the patent. It takes away the motive of the infringer of patented rights, by requiring him to pay the profits of his labor to the owner of the patent. Generally, this is sufficient to protect the rights of the owner; but where the wrong has been done under aggravated circumstances, the court has the power, under the statute, to punish it adequately by an increase of the damages."

§ 3907. *Rule as to "actual damages" stated.*

The important case of *Seymour v. McCormick*, 16 How., 480, was decided in 1853. That was an action at law. The court below instructed the jury that the actual damages to which the plaintiff was entitled, for an infringement of a patent for an improvement in a machine, might be determined by ascertaining the profits which, in judgment of law, he would have made provided the defendants had not interfered with his rights; and that the same rule applied whether the patent covered an entire machine or merely an improvement on a machine. This instruction this court held to be erroneous, and reversed the judgment on that account. Mr. Justice Grier, in delivering the opinion of the court, referred to the rule of damages, prescribed by the acts of congress, previously in force, stating that "experience had shown the very great injustice of a horizontal rule equally affecting all cases, without regard to their peculiar merits;" and that it was to obviate this that the patent act of 1836 confined the jury to the assessment of actual damages, leaving it to the discretion of the court to inflict punitive damages to the extent of trebling the verdict. He then remarked: "It must be apparent to the most superficial observer of the immense variety of patents issued every day, that there cannot, in the nature of things, be any one rule of damages which will equally apply to all cases. The mode of ascertaining actual damages must necessarily depend on the peculiar nature of the monopoly granted. A man who invents or discovers a new composition of matter, such as vulcanized india-rubber or a valuable medicine, may find his profit to consist in a close monopoly, forbidding any one to compete with him in the market, the patentee being himself able to supply the whole demand at his own price, in which cases "the profit of the infringer may be the only criterion of the actual damage of the patentee;" that "one who invents some improvement in the

machinery of a mill could not claim that the profits of the whole mill should be the measure of damages for the use of his improvement; and where the profit of the patentee consisted neither in the exclusive use of the thing invented or discovered, nor in the monopoly of making it for others to use, it is evident that this rule could not apply. The case of Stimpson's patent for a turnout in a railroad may be cited as an example. It was the interest of the patentee that all railroads should use his invention, provided they paid him the price of his license. He could not make his profit by selling it as a complete and separate machine. An infringer of such a patent could not be liable to damages to the amount of the profits of his railroad, nor could the actual damages of the patentee be measured by any known ratio of the profits of the road. . . . It is only where, from the peculiar circumstances of the case, no other rule can be found, that the defendant's profits become the criterion of the plaintiff's loss. Actual damages must be actually proved, and cannot be assumed as a legal inference from any facts which amount not to actual proof of the fact." Accordingly, it was held in *Corporation of New York v. Ransom*, 23 How., 487, where the rule in *Seymour v. McCormick*, *supra*, was expressly approved, that, in an action at law, if the plaintiff rested his case after proof of infringement merely, he was entitled only to nominal damages. It was also applied in *Jones v. Morehead*, 1 Wall., 155, which was a bill in equity for an injunction and an account, where a decree for a large sum as profits had been rendered against the defendant, upon an entire machine, in respect to which it appeared, as matter of fact, that the defendants had not infringed the patent sued on, but had admitted to the contrary in the answer. The court construed this admission by applying it to the smallest number of patented articles, and to the use of any part of the patent found to be valid, and reversing the decree, ordered one to be entered for a "nominal sum of \$1 for profits."

In *Rubber Company v. Goodyear*, 9 Wall., 788, which was a bill for an injunction and account, a decree for a large sum was rendered in favor of the complainants, which was affirmed on appeal. "The rule," said Mr. Justice Swayne, delivering the opinion of the court, "is founded in reason and justice. It compensates one party and punishes the other. It makes the wrong-doer liable for actual, not possible, gains. The controlling consideration is that he shall not profit by his wrong. A more favorable rule would offer a premium to dishonesty and invite to aggression. The jurisdiction of equity is adequate to give the proper remedy, whatever phase the case may assume; and the severity of the decree may be increased or mitigated according to the complexion of the conduct of the offender."

Mowry v. Whitney, 14 Wall., 620 (§§ 5036-45, *infra*), was also a bill in equity for an injunction and account. A decree was rendered in favor of the complainant for all the profits on the manufactured article, instead of upon the patented process of manufacture, with interest added. On appeal, this court reversed the decree on that point, saying: "The question to be determined in this case is, what advantage did the defendant derive from using the complainant's invention, over what he had in using other processes then open to the public and adequate to enable him to obtain an equally beneficial result. The fruits of that advantage are his profits. . . . That advantage is the measure of profits." On the question of interest, Mr. Justice Strong, speaking for the court, said: "We add only that, in our opinion, the defendant should not have been charged with interest before the final decree. The profits which

are recoverable against an infringer of a patent are in fact a compensation for the injury the patentee has sustained from the invasion of his right. They are the measure of his damages. Though called profits, they are really damages, and unliquidated until the decree is made. Interest is not generally allowable upon unliquidated damages. We will not say that in no possible case can interest be allowed. It is enough that the case in hand does not justify such an allowance."

In *Packet Company v. Sickles*, 19 Wall., 611, which was an action at law, the rule established in *Seymour v. McCormick*, *supra*, was reiterated, as "the established criterion of damages in cases to which it was applicable." "In cases where there is no established patent or license fee in the case, or even an approximation to it, general evidence must necessarily be resorted to," as was said by the court in the case of *Suffolk Company v. Hayden*, 3 Wall., 315. "And what evidence," said Mr. Justice Nelson, in that case, page 320, "could be more appropriate and pertinent than that of the utility and advantage of the invention over the old modes or devices that had been used for working out similar results? With a knowledge of these benefits to the persons who have used the invention, and the extent of the use by the infringer, a jury will be in possession of material and controlling facts that may enable them, in the exercise of a sound judgment, to ascertain the damages, or, in other words, the loss to the patentee or owner by the piracy instead of the purchase of the use of the invention." He added that "a recovery does not vest the infringer with the right to continue the use, as the consequence of it may be an injunction restraining the defendant from the further use of it."

In *Packet Company v. Sickles*, *supra*, Mr. Justice Miller said: "The rule in suits in equity, of ascertaining by a reference to a master the profits which the defendant has made by the use of the plaintiff's invention, stands on a different principle. It is that of converting the infringer into a trustee for the patentee as regards the profits thus made; and the adjustment of these profits is subject to all the equitable considerations which are necessary to do complete justice between the parties, many of which would be inappropriate in a trial by jury. With these corrective powers in the hands of the chancellor, the rule of assuming profits as the groundwork for estimating the compensation due from the infringer to the patentee has produced results calculated to suggest distrust of its universal application even in courts of equity."

The doctrine of this case was reiterated in *Burdell v. Denig*, 92 U. S., 716, where Mr. Justice Miller, again delivering the opinion of the court, said:

"Profits are not the primary or true criterion of damages for infringement in an action at law. That rule applies eminently and mainly to cases in equity, and is based on the idea that the infringer shall be converted into a trustee, as to those profits, for the owner of the patent which he infringes; a principle which it is very difficult to apply in a trial before a jury, but quite appropriate on a reference to a master, who can examine defendant's books and papers and examine him on oath, as well as all his clerks and employees. On the other hand, we have repeatedly held that sales of licenses of machines, or of a royalty established, constitute the primary and true criterion of damages in the action at law. No doubt, in the absence of satisfactory evidence of either class in the forum to which it is most appropriate, the other may be resorted to as one of the elements on which the damages or the compensation may be ascertained."

Littlefield v. Perry, 21 Wall., 205 (§§ 529-47, *supra*), was one where the patentee, by force of an agreement, held the legal title to the patent in trust for the complainant, in violation of which he was making use of his legal rights. It was held, upon a bill filed for an injunction and account, that it was a case under the patent laws, and the defendant was required to account for the profits he had made, according to the rule in *Mowry v. Whitney*, *supra*. The chief justice said, p. 230: "Profits actually realized are usually, in a case like this, the measure of unliquidated damages. Circumstances may, however, arise which would justify the addition of interest in order to give complete indemnity for losses sustained by wilful infringements."

§ 3908. *Under act of 1870 damages sustained by complainant in addition to profits made by defendant are recoverable in equity and are incident to the right to account.*

By the act of July 8, 1870, chapter 230, congress revised, consolidated and amended the statutes relating to patents and copyrights. 16 Stat., 198. The fifty-ninth section renewed the provision previously in force, that damages for infringement might be recovered by action on the case, and that whenever, in any such action, a verdict shall be rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of the verdict. The fifty-fifth section is as follows:

"That all actions, suits, controversies and cases arising under the patent laws of the United States shall be originally cognizable, as well in equity as at law, by the circuit courts of the United States, or any district court having the power and jurisdiction of a circuit court, or by the supreme court of the District of Columbia, or of any territory; and the court shall have power, upon bill in equity filed by any party aggrieved, to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction, and the court shall have the same powers to increase the same in its discretion that are given by this act to increase the damages found by verdicts in actions upon the case; but all actions shall be brought during the term for which the letters patent shall be granted or extended, or within six years after the expiration thereof."

§ 3909. *Section 4919, Revised Statutes.*

These provisions are substantially carried into the Revised Statutes, section 59 of the act of 1870, being section 4919 of the latter, and section 55, corresponding to section 4921, Revised Statutes, except as to the provision in respect to the limitation upon the right to sue, which is not found in the Revised Statutes. But the rights of the parties in the present suit arose while the act of 1870 was in force, and are determinable under it.

In the case of *Birdsall v. Coolidge*, 93 U. S., 64 (§§ 1539-46, *supra*), it is declared, in reference to the effect of the act of 1870, that "gains and profits are still the proper measure of damages in equity suits, except in cases where the injury sustained by the infringement is plainly greater than the aggregate of what was made by the respondent;" in which event the provision is, that the

complainant "shall be entitled to recover, in addition to the profits to be accounted for by the respondent, the damages he has sustained thereby."

Mr. Justice Clifford, in the opinion in this case, quotes a passage, slightly altered, from Curtis on Patents, section 341*a* (4th ed.), p. 461, which, taken by itself, might seem to imply that prior to the act of 1870 the owner of a patent had the election to resort to a court of equity for the recovery of profits, or a court of law for damages, irrespective of any other relief of an equitable character; but the language of the passage is to be restrained to mean merely that the option existed to sue at law for past infringement, or seek equitable relief by way of prevention, the damages or profits following, as either jurisdiction is resorted to, each according to its kind. For if this be not so, it follows that since the passage of the act of 1870 an owner of a patent may recover, in a suit in equity, profits and damages in all cases, according to the rule above stated, without seeking any other relief whatever, the effect of which would be to give two remedies, one in equity, the other at law, merely for the recovery of damages for an injury to a legal right, an anomaly not to be found in any other branch of our jurisprudence. And manifestly, upon such a construction, the action at law would soon become obsolete, as completely as if it had been abolished by legislation. The whole force of the change in the statute consists in conferring upon courts of equity, in the exercise of their jurisdiction in administering the relief which they are accustomed and authorized to give, and which is appropriate to their forms of procedure, the power not merely to give that measure of compensation for the past, which consists in the profits of the infringer, but to supplement it, when necessary, with the full amount of damage suffered by the complainant, and which, if he had sued for that alone, he would have recovered in another forum, with power to increase the amount of the actual damages, as in courts of law. But as the account of profits, previously, was the incident of the suit, and not its object, so now the power to award damages and to multiply them is added as an incident to the right to an account.

But the difference between the state of the law before and after the act of 1870 finds its best illustration in a comparison between two cases, both of which were decided at the October term, 1877 — *Elizabeth v. Pavement Company*, 97 U. S., 126, and *Marsh v. Seymour*, id., 348.

In the former the bill was filed before the passage of the act, but prayed, besides an injunction, for both damages and profits. It was held that the court below had rightly decided that a decree for profits alone could be rendered, inasmuch as the jurisdiction of courts of equity to decree damages, as distinct from profits, was first conferred by the statute. Mr. Justice Bradley, delivering the opinion of the court, remarking that the general question of the profits recoverable in equity by a patentee was surrounded with many difficulties, which the courts had not yet succeeded in overcoming, said:

"But one thing may be affirmed with reasonable confidence, that, if an infringer of a patent has realized no profit from the use of the invention, he cannot be called upon to respond for profits; the patentee in such case is left to his remedy for damages. It is also clear that a patentee is entitled to recover the profits that have been actually realized from the use of his invention, although from other causes the general business of the defendant, in which the invention is employed may not have resulted in profits,—as when it is shown that the use of his invention produced a definite saving in the process of a manufacture. *Mowry v. Whitney*, 14 Wall., 434; *Cawood Pat-*

ent, 94 U. S., 695. On the contrary, though the defendant's general business be ever so profitable, if the use of the invention has not contributed to the profits, none can be recovered. The same result would seem to follow where it is impossible to show the profitable effect of using the invention upon the business results of the party infringing. It may be added, that, where no profits are shown to have accrued, a court of equity cannot give a decree for profits by way of damages, or as a punishment for the infringement. *Livingston v. Woodworth*, 15 How., 559. But when the entire profit of a business or undertaking results from the use of the invention, the patentee will be entitled to recover the entire profits, if he elects that remedy. And in such a case, the defendant will not be allowed to diminish the show of profits by putting in unconscionable claims for personal services or other inequitable deductions. *Rubber Company v. Goodyear*, 9 Wall., 788." And these general propositions, he added, will hardly admit of dispute.

Accordingly, in that case, the bill was dismissed as to the city of Elizabeth, which had infringed, because it appeared that it had made no profit from the use of the patented improvement, while a decree was rendered against the contractor who had laid the pavement which was the subject of the patent, because he was shown to have made profits from the infringement. The municipal corporation, of course, remained liable to respond in damages in an action at law for any loss which the plaintiff could have established by proof.

The cases of *Marsh v. Seymour*, *supra*, arose under the act of 1870, and were bills for injunction and account. Decrees were rendered in favor of the complainant, and a reference ordered to a master to state an account of profits. In both cases, the respondents showing that they had made no profits by reason of the use of the invention, the complainant waived his claim for a recovery on that account, and decrees were rendered for damages on the basis of a license fee for the infringing machines which had been sold, and nominal damages for those manufactured but not sold. These decrees were affirmed, the court saying, Mr. Justice Clifford delivering its opinion, that "damages of a compensatory character may be allowed to a complainant in an equity suit, where it appears that the business of the infringer was so improvidently conducted that it did not yield any substantial profits, as in the case before the court."

In *Parks v. Booth*, 102 U. S., 96, which was a suit in equity for an injunction, an account of profits and damages, under the act of 1870, a decree was rendered in favor of the complainant, and for profits and damages as found by a master. Under the head of damages there were included items for expenses of conducting the suit, being counsel fees, compensation for the complainant's time, and interest on the profits. The decree was modified on appeal by striking out all these allowances, except that for the complainant's time, lost in attending to the suit. Interest on profits was, on the authority of *Silsby v. Foote*, 20 How., 378, disallowed on the ground that profits in such a case are to be regarded in the light of unliquidated damages. No injunction was decreed, as the term of the patent had expired. It does not appear from the report of the case when the suit was begun, but a reference to the original record shows that the bill was filed in April, 1871, before the expiration of the term of the patent. *Hendrie v. Sayles*, 98 U. S., 546, was a bill in equity for an account of profits, filed after the expiration of the patent, the same patent on which the present suit is founded. It was decided upon a single point raised on demurrer to the bill, the question of jurisdiction not

being noticed either by counsel or court. A decree for the complainant was affirmed on appeal. This appears to be the only case of the kind, until the present, that found its way into this court.

Eureka Company v. Bailey Company, 11 Wall., 488, is no exception to this remark; although in respect to it the observation has been made, that the injunction prayed for in that case was incidental to the account, and not *vice versa*. That, however, is a misconception; for, unless upon the ground of a difference of citizenship, the court would not have had jurisdiction to entertain the bill in that case, if it had not prayed for an injunction. For the mere purpose of enforcing the contract for the royalty, it was not a case arising under the patent laws, so as to give jurisdiction to the courts of the United States. It was because the defendant was guilty of an infringement of the complainant's patent that he was suable in equity in these courts, and to restrain that an injunction was asked until he should pay what he had promised. The object of the suit doubtless was to collect the royalty: but it was sought by means of, and therefore as an incident to, the jurisdiction of the court, invoked for the purpose of enjoining the continuance of what, until the royalty was acknowledged and paid, was found to be an infringement.

§ 3910. *Act 1870, section 51, defenses pleadable in equity.*

All the acts of congress relating to patents prior to that of 1870 contained provisions specifying the special defenses which might be made in an action at law for an infringement, under the plea of the general issue, notice thereof having been previously given. The sixty-first section of the act of 1870 enumerates the several special matters thus authorized to be proved, and adds, for the first time in the history of this legislation, the clause, that "the like defenses may be pleaded in any suit in equity for relief against an alleged infringement, and proofs of the same may be given upon like notice in the answer of the defendant and with the like effect."

The plain and obvious purpose of this provision is to furnish appropriate modes in equity pleading for the trial of all issues, both of fact and law, relating both to the alleged infringement and the validity of the patent, without the necessity of framing special issues out of chancery for trial by jury, or sending the parties to a court of law for the trial of an action in that forum, in order to determine their legal right. It proceeds upon the idea that the court of equity, having acquired jurisdiction for the purpose of administering the equitable relief sought by the bill, may determine directly and for itself, in the same proceeding, all questions incidental to the exercise of its jurisdiction, notwithstanding they may be questions affecting legal rights and legal titles.

Although this was the first statutory authority for the practice, it was rather a recognition of what had already been established than its introduction; for the practice had, in fact, originated long before, and was based upon well-known principles of equity jurisprudence. Whatever question may have existed in reference to it previously was settled in the courts of the United States by *Goodyear v. Day*, 2 Wall. Jr., 283, a case argued by Webster and Choate, and decided by Mr. Justice Grier in 1852. That learned judge on that occasion said: "It is true that in England the chancellor will generally not grant a final and perpetual injunction in patent cases, when the answer denies the validity of the patent, without sending the parties to law to have that question decided. But even there the rule is not absolute or universal; it is a practice founded more on convenience than necessity. It always rests on the sound

discretion of the court. A trial at law is ordered by a chancellor to inform his conscience; not because either party may demand it as a right, or that a court of equity is incompetent to judge of questions of fact or of legal titles." See, also, *Orr v. Merrill*, 1 Woodb. & M., 376.

The distinction in the nature of the two proceedings of an action at law and a suit in equity is plainly pointed out in this section of the statute, the former as being an action for an infringement, the latter as a suit for relief against an alleged infringement. And while upon the words used in the fifty-fifth section of the act, it may be that the jurisdiction in equity which is thereby conferred is not exhausted by the power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, yet the statute immediately says that it is upon a decree being rendered in any *such* case for an infringement—as though that was the only one—that the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby.

§ 3911. *The distinction of jurisdiction between law and equity is constitutional, and applies in patent cases as well as others.*

It is impossible, we think, to maintain the claim that the language of this act, similar in that respect to the previous acts of 1819 and 1836, conferring jurisdiction in patent cases in equity as well as at law, was meant to obliterate the distinctions between these two jurisdictions, or even to confuse the boundaries between them, as it is alleged was done by the decision in the case of *Nevins v. Johnson*, 3 Blatch., 80, and perhaps in other subsequent circuit court decisions. Indeed it is the settled doctrine of this court that this distinction of jurisdiction between law and equity is constitutional, to the extent to which the seventh amendment forbids any infringement of the right of trial by jury, as fixed by the common law. And the doctrine applies in patent cases as well as others. This court said in *Parsons v. Bedford*, 3 Pet., 433, speaking of the meaning intended by the framers of that amendment, that "by common law they meant what the constitution denominated in the third article, LAW, not merely *suits* which the common law recognized among its old and settled proceedings, but suits in which *legal* rights were to be ascertained and determined, in contradistinction to those where *equitable rights* alone were recognized and equitable remedies administered." The rule was repeated in *Fenn v. Holme*, 21 How., 481, in this language: "In every instance in which this court has expounded the phrases, proceedings at the common law and proceedings in equity, with reference to the exercise of the judicial powers of the courts of the United States, they will be found to have interpreted the former as signifying the application of the definitions and principles and rules of the common law to rights and obligations essentially legal; and the latter as meaning the administration with reference to equitable as contradistinguished from legal rights, of the equity law as defined and enforced by the court of chancery in England.

§ 3912. *Where a bill is for a naked account of profits and damages from the infringement of a patent, and no ground of equitable jurisdiction is shown, nor that the party is without a complete remedy at law, the bill is properly dismissed for want of jurisdiction.*

It becomes necessary, therefore, to consider what support there is in the general doctrines of equity for the contention of the appellant. It is the fundamental characteristic and limit of the jurisdiction in equity that it can-

not give relief when there is a plain and adequate and complete remedy at law; and hence it had no original, independent and inherent power to afford redress for breaches of contract or torts by awarding damages; for to do that was the very office of proceedings at law. When, however, relief was sought which equity alone could give, as by way of injunction to prevent a continuance of the wrong, in order to avoid multiplicity of suits and to do complete justice, the court assumed jurisdiction to award compensation for the past injury, not, however, by assessing damages, which was the peculiar office of a jury, but requiring an account of profits, on the ground that if any had been made it was equitable to require the wrong-doer to refund them, as it would be inequitable that he should make a profit out of his own wrong. As was said by Vice-Chancellor Wigram in *Colburn v. Simms*, 2 Hare, 543, "the court does not by an account accurately measure the damage sustained by the proprietor of an expensive work from the invasion of his copyright by the publication of a cheaper book," but, "as the nearest approximation which it can make to justice, takes from the wrong-doer all the profits he has made by his piracy and gives them to the party who has been wronged."

Whether a bill for an account of profits against a wrong-doer would lie, independently of other equitable grounds for the intervention of the court, is a question, as was said by Lord Chancellor Brougham in *Parrott v. Palmer*, 3 Myl. & K., 632, "which has been oftentimes agitated, and has, perhaps, never received a clear and a general decision; that is to say, a distinct judgment on the general proposition, with its limitations." He concluded that, "from the whole, it may be collected that, although as to timber there exists considerable discrepancy, yet the sound rule is to make the account the incident and not the principal, where there is a remedy at law; but that mines are to be otherwise considered, and that as to them the party may have an account even in cases where no injunction would lie."

The supposed exception in cases of mines seems to rest upon a *dictum* of Lord Hardwicke in *Jesus College v. Bloom*, 3 Atk., 262, that "it was a sort of trade;" but the reference is to the case of *Bishop of Winchester v. Knight*, 1 P. W., 406, where the bill prayed for an account of ore dug by the ancestor of the defendant, in respect to which the argument was, that, being a personal tort, it died with the person. The decision was that the plaintiff was not entitled; but on this point the lord chancellor said: "It would be a reproach to equity to say, where a man has taken my property, as my ore or timber, and disposed of it in his life-time, and dies, that in this case I would be without remedy. It is true, as to the trespass of breaking up meadow or ancient pasture ground, it dies with the person; but, as to the property of the ore or timber, it would be clear, even at law, if it came to the executor's hands, that trover would lie for it; and if it has been disposed of in the testator's life-time, the executor, if assets are left, ought to answer it." It is plain from these observations that the assumed ground of the equity jurisdiction was the absence of any remedy at law. *Powell v. Aiken*, 4 Kay & J., 343. It is now clearly established in the English chancery "that a bill will not lie for an account of timber felled any more than for any other money demand, except when the account is asked as an incident to an injunction, and that when the plaintiff has no right to an injunction, he has no right to an account, and his remedy is at law alone." Per Sir Wm. M. James, L. J., in *Higginbotham v. Hawkins*, Law Rep., 7 Ch. App., 676.

The same rule is applied by the modern decisions in cases of mines, where,

as incident to the relief sought by a bill, an account is asked of profits against trespassers. It appears that as to the mode of assessing compensation in such suits to an owner of coal which has been improperly worked by the owner of an adjoining mine, a different principle is applicable when the coal is taken inadvertently, or under a *bona fide* belief of title, and when it is taken fraudulently, with knowledge of the wrong. In cases of the latter description, at law, the strict rule of damages laid down in *Martin v. Porter*, 5 Mee. & W., 351, was to charge the value of the coal without allowing any of the expenses of getting it; but in those of the former description a milder rule was applied in *Morgan v. Powell*, 3 Q. B., 278, and *Wood v. Morewood*, id., 440, which was to give to the plaintiff the fair value of the coals, as if the coal-field had been purchased from him by the defendant. This distinction was adopted and the latter rule applied in equity by Vice-Chancellor Malins in *Hilton v. Woods*, Law Rep., 4 Eq., 432, and by Lord Chancellor Hatherley in *Jegon v. Vivian*, Law Rep., 6 Ch. App., 742, the latter remarking that "this court never allows a man to make profit by a wrong." This rule was adopted in *Stockbridge Iron Co. v. Cone Iron Works*, 102 Mass. 80.

The same rule applies in England in patent and copyright cases. The Vice-Chancellor Page-Wood, in *Smith v. London & Southwestern Railway Co.*, Kay, 408, said: "The true ground of relief in these cases is laid down in *Baily v. Taylor*, 1 Russ. & M., 73, where Sir J. Leach, M. R., says: 'The court has no jurisdiction to give to a plaintiff a remedy for an alleged piracy, unless he can make out that he is entitled to the equitable interposition of this court by injunction; and in such case the court will also give him an account, that his remedy here may be complete. If this court do not interfere by injunction, then his remedy, as in the case of any other injury to his property, must be at law.' Unless that primary right to an injunction exists, this court has no jurisdiction with reference to a mere question of damages." The vice-chancellor further observed that, as had often been stated by Lord Eldon, as the object of the court in interfering by injunction was the prevention of a multiplicity of suits, which might be rendered necessary by continued infringements of the patent, he was at a loss to see how the jurisdiction could attach, or the relief by injunction be arrived at, after the expiration of the patent, unless a case were made out, of a numerous series of past infringements, from which the parties were still deriving advantage. He then referred to *Crossley v. Beverly*, Web. P. C., 119, as a case where there was a specific ground for that relief, that the defendants had been manufacturing the patented articles, secretly and fraudulently, for the purpose of pouring into the market the articles so manufactured directly the patent should have expired. In that case the bill was filed before the expiration of the patent, and the right to sue having been thus acquired, the court extended it to restrain using the articles so manufactured after the patent had expired. "Such a case," continues the vice-chancellor, "of a fraudulent attempt to evade the patent might occur, as would enable the court to restrain the use of articles made in infringement of the patent and kept back until it expired, even after its expiration, and the plaintiff having thus obtained a right to the injunction, the right to an account would follow."

In the case of *Price's Pat. Candle Co. v. Bauwen's Pat. Candle Co.*, 4 Kay & J., 727, the bill was dismissed, because the patent having expired *pendente lite*, the relief by injunction could not be granted at the hearing; but in *Davenport v. Rylands*, Law Rep., 1 Eq., 302, the same judge retained the bill,

under similar circumstances, for the purposes of an inquiry as to damages, because the act of 21 and 22 Vict., c. 27, commonly called Cairn's Act, passed after the former decision, had altered the rule. That statute declared that in all cases in which the court has jurisdiction to entertain an application for an injunction against a breach of any covenant, contract or agreement, or against the commission or continuance of any wrongful act, or for the specific performance of any covenant, contract or agreement, the same court may award damages to the party injured either in addition to or in substitution for such injunction or specific performance, and such damages may be assessed in such manner as the court shall direct,—a provision which no doubt suggested the like extension of the jurisdiction of the court in patent cases, contained in our patent act of 1870. But even after the passage of Cairn's Act, it was decided by Vice-Chancellor Sir Wm. M. James, in *Betts v. Gallais*, Law Rep., 10 Eq., 392, that the court would not entertain a bill for the mere purposes of giving relief in damages for the infringement of a patent, when the bill had been filed so immediately before the expiration of the patent as to render it impossible to have obtained an interlocutory injunction. He characterized it as "a mere device to transfer a plain jurisdiction to award damages from the court to which that jurisdiction properly belongs to this court."

Mr. Kerr, in his treatise on Injunctions, 41, summarizes the result of many decisions, which he cites, under this statute, as follows: "The statute did not transfer to the court the general jurisdiction of common law by way of damages, or extend its jurisdiction to cases where, previously to the statute, it had no jurisdiction, or could not, consistently with its rules and principles, have interfered. The statute merely empowered the court to give damages in cases involving elements or ingredients of an equitable character. If the case as presented to the court was an equitable one, so that the subject-matter of the application is properly cognizable in equity, the court had jurisdiction under the statute to entertain the question of damages. If, on the other hand, the plaintiff had no equitable right at the time of bringing the action, so that the matter has been improperly brought into equity, the statute had no application. Damages may be awarded under the statute if it appear that at the time of bringing the action there was an equitable case, although the case for an injunction fails, or although an injunction is not competent from circumstances which have occurred since the filing of the bill."

It will be observed that the British statute does not touch the question of the account of profits by an infringer, leaving that as it stood before the passage of the act. The unavoidable inference is that damages can only be given under the act, in cases in which an account might be decreed; and that the patentee must, as it was expressly decided by the house of lords in *De Vitre v. Betts*, Law Rep., 6 H. L., 319, in all cases when he has a decree, elect whether he will have an account of profits or an inquiry as to damages, and cannot have both. Under the act of congress of 1870, he may recover damages in addition to the profits to be accounted for by the defendant; but as the recovery is limited by the act to the actual damages, it is manifest that the recovery of damages and profits is not intended to be double, but that when necessary the damages are to supplement that loss of the complainant which the profits found to have been received are insufficient to compensate, subject to the power of the court as to their increase, as in case of verdicts.

This firm and indisputable doctrine of the English chancery has been recognized and declared by this court, in *Hipp v. Babin*, 19 How., 271, to be part

of the system of equity jurisprudence administered by the courts of the United States, founded not only upon the legislative declaration in the judiciary act of 1789, "that suits in equity shall not be sustained in either of the courts of the United States in any case where plain, adequate and complete remedy may be had at law," but also upon the intrinsic distinctions between the different jurisdictions of law and equity. In delivering the opinion of the court in that case, Mr. Justice Campbell remarked that "the practice of the courts of the United States corresponds with that of the chancery of Great Britain, except where it has been changed by rule, or is modified by local circumstances or local convenience;" and cited the instances in which "this court has denied relief in cases in equity, where the remedy at law has been plain, adequate and complete, though the question was not raised by the defendants in their pleadings nor suggested by the counsel in their arguments. He then adds: "And the result of the argument is that whenever a court of law is competent to take cognizance of a right, and has power to proceed to a judgment which affords a plain, adequate and complete remedy, without the aid of a court of equity, the plaintiff must proceed at law, because the defendant has a constitutional right to a trial by jury." It was contended in that case that, notwithstanding this general principle, the bill ought to be maintained, because the complainants, being minors, were authorized to call upon the defendants, who had intruded into possession of their lands, for an account as guardians, and that the court of chancery was better fitted to take an account for rents, profits and improvements, and might decide the question of title as incidental to the account.

In reply to these points, Mr. Justice Campbell remarked that "there are precedents in which the right of an infant to treat a person who enters upon his estate with notice of his title, as guardian or bailiff, and to exact an account in equity for the profits for the whole period of his occupancy, is recognized." "But," he added, "in those cases the title must, if disputed, be established at law, or other grounds of jurisdiction must be shown." "Nor can the court retain the bill under an impression that a court of chancery is better adapted for the adjustment of the account for rents, profits and improvements. The rule of the court is, that when a suit for the recovery of the possession can be properly brought in a court of equity, and a decree is given, that court will direct an account as an incident in the cause. But when a party has a right to a possession which he can enforce at law, his right to the rents and profits is also a legal right, and must be enforced in the same jurisdiction. The instances where bills for an account of rents and profits have been maintained are those in which special grounds have been stated, to show that courts of law could not give a plain, adequate and complete remedy. No instances exist where a person who had been successful at law has been allowed to file a bill for an account of rents and profits during the tortious possession held against him, or in which the complexity of the account has afforded a motive for the interposition of the court of chancery to decide the title and to adjust the account."

These principles were announced in a case for the recovery of the possession of real estate held adversely, but they are of general application, and embrace as well the case of torts to personalty and infringements of patent and copy-rights.

§ 3913. *A rule of administration and not of jurisdiction.*

The distinct ground upon which the opposite view is presented to us in

argument is, that the infringer of a patent-right is, by construction of law, a trustee of the profits derived from his wrong, for the patentee, and that a court of equity, in the exercise of its acknowledged jurisdiction over trusts and trustees, will require him to account as trustee, without reference to any other relief. And in support of this contention we are referred to passages in the judgments of this court in the cases of *Packet Company v. Sickles*, *Burdell v. Denig*, and *Birdsall v. Coolidge*, all of which have been already cited in this opinion.

But the inference sought to be drawn from the expressions referred to is not warranted. It is true that it is declared in those cases that, in suits in equity for relief against infringements of patents, the patentee, succeeding in establishing his right, is entitled to an account of the profits realized by the infringer, and that the rule for ascertaining the amount of such profits is that of treating the infringer as though he were a trustee for the patentee, in respect to profits. But it is nowhere said that the patentee's right to an account is based upon the idea that there is a fiduciary relation created between him and the wrong-doer by the fact of infringement, thus conferring jurisdiction upon a court of equity to administer the trust and to compel the trustee to account. That would be a *reductio ad absurdum*, and if accepted would extend the jurisdiction of equity to every case of tort, where the wrong-doer had realized a pecuniary profit from his wrong. All that was meant in the opinions referred to was to declare according to what rule of computation and measurement the compensation of a complainant would be ascertained in a court of equity which, having acquired jurisdiction upon some equitable grounds to grant relief, would retain the cause for the sake of administering an entire remedy and complete justice, rather than send him to a court of law for redress in a second action. The rule adopted was that which the court in fact applies in cases of trustees who have committed breaches of trust by an unlawful use of the trust property for their own advantage; that is, to require them to refund the amount of profit which they have actually realized. This rule was adopted, not for the purpose of acquiring jurisdiction, but in cases where, having jurisdiction to grant equitable relief, the court was not permitted by the principles and practice in equity to award damages in the sense in which the law gives them, but a substitute for damages, at the election of the complainant, for the purpose of preventing multiplicity of suits. And the particular rule was formulated, as will be seen by reference to the cases already referred to, out of tenderness to defendants in order to mitigate the severity of the punishment to which they might be subjected in an action at law for damages, and because it was thought more equitable merely to deprive them of the actual profits arising from their wrong, than to make no allowances, in estimating damages, for the cost and expense of the business in the prosecution of which they had violated the rights of the complainant. The same reason operated in the establishment of the similar rule acted upon in the cases of *Hilton v. Woods* and *Jegon v. Vivian*, already cited in a previous part of this opinion. The rule itself is reasonable and just, though sometimes perverted and abused. It has been constantly acted upon by the courts. But it is a rule of administration and not of jurisdiction; and although the creature of equity, it is recognized as well at law as one of the measures, though not the limit, for the recovery of damages.

The case is not within the principle according to which, in certain circumstances, a court of equity decrees a wrong-doer to be a trustee *de son tort*, and

exerts its jurisdiction over him in that character. Where a defendant has wrongfully intermeddled with property already impressed with a trust, he may be required as a trustee to account for it, as was done in the case of *People v. Houghtaling*, 7 Cal., 348, because trust property may be followed, wherever it can be traced, into whosoever possession it comes, except that of a *bona fide* purchaser without notice. It is the character of the property, and not the wrong done in converting or withholding it, that constitutes the wrong-doer a trustee.

Our conclusion is, that a bill in equity for a naked account of profits and damages against an infringer of a patent cannot be sustained; that such relief ordinarily is incidental to some other equity, the right to enforce which secures to the patentee his standing in court; that the most general ground for equitable interposition is, to insure to the patentee the enjoyment of his specific right by injunction against a continuance of the infringement; but that grounds of equitable relief may arise, other than by way of injunction, as where the title of the complainant is equitable merely, or equitable interposition is necessary on account of the impediments which prevent a resort to remedies purely legal; and such an equity may arise out of, and inhere in, the nature of the account itself, springing from special and peculiar circumstances which disable the patentee from a recovery at law altogether, or render his remedy in a legal tribunal difficult, inadequate and incomplete; and as such cases cannot be defined more exactly, each must rest upon its own particular circumstances, as furnishing a clear and satisfactory ground of exception from the general rule.

The case of *Garth v. Cotton*, 1 Dick., 183, furnishes an interesting and curious illustration of one of the excepted cases. In that case Lord Hardwicke sustained a bill in equity, in a case of waste, for an account of timber felled and sold, where there could be no injunction, in favor of a complainant unborn at the time of its commission, whose estate was a contingent remainder, supported by a limitation to trustees to preserve it, the defendant being the owner of a prior term of years, and the ultimate remainder-man in fee. The lord chancellor proceeded on the ground of collusion between the defendants and a nominal or imputed breach of trust on the part of the trustees to preserve the contingent remainder in permitting the wrong; and distinguished the case from *Jesus College v. Bloom*, 3 Atk., 262, particularly on the ground that the complainant could have no remedy at law. Another instance of an exception is mentioned by Vice-Chancellor Page-Wood in the extract from his judgment in the case of *Smith v. The London & Southwestern Railway Co.*, Kay, 408, contained in a previous part of this opinion.

It does not appear from the allegations of the bill in the present case that there are any circumstances which would render an action at law for the recovery of damages an inadequate remedy for the wrongs complained of; and as no ground for equitable relief is presented, we are of opinion that the circuit court did not err in sustaining the demurrer and dismissing the bill. Decree affirmed.

Jurisdiction — Equity — Expired patent, §§ 3914-3931. See *Injunction*, §§ 3334-3337.

§ 3914. Equity jurisdiction in patent causes is conferred by sections 629, 711 and 4921 of the Revised Statutes, notwithstanding the patent may have expired before suit is brought and no injunction could be granted. *Gordon v. Anthony*, 16 Blatch., 234.

§ 3915. A bill in equity for the infringement of a patent will not lie after the patent has expired, if it asks only for damages for the infringement, for the remedy is complete at law; but

if it asks for a discovery, and such an account as is the proper subject of a suit in equity, the circuit court will take jurisdiction. *Vaughan v. East Tenn., Virg. & Ga. R. Co.*, 1 Flip., 621.

§ 3916. Where a bill praying an injunction and account was brought, and the patent expired prior to the hearing, *held*, that the court had jurisdiction under act 1836, section 17, to decree an account. *Blank v. Manufacturing Co.*, 3 Wall. Jr., 196.

§ 3917. Where, plaintiff's patent having expired, a bill for infringement was filed by him, praying for discovery and account, but not for injunction, *held*, that under act 1836, section 17, the court had jurisdiction, irrespective of plaintiff's right to injunction, and a demurrer to the bill was not sustained. *Nevins v. Johnson*, 3 Blatch., 80.

§ 3918. Where the patent expired pending a bill to enjoin its infringement, the court simply ordered an accounting. *Jordan v. Dobson*, 2 Abb., 398.

§ 3919. A bill in equity lies after the expiration of the extension of a patent to compel an infringer to account for profits. *Stevens v. Kansas Pacific R'y*, 5 Dill., 487.

§ 3920. Where the bill was founded on an agreement, although no royalties were payable, and the patent had expired, *held* to be a bill for account and discovery to ascertain facts from which the damages to plaintiff could be computed, and not open to the objection that there was complete remedy at law. *Magic Ruffle Co. v. Elm City Co.*, 13 Blatch., 151.

§ 3921. Where suit was brought in equity on an expired patent, *held*, that it might be sustained for an accounting without demanding an injunction. *Atwood v. Portland Co.*, 10 Fed. Rep., 283.

§ 3922. The expiration of a patent before final hearing, but in force at the time of bringing the suit, will not of itself defeat the jurisdiction of a court of equity to administer any necessary relief. Foot-note to *Gottfried v. Moerlein*, 14 Fed. Rep., 170.

§ 3923. There is no doubt of the propriety of decreeing an accounting, although the patent has expired since the commencement of the suit, and although for that reason there should not be an injunction. The jurisdiction of a court of equity having been legitimately involved by the complainant, he will not be sent away without redress because all the redress to which he was originally entitled cannot now be awarded to him. The court will retain the cause in order to completely determine the controversy. *Adams v. Howard*, 19 Fed. Rep., 317.

§ 3924. Suits in equity having been begun in 1879 for the infringement of two patents, and the circuit court having dismissed the bills, this court in reversing the decrees, after the first patent had expired, but not the second, awarded accounts of profits and damages as to both patents, and a perpetual injunction as to the second patent. *Consolidated Safety-Valve Co. v. Crosby Steam Gauge & Valve Co.*, 113 U. S., 157.

§ 3925. The power of trebling damages vested in the court under act 1836, section 14, does not extend to suits on expired patents, which are mere cases of collection. *Bell v. McCullough*, 1 Bond, 194.

§ 3926. Where a bill for an account of profits was based upon an invention of such nature that the license fee was the only measure of damages, and there was no basis for an estimate of profits, and the patent had expired, *held*, that as a bill for an account of profits it failed to show a case for equity cognizance, and also the account failing, it did not present a case for discovery as an independent ground of equitable jurisdiction. *Vaughn v. C. P. R. Co.*, 4 Biss., 280.

§ 3927. After the expiration of the patent a court of equity will not undertake to decide upon its validity or to enjoin an action at law for its infringement, unless some purely equitable defense is made out which would not be equally available in that action. *City of Concord v. Norton*, 16 Fed. Rep., 477.

§ 3928. A bill for injunction and account filed subsequent to the expiration of the patents sued upon cannot be sustained in the absence of other grounds of equity jurisdiction, where there is a full and complete remedy at law. *Campbell v. Ward*, 12 Fed. Rep., 150.

§ 3929. An assignee of a claim for profits and damages, becoming such after the expiration of the extended patent, cannot maintain a suit in equity to recover them. *Hayward v. Andrews*, 12 Fed. Rep., 786.

§ 3930. Where the assignee of damages for infringement of an expired patent had an adequate legal remedy, a demurrer to a bill in equity to recover such damages was sustained without prejudice to his legal remedy. *Ibid.*

§ 3931. A bill in equity brought for the infringement of a patent which had expired prior to the bringing of the suit, *held*, to be a bill for a naked account, and dismissed for want of jurisdiction, notwithstanding special allegations in the bill relating to the discovery sought. *Lord v. Whitehead & Atherton Machine Co.*, 33 O. G., 499.

Jurisdiction — Equity — Allowed, §§ 3932-3948. **Refused,** §§ 3949-3956.

§ 3932. Equity jurisdiction over patents is in aid of the common law and of the statute, and will not be exercised, except on the supposition that applicant has a right which has been infringed and entitles him to injunction. *Sullivan v. Redfield*, 1 Paine, 441.

§ 3933. Jurisdiction of courts of equity in patent cases is original and statutory. *Blank v. Manufacturing Co.*, 3 Wall. Jr., 196.

§ 3934. United States circuit courts have original jurisdiction as courts of chancery in all patent cases. They do not act merely as auxiliary to courts of law, and may therefore render a final decree on a patent whose validity is contested, without sending the parties to law to try their rights. *Batten v. Silliman*, 3 Wall. Jr., 124.

§ 3935. A trial at law is not a prerequisite to equity jurisdiction in patent cases. *McMillin v. Barclay*, 5 Fish., 189.

§ 3936. The power conferred upon United States circuit courts to entertain bills in equity with respect to patent-rights is a general equity power, and carries with it the incidents belonging to that species of jurisdiction. *Potter v. Dixon*, 5 Blatch., 160.

§ 3937. The principle upon which equity courts have jurisdiction in patent cases stated. *Motte v. Bennett*, 2 Fish., 642.

§ 3938. Where injunction is sought pending the life of a patent, and the bill prays for damages as well, equity has jurisdiction. *McMillin v. St. Louis & Miss. Valley Transp. Co.*, 18 Fed. Rep., 260.

§ 3939. Equity has jurisdiction in bill for discovery and account in patent cases. *Sayles v. Dubuque & Sioux City R. Co.*, 5 Dill., 561.

§ 3940. Since the Revised Statutes a bill in equity will not lie solely to recover damages for the infringement of a patent, but if it pray for an injunction, or for a discovery and account of profits, it will be maintained. *Vaughn v. East Tennessee, Virginia & Georgia R. Co.*, 1 Flip., 621.

§ 3941. Even when a suit at law will lie for the infringement of a patent, proceedings in equity may usually be maintained, as affording a more practical and efficient remedy. *Hill v. Whitcomb*, 1 Holmes, 317.

§ 3942. An equity court will not entertain jurisdiction of a matter which the person has had opportunity to litigate in another court, and which has there been decided against him, unless it appears that circumstances beyond his control prevented his making the defense or trying the question. *Brooks v. Moorhouse*, 13 O. G., 499.

§ 3943. It is generally true that a court of equity ought not to sustain a bill which, although it may contain matter which can give the court jurisdiction, is merely for the assessment of damages for a breach of contract. *Magic Ruffle Co. v. Elm City Co.*, 14 Blatch., 109.

§ 3944. Where the relief to be ultimately rendered is the payment of damages, and the aid of a court of equity is needed for discovery in a case not of trusteeship or agency, but where the ascertainment of damages is complicated and intricate, and the action at law cannot be adequately tried without great difficulty, a court of equity assumes jurisdiction of the whole case and proceeds to a final decree upon the merits. *Ibid.*

§ 3945. The proper forum in which to sue for damages, arising on an infringement, is a court of law. But chancery courts may take cognizance of such cases, if they involve some element of equitable jurisdiction, and when jurisdiction is once rightfully obtained, the court may proceed and decree full relief. *Burdell v. Comstock*, 15 Fed. Rep., 395.

§ 3946. Where the question was one involving the property rights of the defendant in certain letters patent, of which he and complainant were joint owners, and the bill sought to divest defendant of his rights as one of the partners and confer them on complainant, *held*, that it was a question affecting the patent, over which the court had jurisdiction independent of citizenship. *Duke v. Graham*, 19 Fed. Rep., 647.

§ 3947. Where the parties were citizens of different states, and the bill prayed for a discovery and account, *held*, that the court had jurisdiction, although the groundwork of the relief sought was a contract touching the use of letters patent. *McKay v. Mace*, 23 Fed. Rep., 76.

§ 3948. Where there was no laches in bringing suit for infringement, the exclusive right under the patent was of great value to complainant, was infringed, and there was nothing to indicate that he had granted or was about to grant licenses, and defendant had been requested to desist, *held*, that complainant was properly entitled to equitable relief. *Brick v. Staten Island R'y Co.*, 25 Fed. Rep., 553.

§ 3949. Where a bill was brought for a discovery of certain royalties due complainant under a license granted defendant, and for such other further relief as the case may require, but did not allege that a suit at law had been or was about to be brought, *held*, that it was a bill for relief and discovery, but that in the absence of such allegation, there was no ground for dis-

covery, and further, being brought to enforce a contract, the court had no jurisdiction. *Perkins v. Hendryx*, 23 Fed. Rep., 418.

§ 3950. Where the bill prayed that the defendants be required to account with the complainants and pay over all royalties at the rate of \$3 for each machine not heretofore reported and paid for, *held*, that the only question was as to how much was due from the licensee under his contract, that there was an adequate remedy at law, and a demurrer to the bill was sustained. *Crandell v. Plano Mfg. Co.*, 32 O. G., 1123.

§ 3951. Where A. manufactured a single machine protected by complainant's patent, and B., defendant, bought the machine and continued to use it in his mill for the purpose for which it was intended, and it appeared that the right of action against A. was barred by the statute of limitations, *held*, that the extent of the injury to complainant was the royalty or proper license for the use of the machine; that he had an adequate remedy by action at law, and that the bill for an injunction and accounting should be dismissed. *Smith v. Sands*, 32 O. G., 1467.

§ 3952. Where the object of a suit in chancery was to recover damages for an unlawful and fraudulent conspiracy to cheat complainant out of his interest in an original invention, the bill was dismissed, as complainant's remedy was at law. *Ambler v. Choteau*, 107 U. S., 586.

§ 3953. Where complainant made a contract, by which, if the other contracting party licensed another at a less fee than complainant had agreed to pay, there should be a reduction in favor of complainant by its very terms, and complainant averred in his bill that defendant had granted such a license and sought to have it construed by the court, *held*, that the rights of all parties were strictly legal rights, no construction could be had, no injunction granted, and that equity would not interfere. *Florence Sewing Machine Co. v. Singer Sewing Machine Co.*, 8 Blatch., 113.

§ 3954. Where a bill was filed to enjoin the infringement of a patent, and both parties were citizens of the same state, *held*, that the circuit court had no equity jurisdiction, except as between citizens of different states; that the remedy was confined to an action at law, and the injunction was refused. *Livingston v. Van Ingen*, 1 Paine, 45.

§ 3955. Where the defendant in a bill for infringement had deceased, and there was no prayer for discovery against his executor, nor proof of infringement by him, the title to relief by discovery and injunction was held to have failed, and, as incident to that, the right to an account also, and the bill was dismissed without costs. *Draper v. Hudson*, 1 Holmes, 208.

§ 3956. Where there is an adequate common law remedy, equity cannot take jurisdiction of a bill for profits arising from the use of a patent solely on the ground of constructive trusteeship. *Sayles v. Richmond, Fredericksburg & Potomac R. Co.*, 3 Hughes, 172.

See *Bill of Discovery*, §§ 604-606, 608. *Libel*, § 3985. *Royalty*, § 5887. *Sale*, 4916.

Jurisdiction — State, §§ 3957-3961.

§ 3957. Purchaser of particular machine, in matters of infringement thereof, is subject to state jurisdiction only. *Bloomer v. McQuewan*, 14 How., 539.

§ 3958. Where the controversy does not turn upon the patents, but upon the force and effect of some contract under or in reference to them, in which the question of their validity is not raised, state courts have jurisdiction, and the federal courts can assert none, unless conferred by the residence or citizenship of the parties. *Consolidated Fruit Jar Co. v. Whitney*, 2 B. & A., 30.

§ 3959. Where in a state court it was decreed against three of the defendants that certain patent licenses were fraudulent and void, *held*, that that court had no jurisdiction; that in an infringement suit in a federal court against the same complainants there, defendants were estopped from denying that the licenses were fraudulent and void, as were their privies by rights acquired after the decree. *Ibid.*

§ 3960. A state court has jurisdiction to declare the license and agreement to be void and inoperative for fraud or any other adequate reason; and the fact that in the investigation the state court will be obliged to inquire whether there was anything new in the patents which would operate as a consideration for the license and agreement cannot deprive it of jurisdiction. *Merserole v. Union Paper-Collar Co.*, 6 Blatch., 356.

§ 3961. Where on a suit in a state court upon a note, or under a license for a patent right, it is claimed that the patent is invalid, its validity becomes a subject within the jurisdiction of the court. *Ibid.*

201. JURY.

Jurors, §§ 3962-3964. *Instructions*, §§ 3965-3969. *Questions for*, §§ 3970-3976. *Generally*, §§ 3977, 3978.

§ 3962. It lies in the discretion of the court to withdraw a juror on the ground of surprise arising out of its rulings. *Foote v. Silsby*, 1 Blatch., 445.

§ 3963. A juryman taken sick may be discharged. *Ibid.*

§ 3964. If a juror is discharged in the progress of a trial, his place may be filled by another juror drawn for the purpose. *Silsby v. Foote*, 14 How., 218.

§ 3965. Duty of the court as regards instructions to jury. *Pitts v. Whitman*, 2 Story, 609.

§ 3966. When prayers for instructions are not granted, they are to be considered as refused. *Emerson v. Hogg*, 2 Blatch., 1.

§ 3967. The court need not instruct the jury on points not arising in the case. General principles stated. *Allen v. Blunt*, 2 W. & M., 121.

§ 3968. Where conflict of evidence is great, it is error for a court to instruct the jury to find for defendant. *Klein v. Russell*, 19 Wall., 433.

§ 3969. Evidence given tending to prove disputed facts does not authorize a court to instruct a jury that they had been proved. Such instruction is an invasion of the province of the jury. *Burdell v. Denig*, 2 Otto, 617.

§ 3970. Questions for jury in infringement suits. *Battin v. Taggart*, 17 How., 74.

§ 3971. Jury estimates single damages, which the court trebles (act 1793). *Whittemore v. Cutter*, 1 Gall., 478.

§ 3972. Where the witnesses differed as to the identity or diversity of the principles of the machines, but agreed on the precise differences and agreements in fact, *held*, that it remained for the jury to find if these differences were substantial or formal. *Barrett v. Hall*, 1 Mason, 447.

§ 3973. It is a question for the jury whether delay in patenting an invention and acquiescence in its use prior thereto do not constitute an abandonment. *Morris v. Huntington*, 1 Paine, 348.

§ 3974. The question as to the continuity of an application for patent is a question of fact for a jury. *Howe v. Newton*, 2 Fish., 531; *Godfrey v. Eames*, 1 Wall., 317.

§ 3975. Questions that should be properly left to the jury. *French v. Foley*, 11 Fed. Rep., 801.

§ 3976. Where the evidence rested almost wholly in parol, and there was enough on either side to well warrant a finding that way if there had been none on the other, and the determination of the question depended upon the credibility of the witnesses, *held*, that that question was within the peculiar province of the jury, and unless it appears that they did not consider the question fairly and decide it according to their best judgment, the court has no disposition or authority to review their work. *Milligan v. Lalancé & Grosjean Manufacturing Co.*, 21 Fed. Rep., 570.

§ 3977. Where a jury has disagreed and been discharged, the case cannot be tried by another jury from the same panel except by consent. There must be a new *venire*. *Wilson v. Barnum*, 1 Wall. Jr., 347.

§ 3978. Issues of fact in a civil cause in the circuit court may be tried and determined by the jury whenever the parties or their attorneys of record file with the clerk a stipulation in writing consenting to that mode of trial. *Judson v. Bradford*, 16 O. G., 171.

See *Application*, § 336. *Composition of Matter*, § 1122. *Construction of Patents*, §§ 1146-1151. *Reissues*, §§ 5491, 5492.

202. KNOWLEDGE AND USE.

See USE, KNOWLEDGE AND.

203. LACHES.

See DELAY.

204. LATER PATENT OF TWO PATENTS, PRESUMPTION AS TO.

See PATENTS, PRESUMPTION AS TO SUBSEQUENT PATENT OF TWO PATENTS.

205. LEGAL REPRESENTATIVE.

See ADMINISTRATOR, §§ 152-155. EXECUTOR, §§ 2368-2370. ASSIGNEE, §§ 548-571. PARTIES, § 4508.

§ 3979. "Legal representatives" includes assignees as well as executors and administrators in its terms, under the particular circumstances. *Hamilton v. Kingsbury*, 15 Blatch., 64.

§ 3980. "Legal representatives," in the patent act (§ 4884, R. S.), means executors or administrators. *Shaw Relief Valve Co. v. The City of New Bedford*, 19 Fed. Rep., 753.

§ 3981. The interest of patentee, on his death, passes to personal representatives in the state of domicile, and it so remains until properly assigned; and, until so assigned, all suits must be brought in the name of the administratrix, and next of kin have no title or interest in the patent, and cannot be made parties to suit on the patent; and it is not necessary that the administratrix should take out letters in the state where suit is brought. *Hodge v. Iron Mountain R. R.*, 1 Dill., 104.

See *Bill, of Revivor*, §§ 618-622.

206. LIBEL.

§ 3982. Where, in connection with the infringement of plaintiff's patent, defendants have made disparaging publications denouncing it, damages for the latter may also be allowed. *McCormick v. Seymour*, 2 Blatch., 240.

§ 3983. A bill to prevent the publication of a libel injurious to the plaintiff's business can only be maintained where the publication is malicious and intended to injure plaintiff. *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.*, 13 Blatch., 375.

§ 3984. In action for damages for libel, where defendant, in his answer, omits to deny the amount of damages alleged by plaintiff, as also the statement on which they are based, he will be allowed to amend his answer by making such denial. *Goodyear Dental Vulcanite Co. v. White*, 17 Blatch., 5.

§ 3985. Where suit was brought for certain threats of suits for infringement made, and written representations by defendant that the orator infringed his patent, etc., sent by defendant to dealers in the patented device, and injunction was prayed by the orator, *held*, that courts of equity have no jurisdiction of libel or slander affecting property rights, unless threatened or apprehended repetition makes it necessary; there being no such fear or threats of repetition, the bill was dismissed. *Palmer v. Travers*, 20 Fed. Rep., 501.

207. LICENSE.

License — Apportionment of — *Not apportionable*, §§ 3986-3989.

§ 3986. Apportionment of license. Rule stated. *Brooks v. Byam*, 2 Story, 525.

§ 3987. A mere license is not apportionable so as to permit the licensee to grant to others separate rights to use or work the patent, by subdividing the rights that may have been granted to himself. *Consolidated Fruit Jar Co. v. Whitney*, 1 B. & A., 356.

§ 3988. Where A. licensed B. to make and sell the patented article in a certain territory, and subsequently assigned the legal title to C., complainant, *held*, that an attempted apportionment by B. of the license granted him was void as against C., even if C. held the title subject to A.'s licenses; and a motion to modify an injunction based on such apportioned license from B. was refused. *Ibid.*

§ 3989. A right granted to grantee and six persons to be employed by him construed to be a license, and an entirety not assignable in severalty apportioned among different persons. *Brooks v. Byam*, 2 Story, 525.

See *Sale*, § 5923.

License — *Personal*, §§ 3990-3999. *Transferable*, §§ 4000-4003.

§ 3990. A license "to manufacture" at a certain place is a personal license not transferable. *Searls v. Bouton*, 12 Fed. Rep., 140.

§ 3991. A license to use a patented invention by one at his own establishment, with restrictions not to dispose of the license to others, does not authorize its use in an establishment owned by such person together with others. *Rubber Co. v. Goodyear*, 9 Wall., 788.

§ 3992. An authority conferred upon a party to make or construct the thing patented, without mentioning assigns, confers only a personal right upon the licensee and is not transmissible to any other person. *Baldwin v. Silsby*, 1 Cliff., 150.

§ 3993. A license by a patentee to use his invention is personal to the licensee, and not transferable to a third party. *Eclipse Windmill Co. v. Woodmanse Windmill Co.*, 32 O. G., 1605.

§ 3994. A license will not carry the right to any one but the licensee personally, unless there are express words to show an intent to extend the right to an executor, administrator or assignee, voluntary or involuntary. *Oliver, Finnie & Co. v. Rumford Chemical Works*, 109 U. S., 75.

§ 3995. A license to one to use a patented invention in his own proper business does not authorize one to grant a sub-license and collect royalties thereunder. *Putnam v. Hollender*, 19 Blatch., 49.

§ 3996. In the absence of affirmative authority expressly given by the license, to dispose of the license to others, and to allow it to be availed of by others, it must be read as if it forbade a disposition of it to others. *Ibid.*

§ 3997. Where a party was possessed of a shop-right only, a personal license, *held*, that it was not assignable, and gave him no right to authorize others to use the process, except in the manner expressly stipulated. *Gibbs v. Hoefner*, 19 Fed. Rep., 323.

§ 3998. Where plaintiffs conveyed to certain copartners the right to construct and use two of their patented devices, and defendant was appointed receiver by the court to the firm, to use all its machinery, including the patented devices, *held*, that it was a personal license to the firm, and that defendant could not continue to use. *Curran v. Craig*, 22 Fed. Rep., 101.

§ 3999. The grant of "the right, license and privilege to manufacture" a device "with the said patented invention attached thereto," and the right not to be transferred to others, but "exercised solely and only by the licensees" or their workmen "in their own manufactory," and forbidding the disposal of any part or parts of the device "with, or fitted, or adapted for, the said invention, "otherwise than in a finished state," does not prohibit licensees from having the patented fixture made wherever it can be manufactured, or sending them elsewhere to be finished; but does prohibit dealing in it as an article of manufacture. *Wood v. Wells*, 6 Fish., 382.

§ 4000. Certain licenses construed, and held to be transmissible by succession to a corporation formed of a union of the two licensees, and succeeding to the rights, duties and obligations of both. *Lightner v. Boston & Albany R. Co.*, 1 Low., 338.

§ 4001. Where a license to manufacture was granted to a firm, without setting out the individual names of the partners, and contained no limitation of time or place, but only of quantity, *held*, that on dissolution of the firm and assignment of interest by one partner to the other, who continued to work under the license, that the license was not a personal privilege, but transferable. *Belding v. Turner*, 8 Blatch., 321.

§ 4002. Where the license reserved no royalty to the owner of the patent, and granted the right, not only to the persons named as parties of the second part, but also to their executors, administrators and assigns, it was held assignable. *Adams v. Howard*, 22 Fed. Rep., 656.

§ 4003. *Held*, further, that it was apportionable, and a transfer of the entire interest of one of the licensees sustained. *Ibid.*

License — Implied.

SUMMARY (*McCLURG v. KINGSLAND*, §§ 4004-4008) — *Powers of congress in respect to patents*, § 4004.— *Statutes 1793, 1800, 1836, construed*, § 4005.— *Abandonment*, § 4006.— *Constructive license*, § 4007.— *Act 1839*, § 4008.

McCLURG v. KINGSLAND.

(1 Howard, 202-211. 1843.)

ERROR to U. S. Circuit Court, Western District of Pennsylvania.

Opinion by MR. JUSTICE BALDWIN.

STATEMENT OF FACTS.— This case comes here on a writ of error to the circuit court for the western district of Pennsylvania, in an action brought by the plaintiffs, assignees of James Harley, against the defendants, for the infringement of a patent granted to Harley for an improvement in the mode of casting chilled rollers and other metallic cylinders and cones, in which judgment was rendered for the defendants. On the trial it appeared in evidence that it had long been a desideratum to find out some mode by which iron rollers or cylinders could be so cast that when the metal was introduced into the mould it should cause a swyrl or rotatory motion, by which the slag or dross

would be thrown into the center instead of the surface of the cylinder. By the old mode the metal was conveyed from the furnace to the mould through a gate or pipe, placed in a horizontal or perpendicular direction. The mode alleged to have been invented by Harley is thus described in the specification annexed to the patent: "The tube or tubes, or passages, called gates, through which the metal to be conveyed into the moulds shall not enter the mould perpendicularly at the bottom, but slanting, or in a direction approaching to a tangent of the cylinder, or if the gates enter the moulds horizontally or nearly so, shall not enter in the direction of the axis of the cylinder, but in a tangent form, or inclining towards a tangent of the cylinder."

This was the thing patented, consisting solely in changing the direction of the tube which conveyed the metal to the mould from a horizontal or perpendicular position to an angular one. It produced the desired effect, and was highly useful. The novelty of the invention was much contested at the trial, but as the case turned on other points that became an immaterial question; as the case comes before us on exceptions to the charge of the court, which assumed that Harley was the original and true inventor of the improvement, and put the case to the jury on the following facts, which were in full proof, in no wise contradicted, and admitted to be true:

That Harley was employed by the defendants at their foundry in Pittsburgh, receiving wages from them by the week. While so employed he claimed to have invented the improvement patented, and after several unsuccessful experiments made a successful one in October, 1834. The experiments were made in the defendants' foundry, and wholly at their expense, while Harley was receiving his wages, which were increased on account of the useful result. Harley continued in their employment on wages until January or February, 1835, during all which time he made rollers for them. He often spoke about procuring a patent, and prepared more than one set of papers for the purpose; made his application the 17th February, 1835, for a patent; it was granted on the 3d of March, assigned to the plaintiffs on the 16th of March, pursuant to an agreement made in January.

While Harley continued in the defendants' employment, he proposed that they should take out a patent, and purchase his right, which they declined; he made no demand on them for any compensation for using his improvement, nor gave them any notice not to use it, till, on some misunderstanding on another subject, he gave them such notice, about the time of his leaving their foundry, and after making the agreement with the plaintiffs, who owned a foundry in Pittsburgh, for an assignment to them of his right. The defendants continuing to make rollers on Harley's plan, the present action was brought in October, 1835, without any previous notice by them. The court left it to the jury to decide what the facts of the case were; but if they were as testified, charged that they would fully justify the presumption of a license, a special privilege, or grant to the defendants to use the invention; that the facts amounted to "a consent and allowance of such use," and show such a consideration as would support an express license or grant, or call for the presumption of one to meet the justice of the case, by exempting them from liability; having equal effect with a license, and giving the defendants a right to the continued use of the invention. The court also charged the jury that the facts of the case which were not controverted brought it within the provisions of the seventh section of the act of 1839, by the unmolested, notorious use of the invention before the application for a patent by Harley, and that

nothing had been shown by the plaintiffs to counteract the effect of this prior use. That as assignees of Harley, the plaintiffs stand in his place, as to right and responsibility; they took the assignment of the patent subject to the legal consequences of his previous acts, and connecting these with the absence of an assertion of a right adverse to the defendants' use till this suit was brought, protected the defendants from liability for any damages therefor.

§ 4004. *Congress has plenary power over patents; it can modify patents at pleasure, subject only to existing rights of property.*

The exceptions to the charge were confined to these two points, which constitute the only subject for our consideration. Whether these exceptions are well taken or not must depend on the law as it stood at the emanation of the patent, together with such changes as have been since made; for though they may be retrospective in their operation, that is not a sound objection to their validity; the power of congress to legislate upon the subject of patents is plenary by the terms of the constitution, and as there are no restraints on its exercise, there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents.

§ 4005. *Acts 1793, 1800, 1836, "abandonment," "constructive license," construed.*

When the patent to Harley was granted, and this suit brought, the acts of 1793 (1 Stats. at Large 383), and 1800 (2 Stats. at Large, 37) were the tests of its validity; but the twenty-first section of the act of 1836 (5 Stats. at Large, 117) repealed all existing laws on the subject of patents, with a proviso that all suits brought before may be prosecuted in the same manner as if that act had not been passed, "excepting and saving the application to any such action of the provision of the fourteenth and fifteenth sections of this act, so far as they may be applicable thereto." This repeal, however, can have no effect to impair the right of property then existing in a patentee, or his assignee, according to the well-established principles of this court in 8 Wheat., 493; the patent must, therefore, stand as if the acts of 1793 and 1800 remained in force; in other respects, the fourteenth and fifteenth sections of the act of 1836 prescribe the rules which must govern on the trial of actions for the violation of patented rights, whether granted before or after its passage.

§ 4006. *A patentee may forfeit his patent by permitting others to use the invention before it is patented.*

In *Pennock v. Dialogue* this court held, in 1829: "That if an inventor makes his discovery public, looks on, and permits others freely to use it, without objection or assertion of claim to the invention, of which the public might take notice, he abandons the inchoate right to the exclusive use of the invention, to which a patent would have entitled him, had it been applied for before such use, and that it makes no difference in the principle that the article so publicly used, and afterwards patented, was made by a particular individual who did so by the private permission of the inventor." 2 Pet., 14, 15; S. P., *Grant v. Raymond*, 6 Pet., 248, 249; *Shaw v. Cooper*, 7 Pet., 313-323.

On this construction of the acts of 1793 and 1800, Harley's patent would have been void on the evidence in this case. Such seems to have been the sense of congress, as expressed in the act of 1832 (4 Stats. at Large, 559), which authorized the issuing a new patent when an original one was invalid by accident, inadvertence, or mistake, and without any fraudulent intent, by reason of the terms of the third section of the act of 1793 not having been complied

with: "Provided, however, that such new patent so granted shall in all respects be liable to the same matters of objection and defense as any original patent granted under the said first-mentioned act. That no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be free public use thereof, shall in any manner prejudice the right of recovery for any use or violation of his invention after the grant of such new patent, as aforesaid." 4 Story, 2301.

This act is an affirmance of the principles laid down by this court in the three cases before referred to; and as the exception to the proviso is limited to a use of the invention under a special license of the inventor after the grant of the original patent, it leaves the use prior to the application for such patent clearly obnoxious to the principle established in 2 Pet., 14, 15, whereby the patent would become void.

§ 4007. *Where the invention, prior to patenting, has been used by employers of patentee with his full acquiescence, a license or grant from patentee of the right to its continued use subsequent to patenting may be presumed.*

The same conclusion follows from the fifteenth section of the act of 1836, which declares that if the thing patented "had been in public use, or on sale, with the consent and allowance of the patentee, before the application for a patent," judgment shall be rendered for the defendant, with costs. 4 Story, 2511. The case before us is one of this description; the defendants use the invention of Harley for four months before his application for a patent; this use was public, and not only with his express consent and allowance, but he himself made the rollers on the plan he invented during those months, from the time when he had ascertained the utility of his invention.

It would, therefore, be no strained if not the fair construction of this act, if, under such and the other circumstances in evidence in the cause, the court had charged the jury that, if they believed the witnesses, the patent subsequently obtained was void. The circuit court, however, did not go so far; they held that the defendants might continue to use the invention, without saying that the public might use it, without liability to the plaintiffs, in which we think there was no error in their direction to the jury; that they might presume a license or grant from Harley, or on the legal effect of the uncontroverted evidence as to the right of recovery by the plaintiffs, or on the construction of the acts of 1793, 1800, 1832 and 1836.

§ 4008. *Construction of act 1839, chapter 7, "constructive license," "abandonment."*

The remaining exception is to the charge of the court below on the effect of the seventh section of the act of 1839, which is in these words: "That every person or corporation who has, or shall have, purchased or constructed any newly-invented machine, manufacture or composition of matter, prior to the application by the inventor or discoverer of a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture or composition of matter, so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held invalid by reason of such purchase, sale or use, prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale or prior use has been for more than two years prior to such application for a patent." Pamphlet Laws, 1839, 74, 75.

The object of this provision is evidently twofold; first, to protect the person who has used the thing patented, by having purchased, constructed or made the machine, etc., to which the invention is applied, from any liability to the patentee or his assignee. Second, to protect the rights granted to the patentee against any infringement by any other persons. This relieved him from the effects of former laws and their constructions by this court, unless in case of an abandonment of the invention, or a continued prior use for more than two years before the application for a patent, while it puts the person who has had such prior use on the same footing as if he had a special license from the inventor to use his invention, which, if given before the application for a patent, would justify the continued use after it issued without liability.

At the trial below, and here, the plaintiff's counsel have contended that this act cannot apply to the present case, inasmuch as the protection it affords to the person who had the prior use is confined to the specific machine, etc., and does not extend to such use of the invention, or thing patented, if it does not consist of a machine, etc., as contradistinguished from the new mode or manner in which an old machine or its parts operates, so as to produce the desired effect; but we think that the law does not admit of such construction, whether we look at its words or its manifest objects, when taken in connection with former laws, and the decisions of this court in analogous cases.

The words "such invention" must be referred back to the preceding part of the sentence, in order to ascertain the subject-matter to which it relates, which is none other than the newly-invented machine, manufacture or composition of matter, constituting the thing patented; otherwise these words become senseless when the invention is not strictly of a machine, etc. Now, in the present case, we find the invention consists solely in the angular direction given to the tube through which the metal is conducted into the cylinder in which the roller is cast. Every part of the machinery is old, the roller itself is no part of the invention, and cannot be the machine, manufacture or composition of matter contemplated by congress, nor can the word "specific" have any practical effect unless it is applied to the thing patented, whatever it may be, without making a distinction between a machine, etc., and the mode of producing a useful result by the mere direction given to one of the parts of an old machine. Such a construction is not justified by the language of the law, and would defeat both of its objects. If it does not embrace the case before us, the consequence would be that the use of the invention, under the circumstances in evidence, would, according to the decision in 2 Pet., 14, 15, invalidate the patent; for if the act operates to save the avoidance of the patent, it must, of consequence, protect the person who uses the invention before the application for a patent. Both objects must be effected, or both must fail, as both parts of the act refer to the same thing, and the same state of things, as affecting the person using the newly-invented machine, or the thing patented, as well as the inventor. Had the words "invention," or "thing patented," been used instead of machine, etc., there could have been no room for doubt of the application of the act to the present case; and by referring to the phraseology of the different acts of congress denoting the invention, it is apparent that, though there is a difference in the words used, there is none as to their meaning or reference to the same thing. Thus we find, in the fourteenth section of the act of 1836, relating to suits for using "the thing whereof the exclusive right is secured by any patent," in the fifteenth, "his invention, his discovery, the thing patented," "that which was in fact invented or discovered,"

“the invention or discovery for which the patent issued,” “that of which he was the first inventor.” In the first section of the act of 1837 (5 Stats. at Large, 191), “any patent for any invention, discovery or improvement,” “inventions and discoveries;” in the second section, “the invention;” in the third, “invention or discovery;” in the fourth, “patented inventions and improvements;” in the fifth, “the thing as originally invented.” 4 Story, 2510, 2511, 2546.

We, therefore, feel bound to take the words “newly-invented machine, manufacture, or composition of matter,” and “such invention,” in the act of 1839, to mean the “invention patented,” and the words “specific machine” to refer to “the thing as originally invented,” whereof the right is secured by patent, but not to any newly-invented improvement on a thing once patented. The use of the invention before an application for a patent must be the specific improvement then invented and used by the person who had purchased, constructed or used the machine to which the invention is applied; so construed, the objects of the act of 1839 are accomplished; a different construction would make it necessary to carry into all former laws the same literal exposition of the various terms used to express the same thing, and thereby changing the law according to every change of mere phraseology, make it a labyrinth of inextricable confusion.

We are, therefore, of opinion that there is no error in the charge of the court below, and that its judgment be affirmed.

License — Implied — Employer and employee, §§ 4009-4014.

§ 4009. Construction of complainant's patented article at defendant's expense, in his factory, and with complainant's consent, while in defendant's employ, operates as a special license to continue to use the specific devices made. *Magoun v. New England Glass Co.*, 3 B. & A., 114.

§ 4010. Where an employee, owner of a patented invention which he had developed and reduced to practice at his employer's expense, and had introduced into his employer's business without a special agreement, brought suit for injunction and accounting against the latter for infringement, *held*, that it constituted a license to the employer to use the particular patented devices, so made and introduced, so long as they would last. *Barry v. Crane Brothers Mfg. Co.*, 22 Fed. Rep., 396.

§ 4011. Where plaintiff, while a workman in an advanced position in defendant's factory, experimented at defendant's expense, succeeded, and incorporated his new devices in machines made under his superintendence in defendant's factory, and so continued for four months, *held*, that these facts were sufficient to justify a presumption of license to defendant to make and use complainant's invention, which presumption was still further strengthened by a written agreement between them, in which complainant was to make a large number of machines embodying the disputed device, with defendant's tools, etc., his labor and services being contracted for, and the additional machinery required being purchased from complainant by defendant on the completion of the contract. *Chabot v. American Button-Hole, etc., Co.*, 6 Fish., 71.

§ 4012. Where patentee was employed and paid by employers to make patentable improvements, which he patented, and on leaving their employ he conveyed his interest in the patent granted him during that time to others, who brought suit against his former employers, *held*, that the defendant employers had acquired an equitable, if not a legal, right to the improvements so made; *held*, further, that the transaction between patentee and defendant operated as a license to use and to sell the improvement. *Continental Windmill Co. v. Empire Windmill Co.*, 8 Blatch., 295.

§ 4013. An agreement that the employer was to have the exclusive benefit of the workman's services in making machinery and improvements in the employer's premises operates to license the use of machinery perfected and constructed, or in course of construction, during the term of service, although it had actually been invented and patented by the workman prior to such service. *Wilkens v. Spafford*, 13 O. G., 675.

§ 4014. An exclusive license for the use of certain patented machinery, invented and constructed during the term of service, results to an employer, where the workman agreed to give

the employer the exclusive benefit of his inventive faculties and of such inventions as he should make in a particular class of machinery during the period of employment. *Ibid.*

See *Contracts*, §§ 1313, 1314. *Employer and Employee*, §§ 2098-2109.

License — Implied — Particular cases, §§ 4015-4021.

§ 4015. Where a person took an assignment under an impression that a certain improvement upon the original invention was included in the patent, and he used such improvement with the consent and permission of the patentee, *held*, that he had an implied license from the patentee to continue the use of said improvement, which would discontinue upon the issuance of a patent to another inventor, and that he was an incompetent witness for his licensor in an interference proceeding. *Cressler v. Custer*, 1 MacA. Pat. Cases, 216.

§ 4016. When a patentee knowingly and for a considerable length of time acquiesced in the use of his patented machine by another, who had previously constructed and used the same by his permission, and actually and voluntarily accepted compensation for such use from the person in possession of the machine as part payment for such use, those acts of the patentee were evidence from which a license was inferred; and the only reservation being a right to additional payment for such use, *held*, that the use was not unlawful, and an injunction was refused. *Blanchard v. Sprague*, 1 Cliff., 288.

§ 4017. Under an agreement between the owners of several conflicting patents, by which each licensed the others to use his patented improvements to a certain extent, and a fund was provided for purchasing other patents deemed necessary for their mutual protection, and stipulating that such patents as should be subsequently acquired should become the joint property of the parties, a patent does not pass which had been previously purchased by one of the parties, and was subsequently assigned to the original inventors, and after having been extended was reassigned to the same party. *Aultman v. Holley*, 11 Blatch., 317.

§ 4018. Such an agreement would operate at most as a license to all the parties to use a patent owned by one of the individuals composing one of them; and he alone could maintain a suit at law upon it, and the others need not join. *Ibid.*

§ 4019. Where Stromberg sold to Miller a machine and the right to use the same, and Stromberg subsequently acquired an interest in the patent covering the machine, *held*, that such sale was a license to Miller to use the machine so far as Stromberg could grant a license. *Gottfried v. Miller*, 14 Otto, 521.

§ 4020. During the existence of a partnership between two persons one of them invented a machine upon which a patent was granted to him. The firm paid the fees and costs of procuring the patent and the expenses of an experimental trial of the invention, and also paid the expenses of some litigation which ensued. It appeared, however, that all the outlay by the firm was more than repaid by the benefits arising from the use of the invention in the partnership business. *Held*, that upon these facts no implied license arises to the member of the firm not the inventor to make, vend and use the patented machine after the dissolution of the partnership. *Keller v. Stolzenbach*, 20 Fed. Rep., 47.

§ 4021. Where plaintiff, as a member of the firm, and at the joint expense, made and altered certain machines to embody his subsequently patented inventions, and permitted their use by the firm, *held*, that under section 4899, Revised Statutes, the firm had a right to continue their use without liability. *Wade v. Metcalf*, 16 Fed. Rep., 130.

License — To make and sell, §§ 4022-4029. See *Infringement*, §§ 2906-2910.

§ 4022. A grant of "the exclusive right under said recited letters patent to manufacture and sell a certain hay-elevator," *held* not to be an assignment of an exclusive interest in the entire monopoly for the whole or any portion of the United States. It is a license only to manufacture and sell exclusively a specified form of hay-elevator, and the representatives of such an interest are not indispensable parties to a suit upon the patent. *Nellis v. Pennock Manufacturing Co.*, 22 O. G., 1131.

§ 4023. Where plaintiff assigned and released to defendant all his right, title and interest in certain letters patent so far as concerned the exclusive right of manufacturing and vending for seven years, conditioned on a certain weekly payment, and "that neither party should sell or use the patent-right without the written consent of the parties," it was construed to be a mere license with a limitation or condition as to its continuance; to which the doctrine of forfeiture in its strict sense does not apply. *Armstrong v. Hanlenbeck*, 3 N. Y. Leg. Obs., 43.

§ 4024. A grant of an exclusive right to make and sell the patented machine in a given territory with reservation to grantor of an unlimited right to vend machines in the same territory, *held* to be a license and not an assignment, and *held* that suit for infringement in such territory was properly brought by grantor under act 1836, section 17, as the "party aggrieved." *Hussey v. Whitely*, 1 Bond, 407.

§ 4025. A license to manufacture and sell a patented article is not an abandonment, but rather a positive assertion of rights of the patentee. *Jordan v. Dobson*, 2 Abb., 398.

§ 4026. An instrument conveying the exclusive right to manufacture and sell the patented article is a mere license, and does not authorize the licensee to maintain an action for damages against infringers who are not infringing the patent in those respects. *Hayward v. Andrews*, 106 U. S., 672.

§ 4027. The fact that the plaintiff sets out such a title with another title derived from a different source does not present such a case of alternative and inconsistent titles as is made one of the grounds for claiming a resort to equity. *Ibid.*

§ 4028. Where patentee, at date of filing his application, licensed defendants to manufacture and sell goods "under any patent that he may obtain by or through his application," held, that amended claims on which the patent was granted, which differed from those of the original application, were included in the terms of the license. *Kelly v. Porter*, 17 Fed. Rep., 519.

§ 4029. A conveyance of the right to make and sell a patent includes the right to the use of the thing patented. *Turnbull v. Weir Plow Co.*, 9 Biss., 334 (§§ 475-78).

See *Art, Lost*, § 389.

License — To use, §§ 4030-4041.

§ 4030. The plaintiffs were the owners of patents for improvements in metallic cotton-bale ties, each tie consisting of a buckle and a band. They granted no licenses to make the ties, but themselves made them and supplied the market. They stamped in the metal of the buckle the words "Licensed to use once only." The defendants bought as scrap-iron the buckles and bands at the cotton-mills after the bands had been severed to release the bale, and rolled and straightened the pieces of the bands, and riveted together their ends, and cut them into proper lengths for ties, and sold them, with the buckles, to be used as ties, nothing being done to the buckles. Held, that the defendants had infringed the patents. *American Cotton Tie Co. v. Simmons*, 106 U. S., 89 (§§ 5864-66).

§ 4031. The words "licensed to use once only," stamped upon each buckle, was notice to every one who handled it that there was attached to it a restriction in the shape of a license, and of a license to use only once. *The American Cotton Tie Supply Co. v. Bullard*, 17 Blatch., 160.

§ 4032. Although it was the custom to purchase without tare bales of cotton, whereby the bands and buckles were included in the transfer, such fact could not operate to defeat the express limitation imposed upon the use of the buckles, nor give to the transferee any better title than that obtained by the transferrer. *Ibid.*

§ 4033. The original license is fairly a license to have the buckle and the band confine a bale until the consumer needs to confine the bale no longer, and a license for no longer time. *Ibid.*

§ 4034. A license limiting the right to use a patented invention, only upon the payment of a specific sum on each machine upon which invention is used, will not include other machines where the same invention is used, unless the same is paid for in accordance with the terms of the license. *Wooster v. Seidenberg*, 13 Blatch., 88.

§ 4035. A license to use a patented invention "upon and about the locomotive engines used by said P. R. Co. on the P. Railroad, or any road or roads now owned or that may hereafter be owned or operated by said company," held, of the broadest signification and to embrace not only locomotives in use at the date of the license, upon roads then owned and operated by the company, but also such other engines as it might thereafter use, and other roads which it might thereafter operate. *Matthew v. Pennsylvania R. Co.*, 8 Fed. Rep., 45.

§ 4036. An exclusive right granted to a person to use an acid in a specified territory, purchasing the acid from licensor, and to use and sell therein the flour so made, all for the space of five years, is a mere license. *Oliver, Finnie & Co. v. Rumford Chemical Works*, 109 U. S., 75.

§ 4037. A conveyance of buildings, machinery, etc., "with rights to use" certain patented processes, for working which they might be adapted, is a license to use the processes in those buildings only, and not a general license. *Wetherill v. Passaic Zinc Co.*, 2 O. G., 471.

§ 4038. W., the assignee of the extended term of the patent, entered into an agreement in writing, under seal, with T. & W., which recited that T. & W. were "desirous of obtaining a license to use the improvement secured by said letters patent, to the extent of the use of binders necessary to their business," and which granted to them for a nominal sum, as a "personal privilege," and "for and in consideration of, and in case of, the due and faithful keeping and performing of each and all of the conditions," etc., the license, "to use the said improvement, to the said extent, for and during the space of one year," at their specified place of business, "and not longer, otherwise or elsewhere, without written permission of" W.; said agreement further providing that W. might revoke the license on the failure of T. & W. to

perform any of the conditions therein contained, "in which case this license and all rights and privileges hereunder shall forever cease and determine." After the expiration of the one year, T. & W. continued to use nineteen of the patented machines, claiming that they had them lawfully in use at the end of the first term of the patent, and that by virtue of section 67 of the act of July 8, 1870, they had a right to continue the use of them so long as they remained capable of use. On application for injunction to restrain such use, *held*, that, whatever rights, in respect to the further use of the patented machines, the defendants had when they took the license, they waived and surrendered by taking the license containing the conditions it did; and that, although the term of the license had expired, the defendants were bound and estopped by the recitals and covenants in it. *Wooster v. Taylor*, 12 Blatch., 384.

§ 4039. A license to use a patented machine for a number of years includes the right to manufacture a new one during the term, if the old one wears out; but the two machines cannot be worked together, and the license is assignable. *Woodworth v. Curtis*, 2 W. & M., 524.

§ 4040. A license authorizing defendant to run one machine, with a reference to two such machines owned by defendant, seemingly made with a view to give the right to use either, but not both at the same time, will always be construed to run a machine, unless in express terms it be limited to the identical machine referred to. *Wilson v. Stolley*, 4 McL., 275.

§ 4041. Under a license to use a patented machine, the grantee may manufacture the machine himself and use it according to license. *Woodworth v. Curtis*, 2 W. & M., 524.

License — To make, use and license, §§ 4042, 4043.

§ 4042. The right to make, use, and license to be used, a patent machine is a mere license, not an assignment, and does not authorize the licensee to sell such machine. *Hawley v. Mitchell*, 1 Holmes, 42.

§ 4043. Licenses to make and use the machine for the purposes for which it is constructed, when derived from the patentee, or of one holding a territorial right by virtue of a valid conveyance from him, are not required to be recorded and need not be in writing, and may be proved by parol evidence. *Baldwin v. Sibley*, 1 Cliff., 150.

License — To use and sell, §§ 4044, 4045.

§ 4044. A grant of "all the right, title and interest which I have to use or sell machines" in certain counties, construed to be a mere license and not necessary to be recorded under act 1836, in order to be a defense against subsequent *bona fide* purchasers without notice. *Farlington v. Gregory*, 4 Fish., 221.

§ 4045. A license "to use and sell" is sufficient to confer the right to dispose of the right to use to others. *Ibid.*

License — In respect to infringement, §§ 4046-4060. See *Infringement*, § 2901.

§ 4046. An agreement between an inventor and an infringer compromising their suit, and settling their claims "to this time," *held* not to be a license to use the patented device afterwards. *Troy Iron & Nail Factory v. Corning*, 14 How., 193.

§ 4047. A decree for nominal damages in a suit for the infringement of a patent against the manufacturer of infringing machines does not operate as a license to the manufacturer or his vendee as to all existing infringing machines made by the manufacturer. *Blake v. Greenwood Cemetery*, 16 Fed. Rep., 676.

See *Recovery*, §§ 5222-5237.

§ 4048. Where, for the whole period of infringement laid in the bill, the machine complained of was used by the respondent under the license or permission of complainant, it is of itself a complete answer to the prayer for relief. *Blanchard v. Sprague*, 1 Cliff., 288.

§ 4049. Stipulation in an expired license construed to be an agreement to grant an extension of the license, which the defendants might take or refuse; and where defendants continued the use of the improvement, but refused to take the license or to pay the additional patent fee as stipulated in the old license, *held*, that they were infringers. *England v. Thompson*, 3 Cliff., 271.

§ 4050. A license to a railroad company held to extend no further than to the road in use, and which the company was then authorized to construct at the time of granting the license. *Emigh v. Chicago, Burlington & Quincy R. Co.*, 1 Biss., 400.

§ 4051. Where the owner of the patent granted an assignment to B. conditioned on the payment by instalment of certain promissory notes, in default of which the assignment was to be void, and B., having failed to pay certain of them, reassigned the interest, *held*, that a license granted by B. prior to the reassignment was no defense to a suit for infringement brought by the original owner against B.'s licensee. *Abbett v. Zusi*, 5 B. & A., 38.

§ 4052. Where it was manifest that a written license to use the patented invention was contemplated by both parties which did not pass, but printed schedules of royalties and blanks for monthly returns were from time to time sent alleged licensee, who construed them as a license, and on that ground refused to sign a license sent him later, *held*, on suit brought for infringement, that there was no license which defendant could set up in a plea. *Tilghman v. Hartel*, 9 O. G., 886.

§ 4053. Where the license was for one machine only, it was held an infringement to use two machines, although both were never in operation at the same time. *Bloomer v. Gilpin*, 4 Fish., 50.

§ 4054. Where complainants had licensed large numbers of manufacturers to put a patented tremolo attachment upon their instruments, and had agreed to license all reputable makers who might apply, *held*, that one who simply made and sold the attachment could not be held as an infringer, unless it appeared that the sale was to an unlicensed manufacturer. *Saxe v. Hammond*, 1 Holmes, 456.

§ 4055. A license to the defendants to manufacture the article described in a certain patent held by them will not relieve from the charge of infringement where the device actually made differs somewhat from that set forth in the patent. *Miller's Falls Co. v. Ives & Co.*, 14 Blatch., 169.

§ 4056. Where a city advertised for bids to lay a patented pavement, and contracted with a party to lay it, and patentee's licensee licensed the contractor to lay the pavement, reserving the right to hold the city responsible, but failed to notify the city, *held*, that the relieving the contractor from liability released the city, and that the latter was not liable, notwithstanding the reservation in the license to the contractor. *Bigelow v. City of Louisville*, 3 Fish., 602.

§ 4057. Where plaintiff granted defendant a license conditioned as to its continuance on payments at fixed dates, *held*, that an action brought to recover arrears due was a reaffirmance of the license; *held*, also, that plaintiff could either terminate the license without losing his remedy for past dues, or prosecute and reassert its continuance. *Armstrong v. Hanlenbeck*, 3 N. Y. Leg. Obs., 43.

§ 4058. The mere fact that, in the course of business, the licensee has infringed the patent will not work a revocation of the license, and especially where the license covers a distinct, specific privilege, paid for one for all, and which conveys fixed and definite rights without further fee and consideration. *Wood v. Wells*, 6 Fish., 382.

§ 4059. When a license had been revoked by a plaintiff and a defendant is sued as a naked infringer, he is at liberty to avail himself of any defense ordinarily open to a defendant charged with infringement. *Wooster v. Singer Sewing Machine Co.*, 23 O. G., 2513.

§ 4060. A licensee cannot be treated as an infringer without showing a renunciation of the license; and where the license provides for notice from licensor, or even without notice required, mere failure to pay royalty is not such a renunciation; and where bill for injunction and account was filed against licensee for failure to pay royalties, *held*, that in the absence of the notice required by the license, the latter was still in force. *White v. Lee*, 3 Fed. Rep., 222.

License — Term (Duration), §§ 4061-4069.

§ 4061. An exclusive privilege of making and selling the patented article expires with the original term of the patent, unless it is otherwise stipulated. *Mitchell v. Hawley*, 16 Wall., 544.

§ 4062. The presumption of law in regard to every license under a patent is, that the parties deal only in regard to the term existing when the license is given, unless an express provision is inserted looking to a further interest. *Hodge v. Hudson River R. Co.*, 6 Blatch., 85.

§ 4063. License to use a patent held good under extended term. *Day v. Union India Rubber Co.*, 20 How., 216.

§ 4064. *Held*, that a license granted to continue "during the term for which said letters patent are or may be granted," did not cover the extended term. *Hodge v. Hudson River R. Co.*, 6 Blatch., 85.

§ 4065. A license construed as to the term of its duration, and how terminated. *Andrews v. Fielding*, 20 Fed. Rep., 123.

§ 4066. Where a license was granted under certain patents specifically named; and also under "all patents which the said party of the first part now has or may hereafter obtain," "until the expiration of all the letters patent which the lessees are hereby licensed to use," *held*, that the lease expired with the term of the youngest of the patents thus generally mentioned, and was not limited to the term of the youngest patent specifically named. *McKay v. Mace*, 23 Fed. Rep., 76.

§ 4067. Where a license was granted to continue "during the term of the application for a patent," and after patentee "shall have obtained a patent from the United States government as aforesaid," and the only provision made for its abrogation was in case the patent was not allowed, *held*, that having named these terms, it must be presumed that they covered all the contingencies contemplated by the parties upon which the contract should cease; that the license ran for the entire term, and that complainant had no right to revoke it. *Kelly v. Porter*, 17 Fed. Rep., 519.

§ 4068. Under license to use a given number of looms on payment of a certain royalty for the term of two patents "and for the additional term of any extension," etc., *held*, that on the expiration of one of the patents, no further royalty was due thereunder; as to the other extended patent the use was not such as to justify an injunction. *Lowell Mfg. Co. v. Hartford Carpet Co.*, 2 Fish., 472.

§ 4069. A license to use an invention "for the whole term of the patent, which may be granted," given before the issuing of the patent, does not authorize the use of it under an extension of the patent. *Wetherill v. Passaic Zinc Co.*, 2 O. G., 471.

See *Extension*, § 2512.

License — Forfeiture, §§ 4070-4072. *Estoppel*, §§ 4073, 4074. *Recording*, § 4075. *Rights under in general*, § 4076.

§ 4070. Failure to perform the conditions of a license does not forfeit it *ipso facto*. *Brooks v. Stolley*, 3 McL., 523.

§ 4071. Under a license with conditions, the licensee is bound to perform them, and a forfeiture of the license may be enforced according to its terms for the non-performance of the conditions. *Wilson v. Stolley*, 5 McL., 1.

§ 4072. If patentee's licensee neglects to pay his license price for a long time, and finally, when prosecuted, abandons the license, or, while relying upon it, defends also upon other grounds, the license will be forfeited, and he will be liable as an infringer. *Bell v. McCullough*, 1 Bond, 194.

§ 4073. License estops licensee from denying the validity of the patent. *Brooks v. Stolley*, 3 McL., 523.

§ 4074. The purchase of a license forms no bond of allegiance to the patentee, or an estoppel from averring and proving the invalidity of the patent, where the license is declared void by the licensor, and the licensee seeks its protection. *Burr v. Duryee*, 2 Fish., 275.

See *Estoppel*, §§ 2202-2212.

§ 4075. The unauthorized recording of a mere license, not being required by the act of congress, cannot affect the rights of any one. *Chambers v. Smith*, 5 Fish., 12.

§ 4076. If the complainant has refused to fulfil any of his obligations in matters of substance under the license, a court of equity will not interfere to assist him by compelling the defendants to observe the obligations upon their part. *Foster v. Goldschmidt*, 21 Fed. Rep., 70.

License — Defined, §§ 4077-4079. *Territorial limitations*, §§ 4080-4085. *State license*, § 4086.

§ 4077. A conveyance of less than the exclusive interest of the patentee in a specified territory, or an undivided portion of such interest, is a license and not an assignment. *Sanford v. Messer*, 1 Holmes, 149.

§ 4078. Any assignment of a patent, short of the entire and unqualified monopoly, is a mere license. *Theberath v. Celluloid Mfg. Co.*, 3 Fed. Rep., 143.

§ 4079. A license is a mere right to use the invention, and is neither an assignment or grant within the meaning of section 4928 of the statutes. *Wooster v. Seidenberg*, 13 Blatch., 88.

§ 4080. An assignment, authorizing the assignees to construct a single telegraph line between two points with conditions stated, *held*, not to empower assignees to restrain others from constructing a line between the same points, but by a different route. *Western Telegraph Co. v. Magnetic Telegraph Co.*, 21 How., 45; *Same v. Penniman*, 21 How., 460.

§ 4081. The mere fact that the agent of the patentee, after the transfer of the machine to the unlicensed territory, demanded of the purchasers the back royalties due upon it, conferred no right to use it outside the territory named in the license. *Wicke v. Kleinklecht*, 7 O. G., 1098.

§ 4082. A license exclusive within a limited territory as to all the privileges secured by the patent, with the single reservation of a right in the grantor to make the invention, fails *pro tanto* to be a conveyance of the *exclusive* right within the meaning of the law of 1836, providing for the record of such conveyances in the patent office. *Hamilton v. Kingsbury*, 17 Blatch., 264.

§ 4083. Not being *exclusive*, its record in the patent office is not such notice to purchasers that they can safely rely upon the record as showing the whole transaction between the parties to the instrument in respect to its subject-matter. *Ibid.*

§ 4084. Hence, certain unrecorded written agreements contemporaneous with the license, and like it not necessary to be placed of record, were held binding upon the assignees of the license, although they were *bona fide* purchasers without actual notice of any agreement between licensor and licensee other than the license itself. *Ibid.*

§ 4085. An agreement whereby the patentee granted to the complainant the sole and exclusive right to sell the patented articles within certain specified territory was not a transfer of an individual part of the whole patent or of the exclusive right of the whole patent for a particular territory. It is simply a license, and does not entitle the complainant to bring suit in his own name, the patentee not being a party to the suit. *Ingalls v. Tice*, 22 O. G., 2160.

§ 4086. A state may require the taking out of a license for the sale of a manufactured article, and the fact that the article is produced under a patent will not defeat this power. *Webber v. Virginia*, 103 U. S., 344.

License — Generally, §§ 4087-4096. See *Bill*, § 585. *Defense*, §§ 1834, 1850, 1851. *Extension* § 2452. *Grant*, §§ 2644-2647. *Injunction*, § 3374. *Jurisdiction*, §§ 3839-3847, 3855-3858, 3896, 3897. *Statute*, § 6168.

§ 4087. Where, in his contract with the defendant, the plaintiff agreed that he would sell no licenses for less than a certain price, and it conclusively appears that he has broken such agreement in a way calculated to injure the defendant, a preliminary injunction will be denied, notwithstanding the fact that the defendant has admittedly failed to pay his stipulated royalty. *Crowell v. Parmenter*, 18 O. G., 360.

§ 4088. Something having been acquired by reason of the license, even though the right was not exclusive, as was intended, there was not a failure of consideration. *Laver v. Dennett*, 25 O. G., 882.

§ 4089. Where there was no exclusive right given under a certain instrument, it was construed to be a license, and therefore not required to be recorded to give it complete validity. *Brooks v. Byam*, 2 Story, 525.

§ 4090. The surrender of a license by part of the licensees held not to avoid the license as to the remaining licensees. *Theberath v. Celluloid Mfg. Co.*, 3 Fed. Rep., 143.

§ 4091. A reservation in a license construed as rendering the license void, but as imposing an obligation on licensor to extend the pre-emption right of purchase to licensees, and in case of non-compliance with his agreement to render him liable in damages. *Goodyear v. Providence Rubber Co.*, 2 Cliff., 351.

§ 4092. Where a license was granted with obligation in favor of patentee attached, which obligation was also the consideration for the grant of the license, *held*, that unless licensee performed the obligation, an injunction would issue to restrain him from further use under the patent, and that his assignees, the defendants, took the license with the incumbrance attached, and could be enjoined by patentee for its non-performance. *Goodyear v. Congress Rubber Co.*, 3 Blatch., 449.

§ 4093. An exclusive licensee, under agreement to render an account within a time specified, failing to do so, the patentee granted an exclusive license to a third party, but subsequently accepted the tender made by the first licensee of the amount due, and continued to receive royalty from him. *Held*, that the time of the accounting was not of the essence of the agreement; that no harm had resulted to the patentee by reason of the delay; that no good reason for canceling the first agreement was shown, and that the second license was void. *Dare v. Boylston*, 18 Blatch., 548.

§ 4094. When on a first hearing of a case the master reported damages for a larger use of the patented invention than the defendants were guilty of, and the case was referred back to him with liberty to the complainant to reopen his proofs, *held*, it was proper for the master to report that the orator's license fee was for the privilege of using an invention precisely like that used by the defendants, for which this account of damages is being taken. *Wooster v. Simonson*, 20 Fed. Rep., 316.

§ 4095. Such licenses are not required to be in writing, neither is the amount of the fee required to be shown by writing. The whole may be shown by parol. *Ibid.*

§ 4096. The written contracts of license between the orator and others might be evidence between the orator and the defendants, but as this suit is not brought upon these licenses, and the defendants are not parties to them, they are not conclusive upon either the defendants or the orator as they would be upon the parties to them in suits between those parties upon them. *Ibid.*

209. LICENSE FEE AND ROYALTY AS MEASURE OF DAMAGES.

See DAMAGES, MEASURE OF, LICENSE FEE AND ROYALTY.

210. LICENSEE.

Licensee — Right to sue, §§ 4094-4110. See *License*, §§ 3986-4096. *Plea, in Bar*, §§ 4769-4771.

§ 4097. Where plaintiff had a license to use in the manufacture of a particular kind of goods the patented invention, *held*, that he had only an interest in a part of each patent, and was not entitled to sue in his own name under act 1836, sections 11 and 14. *Suydam v. Day*, 2 Blatch., 20.

§ 4098. An exclusive licensee,—where the license does not amount to an assignment, by reason of something reserved to the patentee—cannot maintain a bill in equity for infringement without joining the patentee; neither can the patentee without joining the licensee. *Hammond v. Hunt*, 4 B. & A., 111.

§ 4099. Licensees under a patent have no interest capable of affording the foundation of a suit in their name. *Grover & Baker Sewing Machine Co. v. Sloat*, 2 Fish., 112.

§ 4100. While a mere licensee cannot, in his own name, sue strangers who infringe, yet he would be permitted in a court of equity to bring suit against the patentee for the infringement of the rights secured to him by his license. *Littlefield v. Perry*, 21 Wall., 205 (§§ 529-47).

§ 4101. A party who at best is but a mere licensee cannot maintain an action for infringement in his own name. *Nelson v. McMann*, 16 Blatch., 139.

§ 4102. A mere license to make and use, without the right to grant to others to make and use, the thing patented, though exclusive, will not authorize the licensee to bring suit in his own name for infringement without joining the patentee. *Seem*, if the patentee refuses to join, a court of equity can give a remedy to the licensee. *Wilson v. Chickering*, 14 Fed. Rep., 917.

§ 4103. Where the transfer to the complainant was of a mere right to use and vend the invention for limited purposes in specified places, *held*, that it was a mere license, and that the bill should be amended by bringing in the legal owner as a party. *Gamewell Fire Alarm Telegraph Co. v. City of Brooklyn*, 22 O. G., 1978.

§ 4104. The exclusive licensee has, during the existence of the license, the right to restrain the manufacture or production by another of the patented article, though such manufacturer may claim the privilege under a subsequent license from the patentee. *Dare v. Boylston*, 18 Blatch., 548.

§ 4105. Where patentee sells to another a patented machine made by himself, or permits such other to make the machine, the party thus authorized becomes a licensee, with the right of using and selling the machine; but he has no interest in the patent, and he cannot authorize a third person to make the machine. *Baldwin v. Sibley*, 1 Cliff., 150.

§ 4106. The defendants claimed to be licensees under the patent by reason of a purchase from one of the inventors of a machine used by him; but it appearing that said machine was subsequently torn down and afterward rebuilt of substantially a new construction, it was held that the identity of the original machine was thereby destroyed, and the evidence did not disclose such facts as to show that the patentees had expressly or impliedly given to the defendants license or permission to use such machine. *Gottfried v. Phillip Best Brewing Co.*, 17 O. G., 675.

§ 4107. Where patentee has transferred the right to use his machine for a particular purpose, to the exclusion of other purposes to which it is applicable, suit for infringement is properly brought in the name of patentee, as the holder of such particular right is not such an assignee or grantee of an exclusive right under the act of 1836 as can sue in his own name. *Blanchard v. Eldridge*, 1 Wall. Jr., 337.

§ 4108. Where the legal owners of a patent granted a license to use, and covenanted to license no one else, and had an interest in the damages to be recovered, they were held to be necessary parties to an infringement suit. *North v. Kershaw*, 4 Blatch., 70.

§ 4109. A suit at law to protect the exclusive right of licensee to a patented process for a particular manufacture is properly brought in patentee's name, and cannot be discontinued by the nominal plaintiff, who may, however, claim indemnity against the costs of the suit. *Good-year v. Bishop*, 2 Fish., 96.

§ 4110. A transfer of a right to use a certain invention for only a specific purpose held a mere license; *held*, that the suit for infringement of the right should be brought in the name of the legal owner of the patent, and not in the name of the licensee. *Bogart v. Hinds*, 33 O. G., 1268.

See *Assignee*, § 535. *Grant*, § 2637. *Grantee*, § 2652.

Licensee—Infringer, §§ 4111-4115.

§ 4111. Licensees, if they fulfil the stipulations of their licenses, are entitled to practice the invention, within the terms and conditions of the instrument, to the extent of the authority conferred, without question or impediment by the owner of the patent; but if they refuse to perform on their part, deny the validity of the patent, and repudiate the license and the title of the licensor, he may have his remedy by suit upon the license, or he may elect to treat them thenceforth as infringers of his exclusive rights under the patent. Being infringers they cannot set up the license in defense of a suit any more than if they had never possessed any such authority. *Cohn v. National Rubber Co.*, 15 O. G., 829.

§ 4112. Where a licensee, who had agreed to pay royalties under certain patents, made an invention which he sold to his licensor, also taking a license thereunder, and agreed to continue the payment of the royalties, but did not, and suit was brought to restrain him from the use of the latter invention until payment of the royalties was made, *held*, that he had never parted with the right to use his invention, and could not be compelled to pay anything as a condition for enjoying it. *Washburn & Moen Mfg. Co. v. Wilson*, 19 Fed. Rep., 233.

§ 4113. A licensee who fails to comply with the conditions of the license may be enjoined as an infringer. *Morse v. O'Reilly*, 6 Penn. L. J., 501.

§ 4114. A licensee not having acquired a right to sell, and by the terms of the contract limited to make and use and to license others to use the patented machine up to a certain time, by an act of sale violates the contract and commits an infringement. *Hawley v. Mitchell*, 1 Holmes, 42.

§ 4115. A licensee is at liberty to contest the question whether the articles made by him embody the invention or any material part thereof, and a stipulation to the contrary in the contract is of no effect. *White v. Lee*, 14 Fed. Rep., 789.

211. LIMIT OF APPEAL FROM COMMISSIONER.

See APPEAL FROM COMMISSIONER, LIMIT OF.

212. MACHINE.

See PATENTABILITY, OF A MACHINE. PRINCIPLE, OF A MACHINE.

§ 4116. The word "machine" in the statute includes new combinations as well as new organizations of mechanism, and hence there may be a patent for new combinations of machinery to produce certain effects, whether the machines constituting the combination be new or old. *Wintermute v. Redington*, 1 Fish., 239.

§ 4117. The term "machine" includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. *Piper v. Brown*, 1 Holmes, 20.

§ 4118. The manner of using it does not characterize a machine. This is effected by its structure and capabilities. *Sewing Machine Co. v. Frame*, 24 Fed. Rep., 596.

See *Construction of Patents*, § 1228. *Evidence*, §§ 2283, 2284. *Identity*, §§ 2662, 2676-2709. *Invention*, §§ 3610, 3627-3629. *Patentability*, §§ 4585-4595. *Process*, § 5029. *Reissue*, §§ 5303, 5335. *Specification*, § 6022.

213. MANDAMUS.

See SECRETARY OF INTERIOR, § 5985.

§ 4119. Act 1836, section 16, provides for *mandamus* or injunction to compel the commissioner to issue a patent only in interferences where a patent has already issued to one of the parties. The word "authorize" must be rendered in the mandatory sense. *Mason v. Rowley*, 3 A. L. T. (U. S.) R., 8.

§ 4120. In that the fifty-second section supplies a remedy for a refusal of a patent by the commissioner in such cases, it is decisive against the remedy by *mandamus*; for this writ will not issue where the law furnishes any other adequate specific remedy. *Hull v. Commissioner of Patents*, 2 MacArth., 90.

§ 4121. An application for a patent was put in interference with a party to whom a patent had been previously issued. On the testimony in the interference case it was contended that the applicant had abandoned his invention to the public use, and the commissioner referred the question of such abandonment back to the primary examiner. And it was held that *man-*

damus would not lie to compel the commissioner to allow the patentee to take an appeal from the decision of such primary examiner to the board of examiners-in-chief. *Bigelow v. Commissioner of Patents*, 2 MacArth., 24.

§ 4122. A writ of *mandamus* will not be allowed against the commissioner of patents where the law submits the subject to his opinion. *Ibid.*

§ 4123. On a rehearing the doctrine is again affirmed that this court will not compel the commissioner of patents to issue a patent even in a case where the examiners-in-chief have rendered a decision in favor of the applicant. *Hull v. Commissioner of Patents*, 2 MacArth., 125.

§ 4124. Where, under acts 1836 and 1837, the commissioner examined and refused the application of assignee for reissue, *held*, that a *mandamus* should not issue to compel him to examine it, and that the remedy under the statute was by appeal from his decision. *Commissioner of Patents v. Whiteley*, 4 Wall., 523.

§ 4125. Where applicant does all in his power to make his application for patent effectual, the commissioner is bound to receive, and on failure to do so *mandamus* will lie. *Ibid.*

§ 4126. A *mandamus* cannot perform the functions of a writ of error. *Ibid.*

§ 4127. Whether, in an application for a *mandamus* to compel the issuance of letters patent for an invention, the secretary of the interior, and not the commissioner of patents, should be made the party respondent, *quære*. *United States ex rel. Koechlin v. Marble*, 22 O. G., 1365. See *Appeal*, §§ 273-276. *Bill, to Obtain Patent*, § 648. *Practice, in the Patent Office*, § 4928.

214. MANUFACTURE, ARTICLE OF.

See ARTICLE OF MANUFACTURE.

215. MARKING ARTICLES "PATENTED."

§ 4128. Act of 1842 authorized the infliction of a penalty of just \$100 for the offense of marking the word "patented" on an unpatented article, and no more, and that it may be recovered in an action of debt. *Stimpson v. Pond*, 2 Curt., 502.

§ 4129. Under act 1842, section 5, suit for marking articles patented must be brought in the name of the informer, and the penalty is not incurred unless the article is patentable. *United States v. Morris*, 2 Bond, 23.

§ 4130. To render a defendant liable under act 1842, section 5, marking articles patented, he must have used the marks knowing that he had no right to do so, and also with intent to deceive the public. *Walker v. Hawxhurst*, 5 Blatch., 494.

§ 4131. Intent to deceive the public under section 5, act 1842, must be proved to entitle plaintiff to recover. What may be evidence of such intent. *Nichols v. Newell*, 1 Fish., 647.

§ 4132. Intent to deceive the public is a necessary ingredient of the offense of marking articles patented. *Kass v. Hawlowetz*, 33 O. G., 1135.

§ 4133. Marking articles "patent" which are not patentable is within the prohibition of the third clause of section 4901, Revised Statutes, but it must also appear that the article was so falsely marked with intent to deceive the public. *Oliphant v. Salem Flouring Mills*, 5 Saw., 128.

§ 4134. In subdivision 2 of section 4901 the words "with intent to imitate or counterfeit the mark or device of the patentee" can only refer to the patentee of the article patented by such patentee. Hence it follows that if upon a patented article a stamp is put, not of the patentee of that article, but of some other patentee who never patented or claimed as his the article so stamped, such case is not within this subdivision. *French v. Foley*, 11 Fed. Rep., 801.

§ 4135. In an action for penalty under section 4901, Revised Statutes, for unlawfully marking "patent" upon an article, an intention on the part of the defendant to affix a stamp or plate indicating that there was at the time a present subsisting patent on the machine must appear, and where the patents thus stamped, and on the machine, had issued and expired, and therefore there was no subsisting patent upon the machine or on any part of it, the offense was held incomplete. *Wilson v. Singer Mfg. Co.*, 12 Fed. Rep., 57.

§ 4136. The mischief which the act of congress, prohibiting under severe penalties the marking of any article with the word "patented," or with words importing that the same is patented, was intended to prevent, was the deception of the public. *Wilson v. Singer Mfg. Co.*, 9 Biss., 173.

§ 4137. The law makes it the duty of the manufacturer of a patented article, during the time the patent is in force, to give notice to the public that the same is patented by fixing thereon the word "patented," with the day and year the patent was granted; and there is nothing in the spirit of the prohibitory statute which prevents the manufacturer from continu-

ing to affix the word and date after the expiration of the patent. The public is presumed to know the law, and that a patent issued in October, 1855, had expired on the 1st day of November, 1876; so that instead of being deceived the public is in fact informed that the article had been patented, but the patent has expired. This is the fair import of the words, and they do not make a case coming within the prohibition of the statute. *Ibid.*

§ 4138. Under third subdivision of section 4901, the offense is the act of marking an unpatented article with the word "patented," for the purpose of deceiving the public; such intent must accompany the act; but the act made penal is affixing the stamp, and suit for the penalty can be maintained only in the district where the act was done, and section 732 does not apply to suits under it. *Pentlarge v. Kirby*, 19 Fed. Rep., 501.

§ 4139. In an action to recover penalty under section 4901, Revised Statutes, the jury was instructed that the corporation defendant was responsible for the conduct of its superintendent, who had affixed the patented marks on the articles; and that if he honestly, though mistakenly, believed the articles to have been made under the patent marked thereon, he had no "purpose of deceiving the public," and the corporation was not liable. *Tompkins v. Butterfield*, 33 O. G., 758.

§ 4140. Under section 4901, Revised Statutes, plaintiff must prove beyond a reasonable doubt that the marks affixed to the article were for the purpose of deceiving the public. *Ibid.*

§ 4141. *Held*, that in an action brought under section 4901, Revised Statutes, to recover the penalty, it is not incumbent on plaintiff to prove his case beyond a reasonable doubt. The rule of evidence in such cases stated. *Hawlowetz v. Kass*, 33 O. G., 1499.

§ 4142. The burden of proof is upon the plaintiff to satisfy the jury beyond a reasonable doubt as to the offense committed. *Nichols v. Newell*, 1 Fish., 647.

§ 4143. A manufacturer has the right, and it is his duty, to mark his goods with his own patent mark; but this does not give him the right to put upon the goods any *indicia* showing that they are made under another man's patent, or a patent which he does not own or has no right to use. *Washburn & Moen Mfg. Co. v. Haish*, 9 Biss., 141.

§ 4144. It is no defense to an action for the recovery of a penalty under section 4901, that complainant fails to allege that the articles stamped were capable of being patented, unless, possibly, they were of such a nature that the public could not possibly be deceived by the mark "patented" put on them. *Winne v. Snow*, 19 Fed. Rep., 507.

§ 4145. Articles marked patented by an employee of a person carrying on a manufacture, and necessarily employing various persons, if done according to his direction or with his sanction, is in law his act. *Kass v. Hawlowetz*, 33 O. G., 1135.

§ 4146. *Held*, that in an action brought under section 4901, Revised Statutes, to recover the penalty, it was clearly the duty of the trial judge to construe and to determine the scope and effect of defendant's patent; *held* further, that in this case there was not the slightest room for doubt that defendant's patent did not cover the articles alleged to have been stamped, and that there was no question of fact upon this point which could have been properly submitted to the jury. *Hawlowetz v. Kass*, 33 O. G., 1499.

§ 4147. Where, in an action to recover a penalty for marking articles patented, and the patent of defendant was produced containing certain statements as to the state of the art, and also the claims, the jury was charged that it would be a serious question for them, how far a person coming into a court of justice is to be credited in intimating that he did not understand a matter seemingly so clearly stated in the patent, and honestly supposed the device marked to be covered by the patent. *Kass v. Hawlowetz*, 33 O. G., 1135.

§ 4148. Where, in suit for recovery of penalty under section 4901, defendant demurred for misjoinder of causes of action, one for penalty, and the other for damages to plaintiff's business, *held*, that the matter set up as special damages was unnecessary and irrelevant; but as it was not stated in the complaint as a separate cause of action, and no relief was prayed in reference to it, the demurrer was overruled. *Winne v. Snow*, 19 Fed. Rep., 507.

§ 4149. In actions based on section 4901, "marking articles patented," the citizenship of the parties is immaterial; the action must be brought within the district where the offense is committed. *Ibid.*

§ 4150. Where, in a suit for the recovery of the penalty under section 4901, Revised Statutes, plaintiff stated that he sued "for himself, as well as for the United States," a demurrer for misjoinder of parties plaintiff was not sustained. *Ibid.*

§ 4151. Allegation of patentability of article marked "patented," on suit to recover penalty under section 4901, Revised Statutes, is immaterial. *Oliphant v. Salem Flouring Mill*, 5 Saw., 128.

§ 4152. In an action to recover the penalty for marking articles patented, it is a question of law for the court, whether the articles stamped in the manner alleged were articles which the defendant was entitled to stamp in such manner. *Kass v. Hawlowetz*, 33 O. G., 1135.

§ 4153. Stamping articles "patented," done without the district, with the intent of bring-

ing the stamped articles within the district, and there sell them in fraud of the public, and such articles being accordingly brought and offered for sale within the district, is not an offense committed under section 4901, for which a penalty can be recovered in the district. *Pentlarge v. Kirby*, 19 Fed. Rep., 501.

See *Utility*, § 6668.

216. MARKING PATENTED ARTICLES.

§ 4154. Act 1861, section 13, the penalty imposed by the statute for a failure to mark patented articles, is only the taking away of the right to recover damages in the suit. It does not affect the right to an injunction, either perpetual or provisional, as a remedy. Doubted whether it applies to a suit in equity, or to any other suit, except an action on the case for damages brought under act 1836, section 14. *Goodyear v. Allyn*, 6 Blatch., 33.

§ 4155. The objection that the word "patented," with date, was not affixed to the article as required by act 1861, must be raised by the pleadings or it will be deemed waived. *Rubber Co. v. Goodyear*, 9 Wall., 788.

§ 4156. The burden of proof is on defendants to show failure of plaintiff to mark his patented articles "patented." *Goodyear v. Allyn*, 6 Blatch., 33.

§ 4157. Under act 1870, section 20, a patentee can recover nothing for infringements unless he shows that the patented articles were duly stamped as such, or that he had notified the defendant that he was infringing. *McComb v. Brodie*, 1 Woods, 153.

§ 4158. Where in suit for infringement defendant denied infringement, and set up plaintiff's failure to mark the patented product as required by law, *held*, that the character of the article (a bottle stopper fastener) was such as exacted the stamping by law, independent of pecuniary loss or gain to plaintiff, and that his failure to so mark them deprived him of recovering "damages," and the decree was issued for a perpetual injunction and actual profits. *Putnam v. Sudhoff*, 1 B. & A., 198.

§ 4159. Where defendants were themselves the persons who made and used the device, the defense that the device was not labeled or marked as patented under section 4900, Revised Statutes, does not apply. *Herring v. Gage*, 15 Blatch., 124.

§ 4160. Patentees are required to give "sufficient notice to the public" that the article is patented, "together with the day and year the patent was granted," by stamping or labeling the article. Where this has not been done it is a fair interpretation to hold that when any equivalent notice has been given the defendant has been "duly notified" within the meaning of section 4900, Revised Statutes. *New York Pharmaceutical Association v. Tilden*, 14 Fed. Rep., 740.

§ 4161. As the sufficient notice prescribed includes a specification of when the patent was granted, it is reasonable to conclude that any notice, verbal or written, that includes this information, will suffice. *Ibid*.

§ 4162. Where the patented article not being stamped, complainant notified defendants verbally that it was patented, and exhibited to defendants a copy of the patent and notified them that they infringed, it was held "sufficient notice" in compliance with section 4900, Revised Statutes. *Ibid*.

§ 4163. When it was difficult to stamp the patented article "patented" on account of its small size, but the packages containing such articles were stamped, it is held that the statute was sufficiently complied with. *Sessions v. Romadka*, 21 Fed. Rep., 124.

See *Damages and Profits*, § 1536. *Infringer*, § 2990.

217. MASTER'S REPORT.

Master's report — Exceptions to, §§ 4164-4174.

§ 4164. Where, on exceptions to master's report, based on correctness of master's finding as to damages, the case was not allowed to be returned to master, it appearing that the use could not be found with accuracy unless by aid of defendant's books, and plaintiff having had abundant opportunity to ask for an order for their production, and not having done so. *Fisher v. Hayes*, 16 Fed. Rep., 469.

§ 4165. The plaintiff filed exceptions to the master's report. The defendant insisted that the exceptions could not be heard because no written objections were filed to the draft reports. *Held*, that, as the certificate of the master shows that the respective counsel were notified that the draft reports were ready; that they appeared before him; that plaintiff's counsel verbally objected to certain findings, which verbal objections were substantially the same as the writ-

ten exceptions which have been filed, it will be sufficient if they are now reduced to writing and filed with the master *nunc pro tunc*. *Ibid*.

§ 4166. The exceptions to the master's report on extent of infringement and amount of damages declared to be well taken, it appearing that a narrower construction of the patent had been made by him than was warranted. *Ruggles v. Eddy*, 12 O. G., 716.

§ 4167. After defining the scope of the patent reference was again made to the master to ascertain infringement and damages, with leave to the parties litigant to introduce additional evidence because of the new construction placed upon the patent. *Ibid*.

§ 4168. An exception taken to the master's report upon the ground that plaintiff's device is one which can be used only by the postal service, which is wholly monopolized by the government, which could send letters without postmarking them, or could lessen the frequency of the mails, so that the postmarking could be done separately from the cancellation of the stamps by the old method without increase of clerical force, thus leaving the invention subject as to use and value entirely to the will of the postoffice department, so that the use of it in the postal service would not deprive the owner of any opportunity to have it used otherwise and could not damnify him, and that therefore no damage can be recovered in the case, and that no profits can be recovered because there is no party before the court or that can be brought before the court who has received any, *overruled*, it appearing that the postoffice department required the mails to be sent with certain frequency, and that the stamps should be canceled and the letters marked separately, and required that the defendant should do this either himself or by the employment of clerks to be paid by him out of the surplus revenues of his office. *Campbell v. James*, 18 Blatch., 92.

§ 4169. An exception to the master's report that the defendant might have used other forms of canceling stamps which would not have infringed, and that the saving by using plaintiff's invention instead of such other stamps would have been much less than that reported, *overruled*, it not appearing that any such other form was known to defendant, or that the use of the same would not also have been an infringement. *Ibid*.

§ 4170. An exception to the ruling of a master should always be taken on the spot. Practice as to taking such exceptions. *Troy Iron & Nail Factory v. Corning*, 6 Blatch., 328.

§ 4171. Exceptions to a master's report, to be available, should specifically point out wherein he has erred. *Turrill v. Illinois Central R. Co.*, 5 Biss., 344.

§ 4172. Upon exceptions to final report of master, questions foreclosed by the decree referring the case to the master will not be considered. *Whitney v. Mowry*, 4 Fish., 207.

§ 4173. Hypothetical findings of master outside of the case as referred to him on decree should not be in the record; and exceptions thereto will be sustained. *Ibid*.

§ 4174. An averment of parties that an injunction shall go and an account taken does not bind them not to object to the master's report, or to take an appeal from the order conferring it. *Livingston v. Woodworth*, 15 How., 546.

See *Damages and Profits*, §§ 1626, 1627. *Estoppel*, § 2193.

Master's report — Generally, §§ 4175-4186.

§ 4175. Upon a motion to recommit a master's report, it appearing that some of the matter desired to be shown was material, the motion was granted that the case should be so completed as to present the questions to be decided in all the aspects which might ultimately be found to be material, and further because to some material extent it appeared to be a test case. *McKay v. Jackman*, 17 Fed. Rep., 641.

§ 4176. Where an interlocutory decree was entered and a reference made to a master to report an account of profits and damages for infringement, and the chief deputy clerk of the court was appointed as master *pro hac vice* without assignment of special reason as required by act March 3, 1879 (20 Stat. at Large, 415), a motion to set aside his report refused, the appointment having been made with assent of both parties in open court, and the accounting proceeded with for several months after discovery that he was deputy clerk; but the decree was amended *nunc pro tunc* to set out their consent. *Fischer v. Hayes*, 22 Fed. Rep., 92.

§ 4177. The finding of a master as to the construction of infringing apparatus will not be set aside for error in fact, if it is founded on personal inspection made with the consent of the parties, as well as upon the evidence of others, which is not all reported. *Piper v. Brown*, 1 Holmes, 196.

§ 4178. The master's refusal to receive further evidence after having submitted to the counsel the draft of his report upon a hearing approved. *Ibid*.

§ 4179. Where on account for profits the case presented was one for apportionment, and there was nothing in the master's report on which to base it, the report was referred back to master to find the value of the article without as well as with the improved process. *Whitney v. Mowry*, 4 Fish., 141.

§ 4180. It being manifest from the master's report that in fixing the profit per ton he included profits due to cutting the hay and other improper profits, and no evidence having been offered separating the profits properly due to the patented invention, the report is set aside and leave given to apply to the master to be allowed, in his discretion, to give further proof as to profits and for a further report. *Faulks v. Kamp*, 10 Fed. Rep., 675.

§ 4181. A court has power to set aside the report of a master for any manifest error, either in law or fact, and to recommit it for further proceedings, or to correct it, if the means of correction are furnished. *Steam Stone Cutter Co. v. Windsor Mfg. Co.*, 17 Blatch., 24.

§ 4182. The master having reported that the defendants could not preserve fish in their apparatus as constructed without using the complainant's process, they thereupon altered the apparatus in that particular; but on their refusing to permit the master to inspect the chamber where they preserved fish afterward, he found them guilty of still infringing the patent, and his report to that effect was confirmed. *Piper v. Brown*, 1 Holmes, 186.

§ 4183. Under reference to a master to take account of "damages sustained" and of "gains, profits and advantages accrued to defendant," master was sustained in reporting a "compensation," although he also reported that plaintiff had suffered no damages, and no profits on the part of defendant were shown. *Sargent v. Yale Lock Mfg. Co.*, 17 Blatch., 249.

§ 4184. Where it does not appear from the master's report that there was evidence before him to sustain a charge which he has allowed, it will be stricken out. *American Nicholson Pavement Co. v. Elizabeth City*, 6 O. G., 764.

§ 4185. Master charged with the duty of computing and reporting the profits of respondents in infringement suit may examine the respondents, and, if necessary, inspect their books; but it is incumbent upon the complainant to furnish whatever additional proof may be necessary to enable the master to make the proper computation. *Brady v. Atlantic Works*, 15 O. G., 965.

§ 4186. An allowance to the respondents of charges for extra work and materials upon condition of their assignment of the charges to the complainant will, if the arrangement is an equitable one, be confirmed by the court. *Ibid.*

See *Practice*, §§ 4903, 4904.

218. MEASURE OF DAMAGES.

See DAMAGES, MEASURE OF.

219. MECHANICAL EQUIVALENT.

See EQUIVALENT, MECHANICAL.

220. MECHANICAL SKILL.

§ 4187. Mechanical skill is not patentable; patentee must add something to what was previously known or used. *Spaulding v. Tucker*, Deady, 649.

§ 4188. Mere mechanical skill can never rise to the sphere of invention. *Blandy v. Griffith*, 3 Fish., 609.

§ 4189. Mechanical adaptation not involving invention; instance of. *Decker v. Grote*, 10 Blatch., 331.

§ 4190. Those parts of a machine which the experience of a mechanic would suggest cannot be appropriated by a patent, though they are essential in producing the desired result. *Barry v. Gugenheim*, 1 O. G., 382.

§ 4191. To improve the efficient operation of the mechanism described in the patent (Reissue No. 1,682, May 31, 1864), by the simple exercise of mechanical skill, does not constitute invention. The patent is for a practical and useful invention, although the particular improvement is not suggested, and is infringed, notwithstanding the described mechanism is used only in connection with such improvement. *Marsh v. Seymour*, 7 Otto, 349.

See *Invention*, §§ 3542, 3543, 3611, 3615-3620, 3631. *Inventor*, §§ 3762-3772, 3784. *Patentability*, § 4557.

221. MESNE ASSIGNMENT.

See ASSIGNMENT, MESNE.

222. MISLEADING SPECIFICATION.

See SPECIFICATION, MISLEADING.

223. MISNOMER IN PATENT.

§ 4192. A misnomer in a patent of the christian name of one of the patentees does not invalidate it if it contains a description of him by which he can be identified. *N. W. Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 6 O. G., 34.

§ 4193. Where one of two patentees was described in the patent as a joint inventor with the other, and was identified as such, the patent was held valid, although his christian name was erroneously stated. *Ibid.*

See *Identity*, § 2719.

224. MISNOMER IN PLEADING.

§ 4194. Misnomer of complainant in equity suit must be objected to by demurrer or answer before trial. It cannot be raised in appellate court for the first time. *Livingston v. Woodworth*, 15 How., 546.

See *Decree*, § 1797.

225. MODE.

See ART, §§ 382-397. PROCESS, §§ 5028-5104.

§ 4195. "Mode," when referring to something permanent, means an engine or machine; when to something fugitive a "method," which may mean engine, contrivance, device, process, instrument, mode and manner of effecting the purpose. *Whitney v. Emmett*, 1 Bald., 303.

226. MODEL.

See CLAIMS, CONSTRUCTION OF, §§ 767, 768. CONSTRUCTION OF PATENTS, § 1206. COSTS, §§ 1397-1401. REDUCTION TO PRACTICE, §§ 5241-5247. REISSUES, §§ 5524-5537, 5690.

§ 4196. The model is as much a part of the patent as are the specification and drawings. *Hoffheims v. Brandt*, 3 Fish., 218.

§ 4197. A model is not such a practical working machine as will invalidate a subsequent patent. *Johnson v. McCulloch*, 4 Fish., 170.

§ 4198. The statute has not placed the lack of specimens among the defenses to a patent, and where the patent has been granted, it cannot fail for that reason. *Badische Anilin & Soda Fabrik v. Cochrane*, 16 Blatch., 155.

§ 4199. Features contained in the patent office model may be incorporated into the drawings and specifications of the letters patent upon reissue without prejudice. They do not constitute new matter in the sense of the law. *Reissner v. Anness*, 13 O. G., 870.

§ 4200. Where it appeared that the drawing of a patent had been changed at the time of the reissue thereof, and the complainant in a suit under the reissue had introduced a duplicate of the patent office model which conformed to the drawing of the reissue, *held*, that the defendant ought to be permitted to show the condition of the model at the time when it was filed in the patent office and at the date of the original patent. A motion to reopen a case for the introduction of such proofs, it being alleged that the testimony was newly discovered, was entertained at final hearing, and was allowed. *Johnsen v. Beard*, 8 O. G., 435.

§ 4201. Where the specification was uncertain, but the model, admittedly made after the pattern of the specification, operated in a certain way, *held*, that the plaintiffs must have the advantage of the fact in the decisions of the questions which depend upon it. *Miller's Falls Co. v. Backus*, 17 O. G., 852.

See *Abandonment*, § 44. *Application, Date of*, §§ 356, 357. *Evidence*, § 2296. *Priority of Invention*, §§ 5003, 5006.

227. MODIFICATION OF INJUNCTION.

See INJUNCTION, MODIFICATION OF.

228. MOTIONS.

See PRACTICE, MOTIONS. ANSWER, MOTION TO AMEND. INJUNCTION, VIOLATION OF, MOTION FOR ATTACHMENT FOR. DECREE, MOTION TO REVISE. MASTER'S REPORT.

229. MULTIFARIOUSNESS.

Multifariousness — *Held not*, §§ 4202-4213. *Held to be*, §§ 4214-4219.

§ 4202. Where complainant alleges infringement of two separate patents by the same device, and it appears to be so, the bill is not bad for multifariousness. *Gillespie v. Cummings*, 3 Saw., 259.

§ 4203. Where the right of both patents alleged to be infringed was assigned to complainant, one being to the Pacific coast and the other to the state of California, as the assignments covered the state of California, *held*, that the bill was not bad for multifariousness. *Ibid.*

§ 4204. A bill in equity on two patents, alleging the use of both in one apparatus of defendant, even if regarded as a joinder of two causes of action, is not open to demurrer in the absence of other circumstances. *Horman Patent Mfg. Co. v. Brooklyn City R. Co.*, 15 Blatch., 444.

§ 4205. When a suit embraces several patents the bill must allege that the various patents are connected with each other in each infringing machine. *Hayes v. Dayton*, 18 O. G., 1406.

§ 4206. It has never been held, as a general rule, that a bill is of course demurrable where there is a joinder of distinct claims between the same parties; nor is there any positive inflexible rule as to what, in the sense of the courts of equity, constitutes a fatal multifariousness on demurrer. A sound discretion is always exercised in determining whether the subject-matters of the suit are properly joined or not. *Ibid.*

§ 4207. A bill is multifarious when it improperly unites in one bill against one defendant several matters perfectly distinct and unconnected, or when it demands several matters of a distinct and independent nature against several defendants in the same bill. *Ibid.*

§ 4208. Where the bill set out three distinct patents, but alleged that all three inventions were used in the one infringing machine, and prayed discovery as to the number of machines containing all the inventions, it was held not bad for multifariousness, and a demurrer thereto was overruled. *Gamewell Fire Alarm Telegraph Co. v. City of Chilicothe*, 7 Fed. Rep., 351.

§ 4209. A bill for the infringement of several patents, which alleges that they are susceptible of conjoint use, and that defendant has used one or more of them in violation of the right, is not multifarious. *Shickle v. South St. Louis Foundry Co.*, 22 Fed. Rep., 105.

§ 4210. A bill alleging infringement of several patents for different inventions must aver that the inventions are capable of conjoint use, and are so used, else be liable to the objection of multifariousness. *Barney v. Peck*, 16 Fed. Rep., 314.

§ 4211. Where complainant in his bill alleged the infringement of four several patents for improvements in a reaping machine, which were capable of a connected use, and were thus connected by defendant, a demurrer on the ground of multifariousness was not sustained. *Nourse v. Allen*, 4 Blatch., 376.

§ 4212. Several patents may be included in the same suit when their subjects are correlative and the inventions claimed are embodied in the same infringing machine. Demurrer for this cause overruled. *Nellis v. Pennock Manufacturing Co.*, 22 O. G., 1131.

§ 4213. Where, on a motion to consolidate two infringement suits, each involving different patents, an objection that it would constitute a bill bad for multifariousness overruled, in view of complainant's allegation that all the mechanical devices alleged to be infringed were used in one of the defendant's machines, and the motion was allowed. *Deering v. Winona Harvester Works*, 24 Fed. Rep., 90.

§ 4214. Where the bill was founded on distinct patents, alleged to be infringed by the sale, etc., of skates, without its appearing that the several inventions could be embodied in one skate, the bill was held bad for multifariousness. *Barney v. Peck & Snyder*, 16 Fed. Rep., 413.

§ 4215. Where complainant failed to show in his bill that the two inventions sued upon were capable of conjoint use, or that they were so used by defendant, *semble* that the bill was bad for multifariousness. *Pope Mfg. Co. v. Marqua*, 15 Fed. Rep., 400.

§ 4216. Where the bill set forth separate and distinct letters patent as infringed, but showed no reason for uniting the separate and distinct causes of action in one suit against defendants, a demurrer to the bill for multifariousness was sustained. *Lilliendahl v. Detwiller*, 18 Fed. Rep., 176.

§ 4217. A bill alleging that six reissued patents have been infringed by the defendant, without stating that the patents are in fact, or are capable of being, used in making a single structure, or that they are connected with each other in any infringing machine, or to be used at the same time in any infringing machine, is bad for multifariousness. *Hayes v. Bickelhaupt*, 19 O. G., 177; *Hayes v. Dayton*, 18 O. G., 1406.

§ 4218. Where the several patents covered inventions which were capable of being used conjointly, and infringement of each and all was alleged, and which were made and sold as parts of the same electric lighting system, yet as the inventions could be used separately and operate independently with respect to each other, and any of them could be infringed without infringing the others, the bill was adjudged to be open to the objection of multifariousness. *Consolidated Electric Light Co. v. Brush-Swan Electric Light Co.*, 20 Fed. Rep., 502.

§ 4219. Where suit was brought under three different patents, and the bill charged defendants with construction of a device "in some parts thereof substantially the same as in the said several letters patent mentioned," and there was no explicit averment that the device contained all the improvements embraced in the patents, and the patented inventions were not necessarily embraced in the device complained of, the bill was held bad for multifariousness. *Nellis v. McLanahan*, 6 Fish., 286.

230. NEBULOUS CLAIM.

See CLAIM.

231. NEW MATTER.

See REISSUES, NEW MATTER.

232. NEW TRIAL.

New trial — *Rules governing*, §§ 4220-4222. *Damages*, §§ 4223-4228. *Disclaimer*, § 4229. *Evidence, effect of*, §§ 4230-4235. *Newly discovered evidence*, §§ 4236-4241. *Co-operation in infringement*, § 4242. *Waiver of notice*, § 4243.

§ 4220. Rules which govern the granting of a new trial to introduce newly discovered evidence. *Ready Roofing Co. v. Taylor*, 15 Blatch., 94.

§ 4221. The question of granting and refusing new trials, and the grounds therefor, considered by the court. *Allen v. Blunt*, 2 W. & M., 121.

§ 4222. If such a trial has not been had, the remedy is by rehearing or new trial, or some equivalent proceeding, in the tribunal where the first trial took place. The sound discretion of that tribunal must be invoked; and from its refusal to interfere there is no appeal. Discretion ought to be governed by the rules of law; and there is no better guide than the rules and principles applicable in courts of justice in cases of rehearings and new trials. The present case distinguished from *Matthews v. Wade*, 1 MacA. Pat. Cases, 143. *In re Rouse*, 1 MacA. Pat. Cases, 286.

§ 4223. Upon a motion for a new trial the finding of a jury upon a question of damages will not be disturbed, unless it is made clear that they have disregarded the law. *Whitney v. Emmett*, 1 Bald., 303.

§ 4224. The sum given in damages for the infringement of a patent must be plainly exorbitant to require the interference of the court and grant of a new trial. *Aiken v. Bemis*, 3 W. & M., 348.

§ 4225. Where damages found are excessive, a new trial does not necessarily follow, as plaintiff may remit the excess. *Russell v. Place*, 9 Blatch., 173.

§ 4226. Where the infringement was wilful, with full notice of patentee's claim, a new trial sought on the ground of excessive damages was refused. *Foote v. Silsby*, 1 Blatch., 445.

§ 4227. Where the error consisted in charging the jury that counsel fees should be estimated in the damages, but was not made a ground of application for the new trial, the motion was refused, as it was practicable for the court to do justice otherwise. *Stimpson v. The Railroads*, 1 Wall, Jr., 164.

§ 4228. Where but one machine having been sold, the court charged the jury to give but nominal damages, and, contrary to both charge and evidence, the jury found a large sum (\$500), the verdict was set aside, and a new trial granted. *Johnson v. Root*, 2 Cliff., 108.

§ 4229. Motion for opening a decree on account of an alleged change of issue made by the filing of a disclaimer by the patentee, denied where it appeared that the effect of the disclaimer

was merely to limit the claim of the patent and the issue, and where the parties had full opportunity to try, and diligently availed themselves of the opportunity to try, the question which would be open if the case should be again opened. *Coburn v. Schroeder*, 11 Fed. Rep., 425.

§ 4230. When evidence is given on both sides and the verdict is satisfactory to the court, no extended argument will be made by the court in disposing of a motion for a new trial. *Bray v. Hartshorn*, 1 Cliff., 538.

§ 4231. On a motion for a new trial the complainant might have had the evidence submitted to the jury, or the substance of it stated and made part of the record, and the court would have determined whether it had sufficient grounds for being satisfied with the conclusions of the jury. *Watt v. Starke*, 17 O. G., 1092.

§ 4232. To bring the matter before the chancellor on a motion for a new trial the party may have the proceedings and evidence reported with the verdict, or by moving the chancellor to send to the judge who tried the issue for his notes of trial, or by procuring a statement of the same in some other proper way. The evidence and proceedings then become a part of the record and go up to the court of appeal. *Ibid.*

§ 4233. A motion for a new trial, where a question of fact has been referred to a court of law for determination, must be made to the court of chancery, and for that purpose the party applying for a new trial must procure notes of the proceedings and of the evidence given at the trial for the use of the chancellor. *Ibid.*

§ 4234. A new trial will not be granted because of the refusal of the court to admit in evidence the record in a suit in equity in an action for damages between the same parties, where there was no judgment rendered on the merits, and the case was dismissed by plaintiff at his motion and upon his volition. *Allen v. Blunt*, 2 W. & M., 121.

§ 4235. In a rehearing or new trial of an interference, the depositions taken on the first trial may be used. *Carter v. Carter*, 1 MacA. Pat. Cases, 388.

§ 4236. A new trial will be allowed on newly discovered evidence which goes to the originality of a patent, not cumulative, not known before the trial. *Aiken v. Bemis*, 3 W. & M., 348.

§ 4237. A new trial will not be granted on newly discovered evidence if by due diligence it might have been produced in time for the first trial. *Washburn v. Gould*, 3 Story, 122.

§ 4238. A motion for a new trial on the ground of newly discovered evidence must be supported by the plainest proof of the sufficiency of such evidence to lead the court to a different result. *Buerk v. Imhaueser*, 10 O. G., 907.

§ 4239. A motion for a new trial on the ground of newly discovered evidence, in order to be allowed, must be supported by the plainest proof of the sufficiency of the newly offered evidence to lead the court to a different result. *Buerk v. Imhaeuser*, 14 Blatch., 19.

§ 4240. Motion to have a decree opened and leave granted to put further defenses to the patent denied where it appeared that the new evidence would not affect the result. *Coburn v. Schroeder*, 11 Fed. Rep., 425.

§ 4241. In applications for a new trial on newly discovered evidence, the evidence offered should of itself be such as to make it probable that its introduction would change the result. Application denied when there was a doubt as to the materiality of the evidence offered. *Munson v. City of New York*, 22 O. G., 586.

§ 4242. Where B., a relative of A., became his subtenant, and manufactured on an infringing machine articles which he sold to A., *held*, that the court properly charged the jury to the effect that, if A. was no more than a purchaser from B., the action against A. could not lie; and there being other evidence tending to show co-operation in the infringement, a motion to set aside the verdict and grant a new trial was denied. *Blanchard Gun-Stock Turning Factory v. Jacobs*, 2 Blatch., 69.

§ 4243. Where a patent was offered in defense, as showing that the invention was not new, and was excluded for want of notice, a new trial will not be granted on the ground that the plaintiff's counsel agreed, at the taking of the testimony, to waive the objection if that is denied, and no such waiver is noticed in the record of the testimony (which does show that the objection was insisted upon), and if the benefit of the waiver was not claimed upon the hearing. *American Saddle Co. v. Hogg*, 1 Holmes, 177.

New trial — Generally, §§ 4244-4251.

§ 4244. Irregularity and misconduct that will authorize a new trial. *Johnson v. Root*, 2 Cliff., 108.

§ 4245. Where the service of the subpoena upon defendant in the district of Massachusetts was essential to the jurisdiction, a failure to set it forth in the record held sufficient ground for a new trial. *Allen v. Blunt*, 1 Blatch., 480.

§ 4246. Where, on motion for a new trial, the patent (Wilson's) was construed and held to

be wanting in novelty and not infringed, the verdict, having been contrary to the evidence, was set aside and a new trial granted. *Wilson v. Janes*, 3 Blatch., 227.

§ 4247. One full, fair and impartial trial between the same parties and for the same matter of controversy is all that any citizen can claim under the statute or any other law known or practiced by the courts of this country. *In re Rouse*, 1 MacA. Pat. Cases, 286.

§ 4248. The want of expert testimony is no ground for a new trial; an opportunity to procure it and put it in should have been asked for before the first hearing. *Hitchcock v. Tremaine*, 9 Blatch., 550.

§ 4249. The validity of the plaintiff's patent cannot be affected by subsequent reissues of a prior patent, where there is nothing in the original application which would have any such effect, and they afford no reason for a new trial. *Ibid.*

§ 4250. In order to obtain leave to file an amended answer, and a rehearing on the ground of newly-discovered testimony, it must be shown that it could not have been procured on the former hearing with reasonable diligence. *Ibid.*

§ 4251. A new trial will not be allowed because evidence has been discovered of the invention having been in use, if it appears that such use was no more than experimental. *Ibid.*

233. NOMINAL DAMAGES.

See DAMAGES, NOMINAL.

234. NON-INVENTION.

See INVENTION, NON-INVENTION.

235. NON-JOINDER OF PARTIES.

See PARTIES, NON-JOINDER.

236. NOTARY PUBLIC.

§ 4252. Notaries public have no power, under the Revised Statutes, to administer oaths in the United States circuit courts. *Buerk v. Imhaeuser*, 14 Blatch., 19.

See *Affidavit*, § 170.

237. NOTICE.

See USE, PRIOR KNOWLEDGE AND NOTICE OF. PUBLICATION, PRIOR, STATUTORY NOTICE. NOVELTY, STATUTORY NOTICE AS TO WANT OF.

Notice — Judicial, §§ 4253-4259.

§ 4253. Following the common law, the courts of this country take judicial notice of all other nations and their seals of state, but not of their inferior departments and their officers and seals. *Schoerken v. Swift & Courtney and Beecher Manufacturing Co.*, 19 Blatch., 209.

§ 4254. Judicial notice will be taken of facts of general knowledge. *Slawson v. Grand St., Prospect Park & Flatbush R. Co.*, 107 U. S., 649; *Brown v. Piper*, 91 U. S., 37 (§§ 6354-57).

§ 4255. The court will take judicial notice that a thing patented was known and in general use long before the issuing of the patent. *Terhune v. Philips*, 9 Otto, 592.

§ 4256. In deciding whether the patent covers an article, the making of which requires invention, we are not required to shut our eyes to matters of common knowledge or things in common use. *King v. Gallun*, 109 U. S., 99.

§ 4257. In passing upon the novelty of a patent, the court will consider matters of common knowledge or things in common use. *Phillips v. City of Detroit*, 111 U. S., 604.

§ 4258. In estimating the novelty of a patented device the courts will take judicial notice of common knowledge and use. *McCloskey v. Dubois*, 19 Blatch., 205; 20 O. G., 371.

§ 4259. The court will take notice judicially of the persons who from time to time preside over the patent office, whether permanently or transiently. *York & Maryland Line Road v. Winans*, 17 How., 30.

See *Use, Double*, §§ 6356, 6357.

Notice — Statutory — General issue and notice, §§ 4260-4264. See *Defenses*, §§ 1852-1860. *Infringement*, § 2827. *New Trial*, § 4243. *Reissues*, § 5300.

§ 4260. Under section 6, act 1793, the notice to be given under the general issue is in lieu of a special plea, and defendant may give evidence under it of matter not specified in it to the same extent as under a special plea. *Evans v. Eaton*, 3 Wheat., 454.

§ 4261. Thirty days' notice must be given in writing before the trial to the plaintiff, in order that the evidence may be admitted under the general issue to prove that the invention of the plaintiff had been previously patented or described in a printed publication, or that it had been in public use or on sale in this country for more than two years before his application for a patent. The notice must show the name of the patentee and the date of the patent when granted, and the name and residence of the alleged inventor, when the patentee is not the inventor. And it must also show the names and places of residence of persons alleged to have had prior knowledge of the thing patented, and by whom it had been used. *Judson v. Bradford*, 16 O. G., 171.

§ 4262. Persons sued as infringers may, if they comply with the statutory condition as to notice, give the special defenses mentioned in the patent act in evidence, under the general issue. *Bates v. Coe*, 8 Otto, 31 (§§ 1816-30).

§ 4263. Such notices, in a suit in equity, may be given in the answer, and the provision is that if any one of those defenses is proved, the judgment or decree shall be in favor of the defending party with costs. *Ibid.*

§ 4264. The defendant referred in his answer to a withdrawn application as containing the invention, but did not name the applicant as a witness, nor give his residence; his testimony was objected to on that account when taken, and was struck out on motion. *Decker v. Grote*, 10 Blatch., 331.

Notice — Statutory — Of special matter, §§ 4265-4272.

§ 4265. Matter of which, under act 1836, section 15, special notice is required, is not a subject of defense which can be pleaded specially, but stands upon the general issue with notice as prescribed. *Wilder v. Gayler*, 1 Blatch., 597.

§ 4266. All that the act of congress requires is that notice of the special matter to be offered in evidence at the trial shall be in writing, and be given to plaintiff or his attorney more than thirty days before the trial; and defendant may exercise the right in the manner and upon the conditions therein pointed out without any leave or order from the court, and he may remedy a defect therein by a subsequent notice, subject to the same conditions as to writing and time. *Teese v. Huntingdon*, 23 How., 2.

§ 4267. It is not sufficient to give notice of special matter of defense in an action upon a patent thirty days before the trial; it must be given thirty days before the first day of the term. *Westlake v. Carter*, 4 O. G., 636.

§ 4268. Such notice need not specify the particular portion of the plaintiff's patent to which the evidence applies. *Ibid.*

§ 4269. Patents may be given in evidence to show the state of the art without such notice; but printed publications cannot be. *Ibid.*

§ 4270. A notice of "special matter" in an action at law for the infringement of a patent is not a pleading, but should have been served on the adverse party, so as to be shown under the general issue, or it may be pleaded specially. *Cotter v. Stimson*, 20 Fed. Rep., 906.

§ 4271. A reference to a book by name and title, in a notice of special matter, without specifying article, page or section, is not sufficient notice, and such evidence should be excluded. *Silby v. Foote*, 14 How., 218.

§ 4272. The filing of notice of special matter is wholly irregular. The issue raised must be by bill and answer, and whenever either is defective, it must be cured by amendment and not by filing special notice. *Doughty v. West*, 2 Fish., 553.

See *Defenses*, § 1817.

Notice — Statutory — Generally, §§ 4273-4284.

§ 4273. Under act 1793, prior knowledge, to afford ground for canceling the patent, must be actual, and not legal or constructive. *Delano v. Scott*, 1 Gilp., 485.

§ 4274. Where want of notice (act 1836, sec. 15) is not made specifically a ground of objection to the admission of evidence in the trial court, an appellate court should presume that proper notice of evidence was given. (Dissenting opinion of SWAYNE, GRIER and MILLER, JJ.) *Blanchard v. Putnam*, 8 Wall., 420.

§ 4275. In an action for infringement a special plea may be filed, but plaintiff is entitled to the thirty days' notice under the statute, whether the matter be set up by plea or notice. *Phillips v. Combstock*, 4 McL., 525.

§ 4276. Publishing notice of the day appointed for the hearing of an application for an extension three times, the first of which is sixty days previous, seems to be a compliance with the law which requires it to be published for sixty days previous. *Gear v. Grosvenor*, 1 Holmes, 215.

§ 4277. The court cannot take notice of what was not set up in answer as against plaintiff's patent. *United States & Foreign Salamander Felting Co. v. Haven*, 3 Dill., 131.

§ 4278. Evidence of the prior use of the patentee's invention, given by a witness who was not referred to in the answer, excluded from consideration, although it might be said that it showed the state of the art. *Richardson v. Lockwood*, 4 O. G., 398.

§ 4279. In an action on a patent, if witnesses are produced to show a prior use of the invention of whom no notice was given in the answer, the objection must be made when the testimony is taken; otherwise it will be received. *Roemer v. Simm*, 5 O. G., 555.

§ 4280. The objection that the combination which is claimed as the invention is not a legitimate one for want of co-operation in the elements will not prevail against a bill for infringing a patent if it has not been set up in the answer. *Russell & Erwin Manufacturing Co. v. Mallory*, 10 Blatch., 140.

§ 4281. An answer to a motion to dissolve an injunction, if formed to try the validity of the patent, should set out the names of places, and persons who have before used the patented article. *Orr v. Merrill*, 1 W. & M., 376.

§ 4282. Where the answer denies that the patentees were the first inventors of the improvement, but gives no notice of the persons by whom, or the places where, it had been previously known or used, evidence of foreign patents and other evidence in support of the answer will not be regarded. *Earl v. Dexter*, 1 Holmes, 412.

§ 4283. In the absence of any statutory provision, there is no principle of equity which requires the owner of a patented invention to notify the voluntary purchaser of a licensee's right, in order to enable him — the owner — to hold the purchaser to the restrictions imposed by the license. *Chambers v. Smith*, 5 Fish., 12.

§ 4284. The bringing and pendency of a former suit were sufficient notice to all other infringers that the rights conferred by the patent were to be asserted and maintained. *Colgate v. Gold & Stock Tel. Co.*, 16 Blatch., 503.

See *Injunction, Provisional*, § 3222. *Injunction*, §§ 3357-3359. *State of the Art*, §§ 6095-6107.

Notice — *Express*, § 4285. *Constructive*, §§ 4286, 4287. See *Assignments, Recording. License*, §§ 4082-4084.

§ 4285. A pamphlet, containing an account of licenses under the patent, sent to purchasers with the goods purchased, *held*, express notice of the condition of the patent. *United Nickel Co. v. California Electrical Works*, 25 Fed. Rep., 475.

§ 4286. *Lis pendens*, to whom it applies as constructive notice. *Consolidated Fruit Jar Co. v. Whitney*, 2 B. & A., 30.

§ 4287. Where an assignment of a patent referred to it as being in use by a certain party, *held*, it was not only constructive notice to assignees of such use, but was express information of it, if they did not have the information otherwise, and that this use by the party was possession of the monopoly, as far as that use extended; and this possession, when actually known, was constructive notice of the claim of right under which the possession and use were had. *Prime v. Brandon Mfg. Co.*, 16 Blatch., 453.

Notice — *Generally*, §§ 4288-4299. See *Marking Patented Articles*, §§ 4160-4162. *Purchaser*, §§ 5183, 5195.

§ 4288. Every one is bound to take notice of the existence of a patent and of the rights of parties under it. Like the record of a deed to real estate, the record of a patent at Washington is notice thereof to all the world. *National Car-Brake Shoe Co. v. Terre Haute Car & Manufacturing Co.*, 19 Fed. Rep., 514.

§ 4289. A special notice set out in the answer to a demurrer cannot have of itself the effect to vary the rights of parties under a formal agreement of that date. *Perry v. Littlefield*, 2 Fed. Rep., 464.

§ 4290. Notice of a motion to amend answer treated as a notice of a motion for leave to renew a motion to amend. *Richardson v. Croft*, 20 O. G., 526.

§ 4291. Notice to individual stockholders is not notice to the corporation, and their knowledge of facts is not notice of them to the corporation. *Davis Improved Wrought Iron Wagon Wheel Co. v. Davis Wrought Iron Wagon Co.*, 20 Fed. Rep., 699.

§ 4292. If the officer or director of a corporation is an active agent of the corporation in the transaction affected by his knowledge, it is not material how or when he acquired his knowledge, and the corporation is chargeable with notice. *Ibid.*

§ 4293. In a transaction between the corporation and its agent, in which the latter is acting for himself personally, the corporation is not charged with notice of facts known to him. *Ibid.*

§ 4294. The object of notice generally, and as provided in office rule 90, is to bring the adverse party before the examining officer, and to give him the opportunity to cross-examine the witnesses. But if the adverse party voluntarily comes, and is present and cross-examines, notice and proof of service are thereby waived; the substance is obtained, and they are mere form. The adverse party, under such circumstances, is also bound to take notice of the adjournment. *Gibbs v. Ellithorp*, 1 MacA. Pat. Cases, 699.

§ 4295. A notice from the other party to have the depositions produced before a commissioner for inspection is not a waiver of the right to notice, nor is an offer to have the witness again before the commissioner for cross-examination and the refusal to cross-examine when so produced. The party has a right to be present at the direct examination-in-chief. *Perry v. Cornell*, 1 MacA. Pat. Cases, 66.

§ 4296. Depositions taken without notice cannot be read in evidence unless the other party has waived his right to notice and agreed to admit them into the case. *Ibid.*

§ 4297. A notice of eleven days before taking testimony at a distance of four hundred miles considered reasonable. *Smith v. Flickenger*, 1 MacA. Pat. Cases, 46.

§ 4298. The objection to the insufficiency of the notice of taking testimony must be made at the hearing; otherwise, it appears, it is no ground of appeal. *Ibid.*

§ 4299. Objection to shortness of the notice of taking testimony is waived by appearance at place of examination and cross-examination of witnesses. *Arnold v. Bishop*, 1 MacA. Pat. Cases, 27.

238. NOVELTY.

See COMBINATION, NOVELTY OF. PROCESS, NOVELTY OF. PRODUCT, NOVELTY OF. SUGGESTIONS. USE, PRIOR FOREIGN USE IN RESPECT TO DOMESTIC PATENT. USE, EXPERIMENTAL IN RESPECT TO NOVELTY.

Novelty — What constitutes, §§ 4300-4307.

§ 4300. The novelty of an invention consists either in the manufacture produced or in the manner of producing an old one. *Whitney v. Emmett*, 1 Bald., 303.

§ 4301. Novelty in principle may consist in a new and valuable mode of applying an old power, affecting it not merely by a new instrument or form of the machine or any equivalent, but by something giving a new or greater advantage. *Hovey v. Stevens*, 1 W. & M., 290.

§ 4302. To be new, in the sense of the act, the device must be the product of original thought and inventive skill, and not a mere formal and mechanical change of what was old and well known. *Stanley Works v. Sargent & Co.*, 8 Blatch., 344.

§ 4303. To be new in the sense of the patent law an article must possess new properties by combination with other ingredients. *Milligan & Higgins Glue Co. v. Upton*, 7 Otto, 3.

§ 4304. In determining the novelty of a compound, the question is, whether this substance which they (the inventors) produced is in its structure and properties old or new; and not whether they looked for something new or old, or thought they had found either one or the other. *Badische Anilin & Soda Fabrik v. Cochrane*, 16 Blatch., 155.

§ 4305. Whether this is a new device or not does not depend upon the question whether the separate instrumentalities are new, but rather upon the question whether any new and useful result is produced by their combination. *Albright v. Celluloid Harness Trimming Co.*, 12 O. G., 227.

§ 4306. The ingredients of a composition need not necessarily be new or not used before for similar purposes, provided the combination is new; that is, that they have not been before compounded in the same proportions. *Corbin v. Martlett*, 1 MacA. Pat. Cases, 521.

§ 4307. The patent law protects simplicity and economy of construction as against prior complex and expensive combinations; and although the general and abstract effect may be analogous, if the two mechanisms produce their respective results by essentially different processes, the one being more simple and capable of being operated with greater economy than the other, it is not anticipated thereby. *Gottfried v. Phillip Best Brewing Co.*, 17 O. G., 675.

Novelty — Presumption is in favor of, §§ 4308-4314. See *Claims*, §§ 857-860. *Interfering Patents*, § 3480. *Patentability*, § 4553. *Patents*, § 4629.

§ 4308. The patent on its face raises the presumption of novelty. *Hays v. Sulsor*, 1 Bond, 279.

§ 4309. The patent raises the presumption of novelty, and the burden of proof to show the contrary is on defendant, who must notify plaintiff of such defense to prevent surprise. *Latta v. Shawk*, 1 Bond, 259.

§ 4310. Where a machine has been long in public use, under a patent which has existed for a number of years, unchallenged and undisputed, a jury should hesitate before coming to the conclusion that the patent was void on the ground of want of novelty. *Blanchard v. Puttman*, 2 Bond, 84.

§ 4311. The presumption of novelty is in favor of a patent and is strengthened by running a long time without successful challenge. *Proctor v. Brill*, 4 Fed. Rep., 415.

§ 4312. The presumption in favor of the novelty and utility of an invention arising from the grant of a patent for it is strengthened if the patent has been extended. *Cook v. Ernest*, 2 O. G., 89.

§ 4313. The fact of issue, reissue and extension of a patent, and its being sustained in suits at law, raises a strong presumption of its novelty and validity. *Jordan v. Dobson*, 2 Abb., 398.

§ 4314. On an application for a patent it is not proper to question too vigorously the novelty of the invention. The applicant is entitled to the benefit of the doubts that arise upon this subject, for the reason that if his application is unjustly refused it will work an irremediable injury, whereas, if it should appear that the invention is not new, that fact may be established in other proceedings before the courts. *In re Cole*, 1 MacA. Pat. Cases, 539.

Novelty — Evidence of — Admissibility; what constitutes, §§ 4315-4319.

§ 4315. On the question of novelty of plaintiff's device, evidence of resemblance between a prior machine and defendant's is not admissible. *Judson v. Cope*, 1 Bond, 327.

§ 4316. Upon the question of novelty speculative opinions as to what might have been done with prior machines is not admissible in evidence. *Ibid.*

§ 4317. Evidence to sustain a want of novelty must be strong and conclusive to justify a judgment setting aside the patent. *Whitney v. Mowry*, 2 Bond, 45.

§ 4318. Where the answer is responsive to the bill concerning infringement, and denies any novelty whatever in the patent, and is sworn to, the novelty of the patented invention must be proved by more than one witness. *Hovey v. Stevens*, 1 W. & M., 290.

§ 4319. Catalogue advertisement of defendant held evidence of novelty of patented device advertised therein and infringed by him. *Masury v. Tiemann*, 8 Blatch., 426.

See *Date of Invention*, §§ 1737, 1738. *Infringement*, § 2833. *Oath*, §§ 4450, 4452, 4453.

Novelty — Evidence of — Patent is *prima facie*, §§ 4320-4330.

§ 4320. Patent is *prima facie* evidence of novelty. *Goodyear v. Dunbar*, 3 Wall. Jr., 310; *Clark Patent Steam & Fire Regulator Co. v. Copeland*, 2 Fish., 221; *Teese v. Phelps*, 1 McAl., 48.

§ 4321. Patent raises *prima facie* presumption of novelty, and the burden of proving the contrary is on defendant. *Howes v. Nute*, 4 Cliff., 173.

§§ 4322-3. The patent is *prima facie* evidence of the novelty, and this is strengthened by the fact of its renewal. *Wintermute v. Redington*, 1 Fish., 239.

§ 4324. The patent is *prima facie* evidence of novelty and utility. *Matthews v. Skates*, 1 Fish., 602; *Winans v. New York & Erie R. R.*, 1 Fish., 213; *Hussey v. Bradley*, 5 Blatch., 132; *Haselden v. Ogden*, 3 Fish., 378; *Waterbury Brass Co. v. New York & Brooklyn Brass Co.*, 3 Fish., 43; *Judson v. Moore*, 1 Bond, 285; *Goodyear v. Beverly Rubber Co.*, 1 Cliff., 348; *Carter v. Baker*, 1 Saw., 512.

§ 4325. A patent, original or reissued, is *prima facie* evidence of novelty and utility. *Serrell v. Collins*, 1 Fish., 289.

§ 4326. The patent is *prima facie* evidence of novelty and utility and that patentee has invented it. *Middletown Tool Co. v. Judd*, 3 Fish., 141.

§ 4327. The patent is *prima facie* evidence of novelty, of utility and of invention, and is strengthened by extension of the patent. *Ransom v. Mayor of New York*, 1 Fish., 252.

§ 4328. The patent is *prima facie* evidence of novelty, utility, of completeness of description, and that patentee is the inventor. *Poppenhusen v. New York Gutta-percha Comb Co.*, 2 Fish., 62.

§ 4329. If a patent has been extended, that should be considered in determining whether it is void for want of novelty. *Black v. Thorne*, 10 Blatch., 66.

§ 4330. The same novelty and merit that will entitle an applicant to a patent entitles him to the judgment of a court upon that point, and the action of the patent office in making the grant is *prima facie* proof that the requisite novelty and merit exist. *Miller & Peters Mfg. Co. v. Du Brul*, 12 O. G., 351.

Novelty — Evidence of — *Utility is evidence of*, §§ 4331-4340.

§ 4331. On the question of novelty, evidence of utility may be admitted to assist the jury in their determination. *Judson v. Cope*, 1 Bond, 327.

§ 4332. A greater degree of utility is evidence, and sometimes conclusive evidence, of novelty in the means or instrumentalities which are used. *Eames v. Cook*, 2 Fish., 146.

§ 4333. Utility is not an infallible test of originality. *Stanley Works v. Sargent & Co.*, 8 Blatch., 344.

§ 4334. That an article is better and more useful in the trade than what was known before is evidence of its novelty; but not if its superiority is owing to the application of known means in a known way to produce a known result. *Smith v. Nichols*, 1 Holmes, 172.

§ 4335. Superior utility in defendant's invention is evidence tending to show that some new principle or mechanical power, or mode of operation producing a new kind of result, has been introduced, and it may rise so as to be conclusive; but the utility must arise from changes introduced and not from better material or greater skill. *Many v. Sizer*, 1 Fish., 17.

§ 4336. The fact that an invention is of great utility and has gone largely into use goes far to show that the inventor discovered and put to use what others skilled in the art had overlooked, and it would probably have been found out before if ordinary skill in that art could have discovered it. *Bruce v. Marder*, 10 Fed. Rep., 750.

§ 4337. That the respondent offered a large sum of money for a patent, and subsequently took out patents for similar devices, are facts to be considered as being inconsistent with his subsequent contention of want of novelty in the patent. *Bostock v. Goodrich*, 21 Fed. Rep., 316.

§ 4338. If an alleged invention proves superior to what has been known before, it is evidence in favor of its novelty. *Birdsell v. McDonald*, 6 O. G., 682.

§ 4339. Novelty and utility held established by the immediate and extensive use of the process subsequent to patenting. *United Nickel Co. v. California Electrical Works*, 25 Fed. Rep., 475.

§ 4340. Commercial and patentable novelty distinguished. *Milligan & Higgins Glue Co. v. Upton*, 7 Otto, 3.

Novelty — *Is essential to patentability*, §§ 4341-4345. *Must be new to all the world*, §§ 4346, 4347. *Relation back to date of invention*, §§ 4348, 4349. *Degree of novelty not essential*, §§ 4350, 4351.

§ 4341. Novelty is essential to patentability. *Rice v. Heald*, 13 Pac. L. R., 33.

§ 4342. Novelty is essential to the validity of a patent. *Blanchard v. Puttman*, 2 Bond, 84.

§ 4343. To support the claim to an invention it should be substantially new, and be so clearly described that a person skilled in the art could construct it from such description. *Allen v. Blunt*, 3 Story, 742.

§ 4344. In a patent for an entire machine the invention must be substantially new in structure and operation to be valid. *Evans v. Eaton*, 7 Wheat., 356.

§ 4345. Novelty is an essential element of every patented invention and presumed on the grant of the patent, and its absence is a good defense thereto. *Swift v. Whisen*, 2 Bond, 115.

See *Invention*, §§ 3585, 3586.

§ 4346. The invention must be new with respect to the whole world (act 1793). *Reutgen v. Kanowrs*, 1 Wash., 168; *Evans v. Eaton*, Pet. C. C., 322; *Whitney v. Emmett*, 1 Bald., 303.

§ 4347. Under act 1793, the invention must be new as to all the world, and must not have been "known or used before the application" either by the inventor or others; and if the inventor had gratuitously or negligently suffered his invention to become public before his application, he was not entitled to a patent. *Thompson v. Haight*, 1 U. S. L. J., 563.

§ 4348. The question of novelty of a patented invention relates back to the date of invention, not to that of the application. *Klein v. Russell*, 19 Wall., 433.

§ 4349. On a question of novelty, held, that an American patent of later date than complainant's patent could not be brought in to supply the deficiencies of the prior English patent for the same thing alleged to anticipate complainant's patent. *Odell v. Stout*, 22 Fed. Rep., 159.

§ 4350. The validity of a patent is not determinable by the degree of novelty or invention

displayed, but it is sufficient if there exists some novelty and merit, however slight. *Miller & Peters Manufacturing Co. v. Du Brul*, 12 O. G., 351.

§ 4351. In considering anticipation, size is not of the essence of the invention. *Peters v. Active Manufacturing Co.*, 21 Fed. Rep., 319.

Novelty — Want of — Defense, §§ 4352-4354.

§ 4352. No reason is seen why any one should not be permitted, upon discovering his mistake, to set up the defense of want of novelty against another party who claims what in fact belongs to the public; but if with a knowledge of the state of the art he attempts to appropriate what does not in fact belong to him, he should be estopped, when his fraud is discovered, from interposing such defense, especially against one whom the patent office has decided as against him to be the original and first inventor. *Greenwood v. Bracher*, 1 Fed. Rep., 856.

§ 4353. The defeated party to an interference may, in another action, raise the question of want of novelty in the invention; yet, if he had knowledge of the state of the art at the time he made his application, the want of novelty must be made clearly apparent. *Smith v. Halkyard*, 16 Fed. Rep., 414.

§ 4354. But in a suit for infringement, the defense of want of novelty is undoubtedly open to the defeated parties. *Shuter v. Davis*, 16 Fed. Rep., 564.

Novelty — Want of — Burden of proof; on party asserting it, §§ 4355-4360.

§ 4355. The burden of proof is on defendant, to prove want of novelty in the patented invention. *Magic Ruffle Co. v. Douglass*, 2 Fish., 330; *Union Sugar Refinery Co. v. Matthieson*, 3 Cliff., 639; *Putnam v. Yerrington*, 9 O. G., 689; *Clark v. Scott*, 9 Blatch., 301.

§ 4356. The patent being *prima facie* good, the burden of proof on a question of anticipation is upon the defendant. *Green v. French*, 11 Fed. Rep., 591.

§ 4357. Upon the question of novelty, the burden of proof is upon defendant; it being the province of the court to decide what constitutes novelty, of the jury to determine on the evidence whether the invention is new. *Parker v. Stiles*, 5 McL., 44.

§ 4358. The burden of proof is upon the party asserting the want of novelty of the patent to prove the same beyond reasonable doubt. *United States Stamping Co. v. Jewett*, 18 Blatch., 469; *Roberts v. Dickey*, 4 Brewster, 260; *Fisk v. Church*, 5 Fish., 540; *Shirley v. Sanderson*, 8 Fed. Rep., 905.

§ 4359. The burden of proof of want of novelty being on the defendant, any disadvantage resulting from conflicting evidence falls upon him. It was his duty to show the alleged anticipation distinctly and clearly. He has not done so, and the original presumption in favor of the patent must therefore stand. *Bostock v. Goodrich*, 21 Fed. Rep., 316.

§ 4360. Where an old instrument that has passed away is set up to defeat a subsequent patent, the burden is upon the party setting it up to show by a preponderance of evidence its substantial identity with the patented device. *Hayden v. Suffolk Mfg. Co.*, 4 Fish., 86.

Novelty — Want of — Must be proved beyond reasonable doubt, §§ 4361-4369.

§ 4361. There must be reasonable certainty that patentee's invention was known before his application to justify a verdict which will invalidate it. *Wayne v. Holmes*, 1 Bond, 27.

§§ 4362-3. Want of novelty must be satisfactorily proved beyond a mere doubt. *Tompkins v. Gage*, 5 Blatch., 268.

§ 4364. If a reasonable doubt exists as to the truth of the evidence adduced to impeach the novelty of the invention, the presumption in favor of the patentee must prevail over it. *Crouch v. Speer*, 6 O. G., 187.

§ 4365. In order to defeat a patent on the ground of want of novelty, the proof of prior use or previous knowledge must be such as to establish the fact clearly and satisfactorily and beyond a reasonable doubt. Where the proofs are contradictory, *mere* preponderance is not sufficient to sustain the allegation. The preponderance in such case must be such as to remove all reasonable doubt. To doubt in such a case is to solve the question in the negative. *Hawes v. Antisdel*, 8 O. G., 685.

§ 4366. Clear proof held required of want of novelty where the device was an old patented one used in every-day life. *Zane v. Peck*, 9 Fed. Rep., 101.

§ 4367. To defeat a patent on the ground of want of novelty the proof must be clear beyond any fair and reasonable doubt. *Campbell v. Mayor, etc., of New York*, 9 Fed. Rep., 500.

§ 4368. It is not sufficient to raise a doubt as to the novelty of the plaintiff's patent; it must be affirmatively proved to be old by preponderating and satisfactory proof. *Doubleday v. Beatty*, 11 Fed. Rep., 729.

§ 4369. The defendants, to defeat the patent on the ground of want of novelty, must make out the defense by satisfactory and preponderating proof. *Strauss v. King*, 18 Blatch., 88.

Novelty — What will defeat it, §§ 4370-4378. See *Interfering Patents*, §§ 3479-3497.

§ 4370. If the thing claimed by the applicant has been done before, it is immaterial to the question of anticipation whether it was done by accident or design. *In re Kemper*, 1 MacA. Pat. Cases, 6.

§ 4371. The existence of a single machine prior to patentee's, though never put into actual use, *held* sufficient to establish want of novelty. *Parker v. Ferguson*, 1 Blatch., 407.

§ 4372. To anticipate a patented invention, it is immaterial whether the prior machine was patented or not. *Whipple v. Baldwin Mfg. Co.*, 4 Fish., 29.

§ 4373. It is not necessary that the inventor of the prior machine know the full extent to which part of his invention will apply in order that it may anticipate a subsequent device so applying it. *Woodbury Patent Planing Machine Co. v. Keith*, 4 B. & A., 100.

§ 4374. A patent for varying the proportions in which the ingredients have been used in a chemical mixture cannot be sustained if the process remains substantially the same. *Rumford Chemical Works v. Lauer*, 10 Blatch., 122.

§ 4375. Where, in a defense to an action for infringement of a patent, the defense proved the existence of the same combinations in a device used for analogous purposes, and in which no change of mechanism was needed, and the operation of such device was successful, it was held that the patent upon which the suit was brought could not be sustained, although the use of the device shown in defense was altogether discontinued. *Shoup v. Henrici*, 9 O. G., 1162.

§ 4376. Where the like effect is produced by prior inventions, they are sufficient to defeat the pretensions of the later inventors to perfect novelty. *Railway Co. v. Sayles*, 7 Otto, 554.

§ 4377. That which would infringe the patent, if later, anticipates if earlier. *Peters v. Active Mfg. Co.*, 21 Fed. Rep., 319.

§ 4378. *Held*, that, while certain alleged prior inventions might not show all the minor elements of the combination claimed, yet as certain parts, by their peculiar structure, supplied such omitted parts, and made those parts unnecessary, the combination claimed was wanting in novelty. *Gilbert v. Weir Plow Co.*, 22 Fed. Rep., 428.

Novelty — What will not defeat it, §§ 4379-4386.

§ 4379. Novelty of an invention. What will not defeat it. *McComb v. Ernest*, 1 Woods, 195.

§ 4380. Similarity in shape unaccompanied by similarity in function cannot be relied upon to establish anticipation. *Wilson v. Coon*, 18 Blatch., 532.

§ 4381. The claim of an article to novelty is not impeached because it can be made only on a machine previously patented, if the patent for the machine makes no mention of such an article, and the machine has not been used for producing it. *Young v. Lippman*, 9 Blatch., 277.

§ 4382. More than three years after the patentee had shown a drawing of his invention to several persons, and a year and a half after it had been embodied for him by the respondents in a working machine, a workman of theirs described it in a sworn caveat, which was never filed, and it was held not to impeach the plaintiff's claim to novelty. *Child v. Boston & Fairhaven Iron Works*, 1 Holmes, 303.

§ 4383. A device which could not be used as a substitute for the patentee's invention without the exercise of invention is not an anticipation of it. *Crandal v. Parker Carriage Goods Co.*, 20 Fed. Rep., 851.

§ 4384. The novelty of a patented invention is not impeached by a prior patent which did not originally describe the invention, but has since been enlarged by reissue so as to include it. *Vogler v. Semple*, 7 Biss., 382.

§ 4385. Patents granted between the making of a drawing by complainant and his filing an application a year afterward are not anticipated by his invention. *Odell v. Stout*, 22 Fed. Rep., 159.

§ 4386. It appearing from the evidence that the machines relied upon to anticipate the complainant's invention did not arrive in this country until after the date of complainant's invention, *held*, that such machines have no bearing upon the question of novelty. *Weston Dynamo Electric Machine Co. v. Arnoux*, 20 Fed. Rep., 112.

See *Drawings*, §§ 2076-2080. *Model*, § 4197. *Priority of Invention*, §§ 4997-5006.

Novelty — Not defeated — *By prior unconnected parts of an entirety*, §§ 4387, 4388. *By similar result obtained in a different way*, § 4389. *By device of like purpose, but different in result and means*, §§ 4390-4395.

§ 4387. It is no answer to a patent for a manufacture that all the parts were known before, if they were not known in that connection and arrangement before. *Bell v. United States Stamping Co.*, 19 Fed. Rep., 312.

§ 4388. Where the patent covers an entirety it cannot be defeated by showing that the several component parts are old in other connections. It must appear that they have existed together in the same relation. *Parks v. Booth*, 12 Otto, 96.

§ 4389. An invention is not anticipated by one which produces the same result and reaches the same end, but by a different process. *Gottfried v. Bartholomae*, 8 Biss., 219.

§ 4390. Where the patent was for a method of producing a certain result by means of mechanism described in the specification, under certain essential conditions, *held*, that the same result may be produced, if different means to that end are employed, without invalidating the patented method. *McMillan v. Rees*, 1 Fed. Rep., 722.

§ 4391. The accomplishment of the same result is not anticipation, unless it is done by the same means, in substantially the same way. *Hall v. Stern*, 15 Fed. Rep., 463.

§ 4392. A patent will not be invalidated by a prior device requiring changes and modifications in its structure in order to accomplish the same result as that attained by the patented invention. *Cahoon v. Ring*, 1 Cliff., 592.

§ 4393. An invention is not anticipated by a device which serves a like purpose through mechanical means which are different and produce a different mechanical result. *Buerk v. Valentine*, 9 Blatch., 479.

§ 4394. A design patent in which the claim is to the shape, *held*, not to anticipate a subsequent mechanical patent in which the shape of the structure might be the same as that of the design patent, but the subject-matter of the two claims was not the same. *Collender v. Griffith*, 18 Blatch., 110.

§ 4395. The fact that a mechanical patent was issued more than two years after the date of a design patent showing, but not claiming, a like invention, will not invalidate the former. *Ibid.*

Novelty — Not defeated by prior accidental similarity, §§ 4396-4401. See *Process*, § 5047.

§ 4396. It is no objection to the novelty of a process which has been newly developed and applied to a useful purpose, that it has been incidentally practiced before, when the result was not designed, discovered, nor appreciated. *United Nickel Co. v. Authes*, 1 Holmes, 155.

§ 4397. A single prior existing device, similar to that patented, but not constructed with the design to operate in the same way, and not so used in a manner fairly accessible to the public, and having passed out of existence and out of the memory of the single witness, until recalled by the suit, and unknown to the inventor of the patented device, *held*, not to anticipate the latter. *Hartshorn v. Tripp*, 7 Blatch., 120.

§ 4398. *Held*, that where a prior machine had substantially all the elements of the patented device, and that if the same effect was produced, it constituted an imperfection rather than an advantage to the perfect operation of such prior machine, and such effect was not the intent and purpose of the machine, it was no anticipation. *Waterbury Brass Co. v. Miller*, 9 Blatch., 77.

§ 4399. *Held*, that a cutter for grass was not anticipated by cutters for other purposes in which the particular structure claimed for the grass cutter existed only by accident and not by intent. *Monce v. Adams*, 12 Blatch., 1.

§ 4400. Evidence of a prior construction, which showed that of plaintiff's patent, but not known to have the effect contemplated by patentee, which occurred but accidentally and incidentally therein, and which effect was not observed before the date of plaintiff's invention, if it existed, *held*, not to show a prior knowledge of the thing patented by plaintiff before he invented it. *Maxheimer v. Meyer*, 9 Fed. Rep., 460.

§ 4401. If a certain machine or organization is capable of a certain use only under unusual and abnormal conditions, so that a person of skill and knowledge in the art to which it relates, or a person using the machine, would not, unless by accident, discover that it was capable of such mode of operation, it shall not be considered an anticipation of a machine or organization which is founded upon such mode of operation. This doctrine must be applied with much reserve. *American Bell Telephone Co. v. Dolbear*, 17 Fed. Rep., 604.

See *Novelty*, § 4415.

Novelty — Not defeated — *By suggestions of prior machines*, §§ 4202-4404. *By experiments abandoned*, §§ 4405-4407. *By single forgotten machine*, §§ 4408. *By unused prior device*, 4409, 4410. *By long remembered evidence of single witness*, §§ 4411, 4412. *By slight change*, §§ 4413-4415. See *Experiments*, §§ 2371-2402. *Foreign Patent*, §§ 2518-2540. *Suggestions*, §§ 6224-6236.

§ 4402. Prior use of a structure bearing some resemblance in some respects to plaintiff's invention, and which might have been suggestive of ideas, or have led to experiments resulting in his discovery, will not invalidate his claim under his patent. *Parker v. Stiles*, 5 McL., 44.

§ 4403. However suggestive the experiments of others may have been, they cannot avail to defeat a patent granted to one who, after the failure of prior experiments, first succeeded so as to disclose a practical process, first perfected by him and made capable of a useful application. *United Nickel Co. v. Authes*, 1 Holmes, 155.

§ 4404. Experimental models or incomplete devices not capable of use as operative machines cannot impair the rights of the patentee, but if the invention has been made and practiced prior to himself, however restricted such knowledge and use may be, it is fatal to the patent. *Kelleher v. Darling*, 4 Cliff., 424.

§ 4405. A patent will not be defeated by evidence of prior similar devices which were of an experimental character simply, and which were subsequently destroyed. *Whittlesey v. Ames*, 9 Biss., 225.

§ 4406. The existence twenty years before of a single machine similar to that described in a patent, which was abandoned directly, and which appears to have been impracticable, will not invalidate the patent. *Blake v. Rawson*, 1 Holmes, 200.

§ 4407. A patent held not invalidated by the existence of a single prior machine, the knowledge and use of which did not exist in a manner accessible to the public, and had been substantially abandoned, and had substantially passed away from the memory of those who used it. *Hall v. Bird*, 6 Blatch., 438.

See *Art, Lost*, § 390.

§ 4408. The existence of a single, forgotten device, not known to the public, and lost as though it had never been discovered, will not invalidate a patent therefor to one who rediscovers the invention anew. *Rich v. Lippincott*, 2 Fish., 1.

§ 4409. A prior device which had never been used, *held*, not to anticipate a patent. *Zane v. Peck*, 9 Fed. Rep., 101.

§ 4410. The mere knowledge of a prior mechanical structure similar to the one patented, which has not been used practically, would not be an answer to the novelty of the later patent. *Swift v. Whisen*, 2 Bond, 115.

§ 4411. The loose testimony of a single witness as to a single prior machine seen twenty years before, *held*, insufficient to invalidate a patent. *Blake v. Eagle Works Mfg. Co.*, 3 Biss., 77.

§ 4412. Where there was conflicting evidence of the existence of an alleged anticipating device, testified to by witnesses, who had seen it twenty-five years before, it was held insufficient to anticipate the patent. *Washburn & Moen Mfg. Co. v. Grinnell Wire Co.*, 24 Fed. Rep., 23.

§ 4413. Where the patented invention was but slightly different in construction from that in a prior patent, but was operated to produce an entirely different result, its validity was sustained. *Pitts v. Wemple*, 1 Biss., 87.

§ 4414. Want of novelty cannot be proved by evidence of prior contrivances, which might by certain changes be converted into the patented invention, though not intended to be so changed by the maker. *Livingston v. Jones*, 1 Fish., 521.

§ 4415. A prior burner was set up as anticipating the invention. If used now in a way in which it was never designed to be used, and was not shown to have ever been used before Clough's invention, it might be made to furnish a supplementary supply of gas; but, as it was not designed for the same purpose as Clough's burner, and no person looking at it or using it would understand that it was to be used in the way Clough's was used, and it was not shown to have been really used and operated in that way, it was *held* not to have amounted to an invention of what Clough invented. *Clough v. Gilbert & Barker Mfg. Co.*, 106 U. S., 166.

Novelty — The prior device must be practical to establish want of, §§ 4416-4426.

§ 4416. In order to defeat a patent for want of novelty, it is not enough for defendant to show that machines like the patented ones were *made*, but he must also show that they were used before plaintiff's invention. *Farker v. Hulm*, 1 Fish., 44.

§ 4417. If there has preceded the invention for which a patent has been obtained, another invention of the same kind, and that has been perfected within the meaning of the patent law, so as to be of practical utility and not to end in mere experiment, then it has anticipated the subsequent discovery. *Howe v. Underwood*, 1 Fish., 160.

§ 4418. A patented invention is not anticipated by the prior existence of the idea unembodied in a practical form. *Teese v. Phelps*, 1 McAl., 48.

§ 4419. Where the prior patent merely said that a certain thing was to be done, but left others to invent the mode of doing it, it was held such a suggestion as would not anticipate a subsequent patent for the mode. *Nathan v. New York Elevated R. Co.*, 2 Fed. Rep., 225.

§ 4420. The Stilwell patent is not invalidated by the earlier English patent of Wagner, since it is doubtful whether the Wagner device could be practically used with success. *Stilwell & Bierce Manufacturing Co. v. Cincinnati Gas Co.*, 7 O. G., 829.

§ 4421. A complete invention is not anticipated by a partial embodiment of the idea that was lacking in just those features necessary to its success. *Richardson v. Noyes*, 10 O. G., 507.

§ 4422. Where it is claimed that a patented device is anticipated by another, and that there has been a prior use, it is necessary to show, not perhaps that the anticipating device has been actually used, but certainly that it was capable of practical and successful use. *Allis v. Stowell*, 9 Fed. Rep., 304.

§ 4423. Mere applications for patent cannot be considered on the question of novelty. To make the things described and shown in them available, there must be evidence that such things were actually constructed in working form. *Barker v. Stowe*, 15 Blatch., 49.

§ 4424. To justify the court in overthrowing a patent granted for what appears to be a new and useful invention or improvement, on the ground that the device has been anticipated by another and earlier invention, the court should be well satisfied by clear and credible testimony that the alleged earlier invention actually existed; that it was a perfected device capable of practical use; that it was embodied in distinct form and carried into operation as a complete thing, and was not of such character as to entitle it only to be regarded as an unperfected or abandoned experiment. *Gottfried v. Phillip Best Brewing Co.*, 17 O. G., 675.

§ 4425. A patent may be invalidated by proof of the existence of practical instruments fully capable of use prior to the origination of the invention by the patentee. *American Bell Telephone Co. v. People's Telephone Co.*, 22 Fed. Rep., 309.

§ 4426. *Held*, that on the question of novelty, the practicability of the devices shown in the alleged prior patents was immaterial. *Gilbert v. Weir Plow Co.*, 22 Fed. Rep., 428.

Novelty — Want of — *Statutory notice*, §§ 4427-4436.

§ 4427. Novelty of an invention cannot be attacked without previous notice. *Eureka Co. v. Bailey Co.*, 11 Wall., 488.

§ 4428. A defense of want of novelty in bar of plaintiff's rights must be set up so as to enable plaintiff to meet it. *Pitts v. Edmonds*, 1 Biss., 168.

§ 4429. Where the defense is want of novelty or originality, it is made the duty of the party sued to notify plaintiff particularly of the circumstances under which the invention is known and used. *Judson v. Moore*, 1 Bond, 285.

§ 4430. Notice of defense of want of novelty should be set up in the answer with sufficient particularity to enable the plaintiff to know what he has to meet. *Brown v. Hall*, 6 Blatch., 401.

§ 4431. In the absence of notice of defense of want of novelty in the answer to the bill, defendants will not be allowed to set it up in the subsequent proceedings. *Jordan v. Dobson*, 2 Abb., 398.

§ 4432. A patent cannot be introduced in evidence to impeach the novelty of the plaintiff's invention if it has not been set up in the answer. *American Saddle Co. v. Hogg*, 1 Holmes, 133.

§ 4433. In an action upon a patent, if it is alleged by way of defense that the supposed invention is not new, that should be set up in the plea or answer; otherwise the evidence in support of the defense is not admissible. *Guidet v. Barber*, 5 O. G., 149.

§ 4434. Where evidence that the invention was not new was taken under objection because no notice was given of it in the answer, it will not be received, although the answer is afterward amended so as to include such a notice. *Roberts v. Blake*, 1 Holmes, 224.

§ 4435. Evidence against the novelty of the invention of which no notice had been given was held to have been properly received by the master, and the objections should be taken by a motion to suppress the testimony, and not by exceptions to the master's report. *American Nicholson Pavement Co. v. Elizabeth City*, 6 O. G., 764.

§ 4436. Evidence of want of novelty cannot be introduced under the general issue without thirty days' notice under act 1836, section 15. *Blanchard v. Putnam*, 8 Wall., 420.

Novelty — Generally, §§ 4437-4440.

§ 4437. The differences between the English and the American cases on the questions of novelty and invention relate rather to the kind and degree of evidence required. According to the English cases the result of the change alone may furnish a conclusive test of the invention and novelty, while the American authorities hold that it must appear by some other evidence than a mere inspection of the result that the effect was produced by some new process, device, contrivance, mode, manner or means. *Yearsley v. Brookfield*, 1 MacA. Pat. Cases, 193.

§ 4438. The experts produced by the parties having disagreed whether the machine covered by the patent in suit was anticipated by one previously patented, the court examined the question itself and held that it was not. *La Baw v. Hawkins*, 6 O. G., 724.

§ 4439. Conditional denials of the novelty of the patent on which suit is brought are not regular, and should be explicit and unqualified if the novelty of the invention is to be contested. *Graham v. Mason*, 4 Cliff., 88.

§ 4440. Where the defendant, in opposing a motion for preliminary injunction and afterwards a motion to punish for contempt, neglected to present evidence of want of novelty, he was refused permission to do so on motion to dissolve the injunction. *National School Furniture Co. v. Paton*, 16 Blatch., 563.

See *Commissioner*, §§ 1075, 1076. *Injunction, Preliminary*, §§ 3109-3112. *Patentability*, §§ 4596-4602.

239. OATH.

See REISSUES, OATH.

§ 4441. Necessity of applicant's oath to his invention. *Wirt's Opinion*, 1 Op., 333.

§ 4442. Any abrogation of oaths in the patent laws of England will not affect the question here; all conditions requisite to a patent in this country must be complied with according to the laws of congress. *Gilpin's Opinion*, 3 Op., 532.

§ 4443. The oath required by act 1836, section 7, must be taken by applicant, and cannot lawfully be taken by his agent or attorney. *Bates' Opinion*, 10 Op., 137.

§ 4444. Inventor's oath is unessential to the validity of the patent. *Whittemore v. Cutter*, 1 Gall., 429.

§ 4445. The oath of patentee in his application for patent is the foundation of the burden of proof thrown upon the defendants in patent cases. *Alden v. Dewey*, 1 Story, 336.

§ 4446. Inventor's oath made prior to issue of the patent as to the originality of his invention may be opposed by the oath of any other witness. *Ibid.*

§ 4447. The affidavit of a single witness, after the lapse of a certain time, is not sufficient to outweigh patentee's oath that he is first inventor and the general presumption arising from the grant of the patent. *Woodworth v. Sherman*, 3 Story, 171.

§ 4448. The oath of the inventor, unopposed, is some evidence of the novelty, invention and usefulness of the improvement. The rule of law is that a patent issuing, grounded upon the oath of the patentee, under such circumstances, will be considered as *prima facie* evidence in an action for the infringement of a patent-right. *In re Fultz*, 1 MacA. Pat. Cases, 178.

§ 4449. The oath of invention attached to the specification covers all matters described therein, and not merely the matters specified in the claim. *King v. Gedney*, 1 MacA. Pat. Cases, 443.

§ 4450. The oath attached to the application is *prima facie* evidence of the novelty of the invention disclosed therein. *In re Wagner*, 1 MacA. Pat. Cases, 510.

§ 4451. The statutory requirements of an affidavit by an applicant for an original patent is directory merely, and if it is irregular or omitted altogether, the patent is not thereby vitiated. *Hartshorn v. Eagle Shade Roller Co.*, 18 Fed. Rep., 90.

§ 4452. The oath of invention accompanying the application is *prima facie* evidence that the invention therein set forth has been made, and none of the patent laws have ever required that the invention should have been in use or reduced to actual practice before the issuing of the patent otherwise than by furnishing a model, drawing and description of the invention as required by law. *In re Seely*, 1 MacA. Pat. Cases, 248.

§ 4453. The taking of the oath is not a condition precedent failing which the patent must fail. It is *prima facie* evidence of the novelty and originality of the invention until the contrary appear. *Crompton v. Belknap Mills*, 3 Fish., 536.

§ 4454. The description and oath of the inventor are required to protect the public. *Brooks v. Fiske*, 15 How., 212.

§ 4455. Negative testimony that the oath to the application was not taken will not overcome the direct recital in the patent that it was taken, or the presumption that the requirements of the law were complied with in issuing it. *Crompton v. Belknap Mills*, 3 Fish., 536.

§ 4456. The decision of the patent office in granting a patent upon the sufficiency or the fact of an oath made must be final. *De Florez v. Raynolds*, 14 Blatch., 505.

§ 4457. Where the amended application was, under act 1836, verified by the oath of the attorney and not of the patentee, as required by the statute, *held*, that in view of the recital in the patent that the necessary oath had been taken, an inquiry into the truth of the statement was precluded in a suit against an infringer. *Hancock Inspirator Co. v. Jenks*, 21 Fed. Rep., 911.

§ 4458. The negative probative force of a file-wrapper and contents, arising from the absence therein of certain papers, *held* insufficient to rebut the presumption arising on grant of a patent that the commissioner required and received a proper preliminary oath. *Hoe v. Kohler*, 25 Fed. Rep., 271.

See *Application*, §§ 332, 360, 361. *Construction of Patents*, § 1152. *Evidence*, §§ 2304, 2305. *Notary Public*, § 4252. *Reissue*, § 5301.

240. OFFICERS.

Officers — Military — *Right to patent*, § 4459.

§ 4459. If an officer in the military service, not especially employed to make experiments with a view to suggested improvements, devises a new and valuable improvement in arms, tents or any other kind of war material, he is entitled to the benefit of it and to letters patent for the improvement from the United States equally with any other citizen not engaged in such service; and the government cannot, after the patent is issued, make use of the improvement any more than a private individual, without license of the inventor or making compensation to him. *United States v. Burns*, 12 Wall., 246.

Officers — Of patent office — *Commissioner and examiners*, §§ 4460-4464. *Board of examiners*, §§ 4465, 4466. *Examiners*, §§ 4467-4470. See *Commissioner*, §§ 1068-1085.

§ 4460. It is not the duty of officers of the patent office to decide upon the legal effect of patents issued in conformity to the laws, nor to inform patentees of their rights. *Wirt's Opinion*, 1 Op., 575.

§ 4461. Taking the sections of the acts of 1836 and 1839, relating to appeals from the decision of the commissioner, together, it is evident that the judge succeeded to the power formerly conferred upon the board of examiners, to require the commissioner and the examiners in the patent office to furnish such information as they might possess relative to the matter under consideration, and so *held* that an examiner might be interrogated under oath as to the peculiar nature and features of the invention in dispute. *In re Seely*, 1 MacA. Pat. Cases, 248.

§ 4462. The section (section 11, act of 1839) means that the explanation which it authorizes to be required of the commissioner and examiners may be so full and clear an explanation of the principles as to enable the judge duly to apply and weigh the evidence offered to support the issue in the case, and not to be limited to a mere exposition of the terms used. Such explanations, so given, the judge is bound to respect as part of the case. *Richardson v. Hicks*, 1 MacA. Pat. Cases, 335.

§ 4463. The provisions of the eleventh section of the law of 1839, that the commissioner and the examiners in the patent office may be examined under oath in explanation of the principles of the machine or other thing, etc., must be considered in connection with the similar provisions of the seventh section of the code of 1836, governing appeals to the board of examiners. *Ibid.*

§ 4464. The examiners in the patent office are the assistants of the commissioner in the discharge of his duties, but the commissioner cannot transfer to them, or any of them, his own power to decide. The examination of the alleged invention required by the seventh section of the law of 1836 may be made by the commissioner alone, or with the aid of such examiners as he may assign for that purpose, but he cannot constitute them a "board of examiners," known to the law as such. *In re Aiken*, 1 MacA. Pat. Cases, 126.

§ 4465. The provisions of the act of 1836 relating to a board of examiners were repealed by the twelfth section of the act of 1839. *Ibid.*

§ 4466. When the board of examiners created by the act of 1836 was abolished by the act of 1839, its original jurisdiction was vested in the commissioner, and its appellate jurisdiction in the chief justice of the District of Columbia. *Hunt v. Howe*, 1 MacA. Pat. Cases, 366.

§ 4467. The contingency on which the examiner-in-chief assumes the duties of commissioner is primarily to be taken to exist from his discharge of those duties, and the burden of showing its non-existence is on him who denies the validity of the ostensible officer's act. *Dorsey Revolving Harvester Rake Co. v. Marsh*, 6 Fish., 387.

§ 4468. The statute nowhere prescribes the duties of examiners and their assistants. They are appointed upon nomination of the commissioner, and their duties are such as he is authorized to prescribe under the nineteenth section of the patent act. (Sec. 483, R. S.) *Hull v. Commissioner of Patents*, 2 MacArth., 90.

§ 4469. The decision of a principal examiner as to the patentability of a device is not conclusive on the court. *Ward v. Grand Detour Plow Co.*, 14 Fed. Rep., 696.

§ 4470. An officer of the patent office may attend the hearing before the judge for the purpose of explaining the decision of the commissioner. He cannot be considered, however, as counsel for the commissioner, nor as advocate for either of the parties litigant. *Perry v. Cornell*, 1 MacA. Pat. Cases, 66.

Officers — Public — Presumptions, §§ 4471, 4472. See *Commissioner*, §§ 1068-1085. *Contracts, Government*, §§ 1339-1343. *Employer and Employee*, §§ 2104, 2105. *Government*, §§ 2613-2630. *Secretary of Interior*, §§ 4985-4995.

§ 4471. A public officer is presumed to have discharged his duty faithfully, until the contrary is shown. *Allen v. Blunt*, 2 W. & M., 121.

§ 4472. The actual incumbent of a public office is presumed to be in the lawful possession of it, and no affirmative proof of his title is required to support his official action. *Dorsey Revolving Harvester Rake Co. v. Marsh*, 6 Fish., 387.

See *Defenses*, § 1842. *Reissues*, §§ 5717-5726.

241. OLD ELEMENTS, COMBINATION OF.

See COMBINATION OF OLD ELEMENTS.

242. ORIGINAL INVENTOR.

See INVENTOR, ORIGINAL.

243. OWNERS.

SUMMARY (*DUNHAM v. INDIANAPOLIS & ST. LOUIS R. CO.*, §§ 4473-4475) — *Joint patentees are tenants in common*, § 4473. — *Liability of joint owners*, §§ 4474, 4475.

(*HERRING v. GAS CONSUMERS' ASSOCIATION*, §§ 4476, 4477) — *Liability of joint owners for infringing*, §§ 4476. — *Damages; proportionate recovery*, § 4477.

DUNHAM v. INDIANAPOLIS & ST. LOUIS RAILROAD COMPANY.

(Circuit Court for Illinois: 7 Bissell, 223-226. 1876.)

§ 4473. *Where two or more persons together take out a patent on an article, each is tenant in common of the right, so that he may grant to another a license to manufacture the same, without the joinder or consent of the others.*

Opinion by DRUMMOND, J.

The facts in this case are, that three persons were patentees for an improvement in car-brake shoes, and that the plaintiff, being one of them, made a contract with the defendant for a license to use the invention described in the patent; the price to be paid for the license was a thousand dollars. The plaintiff executed and offered to deliver to the defendant the license signed by himself, but not by the two other patentees, and the defendant refused to comply with the terms of the contract and pay the money, because the license was not signed by all of the patentees. The patentees did not own the right in equal shares; one of them owned a half, and the other two a quarter each, the plaintiff only owning a quarter; and the question in the case is, whether this constitutes a good defense to a suit brought upon the contract made between the plaintiff and the defendant; and I am of opinion that it does not.

The material point is, who is to answer, if any one, to the other patentees for the use of the part which does not belong to them, when a joint owner uses the improvement, or makes a contract with another person for its use. What is the position of patentees with reference to their right to use the thing patented? The patentees are tenants in common of the right. One of them has no superiority of right over the other. One of them can manufacture and use the article patented without the consent of the others; that is, each has the same right, although one may own a greater share of the thing patented than the other. The grant was, in this case, to the three to use and vend the improved car-brake shoes, and while it is clear that one of the patentees cannot grant what does not belong to him, and if he gives a license or makes a contract for the use of the thing patented, he can only grant that which he has himself, and not the rights of the other patentees, still he can clothe his grantee or his licensee with the same right that he has himself, namely, the right to sell or use the thing patented.

§ 4474. *Liability of joint owner of patent.*

And it seems to me the better rule is to hold, if there is a liability at all, that where a party owning less than the whole of a thing patented makes a grant or a license, he shall be answerable to the others, rather than that the other patentees shall look to the grantee or licensee. There were three cases particularly referred to on the argument. One was the case of *Pitts v. Hall*, 3 Blatch., 201—decided by Judge Hall, of the northern district of New York. He seems to hold that if one joint owner of a patent uses or sells his right without the authority of his co-owner, he is liable to an action by such co-owner for an infringement of the patent; and the conclusion, perhaps, to be drawn from his decision is, that if the party to whom he sells uses the thing patented, an action could be maintained and an injunction issued against the grantee or licensee of the co-owner.

Judge Curtis, in the case of *Clum v. Brewer*, 2 Curt., 506, seems to hold, and I think that is the true rule upon the subject, that where one of the joint patentees uses or sells the thing patented, or any portion of it, the others cannot sue him as for an infringement of the patent.

§ 4475. *Joint owners' liability to each other.*

The most that can be claimed is, that if one uses or sells it to the detriment of the others he may be held responsible. For example, if he obtains more than his share of the profits from the use of the article, or in issuing licenses he obtains more than his share of the license money, he possibly may be held responsible by the other joint patentees; but Judge Curtis, in that case, held that an injunction should not issue against the use, by one of the joint patentees, of the thing patented, and the principle decided by him is, that one tenant in common of letters patent has the same rights as the others to make, use and sell the thing patented, and a licensee under one tenant in common cannot be enjoined on a bill by another tenant in common.

A case has been decided in England bearing on this question (*Mathers v. Green*, 1 Law Rep., Ch. App., 29), and the opinion is given by Lord Chancellor Cranworth. That was a case of letters patent granted to three individuals. The chancellor says: "The right conferred is a right to exclude all the world, other than the grantees, from using the invention; but there is no exclusion in the letters patent of any one of the patentees. The inability of any one of the patentees to use the invention, if any such inability exists, must be sought elsewhere than in the letters patent. But there is no prin-

ciple, in the absence of contract, which can prevent any persons not prohibited by statute from using any invention whatever. Is there any implied contract where two or more persons jointly obtain letters patent that no one of them shall use the invention without the consent of the others, or, if he does, that he shall use it for their joint benefit? I can discover no principle for such a doctrine. It would enable one of two patentees either to prevent the use of the invention altogether, or else to compel the other patentee to risk his skill and capital in the use of the invention on the terms of being accountable for half the profit, if profit should be made, without being able to call on his co-patentee for contribution if there should be loss."

Now while this is the principle announced by the chancellor, it perhaps should be with this qualification: that if one of the patentees obtains more than his share of the profits he might be held liable under certain circumstances to the others. Certainly I do not wish to be understood as affirming that there is never such liability. Of course we must take into consideration any risk which he may run; any outlay of money which he may make in the manufacture or sale of the article; but if, looking at it upon equitable principles, he has obtained more than his share of the profits arising from the thing patented, either in the use or sale of it, or of licenses, it seems to me he might in certain cases be held accountable to the other joint patentees. But it is not necessary in this case to decide that point. My conclusion therefore is, that the fact that one of the patentees has given a license to the defendant to use the thing patented clothes him with the right to use it, and, having that right, he is liable under his contract for the payment of the one thousand dollars which he agreed to pay for the license. Judgment will accordingly be entered for the plaintiff.

HERRING *v.* GAS CONSUMERS' ASSOCIATION.

(Circuit Court for Missouri: 3 McCrary, 206-208. 1878.)

Opinion by TREAT, J.

STATEMENT OF FACTS.—The plaintiff avers, substantially, that he is owner of an undivided two-thirds interest in the patent described, and that the defendant is owner of the other undivided one-third interest; that the defendant is using a device which is an infringement upon their common patent, and that he is so doing under cover of their common patent. Hence the claim for damages for said infringement,—not for the entire amount thereof, but for plaintiff's proportion, to wit, two-thirds.

§ 4476. *A joint owner of a patent is liable for use of an infringing patent, and recovery is in proportion to their respective interests.*

The direct question presented is whether an infringer of a patent can escape liability for his infringement because he is a joint owner of the original patent upon which the infringement occurs. The cases cited do not reach the precise point raised by the bill. It is evident that if a stranger was guilty of the infringement he would be compelled to respond in damages. Can a part owner infringe the common patent and escape all liability? If he can, it is obvious that, however small his aliquot part, he can make the enjoyment of the patent valueless to his joint owner. He has, by virtue of the joint ownership, a right to use the patent, but he has no right, more than a stranger, to infringe the same. If there is an infringement the right of recovery is in the party wronged. All the joint owners should ordinarily be parties plaintiff,

but if the wrong-doer is one who is guilty to the damage of the other joint owner, the latter should not be left remediless. As to such infringement they are strangers. All the joint owners are on the record, and the amount of the recovery determines their respective interests. The infringer cannot escape the consequences of his wrong to his joint owner by averring that he was by his infringement injuring not his joint owner alone, but himself also. In other words, he cannot, *under cover* of his interest in the common patent, shield every wrong-doer who may infringe that patent. He can, as to the other part owners, by infringing, become liable to them for the wrong done.

§ 4477. *Damages recovered for such infringement will be proportioned to the respective interests of the parties.*

The amount of recovery will be in proportion to their respective interests. Were this not so, the door would be open to the grossest frauds by one joint owner against all other joint owners. The case of *Pitts v. Hall*, 3 Blatch., 204, and the comments thereon in *Curtis, Pat.*, sec. 108 *et seq.*, do not cover this case. The question there discussed pertains to the use by one joint owner of the common property. The difficulties in maintaining an action for an infringement against a joint owner who merely uses the common patent may be insurmountable. As to that no opinion is expressed. In this case an entirely new and distinct proposition is presented, viz.: one of the several joint owners is not using the common patent, but an infringing patent. His defense is that inasmuch as he had a right to use the original patent without question from his joint owners, despite the decision in *Pitts v. Hall*, *supra*, he has a right also to use any infringing patents, on the ground that his right to use the original, being vested in him, his use of other and infringing patents did not cause any wrong or injury to himself as joint owner. In other words, the defendant contends that as one joint owner he could use the common patent without being liable to account to the other joint owners; that he could not be sued as an infringer for using what he had a right to use by virtue of his proprietary interest; and, therefore, if he used an infringing device, he was only injuring himself in what he had a proprietary right to forbid.

This would be correct if no interest except his own were involved, for a man may do what he pleases with his own, and "*volenti non fit injuria*" would be, *a fortiori*, applicable in such a case. If a stranger were using the infringing patent this action would unquestionably lie against him; and the question before us is whether it will lie against a joint owner, or, in the language of the bill, whether he, under cover of his joint ownership, can infringe and escape liability. So far as he acts outside of his interests or rights or powers as a joint owner, there is no adequate reason for treating him, *quoad hoc*, otherwise than as a stranger. If this be not so, then one joint owner may destroy, without remedy, the rights of the other joint owners. Demurrer overruled.

Owners — Joint, §§ 4478-4485. See *Contracts*, § 1301. *Estoppel*, §§ 2189-2193, 2229. *Partnership*, §§ 4546-4550. *Reissues*, § 5396. *Title*, §§ 6306, 6307.

§ 4478. The joint owner of a patent can sue his co-owner for infringement, in which he can recover his actual damages, according to his interest in the patent. *Pitts v. Hall*, 3 Blatch., 201.

§ 4479. One joint owner of a patent can legally grant, license, assign or sell only in respect to his own share or right. *Ibid.*

§ 4480. In the case of joint patentees, where no partnership agreement exists, such copartnership does not result from their relation as joint patentees; and the assignee of one joint

owner does not become partner of the other. They are simply joint owners or tenants in common, and their rights with respect to each other are substantially those of the joint owners of a chattel. *Ibid.*

§ 4481. One of two joint owners can legally grant, assign, license or sell his own share or right in the patent. *May v. Chaffee*, 2 Dill., 385.

§ 4482. Where one of two joint owners of a patent engaged in the rebellion, the United States considered their interests as severed, and paid half of the royalty due on the whole patent to the loyal owner. *Burns' Case*, 4 Ct. Cl., 113.

§ 4483. The interest of a joint owner of a patent in the royalty paid by the government for use thereof, who remained loyal during the rebellion, cannot be affected by the disloyalty of the other joint owner; and if the government recognized his interest and paid him a moiety of the royalty, it became severed from the claim of the other joint owner. *United States v. Burns*, 12 Wall., 246.

§ 4484. Where complainant was possessed of one-third undivided interest in the patent, and the other two owners of the patent not having been joined, he was held entitled to recover but one-third of the accrued damages and profits. *Adams v. Howard*, 19 Fed. Rep., 317.

§ 4485. Where there was a mutual agreement between a patentee and the inventor of an improvement on the patent, that the former should surrender his individual right under the patent, and that the latter and patentee should apply jointly for a new patent embodying the improvement, *held*, that they were joint owners of the improved patent, and that the improver could restrain patentee from using it except for their joint interest. *Duke v. Graham*, 19 Fed. Rep., 647.

Owners—Tenants in common, § 4486.

§ 4486. Tenants in common of letters patent have equal rights, and equity will not enjoin a license under one upon application filed by another. *Clum v. Brewer*, 2 Curt., 506.

See *Estoppel*, § 2267. *Owners, Joint*, §§ 4473-4475.

Owner—Sole, § 4487. See *Grant*, § 2638.

§ 4487. The action for the violation of an exclusive right under a patent is confined to the owner of such right. *Washburn v. Gould*, 3 Story, 122.

244. OYER.

§ 4488. Oyer of letters patent is not demandable, as of a deed; but being matter of record, and not necessarily a part of the declaration, should be stated in a plea averring insufficient description. *Smith v. Ely*, 5 McL., 76.

245. PARTIES.

Parties—In general—*Title to sue*, § 4489; *of parties contributing money*, § 4490. *Conclusiveness of court decision as to who are privies and parties*, § 4491. *Married woman; state law*, §§ 4492, 4493. *Surviving member of firm*, § 4494. *Liability*, § 4495. *Jurisdiction*, § 4496. *Bill of discovery; corporation*, § 4497.

§ 4489. The granting of the reissue to the plaintiff is sufficient proof of his title to sue. *Wooster v. Clark*, 21 O. G., 264.

§ 4490. A party who contributes money for the purpose of employing counsel to carry on a litigation under a contract with a party of record must, of necessity, be held to have the right to take such action in the case as will protect his own interest in it. *Miller v. Liggett & Myers Tobacco Co.*, 3 McC., 375.

§ 4491. The decision of a court before whom a case is tried as to who are parties and privies thereto is final and conclusive upon the parties. *Ibid.*

§ 4492. There is no statute or rule in the equity courts of New York which prohibits or prevents a married woman, owning a patent, from bringing suit thereon without joining her husband as a party thereto. *Lorillard v. Standard Oil Co.*, 17 O. G., 1507.

§ 4493. By the law of New York a married woman may own property of every description in the same manner as if she were a *feme sole*, and under the Revised Statutes suits in equity for infringement of letters patent must be brought by the party in interest in his or her own name, and such right cannot be delegated to others to bring suit in their own names when the suit is not in any way for their benefit. Therefore the husband, having no legal interest in the patent or the suit, is neither a necessary nor a proper party to be joined. *Ibid.*

§ 4494. Suit for infringement held properly maintainable in the names of the plaintiffs as surviving members of the firm composed of themselves and the patentee. *Loercher v. Crandal*, 11 Fed. Rep., 872.

§ 4495. The only persons who can be held for damages for the infringement of a patent are those who own or have some interest in the business of making, using or selling the thing which is an infringement, and an action at law cannot be maintained against the directors, shareholders or workmen of a corporation which infringes a patented improvement. *United Nickel Co. v. Worthington*, 23 O. G., 939.

§ 4496. It is not important in equity proceedings for every purpose that all the parties to the controversy should be upon opposite sides in the formal pleadings. It is sufficient that they are citizens of different states on opposite sides of the dispute, although not on opposite sides in the pleadings, for the removal of the cause to the federal courts. *Campbell v. James*, 18 Blatch., 92.

§ 4497. A bill of discovery may be maintained against a corporation, although, in order to compel a discovery on oath, the officers of the corporation must be made parties. *Vaughn v. East Tenn., Virginia & Georgia R. Co.*, 1 Flip., 621.

See *Interfering Patents*, §§ 3485, 3486. *Statutes*, § 6124.

Parties — Owners; assignees; patentees, §§ 4498-4515. See *Administrator*, §§ 152-155. *Assignee*, §§ 548-571. *Corporation*, §§ 1369-1396. *Grantee, Territorial*, §§ 2649-2653. *Executor*, §§ 2368-2370. *Infringer*, §§ 2981-3010. *Licensee*, §§ 4097-4115. *Owner*, §§ 4473-4487. *Patentee. Receiver*, § 5210. *Repeal of Patents*, §§ 5836, 5852-5858. *Right of Action*, §§ 5867-5881.

§ 4498. All parties having title to the patent are necessarily parties either as plaintiffs or as defendants; and those who dispute the title should be made defendants. *Edgerton v. Breck*, 5 B. & A., 42.

§ 4499. No one can maintain a suit for the infringement of a patent except the patentee, or an assignee who owns the entire right in it for a specified territory, exclusive of the patentee himself. *Hill v. Whitcomb*, 1 Holmes, 317.

§ 4500. On bill filed to enjoin for infringement of patent, all the owners must be made parties; by owner is meant the original patentee or those to whom he has made an assignment in writing. *Jordan v. Dobson*, 2 Abb., 398.

§ 4501. No person can bring a suit for profits or damages for infringement who is not the patentee or such an assignee or grantee as the statute points out. *Gordon v. Anthony*, 16 Blatch., 234.

§§ 4502-5. Full title to one-half of the patent is sufficient to sustain suit for infringement, in absence of objection to non-joinder of any other party. *American Diamond Rock-Boring Co. v. Sheldon*, 17 Blatch., 208.

§ 4506. Under act 1836, section 14, suit for infringement is properly brought in patentee's name in behalf of party holding a license to use. *Goodyear v. McBurney*, 3 Blatch., 32.

§ 4507. Where patentee has assigned his interest prior to filing the bill, he cannot obtain an injunction. *Morse v. O'Reilly*, 6 Penn. L. J., 501.

§ 4508. The death of the patentee since the appeals were taken does not prevent the suits from being further prosecuted in the name of the legal representatives. *Illinois Central R. Co. v. Turrill*, 26 O. G., 917.

§ 4509. A patentee may maintain a suit at law upon his patent in his own name, although he is under a contract to assign it to others, if the contract has not been executed. *Wheeler v. McCormick*, 11 Blatch., 334.

§ 4510. But equity regards that as already done which the patentee has agreed to do, and requires that the proposed assignees be made parties to a bill in chancery brought against infringers. *Ibid.*

§ 4511. If the other parties to such a contract release to the patentee all their interest in the patent, he may maintain a bill in his own name for all subsequent infringements, but not for those committed previous to the release. *Ibid.*

§ 4512. Neither can he recover damages for any infringements committed after he has sold and assigned the patent. *Ibid.*

§ 4513. Certain patentees having entered into a contract, whereby they sold for a term of years the exclusive right granted by their patent, reserving certain shop-rights, bring suit against a third party for the infringement of their letters patent. The defendants demur on the ground that the patentees cannot maintain suit in their own name, because of the sale of their right for a term of years. *Held*, that the patentees have a beneficial interest in the right secured to them by their letters patent, which in a proper case they may protect in a court of justice. The patentees certainly own the remaining interest after the lapse of five years, and

have a right to see that such interest is not destroyed. Demurrer overruled. *Still & Bro. v. Reading*, 9 Fed. Rep., 40.

§ 4514. In order to make a *prima facie* case of liability against a third party, it must affirmatively appear in the petition that such party is not using the invention under the authority of the patentees' license. *Ibid.*

See *Assignment*, §§ 423, 446.

§ 4515. Patentee and assignee may join as plaintiffs. *Whittemore v. Cutter*, 1 Gall., 429.

Parties — Joinder of, §§ 4516-4545. See *Marking Articles Patented*, § 4150.

§ 4516. In a bill for injunction restraining defendants from a longer use of the patented invention, it is very doubtful whether a misjoinder of parties as plaintiffs could defeat a prayer for an injunction not to use a machine in which any of them were interested. *Woodworth v. Hall*, 1 W. & M., 248.

§ 4517. Patentee being party to an assignment is properly joined in suit, in order to take advantage of the breach of the condition, notwithstanding the whole of the beneficial interest is in plaintiff. *Woodworth v. Cook*, 2 Blatch., 151.

§ 4518. In a suit for an account and to enjoin the infringement of a patent, a party holding an equitable interest should be joined with one holding the legal title. *Stimpson v. Rogers*, 4 Blatch., 333.

§ 4519. In all cases where an assignment does not pass the legal title and is not absolute and unconditional, or there are remaining rights or liabilities of the assignor which may be affected by the decree, assignor is a necessary party to the suit. *Cook v. Bidwell*, 20 O. G., 1083.

§ 4520. Where complainants held the patents in trust for two companies, *held*, that if they are but licensees of complainants, their interest could not be such as would require them to be joined as parties to the suit. *Potter v. Wilson*, 2 Fish., 102.

§ 4521. If the owner of an equitable right in a patent sues for injunction and account for his own benefit, in the name of the owner of the legal title to the patent, he will be made co-plaintiff with the latter on application to the court; and the application will be sustained, though made after answer filed, testimony published, and case placed on term calendar for final hearing, if it appear that suit was brought and costs incurred by the owner of the equitable right for his benefit. *Patterson v. Stapler*, 7 Fed. Rep., 210.

§ 4522. Where the whole legal title to the patent is in the plaintiffs, they may sue without joining patentee. *Siebert Cylinder Oil Cup Co. v. Phillips Lubricator Co.*, 10 Fed. Rep., 677.

§ 4523. It is proper, in a suit in equity on a patent, to join as plaintiff, with the owner of the legal title to the patent, the party who is immediately injured by the infringement, and who is equitably entitled to the fruits of the recovery in the suit. *Goodyear v. Allyn*, 6 Blatch., 33.

§ 4524. Where a motion was made to enjoin an infringement consisting in the manufacture of the alleged infringing articles in a territory belonging to one of the plaintiffs, and sold in the territory of another, complainants being joint owners of the patent, *held*, that the latter was properly joined, although having no interest in the district where suit was brought. *Buck v. Cobb*, 9 Law Rep., 545.

§ 4525. Where the bill of complaint was founded upon title to a reissue granted to executor, a plea thereto that other executors, who did not prove the will nor join in the reissue, were not joined in the suit, was held bad. *Goodyear v. Providence Rubber Co.*, 2 Cliff., 351.

§ 4526. The addition of a party without interest as plaintiff to a bill in equity and not a necessary party on the record can be taken advantage of by demurrer. *Hodge v. Iron Mountain R. R.*, 1 Dill., 104.

§ 4527. Where one person has the legal title to the patent and another an equitable right therein, both must be made parties to the suit in action in equity to restrain infringement. *Gamewell Fire Alarm Tel. Co. v. City of Brooklyn*, 22 O. G., 1978.

§ 4528. The non-joinder of any parties as defendants cannot be regarded as a defense, especially if it is not set up as such, and the proper parties to be joined are not indicated. *Wallace v. Holmes*, *Booth & Hayden*, 19 Blatch., 651.

§ 4529. Where the non-joinder of parties as complainants is not set up in the answer to a bill in equity, it will not serve as a defense if the court can do justice to the parties who are before it without prejudicing the rights of those who are not. *Ibid.*

§ 4530. Where suit was brought in plaintiff's name, and, by the terms of a certain contract, he had a right to join another with him in the suit, a motion to dissolve the injunction for non-joinder was refused, it sufficiently appearing that defendant was infringing plaintiff's exclusive right under the patent; but plaintiff was directed to amend his bill to that effect. *Bassett v. Malone*, 11 Fed. Rep., 801.

§ 4531. A complainant being owner of an undivided third interest in a license, and no ob-

jection having been taken by demurrer or the answer to the non-joinder of the other two owners of the license, such non-joinder cannot be insisted on to defeat a decree. *Adams v. Howard*, 19 Fed. Rep., 317.

§ 4532. A party alleged to have an interest in the patent sued on may waive all interest by filing disclaimer, and thus remove any objection as to non-joinder. *Graham v. Geneva Lake Crawford Mfg. Co.*, 11 Fed. Rep., 138.

§§ 4533-5. Two defendants cannot be united in the same action, where each has infringed distinct patents. *Case v. Redfield*, 4 McL., 526.

§ 4536. Where complainant sought, by decree, to modify an agreement concerning a license fee between himself and three other parties whose interests, under the agreement, were essentially joint, and but one party of the three was made defendant, the objection, though not made by plea, demurrer or answer, was raised and acted upon by the court itself, and the decree was refused. *Florence Sewing Machine Co. v. Singer Sewing Machine Co.*, 8 Blatch., 113.

§ 4537. Where one of the defendants was engaged in manufacturing the alleged infringing articles, which were sold by the other defendant all over the country, *held*, on motion for injunction, that they were properly joined as defendants. *Buck v. Cobb*, 9 Law Rep., 545.

§ 4538. Non-joinder of licensees constitutes no defense for an infringer after the cause has been set for final hearing. *Forbes v. Barstow Stove Co.*, 2 Cliff., 379.

§ 4539. Where the parties were either directors of the company who had the management of the business under whose direction the infringing articles were manufactured and sold, or were agents of the same, concerned in conducting the business, they were held liable therefor, and properly made parties defendant in an application for provisional injunction. *Goodyear v. Phelps*, 3 Blatch., 91.

§ 4540. Where defendants worked the infringing machine under a license to use, granted by an officer of the corporation owning the patent and the machine, *held*, that he should be made a party defendant in order to procure a perpetual injunction against him. *Nichols v. Pearce*, 7 Blatch., 5.

§ 4541. If those who have used an infringing machine lease it to others, who continue to use it, and there are circumstances indicating complicity between them, a joint bill will be sustained against all the parties. *Wells v. Jaques*, 5 O. G., 364.

§ 4542. The defendants were members of a joint stock association capable of being sued without making all its shareholders parties. The infringing device was owned by the association, and used by its agents for the benefit of its stockholders. *Held*, that a suit in which several of the shareholders were individually joined was properly brought, and that each defendant was liable to be enjoined. Bill, however, dismissed against a party who was an officer of the association, but not a shareholder. *Tyler v. Galloway*, 22 O. G., 1294.

See *Bill*, §§ 655, 656.

§ 4543. Where a motion for preliminary injunction was brought by grantee of the extended term of the patent, an objection on the ground of non-joinder of assignee of the original term, whose interest had expired, was not sustained. *Goodyear v. Hullihen*, 2 Hughes, 492.

§ 4544. Where of two joint owners, A. and B., of a patent, the suit was brought in the name of B., who by power of attorney from A. had been appointed to prosecute, compromise, etc., by suits any infringement of the rights of A., *held*, that under section 4919, Revised Statutes, A. should also be made a party, and demurrer to bill on such ground was allowed. *Goldsmith v. American Paper Collar Co.*, 18 Blatch., 82.

§ 4545. In suits at law, under section 4919, for infringement of an expired patent, where assignments of the patent do not include claims for past infringements, the owners of the patent at the date of such infringement should be joined as parties plaintiff; but if they contain claims for past infringement, then the assignee becomes the "party interested" under the section, and has the right to sue in his own name for such infringements. *Adams v. Bel-lair Stamping Co.*, 25 Fed. Rep., 270.

246. PARTNERSHIP.

See *ESTOPPEL*, §§ 2182-2193. *OWNERS, JOINT*, § 4480. *TITLE*, § 6313.

§ 4546. A joint interest in a patent does not constitute the parties partners. *Parkhurst v. Kinsman*, 1 Blatch., 488.

§ 4547. Where two parties were associated together in partnership for the purpose of making a certain invention, and partner A. was by assignment vested with the legal title of the patent and the chief conduct of the partnership affairs, *held*, that under one of the articles of partnership agreement he was chargeable as trustee with one-half of what had been or might be realized on the patent and its improvement. *Ambler v. Whippel*, 20 Wall., 546.

§ 4548. Where it was admitted that the machines in which plaintiff, as member of the firm, had embodied his subsequently patented inventions, were the property of the firm, *held*, that all the partners had an equal proportionate right in them; and that when the firm dissolved and plaintiff consented to convey all the assets to defendants, the other partners, his reservation of the exclusive right to an important part of the machines was useless and void, for by reason of his being only a part owner he could not have this exclusive right. *Wade v. Metcalf*, 16 Fed. Rep., 130.

§ 4549. Where the defendants dissolved partnership, but two of them continued to use the infringing device, *held*, that each was liable for the whole damages, and that the right of the party injured to look to either as well as to all of the defendants for the whole damages is not confined to a resort to a court of law, but is recognized and enforced when resort is had to a court of equity. *Herring v. Gage*, 15 Blatch., 124.

§ 4550. Where, after injunction and account, filing of master's report showing amount due plaintiff for infringement by a partnership of three, and opinion on exceptions to report filed, but no final decree entered, *held*, on death of one partner and filing of bill of revivor against his executor, that the liability was in its nature *ex contractu* and a copartnership liability, and devolved upon them as survivors; that the suit did not abate; that there was nothing in an equity suit on letters patent and prayer for account and profits which withdrew it from its operation. And there being no allegations of survivors' insolvency, the bill must be dismissed. *Troy Iron & Nail Factory v. Winslow*, 11 Blatch., 513.

247. PATENTABILITY.

See COMBINATION, PATENTABILITY OF. COMPOSITION, PATENTABILITY OF. IMPROVEMENT, PATENTABILITY OF. FORMAL CHANGE, PATENTABILITY. PRINCIPLE, PATENTABILITY OF. PROCESS, PATENTABILITY OF. PRODUCT, PATENTABILITY OF. SUGGESTIONS.

SUMMARY (*RECKENDORFER v. FABER*, §§ 4551-4559) — *Patentability, act 1836*, § 4551. — *Commissioner's grant of patent not conclusive as to validity*, § 4552. — *Utility or novelty*, § 4553. — *The patent considered*, § 4554. — *What is essential to patentability*, § 4555. — *Double use is not patentable*, § 4556. — *Mechanical skill is not patentable*, § 4457. — *Combination and aggregation*, § 4558. — *The particular device is not patentable*, § 4559.

RECKENDORFER v. FABER.

(2 Otto, 347-358. 1875.)

APPEAL from U. S. Circuit Court, Southern District of New York.

Opinion by MR. JUSTICE HUNT.

STATEMENT OF FACTS.— This is an appeal from a decree of the United States circuit court for the southern district of New York, dismissing the bill of complaint which was filed to restrain the infringement by the respondent of certain letters patent, and for an accounting and damages. These patents relate to the manufacture of combined pencils and erasers.

1. The first [No. 19,783] was granted to Hymen L. Lipman, March 30, 1858, and was extended for a further term of seven years from the 30th of March, 1872. The material parts of the specification are as follows:

"I make a lead-pencil in the usual manner, reserving about one-fourth of the length, in which I make a groove of suitable size, *A*, and insert in this groove a piece of prepared india-rubber (or other erasive substance), secured to said pencil by being glued at one edge. The pencil is then finished in the usual manner, so that on cutting one end thereof you have the lead, *B*, and on cutting at the other end you expose a small piece of india-rubber, *C*, ready for use, and particularly valuable for removing or erasing lines, figures, etc., and not subject to be soiled or mislaid on the table or desk. In making mathematical, architectural and many other kinds of drawings in which the lines are very near each other, the eraser is particularly useful, as it may be sharpened to a point to erase any marks between the lines; and, should the point

of the rubber become soiled or inoperative from any cause, such cause is easily removed by a renewed sharpening, as in the ordinary lead-pencil."

The claim is as follows: "I do not claim the use of a lead-pencil with a piece of india-rubber, or other erasing material, attached to one end for the purpose of erasing marks; but what I do claim as my invention, and desire to secure by letters patent, is the combination of the lead and india rubber, or other erasing substance, in the holder of a drawing-pencil, the whole being constructed and arranged substantially in the manner and for the purposes set forth."

The drawings forming part of the specification exhibit a continuous sheath of uniform size, with interior grooves of different sizes, the eraser groove being larger than the lead groove.

2. The second patent is for an improvement upon the invention of Lipman, and was granted to Joseph Reckendorfer, the complainant [No. 36,854] the 4th of November, 1862, and reissued [No. 3,863] on the 1st of March, 1872. The material parts of the specification are as follows:

"My invention is intended to provide a means whereby articles of greater size or diameter than the lead may be securely held in the head of a pencil of otherwise ordinary or suitable construction, without making the body of the pencil cumbrous or inconvenient. To this end, my invention consists —

"*First*. Of a pencil composed of a wooden sheath and lead core, having one end of the sheath enlarged and recessed to constitute a receptacle for an eraser or other similar article, as hereinafter stated.

"*Second*. Of a pencil, the wooden case of which gradually tapers from the enlarged and recessed head towards its opposite end for the whole or a portion of the length, as hereinafter set forth.

"The receptacle for the eraser or other article is formed in the head, without too much weakening the wood, owing to the form of the sheath; while, for the same reason, the end of the pencil which contains the ordinary lead is not cumbrous nor clumsy, but can be readily held between the fingers, just as an ordinary pencil is."

Having thus described his invention, Reckendorfer claims:

"1st. A pencil composed of a wooden sheath and lead core, having one end of the sheath enlarged and recessed to constitute a receptacle for an eraser, or other similar article, as shown and set forth.

"2d. A pencil, the wooden case of which gradually tapers from its enlarged and recessed head towards its opposite end for the whole or a portion of its length, substantially as shown and described."

The points we propose here to discuss are two: *First*. Is the article patented by the plaintiff and his assignor, and for the infringement of which patents this action is brought, a patentable invention within the laws of the United States? *Second*. Is it within the power of the courts to examine and determine this question? or is the decision of the commissioner of patents, when, by issuing a patent, he decides that the invention is patentable, final and conclusive on the point?

The plaintiff contends that the decision of the commissioner is conclusive upon the point of invention; and that the question, as distinct from that of want of novelty, is one not open to the judgment of the court. In the natural order of things, this question is the first one to be examined; for if it shall appear that the contention of the plaintiff is correct in this respect, the question in regard to the patentability of the instrument now before us will

not arise. The point will have been decided for us, and by a controlling authority.

§ 4551. *Section 6, act of 1836, construed. Patentability.*

The "act to revise, consolidate and amend the statutes relating to patents and copyrights," passed July 4, 1836 (5 U. S. Stat., 118), is the act regulating this case. By the sixth section thereof it is enacted, "that any person having invented or devised any new and useful art, machine, manufacture, or composition of matter, not known or used by others before his invention or discovery thereof, and not at the time of his application for a patent in public use, or on sale with his consent or allowance as the inventor or discoverer, and shall desire to obtain an exclusive property therein, may make application in writing to the commissioner, expressing such desire; and the commissioner, on due proceedings had, may grant a patent therefor. . . . He shall make oath that he believes himself to be the first inventor or discoverer thereof, and that he does not know or believe that the same has ever before been used."

Looking at this section alone, it may be safely said no one is entitled to a patent unless (1) he has discovered or invented an art, machine or manufacture; (2) which art, machine or manufacture is new; (3) which is also useful; (4) which is not known or patented as therein mentioned. It is not sufficient that it is alleged or supposed, or even adjudged, by some officer, to possess these requisites. It must, in fact, possess them; and that it does possess them the claimant must be prepared to establish in the mode in which all other claims are established, to wit, before the judicial tribunals of the country.

The seventh section of the act (p. 120) provides that on the filing of any such application, etc., and the payment of the duty required by law, the commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on such examination, it shall not appear to the commissioner that the same has been invented or discovered by any other person in this country prior to the alleged discovery, or patented or described in any foreign publication, or been in public use or on sale with the consent of the applicant, and if he shall be of the opinion that the same is sufficiently useful and important, the commissioner shall issue a patent therefor.

Before the commissioner is authorized to issue a patent, it must appear to him that the claimant is justly entitled to a patent; *i. e.*, that his art, machine or manufacture possesses all the qualities before mentioned. The commissioner must also be satisfied, that, if it possesses these qualities, it is sufficiently useful and sufficiently important to justify him in investing it with the *prima facie* respect arising from the governmental approval. These restrictions are wise and prudent; are intended to secure at least a probable advantage to those who deal with the favorites of the government; for they may justly be so termed who receive the exclusive right of making or using or vending particular arts or improvements.

§ 4552. *The ruling of the courts is uniform in holding that the decision of the commissioner of patents in the allowance and issue of patents gives a prima facie right only, and that the validity of the patent is subject to examination by the courts; and such ruling is sound.*

It is nowhere declared in the statute that the decision of the commissioner as to the extent of the utility or importance of the improvement shall be conclusive upon that point; but in the section just quoted it is placed in the same category with the want of novelty and the other requisites of the statute; and it is expressly conceded by the appellant that the judgment of the commis-

sioner on the question of novelty is not conclusive, but that that point is open to examination. On that subject the practice of the courts is uniform in holding it to be subject to inquiry.

The plaintiff's counsel, in his brief, put his argument in this form: "The commissioner, then, passes on these questions: (1) Did the applicant himself make the invention? This question is settled by his oath." This is true to the extent and for the purpose of issuing a patent, and to this extent only. When the patentee seeks to enforce his patent he is liable to be defeated by proof that he did not make the invention. The judgment of the commissioner does not protect him against the effect of such evidence. (2) The counsel says: "Was the invention new? This question is solved by the examination required by the act." To the same extent only. The defense of want of novelty is set up every day in the courts, and is determined by the court or the jury as a question of fact upon the evidence adduced, and not upon the certificate of the commissioner. (3) The counsel says again: "Is the invention sufficiently useful and important? This the commissioner settles for himself by the use of his own judgment. It is a question of official judgment." These questions are all questions of official judgment, and are all settled by the judgment of the commissioner. His judgment goes to the same extent upon each question. He determines and decides for the purpose of issuing or refusing a patent. When the patent is sought to be enforced, the questions, and each of them, are open to judicial examination. We see many reasons why all the questions of invention, novelty and prior use should be open to examination in each case; and such we believe to be the course of the authorities and practice of the courts.

A reference to some of the most recent cases, and to those decided by this court, will be sufficient. A review of all the cases in this court, and the various circuit courts where this question has been alluded to, will not be profitable. In *Hotchkiss v. Greenwood*, 11 How., 248, a patent had been granted for a "new and useful improvement in making door and other knobs of all kinds of clay used in pottery and of porcelain," by having the cavity in which the screw, or shank, is inserted, by which they are fastened, largest at the bottom of its depth, in form of a dovetail, and a screw formed therein by pouring in metal in a fused state. The precise question argued in this court and decided was of the patentability of this invention, and it was held not to be patentable. The only thing claimed as new was the substitution of a knob made of clay or porcelain for one made of wood. This, it was said, might be cheaper or better; but it was not the subject of a patent. The counsel for the defendants, in their points, there say: "The court now is called upon to decide whether this patent can be sustained for applying a well-known material to a use to which it had not before been applied, without any new mode of using the material, or any new mode of manufacturing the article sought to be covered by the patent." Mr. Justice Nelson delivered the opinion of the court to the effect already stated. Mr. Justice Woodbury dissented, not upon the question of the power of the court to pass upon the validity of the patent, but rather in regard to the manner in which the facts were submitted to the jury.

In *Stimpson v. Woodman*, 10 Wall., 117, it was decided that the engraving or stamping of the figure upon the surface of a roller for pebbling leather by pressure, where the use previously had been of a smooth roller, required no invention; that it was a change involving mechanical skill merely, and not

patentable. Mr. Justice Clifford dissented from the majority of the court, but expressly says that the question of patentability is for the decision of the jury, and not for the court, upon a bill of exceptions. The majority of the court held that the question could be considered upon a bill of exceptions; and no one claimed that the decision of the commissioner concluded the question.

In *Hailes v. Van Wormer*, 20 Wall., 353 (§§ 866-72, *supra*), the question of the patentability of certain improvements in stoves was largely discussed in this court upon appeal from the circuit court for the northern district of New York. It was held that, if a new combination produces new and useful results, it is patentable, though all the constituents of the combination were known and in use previous to the combination; but the results must be the product of the combination, not a mere aggregate of several results, each the complete product of one of the combined elements. It was held that the facts there present did not create a compliance with this principle; and the judgment that the plaintiff's bill be dismissed was affirmed.

In *Rubber Tip Pencil Co. v. Howard*, 20 Wall., 498, the same principle was affirmed. In delivering the opinion, the chief justice says: "The question which naturally presents itself for consideration at the outset of this inquiry is, whether the new article of manufacture claimed as an invention was patentable as such; if not, there is an end of the case, and we need not go farther." He makes a careful examination of the claim, and concludes that there is nothing patentable in the character of the invention. The decree of the court below dismissing the bill was unanimously affirmed upon that ground.

In *Smith v. Nichols*, 21 Wall., 115, an elaborate opinion to this same effect was delivered by Mr. Justice Swayne, and concurred in unanimously by the court. The only question discussed is the patentability of the invention. *Hicks v. Kelsey*, 18 Wall., 670, is a similar case. To this rule the case of *Lyman v. Osborne*, 11 Wall., 516, cited by the defendant, is no exception. The remarks there made are chiefly upon the subject of reissues, and are in accordance with the principles above set forth. Even as to reissues, their conclusiveness is limited to questions of fact, and is accompanied by the statement that they are re-examinable in court, when it is apparent upon the face of the patent that the commissioner has exceeded his authority, or there is such a repugnance between the old and the new patent that it must be held as a matter of legal construction that the new patent is not for the same invention as that embraced and secured in the original patent. Pages 543, 544.

We do not attach much significance to the fact that the fifteenth section of the act of 1836 allows the defendant to plead the general issue, and to give in evidence, upon thirty days' notice, special matter tending to prove the various matters therein referred to. The statute in that respect was intended to create an easy system of pleading, and to relieve from any doubt the admissibility in that form of the defenses specified. The argument, that because permission is given to prove, under the general issue, that the specification does not contain the whole truth, or that it intentionally and deceitfully contains too much, or that the patentee was not the first discoverer, or that it had been in prior use, it follows that proof that there is no invention or discovery at all, or that the invention has no importance, cannot be made, is quite unsound. Proof that there is no invention or discovery strikes at the root of the whole claim. The patent is based on an affirmative fact, of which this is the direct negative. It needed no statute to aid or justify this defense. It is provable when it exists

under any general denial, like the fact of not guilty or *non-assumpsit* in cases where guilt or a promise is first to be established.

§ 4553. *The decision of the commissioner of patents is not conclusive as to the extent of the utility, importance or novelty of the subject-matter of invention.*

Upon the proposition that the decision of the commissioner on the question of invention, its utility and importance, is conclusive, and that the same is not open to examination in the courts, we are unanimously of the opinion that the proposition is unsound. His decision in the allowance and issue of a patent creates a *prima facie* right only; and upon all the questions involved therein the validity of the patent is subject to an examination by the courts.

§ 4554. *Patentability of Lipman's device. Considered as no invention.*

We come, then, to the questions, Does the article patented by Lipman, and improved by Reckendorfer, involve an invention? or is it a product of mechanical skill or a construction of convenience only? The article presented is for the performance of mechanical operations to produce mechanical results, and is a mechanical instrument as much as a brush, a pen, a stamp, a knife, a file or a screw. Whether it is styled a manufacture, a tool or a machine, it is an instrument intended to produce a useful mechanical result; and the question presents itself, Does it embody any new device, or any combination of devices producing a new result?

In the first place, what is not claimed by the specification of Lipman is to be observed. "I do not claim," he says, "the use of a lead-pencil with a piece of rubber attached at one end." Of course he does not claim a lead-pencil as his invention, nor the use of a strip of india-rubber for erasure. Each of these articles had been in long and general use. But he claims as his invention "the combination of the lead and india-rubber in the holder of a drawing pencil," in the manner set forth. There is nothing peculiar in the manner set forth. The claim is simply of the combination of the lead and india-rubber in the holder of a drawing pencil; in other words, the use of an ordinary lead-pencil, in one end of which, and for about one-fourth of its length, is inserted a strip of india-rubber, glued to one side of the pencil. The pencil is to be made in the "usual manner:" *i. e.*, he takes an ordinary lead-pencil, and in this he makes "a groove of suitable size," giving no idea of what he deems a suitable size; and in this groove he inserts a piece of prepared india-rubber, which is glued to one edge of the pencil. "The pencil is then finished in the usual manner; so that, in cutting one end thereof, you have the lead, *B*, and on cutting the other end you expose a small piece of india-rubber, *C*, ready for use." It is evident that this manner of making or applying the instrument gives no aid to the patent. It must rest where the patentee claims to place it; that is, on the combination.

This combination consists only of the application of a piece of rubber to one end of the same piece of wood which makes a lead-pencil. It is as if a patent should be granted for an article or a manufacture, as the patentee prefers to term it, consisting of a stick twelve inches long, on one end of which is an ordinary hammer, and on the other end is a screw-driver or a tack-drawer, or, what you will see in use in every retail shop, a lead-pencil, on one end of which is a steel pen. It is the case of a garden rake, on the handle end of which should be placed a hoe, or on the other side of the same end of which should be placed a hoe. In all these cases there might be the advantage of carrying about one instrument instead of two, or of avoiding the liability to loss or misplacing of separate tools. The instruments placed upon the same

rod might be more convenient for use than when used separately. Each, however, continues to perform its own duty, and nothing else. No effect is produced, no result follows from the joint use of the two.

§ 4555. *To obtain patentability the law requires more than a change of form, or juxtaposition of parts, or of the external arrangement of things, or of the order in which they are used. There must be a different force or effect produced or a different result in the combined forces or processes from that given by their separate parts.*

A handle in common, a joint handle, does not create a new or combined operation. The handle for the pencil does not create or aid the handle for the eraser. The handle for the eraser does not create or aid the handle for the pencil. Each has and each requires a handle the same as it had and required, without reference to what is at the other end of the instrument; and the operation of the handle of and for each is precisely the same, whether the new article is or is not at the other end of it. In this and the cases supposed you have but a rake, a hoe, a hammer, a pencil, or an eraser, when you are done. The law requires more than a change of form, or juxtaposition of parts, or of the external arrangement of things, or of the order in which they are used, to give patentability. Curtis on Patents, sec. 50; Hailes v. Van Wormer, 20 Wall., 353 (§§ 866-72, *supra*).

§ 4556. *A double use is not patentable.*

A double use is not patentable, nor does its cheapness make it so. Curtis, secs. 56, 73.

§ 4557. *An instrument or manufacture which is the mere result of mechanical skill is not patentable.*

An instrument or manufacture which is the result of mechanical skill merely is not patentable. Mechanical skill is one thing; invention is a different thing. Perfection of workmanship, however much it may increase the convenience, extend the use, or diminish expense, is not patentable. The distinction between mechanical skill, with its conveniences and advantages, and inventive genius, is recognized in all the cases. Rubber Tip Pencil Co. v. Howard, and other cases, *supra*; Curtis, sec. 72b.

§ 4558. *Patentable combination and aggregation distinguished.*

The combination, to be patentable, must produce a different force or effect, or result in the combined forces or processes, from that given by their separate parts. There must be a new result produced by their union; if not so, it is only an aggregation of separate elements. An instance and an illustration are found in the discovery, that, by the use of sulphur mixed with india-rubber, the rubber could be vulcanized, and that without this agent the rubber could not be vulcanized. The combination of the two produced a result or an article entirely different from that before in use. Another illustration may be found in the frame in a saw-mill which advances the log regularly to meet the saw, and the saw which saws the log; the two co-operate and are simultaneous in their joint action of sawing through the whole log; or in the sewing-machine, where one part advances the cloth and another part forms the stitches, the action being simultaneous in carrying on a continuous sewing. A stem-winding watch-key is another instance. The office of the stem is to hold the watch or hang the chain to the watch; the office of the key is to wind it. When the stem is made the key, the joint duty of holding the chain and winding the watch is performed by the same instrument. A double effect is produced or a double duty performed by the combined result. In these and numerous like

cases the parts co-operate in producing the final effect, sometimes simultaneously, sometimes successively. The result comes from the combined effect of the several parts, not simply from the separate action of each, and is, therefore, patentable.

§ 4559. *A combination made by inserting in a groove at the end of a lead-pencil an eraser, so that by using one end one has a pencil, by using the other an eraser, is not patentable. There is no new result, no joint operation thereby produced.*

In the case we are considering, the parts claimed to make a combination are distinct and disconnected. Not only is there no new result, but no joint operation. When the lead is used, it performs the same operation and in the same manner as it would do if there were no rubber at the other end of the pencil; when the rubber is used, it is in the same manner and performs the same duty as if the lead were not in the same pencil. A pencil is laid down and a rubber is taken up, the one to write, the other to erase; a pencil is turned over to erase with, or an eraser is turned over to write with. The principle is the same in both instances. It may be more convenient to have the two instruments on one rod than on two. There may be a security against the absence of the tools of an artist or mechanic from the fact that the greater the number, the greater the danger of loss. It may be more convenient to turn over the different ends of the same stick than to lay down one stick and take up another. This, however, is not invention within the patent law, as the authorities cited fully show. There is no relation between the instruments in the performance of their several functions, and no reciprocal action, no parts used in common.

We are of the opinion that, for the reasons given, neither the patent of Lipman nor the improvement of Reckendorfer can be sustained, and that the judgment of the circuit court dismissing the bill must be affirmed.

JUSTICES STRONG, DAVIS AND BRADLEY dissented.

Dissenting opinion by MR. JUSTICE STRONG:

I dissent from so much of the opinion of the majority of the court as holds that the instrument or manufacture described in the patents exhibits no sufficient invention to warrant the grant of a patent for it.

Patentability — Generally, §§ 4560-4567.

§ 4560. An applicant will not be entitled to a patent for doing an old thing because he is the first to do the thing with the "intent" to produce a certain beneficial effect, which was before obtained, but not observed, nor for producing that effect in accordance with a pre-conceived "system" or "plan," which refers at most to the purpose or intent with which the thing is done. *In re Kemper*, 1 MacA. Pat. Cases, 1.

§ 4561. In cases of doubt as to invention, it will be congenial with the policy of the law to issue a patent to the petitioner, thereby giving him an opportunity of trying the validity of his right. *Wirt's Opinion*, 2 Op., 52.

§ 4562. A new and useful machine invented by a slave cannot be patented. *Black's Opinion*, 9 Op., 171.

§ 4563. What constitutes patentable changes in old devices. *Bray v. Hartshorn*, 1 Cliff., 538.

§§ 4564-5. If, to attain the utility and convenience which the union of two implements produces, something new in the construction of the implements, or some new device requiring thought or study more or less, it is necessary to unite them, such union may be patentable. *Reckendorfer v. Faber*, 12 Blatch., 68.

§ 4566. The patentability of an alleged invention is, in many cases, most satisfactorily shown by its utility. *Penna. Salt Co. v. Thomas*, 5 Fish., 148.

§ 4567. The tendency of the late decisions of the supreme court is to the effect that the question of patentability, in view of the state of the art, is to be examined with increased attention. *Bradley & Hubbard Manufacturing Co. v. Charles Parker Co.*, 17 Fed. Rep., 240.

See *Commissioner*, § 1085. *Process*, § 5032. *Process and Product*, § 5106.

Patentability — Change of form or structure — *Mere change of form not patentable*, §§ 4568-4571; *or change of structure, effecting no change in operation*, §§ 4571-4574.

§ 4568. When changes of form involve functional differences, producing new or better results, they are patentable. *The Swain Turbine and Manufacturing Co. v. Ladd*, 11 O. G., 153.

§ 4569. There cannot be a patent for a mere form, unless the form is of the essence of the invention. *Wilson Packing Co. v. Clapp*, 8 Biss., 545.

§ 4570. A mere change of form or proportion is not patentable; but if by changing the form or proportion a new effect is produced, it is not simply a change of form or proportion, but a change of principle, and is the proper subject of a patent. *In re Fultz*, 1 MacA. Pat. Cases, 178.

§ 4571. A patent must be for a specific machine, substantially new in its structure and mode of operation, and not for mere change of form or proportion. *Lowell v. Lewis*, 1 Mason, 182.

§ 4572. Incidental changes in the arrangement of the parts of a structure, arising out of an obvious application of the same to a new use, and effected by means of well known devices, are not patentable. *In re Everson*, 1 MacA. Pat. Cases, 406.

§ 4573. Such merely structural modifications which do not change the operation of a device are not patentable, though they produce a better result, if the result be of the same kind. *Ex parte Greeley*, 1 Holmes, 284.

§ 4574. In patents for small articles, slight differences are often important; and if such things are patentable at all, it must almost always be in virtue of a more useful adaptation to the needs of commerce by small changes of structure, which in a great machine might be merely alternate modes of reaching a part of a general result. *Emerson v. Howe*, 8 Fed. Rep., 327.

Patentability — Of degree, §§ 4575, 4576.

§ 4575. An article made according to a known method may be better than other articles made in the same manner on account of its superior mechanism, but this is no foundation of an exclusive right. *Hotchkiss v. Greenwood*, 4 McL., 456.

§ 4576. A mere reduction in size of an old device, so as to make it small enough for a new use, cannot support a claim to a patent. *Double Point Tack Co. v. Two Rivers Mfg. Co.*, 9 Biss., 258.

Patentability — Of change in location, §§ 4577-4584.

§ 4577. If new devices are required in order to adapt an old apparatus to a new position on a machine, and the change produces a new and beneficial result, then the change is patentable in connection with the new devices; not the result, but the means of producing it. *Marsh v. Dodge & Stevenson Manufacturing Co.*, 5 O. G., 398.

§ 4578. Or, if such a change brings into existence a new combination of devices productive of a new and useful result, the new combination is patentable. *Ibid.*

§ 4579. The patent will not be infringed in either case by a like change in the location of the apparatus, unless the new devices which adapt it to its new position are also used in one case, and unless all the material elements of the newly-developed combination are employed in the other. *Ibid.*

§ 4580. Merely placing an old apparatus in a new location upon a machine is not patentable. *Ibid.*

§ 4581. Mere change of use by placing an old device in a different position with regard to another old device is not patentable. *Swaine Turbine Manufacturing Co. v. Ladd*, 12 Otto, 408.

§ 4582. In changing the location of an apparatus upon a machine, it seems not to be patentable to adopt such mechanical changes to render it practicable as mere judgment dictates or the necessity of the case demands. *Marsh v. Dodge & Stevenson Manufacturing Co.*, 5 O. G., 398.

§ 4583. To change the relative position of the parts of a mechanism is not patentable, where no different or additional function is performed. *Dane v. Illinois Manufacturing Co.*, 3 Biss., 374.

§ 4584. Neither is such a change entitled to greater favor because one of the parts thus transposed is made to perform an additional function, if a similar device has been made before to serve the same purpose in the same situation. *Ibid.*

Patentability — Of a machine — *When patentable*, §§ 4585-4592. *When not*, §§ 4593-4595.

§ 4585. A machine is patentable only when substantially new. *Tyler v. Devil*, 1 Am. L. J., 248.

§ 4586. A new part of a machine, which is useful, or some new combination, *i. e.*, a new arrangement of old parts, is patentable. *Hovey v. Stevens*, 3 W. & M., 17.

§ 4587. Where there is novelty in the application and in the machine, and if it produces new and valuable results, it is patentable, whether the combination is new, or an important part only is new. *Adams v. Edwards*, 1 Fish., 1.

§ 4588. A new machine, which accomplishes the same end as a former one, but by substantially different means, is patentable. *Eames v. Cook*, 2 Fish., 146.

§ 4589. If a machine is an advance upon the existing state of the art, it is patentable, although it does not at first accomplish perfectly all that was designed, nor all that was expected of it, but is found in practice to contain imperfections which can be remedied with ordinary skill. *Seymour v. Marsh*, 2 O. G., 675.

§ 4590. An invention is not patentable until a machine has been perfected, and, if not actually used, made capable of useful operation. *Moore v. Thomas*, 14 O. G., 1.

§ 4591. It is not necessary for a machine to be automatic in order to be patentable. *Coupe v. Weatherhead*, 16 Fed. Rep., 673.

§ 4592. The mere function of a machine is not a patentable subject, but a mechanical device, adapted to perform special functions, is, whether its operative efficiency depends upon its combination with other mechanism or not. *Parkham v. American Button Hole & Sewing Machine Co.*, 4 Fish., 468.

§ 4593. The mere alteration or enlargement of a part of a mechanism, so as to make it serve a second and minor purpose, is not patentable. *Dane v. Chicago Mfg. Co.*, 3 Biss., 380.

§ 4594. That the omission of certain elements in a prior patented machine might enable a mechanic to alter and employ the remnant like the infringed machine is no test of the patentability of the latter. *Cawood Patent*, 4 Otto, 695.

§ 4595. This is to be determined by the question whether the information necessary to construct and use the latter machine can be read out of the prior specification. *Ibid.*

Patentability — Requires novelty, utility, invention, §§ 4596-4606. See *Novelty*, §§ 4341-4345. *Utility*, §§ 6655-6658.

§ 4596. New contrivances, though applied to old objects, are patentable. *Bray v. Harts-horn*, 1 Cliff., 538.

§ 4597. New materials applied to useful purposes are patentable. (Woodbury, J., dissenting opinion.) *Hotchkiss v. Greenwood*, 11 How., 248.

§ 4598. Such things are patentable as the discoverer undertakes to apply, in combination or separately, so as to produce new and beneficial results. *Adams v. Edwards*, 1 Fish., 1.

§ 4599. An invention is patentable if it is new and better and cheaper than that which preceded it. (Woodbury, J., dissenting opinion.) *Hotchkiss v. Greenwood*, 11 How., 248.

§ 4600. To entitle to a patent, the invention must be new and useful. *Roberts v. Ward*, 4 McL., 565; *Parker v. Stiles*, 5 McL., 44.

§ 4601. Novelty and utility in the improvement seem to be all that the statute (act 1836) requires as a condition to the granting of a patent. *McCormick v. Seymour*, 2 Blatch., 240.

§ 4602. Duplication producing a new and useful result may be patentable. *Parker v. Hulm*, 1 Fish., 44.

§ 4603. The statutes do not require inventions to be superior to or better than all other things known to be patentable. It is sufficient, if they are useful in themselves, if they are also new. *Shaw v. Colwell Lead Co.*, 11 Fed. Rep., 711.

§ 4604. A patentable subject must not only be new and useful, but must involve some exercise of the inventive faculty; neither must it be merely the application of an old thing to a new use. *Penna. Salt Co. v. Thomas*, 5 Fish., 148.

§ 4605. Invention or discovery constitutes the foundation of the right to obtain a patent, and nothing short of this will support it. *Dunbar v. Myers*, 4 Otto, 187.

§ 4606. It is not enough that a thing shall be new, in the sense that in the shape or form in which it is produced it shall not have been before known, and that it shall be useful, but it must, under the constitution and the statute, amount to an invention or discovery. *Thompson v. Boisselier*, 114 U. S., 1.

Patentability — Of result — *When not patentable*, §§ 4607-4613. *When patentable*, §§ 4614-4616.

§ 4607. A result is not patentable. *Bean v. Smallwood*, 2 Story, 409; *Case v. Brown*, 1 Biss., 382; *Carver v. Hyde*, 16 Pet., 513.

§ 4608. Results are not patentable, but only means used to produce results. *Burr v. Cowperthwait*, 4 Blatch., 163; *New Process Fermentation Co. v. Maus*, 20 Fed. Rep., 725.

§ 4609. He who produces an old result by a new mode or process is entitled to a patent for that mode or process. But he cannot patent a result merely without using some new mode to produce it. *Howe v. Abbott*, 2 Story, 191.

§ 4610. Effect only is unpatentable. A patent may be for an effect produced in a given manner or by a peculiar operation. *Whittemore v. Cutter*, 1 Gall., 478.

§ 4611. A result, a new property of matter, is not patentable, unless practically applied and the process stated with precision. *Le Roy v. Tatham*, 14 How., 156.

§ 4612. An inventor whose invention produces a particular "result" or "effect" cannot patent such result or effect, but only his machine. *Case v. Brown*, 2 Wall., 320.

§ 4613. A result is not patentable, and claims nominally for results will, if possible, be construed to be for the apparatus or certain portions thereof, as described in the specification of the patent. *Fuller v. Yentzer*, 4 Otto, 299.

See *Process*, § 5031.

§ 4614. An improved paper bag is a patentable "result." *Arkell v. J. M. Hurd Paper Bag Co.*, 7 Blatch., 475.

§ 4615. An old result produced by new means is patentable. *Heinrich v. Luther*, 6 McL., 345.

§ 4616. If an inventor is the first to produce a result, he is entitled to all means known at the date of his patent by which the same result can be produced. *Kuhl v. Mueller*, 21 Fed. Rep., 510.

See *Claims, Construction of*, § 786.

Patentability — Particular cases, §§ 4617-4623.

§ 4617. The capacity of a chemical agent to produce any specific effect, medical or other, is not a thing patentable. *Cushing's Opinion*, 8 Op., 270.

§ 4618. *Held*, that, in curing fish, the removal of a part not before known to be injurious, but in reality so, is patentable. *Crowell v. Harlow*, 1 Fed. Rep., 140.

§ 4619. The discovery that the foam in beverages can be increased by the use of saponine is a patentable discovery of a new use in a combination to produce a better result than was known before. *Bowker v. Dows*, 15 O. G., 510.

§ 4620. An article is not patentable because it is superior in its kind, if that is owing to its embracing a combination of elements, each superior in itself, and they do not have any mutual co-operation. *Sarven v. Hall*, 9 Blatch., 524.

§ 4621. A monopoly of the use of a well known substance in a well known application (or form) cannot be permitted. *Tarr v. Webb*, 10 Blatch., 96.

§ 4622. To make and sell a part of a known thing as a separate article is not patentable. *Seligman v. Day*, 14 Blatch., 72.

§ 4623. The fact that an invention is in the form and design of a book does not therefore make it a subject for copyright, and therefore not patentable. *Munson v. Mayor, etc., of the City of New York*, 18 Blatch., 237.

Patentability — Pleading and practice, §§ 4624-4626.

§ 4624. On the hearing of a bill in chancery to enjoin the infringement of a patent the court may inspect the patented product, and from this, without other evidence, declare it not patentable. *Everett v. Thatcher*, 2 Flip., 234.

§ 4625. But it is not necessary to set forth in the pleadings that the subject of the invention is not patentable in its character; it may be shown under the general issue. *Guidet v. Barber*, 5 O. G., 149.

§ 4626. The question whether or not an alleged improvement is or is not patentable is, in an equity suit, a question for the court. *Dunbar & Hopper v. Myers*, 4 Otto, 187.

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See ANTEDATING PATENTS. REPEAL OF PATENTS. CONSTRUCTION OF PATENTS. CONTRACTS, CONCERNING PATENTS. COPIES, OF SPECIFICATIONS AND PATENTS. INJUNCTION, EXPIRATION OF PATENT. EXPIRED PATENT. FOREIGN PATENTS. GRANT, OF A PATENT. GRANT, UNDER A PATENT. INTERFERING PATENTS. SCOPE OF PATENT. SURRENDER OF PATENT. VALIDITY OF PATENT. VOID PATENTS. As to Secret Patent, see FOREIGN PATENTS, §§ 2519, 2533, 2536; TERM, § 6270.

Patent — Presumption of law raised by, §§ 4627-4635.

§ 4627. Letters patent are granted by public authority, and when issued, and regular in form, the presumption is that the power was rightly exercised; and he who alleges the contrary must prove it. *Goodyear Dental Vulcanite Co. v. Wetherbee*, 3 Cliff., 555.

§ 4628. The presumption in favor of a patent is strongly fortified if it has been reissued, and there has been a long acquiescence in the enjoyment of it, and its validity has been sustained when questioned before legal tribunals. *American Nicholson Pavement Co. v. City of Elizabeth*, 3 O. G., 522.

§ 4629. The patent raises the presumption of the novelty and utility of the plaintiff's invention. *Parker v. Styles*, 5 McL., 44.

§ 4630. The presumption on the grant of a patent is that patentee is the first and original inventor. *Blanchard v. Puttman*, 2 Bond, 84.

§ 4631. The presumption is that a person obtains a patent for something practical, not for a mere experiment. *Pitts v. Wemple*, 1 Biss., 87.

§ 4632. A patent raises the presumption that the grantee is the first inventor of the article monopolized; and, to overcome this, it must be shown that there was a prior knowledge of the invention, under such circumstances as to give the public a right to continue the use of it. *Crouch v. Speer*, 6 O. G., 187.

§ 4633. The presumptions of the law are in favor of the patent and the utility of the invention. *Geier v. Goetinger*, 7 O. G., 563.

See *Utility*, §§ 6669-6674.

§ 4634. Patented articles are presumed to be patentably different from those covered by other patents. *Buerk v. Imhaueser*, 11 O. G., 112.

§ 4635. A patentee is entitled to the presumption of priority which his patent affords, and this presumption is only overcome by clear and satisfactory proof to the contrary. *Rogers v. Beccher*, 3 Fed. Rep., 639.

See *Decree*, § 1802. *Reissues*, §§ 5462-5472.

Patent — Is property, § 4636. In the nature of a contract, §§ 4637-4639. Rights conferred by, §§ 4640-4648.

§ 4636. Patents, when rightfully issued, are property, and are surrounded by the same rights and sanctions which attend all other property. *Densmore v. Scofield*, 12 Otto, 375.

§ 4637. A patent is, to a certain extent, a contract between government and patentee. *Ransom v. Mayor of New York*, 1 Fish., 252.

§ 4638. A patent for a useful invention is not, under the laws of the United States, a monopoly, in the old sense of the common law. Attorney-General *ex rel.* *Hecker v. Rumford Chemical Works*, 9 O. G., 1062.

§ 4639. It more nearly resembles a contract which, under the authority conferred by the constitution, congress authorizes to be entered into between the government and the inventor, securing to him, for a limited time, the exclusive enjoyment of the practice of his invention in consideration of the disclosure of his secret to the public, and his relinquishment of his invention to the public at the end of the term. *Ibid.*

§ 4640. The right which the public has acquired to use the thing invented by reason of the applicant for a patent failing to do something prescribed by congress, and the necessity for which congress might, by previous legislation, have dispensed with, has never been held to be a vested right. *Fire Extinguisher Case*, 21 Fed. Rep., 40.

§ 4641. The nature of the right covered by letters patent is such that a warranty of its right may be implied. *Faulks v. Kamp*, 17 Blatch., 432.

§ 4642. Patent gives a *prima facie* right, based on the proceedings prior to its grant in the patent office. *Heinrich v. Luther*, 6 McL., 345.

§ 4643. One receiving letters patent from the United States receives thereby a *prima facie* right to maintain an action against every infringer of the right given by such letters. *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.*, 13 Blatch., 375.

§ 4644. Grant of patent gives a *prima facie* right to the invention, and the burden of proof is on defendant who disputes its validity. *Allen v. Hunter*, 6 McL., 303.

§ 4645. The patent is *prima facie* valid. It is a muniment of title. He who would overcome it must do so by a clear preponderance of evidence. *Comstock v. Sandusky Seat Co.*, 13 O. G., 230.

§ 4646. The production of a patent shows *prima facie* that all the preliminary steps necessary to the grant have been taken. *Wooster v. Muser*, 20 Fed. Rep., 162.

§ 4647. The person having the title to a patent for a new or improved mechanical structure has three distinct rights, which he may dispose of separately to different individuals. These are: the right to make the machine, the right to use, and the right to vend. *Jenkins v. Greenwald*, 1 Bond, 126.

§ 4648. The rights secured by letters patent are the subject of judicial, not of executive, decision. When all the laws and forms have been complied with, patents issue without inquiry as to the precise rights they confer. *Taney's Opinion*, 2 Op., 455.

Patent—Is evidence of patentee's first and original inventorship, §§ 4649-4677.

§ 4649. Patent is *prima facie* evidence that patentee is the first inventor. *Cox v. Griggs*, 1 Biss., 362.

§ 4650. A patent is *prima facie* evidence that patentee is the inventor of the thing patented. *Alden v. Dewey*, 1 Story, 336.

§ 4651. A patent is *prima facie* evidence that patentee has made the invention. *Crompton v. Belknap Mills*, 3 Fish., 536.

§ 4652. Patent is *prima facie* evidence that patentee is first and original inventor. *Roberts v. Harnden*, 2 Cliff., 500; *Ayling v. Hull*, 2 Cliff., 494; *Forbes v. Barstow Stove Co.*, 2 Cliff., 379; *Wing v. Richardson*, 2 Cliff., 449; *Union Sugar Refinery Co. v. Matthieson*, 3 Cliff., 639; *Rich v. Lippincott*, 2 Fish., 1; *Magic Ruffle Co. v. Douglass*, 2 Fish., 330; *Whipple v. Baldwin Mfg. Co.*, 4 Fish., 29.

§ 4653. Patent in due form is *prima facie* evidence that patentee is first and original inventor. *Sands v. Wardwell*, 3 Cliff., 277; *Graham v. Mason*, 4 Cliff., 88.

§ 4654. Patents in due form, when introduced in evidence, constitute *prima facie* proof that the alleged inventor was the original and first inventor of what is therein described as his improvement. *Haskell v. Shoe Machinery Manufacturing Co.*, 15 O. G., 509; *Needham v. Washburn*, 4 Cliff., 254.

§ 4655. Where the patent is correct in form, and is introduced in evidence in a suit for infringement, it is of itself presumptive evidence that the patentee is the original and first inventor of that which is therein described and secured as his invention. *Cahill v. Brown*, 15 O. G., 697.

§ 4656. Letters patent in evidence afford a *prima facie* presumption that patentee is original and first inventor. *Carew v. Boston Elastic Fabric Co.*, 3 Cliff., 356; *Hudson v. Draper*, 4 Cliff., 178; *Howes v. Nute*, 4 Cliff., 173.

§ 4657. The patent, including the specification and drawings, is *prima facie* evidence that patentee is the original and first inventor. *Cahoon v. Ring*, 1 Cliff., 592.

§ 4658. Patentee being required to make oath that he is the inventor, the patent is *prima facie* evidence of his invention of it. *Phila. & Trenton R. Co. v. Stimpson*, 14 Pet., 448.

§ 4659. Patent is *prima facie* evidence that patentee is the first and original inventor, and of date of invention at time of filing application. *Johnson v. Root*, 2 Cliff., 108.

§ 4660. The patent is *prima facie* evidence that it was lawfully issued,—that patentee is the original inventor. *Hoffheims v. Brandt*, 3 Fish., 218.

§ 4661. Letters patent are *prima facie* proof that patentee is the first and original inventor, and that the invention is novel and useful. *Spaulding v. Tucker*, Deady, 649.

§ 4662. The patent, if introduced in evidence, affords a *prima facie* presumption that the patentee is the original and first inventor, and, in the absence of proof to the contrary, is sufficient to entitle the party instituting the suit to recover for the alleged violation of his exclusive rights. *Storrs v. Howe*, 4 Cliff., 388.

§ 4663. Where the patent described in the bill of complaint is introduced in evidence, the patentees or assignees are presumed to be the original and first inventors of the described improvement. *Roemer v. Simon*, 5 Otto, 214.

§ 4664. Having proved the alleged infringement, the burden of proof is cast upon the respondents to show that the patent is invalid, unless the patent is materially defective in form. *Ibid.*

§ 4665. Patent is *prima facie* evidence that patentee is the first and original inventor, and the burden of proving the contrary is on defendants. *White v. Allen*, 2 Cliff., 224; *Waterbury Brass Co. v. Miller*, 9 Blatch., 77; *Bates v. Coe*, 98 U. S., 31 (§§ 1816-30).

§ 4666. Patent is *prima facie* evidence that patentee is the inventor, and the burden of proof is upon the infringer to show the contrary. *Smith v. Goodyear Dental Vulcanite Co.*, 3 Otto, 486 (§§ 5105-10).

§ 4667. The patent, if regular in form and introduced in evidence, affords a *prima facie* presumption that the patentee is the original and first inventor of what is therein described as his improvement. *Brady v. Atlantic Works*, 4 Cliff., 408.

§ 4668. This presumption is not overcome by evidence introduced to impeach the novelty of the invention, which does not clearly show that the alleged anticipating device embodied the same construction and mode of operation as that claimed. *Ibid.*

§ 4669. In suits for infringement "the patent is *prima facie* evidence that the patentee was the original and first inventor, and any one who controverts this assumes the burden of proof and undertakes to show affirmatively that there was a prior knowledge and use of the invention under such circumstances as to give to the public the right of its continued use against the patentee." *Crouch v. Roemer*, 11 O. G., 1112; *Crouch v. Speer*, 6 O. G., 187.

§ 4670. Patent is *prima facie* evidence that patentee was the first inventor; to establish the contrary it must be shown that the construction of the alleged prior invention preceded that of patentee, before the conception of the improvement was applied in practice. *Brodie v. Ophir S. M. Co.*, 5 Saw., 608.

§ 4671. The patent which is *prima facie* evidence that patentee is first and original inventor may be overcome by proof that the improvement was previously made and reduced to practice by another in this country, or that it had previously been patented or described in some printed publication prior to the supposed invention by the patentee. *Judson v. Bradford*, 16 O. G., 171.

§ 4672. Letters patent are *prima facie* evidence that the patentee was first and original inventor. This *prima facie* case is greatly strengthened by the extension of the patent, especially when it is resisted on the ground of want of novelty. *McComb v. Ernest*, 1 Woods, 195.

§ 4673. Patent is *prima facie* evidence of the priority of the claim to invention. *Case v. Brown*, 1 Biss., 382.

§ 4674. The introduction of a patent subsequent in date cannot have the effect as evidence to overcome the *prima facie* presumption, otherwise afforded by the introduction of one of prior date, that patentee was the original and first inventor. *Goodyear Dental Vulcanite Co. v. Gardiner*, 3 Cliff., 408.

§ 4675. The exhibition of a patent sufficiently establishes the priority of invention of the patentee of the invention described in it. This evidence is presumptive only, and the burden of disproof is upon the contestant. *Konold v. Klein*, 3 B. & A., 226.

§ 4676. Where the evidence of priority of invention is doubtful, it is not sufficient to overthrow the presumption of priority based upon the grant of letters patent. *Ibid.*

§ 4677. Testimony offered by the defendants respecting a prior rejected application of a third person, the use of his invention, and his prior knowledge of the thing patented, is not admissible in a suit in equity to show that the patentee was not the original inventor, unless the facts which such testimony tends to prove are mentioned in the answer. *Union Paper-Bag Machine Co. v. Pultz & Walkley Co.*, 15 Blatch., 160.

See *Defenses*, § 1822. *Process and Product*, § 5108. *Reissues*, § 5298.

Patent — Is *prima facie* evidence — Of the right claimed therein, §§ 4678-4681. Of originality, novelty and utility, §§ 4682-4685. Of non-infringement of prior patent, §§ 4686-4688. That it is regularly granted, §§ 4689, 4690. Of date of invention, § 4691.

§ 4678. A patent is *prima facie* evidence of the right of patentee to the subject patented. *Pennock v. Dialogue*, 4 Wash., 538.

§ 4679. The patent is *prima facie* evidence of the right claimed therein. *Pitts v. Edmonds*, 1 Biss., 168.

§ 4680. The patent under which defendants justify is *prima facie* evidence that patentee has an exclusive right to the invention patented; that he is the first inventor thereof, and of an invention substantially different from those covered by the patents he is alleged to have infringed, to produce the like result. *American Pin Co. v. Oakville Co.*, 3 Blatch., 190.

§ 4681. The patent is *prima facie* evidence of all that complainants claim under it, and the burden of overthrowing it rests upon defendant. *Buck v. Cobb*, 9 Law Rep., 545.

§ 4682. The patent raises the presumption of the originality of the patented invention. *Wayne v. Holmes*, 1 Bond, 27.

§ 4683. The patent is *prima facie* evidence of invention, and casts on defendant the burden of proof that it was not plaintiff's invention, or that it was in public use prior to the application. *Knight v. B. & O. R. Co.*, Taney, 106.

§ 4684. The patent is *prima facie* evidence of invention, novelty and utility. *Carter v. Baker*, 1 Saw., 512; *Goodyear v. Beverly Rubber Co.*, 1 Cliff., 348.

§ 4685. Where the patent is joint, it is *prima facie* evidence of joint invention; but if all the patentees did not join in the invention it is void. *Hotchkiss v. Greenwood*, 4 McL., 456.

§ 4686. The granting of a subsequent patent is *prima facie* evidence that the use of the device thus patented does not infringe a prior patent. *Burden v. Corning*, 2 Fish., 477.

§ 4687. If the defendant has a patent it is evidence of the opinion of official experts that it does not conflict with the plaintiff's patent, and that in working under it he is guilty of no infringement. *Westlake v. Carter*, 4 O. G., 636.

§ 4688. Such evidence will be submitted to the jury; the court will not compare the patents. *Ibid.*

See *Process*, § 5035.

§ 4689. Where a patent is to be granted upon evidence and proofs before a public officer, the fact that the patent was granted is *prima facie* evidence that the proofs were regular and satisfactory; and where the law has made him judge of their competency and sufficiency, no other tribunal can re-examine and controvert the same. *Phila. & Trenton R. Co. v. Stimpson*, 14 Pet., 448.

§ 4690. Patents granted by a state or the general government are to be taken as *prima facie* evidence that they were regularly granted, and that they import conformity to the prerequisites of the laws authorizing their allowance. *Dorsey Revolving Harvester Rake Co. v. Marsh*, 6 Fish., 387.

§ 4691. A patent is *prima facie* evidence of the patentee's having made the invention when the application was filed. *Jones v. Sewall*, 3 Cliff., 563.

Patent—Evidence of what, §§ 4692-4695.

§ 4692. It is no objection to producing the patent sued on in evidence that specification and drawing are void for ambiguity, that they contain no reference on the oath of the inventor, that they do not specify what was claimed. *Lippincott v. Kelly*, 1 West. L. J., 513.

§ 4693. Patents introduced as evidence to invalidate complainant's patent must be construed by the court to determine whether they are admissible or not. *Cahoon v. Ring*, 1 Cliff., 592.

§ 4694. Patent is *prima facie* evidence of good title, and puts on respondents the burden of proving that it is void or worthless. *Roberts v. Reed*, 3 Brewster, 558.

§ 4695. When patents are cited as anticipating the plaintiffs' patent they speak only as public grants; and nothing from the patent office can be admitted in evidence of earlier dates than the patents themselves. *Howes v. McNeal*, 17 Blatch., 396.

See *Utility*, §§ 6638, 6639. *Validity*, § 6693.

Patents—Joint, §§ 4696-4698. Inoperative, § 4699. Frivolous, § 4700. Surreptitious, § 4701.

§ 4696. A joint patent for an invention is inconsistent with several patents for the same invention by the same patentees. *Barrett v. Hall*, 1 Mason, 447.

§ 4697. A joint patent cannot be sustained upon a sole invention of either of the patentees. *Barrett v. Hall*, 1 Mason, 447.

§ 4698. A joint patent may be granted upon a joint invention. *Ibid.*

§ 4699. If a patent is inoperative so far as not to cover all that the party is entitled to claim, it is inoperative within the meaning of the provisions of the statute relating to reissues. *Giant Powder Co. v. Safety Nitro Powder Co.*, 19 Fed. Rep., 509.

§ 4700. *Seem*, that a patent for a discovery which is manifestly frivolous cannot be sustained, and that it is competent for the court to declare it inoperative for such cause where apparent on the face of the specification. *Wilson v. Janes*, 3 Blatch., 227.

§ 4701. The fact that a caveat filed by another inventor was pending and in force when an interfering patent was granted does not of itself show that the patent was surreptitiously obtained and void, nor does it authorize the commissioner to grant a patent to the caveator until he shall establish his priority of invention in a regular proceeding for that purpose. *Cochrane v. Waterman*, 1 MacA. Pat. Cases, 52.

See *Fraud*, §§ 2603, 2604.

Patents—Two—The prior patent in general, §§ 4702-4705. Presumption as to subsequent patent, §§ 4706-4712. See *Construction of Patents*, §§ 1242, 1243. *Improvement*, §§ 2745-2784. *Interfering Patents*, §§ 3435-3504.

§ 4702. It is evident from a comparison of the seventh section of the act of 1836 with the sixth, eighth and fifteenth sections, that the patent which would bar the issuing of a patent to

the applicant must be a patent issued prior to his *invention*, and not merely prior to his *application*. *Heath v. Hildreth*, 1 MacA. Pat. Cases, 12.

§ 4703. Where the invention embraced by a prior patent is held not to anticipate a later patent upon which suit is brought, a reissue of such prior patent, granted after the date of the later patent, can have no effect upon the same. *United States Stamping Co. v. King*, 17 Blatch., 55.

§ 4704. A description in a prior patent is no anticipation of a patent the application for which was filed before the application of such prior patent. *Allen v. City of New York*, 17 Blatch., 350.

§ 4705. The grant of a patent to another for matter contained in a prior pending application, which is subsequently patented, subordinates the first patent to the later one. *Ballard v. City of Pittsburgh*, 12 Fed. Rep., 783.

§ 4706. A patent is never invalidated by the fact that the invention claimed in it was described, but not claimed, in a patent granted subsequently to the making of the application for the patent secondly issued, but before it was granted. *Singer v. Braunsdorf*, 7 Blatch., 521.

§ 4707. A subsequent inventor may have a patent for matters included in a prior patent, but not particularly specified and claimed therein, if he be an independent inventor and the invention was not perfected, but was abandoned by the patentee. *Stephenson v. Hoyt*, 1 MacA. Pat. Cases, 292.

§ 4708. Where a person has, within the meaning of the patent law, made an invention which he has described in specifications, including other matter of invention, for which last a patent has been issued, he should not be precluded for that reason alone from applying for and obtaining a patent for that which was not claimed in the first patent. *Graham v. McCormick*, 10 Biss., 39.

§ 4709. The grant of a subsequent patent serves only to indicate the opinion which highly respectable officers had formed on an *ex parte* examination of the subject, that it is for a different invention from that in a prior patent, but is not conclusive or even *prima facie* evidence. *Morse Fountain Pen Co. v. Esterbrook Pen Mfg. Co.*, 3 Fish., 515.

§ 4710. The presumption is that a subsequent patent is for a different invention from that covered by a prior patent. *Blanchard v. Puttman*, 2 Bond, 84.

§ 4711. Where two patents have been granted for articles which resemble each other, a presumption arises from the action of the office that there is such a difference between them that the use of one constitutes no infringement of the patent for the other. *Smith v. Woodruff*, 1 MacArth., 459.

§ 4712. The grant of a patent for a device is necessarily a decision of the patent office that it is novel with respect to a patent granted prior thereto. *Clark v. Scott*, 9 Blatch., 301.

Patents — Two — *For same invention*, §§ 4713-4720. *For different parts of same invention*, §§ 4721-4725.

§ 4713. Two patents may be issued for the same invention, a joint patent to two parties, and a separate one to one of them. *Crocker's Case*, 2 A. L. T. (U. S.) R., 129.

§ 4714. A patentee cannot have in use at the same time two valid patents for the same invention. The first patent, while unrepealed, is an estoppel to any future patent for the same invention. *Odiorne v. Amesbury Nail Factory*, 2 Mason, 28.

§ 4715. It is a valid objection to a second patent, that patentee has a prior unrepealed patent for the same thing. *Morris v. Huntington*, 1 Paine, 348.

§ 4716. Of two patents for the same invention, the later patent is void. *Garratt v. Siebert*, 8 Otto, 75; *Suffolk Co. v. Hayden*, 3 Wall., 315.

§ 4717. That of two patents for the same invention to the same inventor, the last one granted is void, although it may have been first applied for. *McMillan v. Rees*, 1 Fed. Rep., 722.

§ 4718. Two patents will not be granted for the same invention, although it is to be used for different purposes. *McComb v. Brodie*, 1 Woods, 153.

§ 4719. Of two patents for the same invention, the first is entitled to priority of invention. *Colt v. Massachusetts Arms Co.*, 1 Fish., 108.

§ 4720. There cannot be more than one valid patent for an invention, nor can the grantee of a patent sustain an action upon another patent for the same invention issued afterward. *Jones v. Sewall*, 3 Cliff., 563.

§ 4721. Separate patents for separate and distinct parts of the same invention are nevertheless valid. *Ibid.*

See *Identity*, § 2713.

§ 4722. An inventor may claim in one patent a combination of devices, when they are so connected as to operate in a certain way; and in another he may claim, in combination with some

of those devices, another one by means of which especially the operation so described is produced. *Wheeler v. McCormick*, 11 Blatch., 334.

§ 4723. Separate patents for several parts of the same invention may be granted, although the whole invention is fully described in each of them, to explain the purpose and mode of operation of the parts covered by the claims of such patents. *McMillan v. Rees*, 1 Fed. Rep., 722.

§ 4724. The connection or combination of a patented device or improvement with other devices may be the subject of a valid subsequent patent. *Ibid.*

§ 4725. Separate patents for the machine, and the process and the product, are allowable. *McKay v. Dibert*, 5 Fed. Rep., 587.

Patents — Two to same patentee — *The prior patent*, §§ 4726-4729.

§ 4726. Where two patents of the same patentee are issued upon two applications before the office at the same time, the later of the two is not void for claiming matter shown but not claimed in the prior patent; nor is the omission in the prior patent to claim such matter evidence of abandonment. *Suffolk Co. v. Hayden*, 3 Wall., 315.

§ 4727. A patent is void which claims substantially the same thing which is claimed by the same party in a prior patent. *Corn-Planter Patent*, 23 Wall., 181.

§ 4728. A patentee's prior patent cannot be invalidated by the claims of his later patent. *United Nickel Co. v. Melchior*, 17 Fed. Rep., 340.

§ 4729. An inventor may have a patent for an invention described in a prior patent to himself. *Vermont Farm Machine Co. v. Marble*, Commissioner, 27 O. G., 621.

See *Abandonment*, § 81. *Reissues*, § 5336.

Patent — *Granted by special act*, §§ 4730-4732.

§ 4730. A second patent issued by special act of congress, construed to protect the inventor against the use of his machine after the issue of the second patent by one who made and used it in the interval between the expiration of the first and the issue of the second patent. *Evans v. Jordan*, 1 Brock., 248.

§ 4731. Where a foreign patentee had applied for and taken out a patent in this country on July 24, 1860, for a term of fourteen years from the date of the grant, without reference to his foreign patent, and when this grant was subsequently confirmed by a special act of congress, July 22, 1862, *held*, that the patent was governed by the laws in force in 1860 and not by the laws in force in 1862, and that the grant was also of the right to dispute its validity, patentability, etc. *New American File Co. v. Nicholson File Co.*, 8 Fed. Rep., 816.

§ 4732. Where a patent was granted by special act forty years after the inventor's application, and after it had gone into public use, *held*, that it was a constitutional grant, not interfering with vested rights, the rights acquired by the public use not constituting such a right. *Fire Extinguisher Case*, 21 Fed. Rep., 40.

See *Assignment*, §§ 522-524.

Patent — *To whom granted*, §§ 4733-4736. *Cannot be collaterally impeached*, §§ 4737-4739.

Preliminaries to grant are always re-examinable, §§ 4740, 4741. *Depends on state of art*, §§ 4742, 4743.

§ 4733. To whom a patent may be granted. *Rice v. Heald*, 13 Pac. L. R., 33.

§ 4734. Patents for invention are confined to citizens of the United States. *Pinkney's Opinion*, 1 Op., 171.

§ 4735. A patent is valid when granted to any assignee of record. *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 33 O. G., 1597.

§ 4736. A patent issued to the wrong person must be delivered up and canceled. *Appleton v. Bacon*, 2 Black, 699.

See *Executor*, § 2368. *Inventor*, § 3786.

§ 4737. A patent cannot be impeached collaterally. *Hoeltze v. Hoeller*, 2 Bond, 386.

§ 4738. The question of fraud in granting a patent cannot be raised in collateral proceedings, and can only be considered in some direct suit to impeach and set aside the patent. *Eureka Co. v. Bailey Co.*, 11 Wall., 488.

§ 4739. In a suit for infringement a patent cannot be collaterally attacked by showing a failure to comply with the requirements of the statute prior to its grant. *Railway Register Mfg. Co. v. North Hudson C. R. Co.*, 23 Fed. Rep., 593.

§ 4740. The correct performance of all those preliminaries on which the validity of the original patent depends are always examinable in the court in which a suit for its violation shall

be brought. It is the same with a patent reissued under act 1793. *Grant v. Raymond*, 6 Pet., 218.

§ 4741. The correct performance of all those preliminaries on which the validity of a patent depends is always examinable in the court in which a suit for its violation is brought. *Odell v. Stout*, 22 Fed. Rep., 159.

§ 4742. Every patent as to novelty and utility depends on the state of the art at the time of the claim made or patent issued. *United States & Foreign Salamander Felting Co. v. Haven*, 3 Dill., 131.

§ 4743. Every patent as to novelty or utility depends on the state of the art at the time of the claim made or patent issued. *Goodyear Dental Vulcanite Co. v. Flagg*, 9 O. G., 253.

Patent — Generally, §§ 4744-4757.

§ 4744. Patents cannot be withheld on moral grounds relating to the conduct of the applicant. *Pinkney's Opinion*, 1 Op., 170.

§ 4745. It is when speculation has been reduced to practice, when experiment has resulted in discovery, and when that discovery has been perfected by patient and continued experiment, when some new compound, art, manufacture or machine has been produced, useful to the public, that the inventor is entitled to a patent. *Goodyear v. Day*, 2 Wall. Jr., 283.

§ 4746. Where a patent has been granted, three times reissued and once extended, clear and decisive evidence of fraud is required to invalidate it. *Swift v. Whisen*, 2 Bond, 115.

§ 4747. The patent is to be ascertained from the letters and the schedule or specification annexed. *Hogg v. Emerson*, 6 How., 437.

§ 4748. Letters patent with the specifications must be sufficient to distinguish the patent from all other things before known. *Ibid.*

§ 4749. A patent should never be defeated for a mere technical defect, if it clearly appears what the inventor has described and claimed as his invention. *Adams v. Joliet Mfg. Co.*, 3 B. & A., 1.

§ 4750. A patent for an invention cannot be treated as a design patent; the terms are different, as are also the rules as to what constitutes infringement. *Cone v. Powers*, 4 B. & A., 107.

§ 4751. A patent sued upon is not void because one of its claims is found to be invalid and no disclaimer entered. *Burdett v. Estey*, 15 Blatch., 349.

§ 4752. A patent cannot be defeated by dividing the patented device into two parts which, when combined, produce the same result in substantially the same way. *Strobridge v. Lindsay*, *Sterrit & Co.*, 6 Fed. Rep., 510.

§ 4753. Where a useful result is produced in any art, manufacture, or composition of matter, by the use of certain means for which the inventor or discoverer obtains a patent, the means described must be the essential and absolutely necessary means, and not mere adjuncts, which may be used or abandoned at pleasure. *Russell v. Dodge*, 3 Otto, 460.

§ 4754. The statute does not make prior description in a patent a bar, but being patented (secs. 4886, 4887 and 4920). *Vermont Farm Machine Co. v. Marble*, Commissioner, 27 O. G., 671.

§ 4755. An inventor need not know all the uses to which his invention is capable of being put, but there must be some patentable invention patented before any use of it can be covered by the patent. *Eagleton Manufacturing Co. v. West*, *Bradley & Cary Manufacturing Co.*, 18 Blatch., 218.

§ 4756. The patent was issued and assignment made before the 8th day of July, 1870, within the intent of section 4895, if an assignment was made before that time which divested the inventor of his interest in the patent. *Selden v. Stockwell Self-Lighting Gas-Burner Co.*, 19 Blatch., 544.

§ 4757. The effect of a patent is to prevent others from making or using the patented article, but does not enlarge the powers in those respects of the patentee himself. *Patterson v. Kentucky*, 7 Otto, 501.

See *Date of Invention*, §§ 1722-1725. *Errors*, § 2181. *Inventors, Joint*, § 3794. *Model*, § 4196. *Novelty*, §§ 4308-4440. *Reissues*, § 5308. *Void Patent*, §§ 6727-6729.

249. PATENT FEES.

§ 4758. Return of fee to caveator. *Cushing's Opinion*, 6 Op., 36.

§ 4759. Repayment of patent fees, to whom made. *Nelson's Opinion*, 4 Op., 268.

§ 4760. Repayment of fees under act of 1836. *Black's Opinion*, 9 Op., 65.

250. PATENT OFFICE.

§ 4761. The "patent fund," purpose for which it is appropriated. Crittenden's Opinion, 5 Op., 663; Cushing's Opinion, 6 Op., 319.

§ 4762. Cases for the exhibition of models, how procured. Crittenden's Opinion, 5 Op., 663.

§ 4763. The patent office made a deposit with S. W. C., banker in Washington, subject to the draft of B., an agent of the office in London, upon the certificate of which B. B. C., bankers in London, advanced money to B., after which, and before payment of the advances made by B. B. C., C. S. W. suspended payment. *Held*, that the patent office must indemnify B. B. C. Cushing's Opinion, 7 Op., 64.

251. PATENT OFFICE ERRORS.

See ERRORS, IN PATENTS.

252. PATENT OFFICE PRACTICE.

See PRACTICE, IN THE PATENT OFFICE. APPLICATION, PRACTICE IN PATENT OFFICE.

253. PATENT OFFICE RECORDS, ADMISSIBILITY IN EVIDENCE.

See EVIDENCE, ADMISSIBILITY OF PATENT OFFICE RECORDS.

254. PATENT OFFICE RULES.

See PRACTICE, IN THE PATENT OFFICE.

255. PATENTED ARTICLES.

See MARKING PATENTED ARTICLES. PURCHASER OF PATENTED ARTICLES. SALE OF PATENTED ARTICLES, UNRESTRICTED.

256. PATENTED PRODUCT.

See SALE, OF PATENTED PRODUCT.

257. PATENTED PROCESS OR MACHINE.

See SALE, OF PRODUCT OF PATENTED PROCESS OR MACHINE.

258. PATENTEE.

See ALIEN PATENTEE.

Patentee — *Defined*, § 4764. *Joint*, § 4765. See *Estoppel*, §§ 2218-2230. *Grant*, §§ 2634, 2638, 2639. *Inventor*, §§ 3728-3813. *Reissues*, § 5397.

§ 4764. Act 1832, "patentee," signifies a person having a right under the patent, whether as executor, administrator or assignee. *Washburn v. Gould*, 3 Story, 122.

§ 4765. That an old device may have been the invention of one of two joint patentees does not confer upon them a right to its exclusive use, except in the particular combination described in their patent. *Union Paper Bag Machine Co. v. Atlas Bag Co.*, 6 Fed. Rep., 398.

See *Art, Lost*, § 388. *Interference*, § 3435. *Owners, Joint*, §§ 4473-4485.

259. PERFECT INVENTION.

See INVENTION, PERFECT.

260. PERSONAL LICENSE.

See LICENSE, PERSONAL.

261. PLEA.

Plea — In bar, §§ 4766-4774.

§ 4766. A plea in bar which alleged prior invention by others abroad, without also alleging patentee's notice of the same, *held* defective. *Smith v. Ely*, 5 McL., 76.

§ 4767. On suit brought to recover patent fees due under an agreement, where no plea was made impugning the agreement, but sale and manufacture under it was admitted by defendant, a plea in bar that plaintiff was not the original inventor was held bad. *Birdsall v. Perego*, 5 Blatch., 251.

§ 4768. In a suit to recover fees payable to inventor for the sale and manufacture of his patented machine, a plea of recoupment, based on damages arising from plaintiff's infringement of defendant's patent, cannot be pleaded in bar. *Ibid.*

§ 4769. A licensee cannot, by plea in bar, raise the issues usually made in a patent suit; the construction of the reissued and original patent, of the license and of infringement. *White v. Lee*, 4 Fed. Rep., 916.

§ 4770. A plea alleging that the defendants had a license to practice complainant's invention unless established by the proofs will not be sustained. *Tilghman v. Hartel*, 9 O. G., 886.

§ 4771. A defendant corporation having violated the conditions of a contract under which a license to manufacture and sell a patented device was granted, and the license having therefore been revoked by the licensor under a provision of the contract, in a suit for infringement against such corporation after the revocation, a plea setting up the license was overruled. *Wooster v. Singer Manufacturing Co.*, 23 O. G., 2513.

§ 4772. The pendency of a suit upon a patent in one district is no bar to the prosecution of a suit upon it in another, whatever may be the effect of a recovery in such foreign suit. *Wheeler v. McCormick*, 11 Blatch., 334.

§ 4773. A suit dismissed for want of prosecution is no bar to a subsequent suit for the same cause of action. *American Diamond Rock-Boring Co. v. Sheldon*, 17 Blatch., 208.

§ 4774. Where in a suit on a junior patent defendants pleaded in bar a prior suit in which a senior patent, necessarily used in the construction of the junior patent, was declared anticipated, *held*, that such decision does not enlarge or affect the estate of the junior patent, which was for a different invention, both patents belonging to plaintiff; and the plea of defendants, licensees of the real defendants in such prior suit, which also set up their privity with licensors, was overruled. *Brush v. Naugatuck R. Co.*, 32 O. G., 894.

See *Agent*, §§ 192, 193.

Plea — In abatement, §§ 4775, 4776.

§ 4775. Where in a suit in one district the pendency of a suit in another jurisdiction is pleaded in abatement, *held*, that where the remedy is not complete and effectual which the court can afford before whom the suit pleaded is pending, that of itself is ground for discrimination, and the new facts, admitted and not denied by the plea, which operate to the prejudice of the complainant, forbid that such prior suit should be deemed a ground for abatement. *Wheeler v. McCormick*, 8 Blatch., 267.

§ 4776. Objections to the authority of an executor to sue on letters patent should properly be taken by plea in abatement. *Rubber Co. v. Goodyear*, 9 Wall., 788.

Plea — In equity, §§ 4777-4790.

§ 4777. Where a plea is filed to a bill in equity, the omission of a certificate of counsel or an affidavit of the party, as required by the thirty-first equity rule, is waived by a demurrer. *Goodyear v. Toby*, 6 Blatch., 130.

§ 4778. The general rule is, that a plea must not contain more defenses than one. It is not limited to one fact. It may embrace various facts; but they must all conduce to a single point on which the defendant rests his defense. *Reissner v. Anness*, 12 O. G., 842.

§ 4779. If there is more than one distinct ground of defense to be urged, the defendant should set the matter forth by way of answer and not by plea. *Ibid.*

§ 4780. A plea to a bill of complaint alleging facts which, if true, may show that one of the defendants has no interest in the suit, not overruled, but saved to the defendant to the hearing,

then to be considered in the light of the evidence in the case. *Williams v. Empire Transportation Co.*, 14 O. G., 523.

§ 4781. Where, to a bill alleging infringement by a single defendant by the sale of the patented article, defendant pleaded that the sales were not by him alone, but by another with him, named in the plea, the plea was held bad, for failure to allege that such other person was living and within the court's jurisdiction. *Goodyear v. Toby*, 6 Blatch., 130.

§ 4782. Where, in answer to a bill of complaint for infringement, the defendants filed a plea involving three distinct grounds of defense, such plea was held bad for duplicity. *Reissner v. Anness*, 12 O. G., 842.

§ 4783. The several matters, although relating in a general way to but a single defense — viz., the invalidity of the complainants' patent — were essentially independent of one another, and by their retention destroyed the very office of the plea, which is to secure singleness in the issue. *Ibid.*

§ 4784. The defendants were accordingly permitted, either (1) to set down the pleas that had been filed as an answer, or (2) to elect within a time specified which of the several grounds of defense they would stand upon, and when such election had been made, the other grounds would be overruled. *Ibid.*

§ 4785. Two of the defendants have put in a plea to the bill which sets forth "that neither they nor either of them have, since the issuing of the patent set forth in the bill, ever made, constructed, used, or vended to others to be used, the invention described in said patent." The plea also denies infringement of the patent in any manner whatever. There is no answer to any part of the bill. The plaintiff moves that the plea be stricken from the files as improper, or else be ordered to stand as an answer. *Held*, if the plea should be tried on the fact of infringement and the issue be found for the plaintiff, and the plea be thus overruled, it would seem difficult, under equity rules 34 and 37, to exclude the defendant from contesting again under an answer. *Sharp v. Reissner*, 9 Fed. Rep., 445.

§ 4786. None of the adjudicated cases sanction in a case like this a plea merely of non-infringement under rules of practice such as those which govern this case. On the contrary, the authorities condemn such a plea. *Ibid.*

§ 4787. Where a bill brought upon five several letters patent for distinct inventions charges the defendant with infringement by making certain structures, each containing inventions contained in each of the patents, and a plea is filed denying that each structure embodied inventions claimed in each of the patents, and issue is joined and proofs taken, the bill will not be dismissed upon showing that two of the patents were not infringed. Such plea amounts to no more than a denial of an allegation of the bill, and upon the issue as to such allegation, whether raised by plea or answer, the plaintiff can recover, even though defendant's structure embodied in it the inventions covered by only one, two, three or four of the patents. *Matthews v. Lalance & Grosjean Manufacturing Co.*, 18 Blatch., 84.

§ 4788. Even though the facts stated in such plea were found for the defendant, the proper disposition of the case would be to overrule the plea as bad in substance. *Ibid.*

§ 4789. Where the bill alleged fraud in the making of a certain instrument of reassignment of a patent, and defendant pleaded that he was a *bona fide* purchaser of the patent "for a good and valuable consideration, to wit, a certain sum of money," without notice of fraud, *held*, that the plea was bad for not setting forth the amount of the consideration in traversable form. *Secombe v. Campbell*, 18 Blatch., 108.

§ 4790. A plea which set up that the invention was patented or described in a printed publication prior to its supposed invention by the patentees, overruled on the ground that section 4920, Revised Statutes, requires such defense to be set up in answer and not as a technical plea. *Carnrick v. McKesson*, 19 Blatch., 369.

See *Notice*, §§ 4253-4299.

Pleas — Statutory — *General issue*, §§ 4791-4793. *Special plea*, §§ 4794-4796. *General issue and special pleas*, §§ 4797-4799.

§ 4791. Under plea of general issue, defendant can produce evidence of use of a prior machine in other places than those named in the notice. *Evans v. Kremer*, Pet. C. C., 215; *Evans v. Eaton*, Pet. C. C., 322.

§ 4792. When general issue is pleaded, there is no limitation as to when evidence that patentee is not the original inventor may be given. *Ibid.*

See *Evidence*, § 2287.

§ 4793. The rule laid down by the supreme court leaves it absolutely optional for the defendant to rely upon the general issue, or to plead specially, although the facts specially pleaded be such as are by the statute permitted to be given in evidence under the general issue; and

although the special pleas would thus have no other effect than the general issue with notice. *Day v. New England Car Spring Co.*, 3 Blatch., 179.

§ 4794. The question of the infringement of a patent is not the proper subject of a special plea. *Hubbell v. De Land*, 22 O. G., 1883.

§ 4795. The single question of the validity of a reissue may be specially pleaded. *Ibid.*

§ 4796. Where, in a suit for infringement, defendants pleaded the general issue, and also a special plea setting out an agreement with plaintiff conveying interest in the extended term, with condition precedent, *held*, that the offer to perform the condition did not vest the interest, and that the plea was bad. *Pitts v. Hall*, 3 Blatch., 201.

§ 4797. Where defendant, in an action for infringement, pleaded general issue and notice, and also special pleas, setting up a license under patentee paramount to plaintiff, they were held not to involve the general issue, and to be properly pleaded, and a motion to strike them out was refused. *Day v. New England Car Spring Co.*, 3 Blatch., 179.

§ 4798. Where defendants pleaded the general issue with the statutory notice and special pleas, giving matter which might have been given under the notice, the special pleas were ordered to be stricken out, and leave was granted to add new matter to the notice by way of defense. *Wilder v. Gayler*, 1 Blatch., 597.

§ 4799. Defendant cannot plead the general issue, and a special plea that plaintiffs were not the original inventors, as the matter is the same in both defenses. *Read v. Miller*, 2 Biss., 12.

Plea — Generally, §§ 4800-4807.

§ 4800. Where abandonment was pleaded in the answer in avoidance of the infringement set up in the bill, *held*, it was not evidence, must be proved, and the burden of proof is on defendant. *Howe v. Williams*, 2 Cliff., 245.

§ 4801. It is only when a plea is unexceptionable in its form and character that it is to be set down for argument or to be replied to. *Sharp v. Reissner*, 9 Fed. Rep., 445.

§ 4802. A plea alleging sale, etc., by defendant, as agent for another, and not for his own profit, *held* hypothetical and demurrable, where the declaration alleged infringement by sale, etc. *Morse v. Davis*, 5 Blatch., 40.

§ 4803. A plea of jurisdiction in another court is not a good plea to a cross-bill, if the cross-bill is appropriate to the original. *Brandon Mfg. Co. v. Perine*, 14 Blatch., 371.

§ 4804. The object of a plea, where there is some certain single issue requiring but little evidence that will dispose of the whole case, if sustained, is to try that issue without putting the parties to the expense of the trial of the case at large; and pleas are limited to a single defense or issue, unless, by permission of the court, the defendants are allowed to plead double. *Held*, that the plea in this case does not conform to this rule, and, besides, comes too late. *Giant Powder Co. v. Safety Nitro Powder Co.*, 19 Fed. Rep., 509.

§ 4805. Where the specifications of the patent were not so incorporated into a plea that the improvement was not distinguished from the former mode, as to make part of the plea, it was held defective. *Smith v. Ely*, 5 McL., 76.

§ 4806. A plea which averred public use of the patented improvement with patentee's consent on a certain date, *held* defective in not averring abandonment or public use more than two years prior to application for patent. *Ibid.*

§ 4807. By taking issue upon a plea that defendant's vendor was licensed to sell the article complained of to defendant, *held*, that its sufficiency was admitted, and defendants, having proved the facts alleged in their plea, were entitled to judgment. *Birdseye v. Heilner*, 34 O. G., 1392.

262. PLEADING.

§ 4808. A breach assigned as broad as the right set forth in the declaration and granted by the patent is not too broad. *Cutting v. Myers*, 4 Wash., 220.

§ 4809. Where a defect in pleading is cured by verdict, a motion in arrest will be overruled. *Stanley v. Whipple*, 2 McL., 35.

§ 4810. Where the defendant had litigated the case on its merits, he was not allowed to raise for the first time at the hearing the question of a defect of parties, where no indispensable parties were absent. *Adams v. Howard*, 22 Fed. Rep., 656.

§ 4811. Where the merits of a cause had been decided in another case on the same issue, a motion to argue technical points of special pleading was overruled and the case was remanded. *Smith v. Ely*, 15 How., 137.

263. PRACTICE.

See APPLICATION, PRACTICE IN PATENT OFFICE. INTERFERENCE, IN PATENT OFFICE.

Practice — Collusive case — *What constitutes*, §§ 4812-4814. *Particular cases*, §§ 4815-4817.

§ 4812. What is not evidence of collusion in securing a judgment. *American Middlings Purifier Co. v. Atlantic Milling Co.*, 4 Dill., 100.

§ 4813. What would constitute a collusive patent case. *American Middlings Purifier Co. v. Christian*, 4 Dill., 448.

§ 4814. It cannot be admitted that one party to a suit can pay the fees of counsel on both sides, both in the court below and on appeal, without being held to have such control over both the preparation and argument of the case as to make the suit merely collusive in both courts. *Gardner v. Goodyear*, 3 O. G., 295.

§ 4815. Where, after appeal, it appeared that complainants had purchased in the patents under which the suit was defended, and that defendants had taken in consideration for the sale stock in complainants' company, *held*, that defendants' interest had been transferred to the side of complainants, that the suit was a fictitious one, and the appeal was dismissed, notwithstanding that the damages alleged in the bill had not been compromised. *American Wood Paper Co. v. Heft*, 4 Wall., 333.

§ 4816. A compromise was made between the parties to a suit for infringing a patent, in pursuance of which a decree for the complainants was entered in the circuit court and affirmed on appeal in the supreme court, and they paid the defendant's counsel as well as their own. Upon these facts being shown to the supreme court, the decree of affirmance was vacated, the appeal dismissed, and the mandate which had been issued to the circuit court was recalled. *Gardner v. Goodyear Dental Vulcanite Co.*, 3 O. G., 295.

§ 4817. A decree which is in substance a decree by default, in which no opposition was made to its entry, no contest was had before the court, and which was made because of an understanding between the parties that contest should cease, and not because the court had examined and found the plaintiff's patents valid, is not sufficient ground for the grant of a preliminary injunction in a subsequent suit, in another district, against different parties, but on the same patent. *Hayes v. Leton*, 5 Fed. Rep., 521.

See *Decree*, § 1805.

Practice — Divided court, §§ 4818-4820.

§ 4818. Where the question raised on demurrer, as to whether suit could be maintained after expiration of patent, had been previously argued before the supreme court, which was equally divided in opinion, the rule previously adopted in the circuit court was maintained, and the bill was allowed to be brought. *Hayden v. Great Falls Mfg. Co.*, 3 Fed. Rep., 519.

§ 4819. The question to be certified under section 652, Revised Statutes, on a division of opinion, must be a question of law, and must be capable of being presented in a single point; and where the question certified up was a mixed question of law and fact as to the infringement of a patent under a certain construction put upon it in the circuit court, the case was dismissed. *California Artificial Stone Paving Co. v. Molitor*, 31 O. G., 1044.

§ 4820. Where, after decree and perpetual injunction, defendant varied his method, but, as alleged, still infringing, complainant obtained a rule to show cause why he should not be punished for contempt. The judges, divided in opinion on the question of infringement, certified the case up. *Held*, that it was a mixed question of law and fact not capable of being certified up under section 652, Revised Statutes; that the court must decide for itself in the ordinary way. The proper course is a new suit and not by process of contempt. *Ibid.*

Practice — Judges, §§ 4821-4824. *Judicial opinions, construction of*, §§ 4825-4829.

§ 4821. The relations between a district judge and a justice of the supreme court in holding a circuit court considered. *Hussey v. Whiteley*, 1 Bond, 407.

§ 4822. Limitation of judicial, executive and legislative powers considered. *Bloomer v. Stolley*, 5 McL., 158.

§ 4823. A judge sitting at chambers is a court in the sense of the statute, and has the power to allow the writ of error under act 1836, section 17, where the judgment is under \$2,000. *Foote v. Silsby*, 1 Blatch., 542.

§ 4824. Power of district judge sitting as circuit judge to grant writs, or exercise the power of the circuit courts. Section 609, Revised Statutes, and rule 55 of supreme court, construed in this respect. *Goodyear Dental Vulcanite Co. v. Folsom*, 5 B. & A., 590.

See *Marking Articles Patented*, § 4145.

§ 4825. Authority of judicial *dicta* considered. *Day v. Union India Rubber Co.*, 3 Blatch., 488.

§ 4826. In applying the language of the courts, attention must be paid to the facts with which they are dealing. This is of especial importance when citing their opinions in patent causes. *Bevin v. East Hampton Bell Co.*, 9 Blatch., 50.

§ 4827. In considering authorities cited as precedents, general observations by a judge or court in deciding a case must always be read in view of the facts of the case that was *sub judice*, and are not necessarily authoritative, *ex vi termini*, in another case where the facts are not the same, although entitled to consideration, as are the views of a text-writer of experience and repute. *Wilson v. Coon*, 18 Blatch., 532.

§ 4828. The *dicta* of the judges in infringement suits, to the effect that the person who reduces the invention to practice, and he only, is entitled to a patent, are not applicable to all cases of interference, but they may well apply to those cases where, from a long and unreasonable delay and unsuccessful experiments or an acquiescence in the inventions becoming public, evidence is furnished of an abandonment by the person claiming to be the first and original inventor, so that his prior right is forfeited and lost. *Hill v. Dunklee*, 1 MacA. Pat. Cases, 475.

§ 4829. *Semble*, that the judge's decision will govern the further proceedings of the commissioner in the case only so far as it is decisive of the points raised in the reasons of appeal; and if other sufficient reasons remain for rejecting the claim for a patent, untouched by the decision of the judge, the commissioner may properly still reject it. *Arnold v. Bishop*, 1 MacA. Pat. Cases, 36.

Practice — Equity — In general, §§ 4830-4844.

§ 4830. Chancery jurisdiction and practice in the United States circuit courts are the same in all the states. *Blanchard v. Sprague*, 1 Cliff., 288.

§ 4831. When there is a demurrer to the whole bill, and also to part, and the latter only is sustained, the regular decree is to dismiss so much of the bill as seeks relief in reference to the matters adjudged bad, and to overrule the demurrer to the residue, and direct the defendant to answer thereto. *Atlantic Giant Powder Co. v. California Powder Works*, 8 Otto, 126.

§ 4832. Objections not taken in the answer cannot be raised on the hearing. *Potter v. Wilson*, 2 Fish., 102; *Grover & Baker Sewing Machine Co. v. Sloat*, 2 Fish., 112.

§ 4833. On bill to recover damages, and answer, mere formal objections to the right of complainants to maintain suit will not be considered, for the reason that, even if well taken, they may be obviated by additional proofs; and if complainants should appear to have a meritorious cause of action on the merits, it would still be competent for the court to allow such proof to be introduced. *Goodyear v. Beverly Rubber Co.*, 1 Cliff., 348.

§ 4834. When a court of chancery suspends proceedings in a cause in order to allow the parties to bring an action at law to try the legal right, it does not assume to interfere with the course of proceedings in the court of law. *Watt v. Starke*, 17 O. G., 1092.

§ 4835. To prevent a multiplicity of suits the court may, in a proper case, and on a proper showing, require the prosecution of suits between the patentee and the mere user of a patented machine to be suspended, and to await the result of a suit pending between patentee and the principal infringer from whom the user purchased. *Allis v. Stowell*, 16 Fed. Rep., 783.

§ 4836. Where, on suit brought on patent in one circuit, the decree of the court would not be conclusive as to an alleged prior inventor, the bill was restrained until a decision should be reached in another suit pending elsewhere between the interfering patents of plaintiff and the alleged prior inventor. *Lockwood v. Cutter Tower Co.*, 11 Fed. Rep., 724.

§ 4837. Where an article cannot be produced without infringing a patent for it, as well as a patent for the machine on which it is made, proceedings at law upon either patent must be conducted without reference to the other. *Young v. Lippman*, 9 Blatch., 277.

§ 4838. Where, pending a suit for infringement, the parties agreed to submit the question of infringement to an arbitrator, and abide by his decision, and he decides there is no infringement, but patentee afterwards reissues his patent and files a supplemental bill thereon, to which defendant pleads, both conceding the identity of the original and reissued patent, the award of such arbitrator, if otherwise legal, is as effective a defense to the supplemental as to the original bill, and will be presumed to be correct by the courts until the contrary appear. *Reedy v. Scott*, 23 Wall., 352.

§ 4839. Particularly where the record discloses neither the patented article, nor that claimed to be an infringement upon it. *Ibid.*

§ 4840. What is meant by the discretion of a court of equity. *Motte v. Bennett*, 2 Fish., 642.

§ 4841. Mode of taking depositions in equity. *Sickles v. Gloucester Mfg. Co.*, 3 Wall. Jr., 186.

§ 4842. Rule as to interlocutory orders for issues to a jury. *Goodyear v. Providence Rubber Co.*, 2 Cliff., 351.

§ 4843. Applications for matters not of right, but of favor, will not be granted, if they would jeopardize the interest of the opposing party. *Schneider v. Hill*, 18 Blatch., 241.

§ 4844. The practice of dismissing a bill because the invention described in the patents sued upon did not embody or require invention, although no such defense was set up in the answer, sustained. *Slawson v. Grand Street, Prospect Park & Flatbush R. Co.*, 107 U. S., 649.

Practice — Service of process, §§ 4845-4857.

§ 4845. The act of congress conferring jurisdiction on circuit courts for the infringement of patent rights irrespective of citizenship does not affect the provisions of the judiciary act regarding service of process on the person of defendant within the district where the suit is instituted. *Day v. Hayward*, 20 How., 208.

§ 4846. Summons for an alleged infringement being served on the president of a New Jersey corporation temporarily in New York, *held*, that under judiciary act 1789, section 11, defendant must be resident of the district where suit is brought or found within it at the time of service; that this section is equally applicable to patent cases under act 1836; and as a corporate body has no existence beyond the limits of the territory in which the law creating it can exist, the New York circuit court had no jurisdiction, and a motion to quash the writ was allowed. *Day v. Newark India Rubber Co.*, 1 Blatch., 628.

§ 4847. The judiciary law expressly authorized suits for infringement to be brought and process to be served upon the defendants in any district in which they may be found, although defendants may be resident of another district where the infringement was committed. *Thompson v. Mendelsohn*, 5 Fish., 187.

§ 4848. Where the bill averred that defendant resided in New Jersey, *held*, that it should appear affirmatively in the return that the subpoena was served on him in the district in which suit was brought to render such return foundation for jurisdiction. *Thayer v. Wales*, 5 Fish., 448.

§ 4849. A circuit court of the United States cannot, through service of process in its district on an officer of a corporation created under the laws of another state, acquire jurisdiction over the corporation. *Decker v. New York Belting & Packing Co.*, 3 O. G., 441.

§ 4850. A corporation does not waive the objection in consequence of appearing by attorney and pleading to the jurisdiction of the court. *Ibid.*

§ 4851. Upon bill filed, charging defendants with infringement of reissued letters patent, and praying for an injunction, and account of gains and profits made by defendants, *held*, that a subpoena *duces tecum* might be issued, requiring defendants to produce before the examiner all books, papers and documents whatsoever that will show the number of "skates" made or delivered by the defendants, or their employees, since the date of the reissue of letters patent, and until the commencement of the suit, on the ground that the combination may be infringed by a sale of some of its elements with intent to procure infringement. *Turrell v. Spaeth*, 8 O. G., 986.

§ 4852. Service of process on a foreign corporation. What constitutes being "found" in the state in order to warrant service. *Wilson Packing Co. v. Hunter*, 4 B. & A., 184.

§ 4853. Where, on a motion to set aside the service of a subpoena on the ground of privilege of attendance within the district, and the point had been raised that the defendant was not a non-resident, and the motion had been denied on the ground that the defendant had failed to show that he was a non-resident of the state, *held*, on the renewal of such motion, that the defendant had lost his right to show that he was a non-resident. It is not a newly discovered fact. *Matthews v. Puffer*, 22 O. G., 332.

§ 4854. The objection to the service of a subpoena as made while defendant was protected by a privilege may be waived as well by not making it when he ought to make it, or by not making it in a proper way, as by not making it at all. It is one of those irregularities which must be promptly availed of. *Ibid.*

§ 4855. In a suit for the infringement of a patent against a corporation, L., president, was named as a defendant, but was not served. An appearance was entered for the defendants without naming them. L. signed and swore to the answer as one of the defendants. L. owned all the stock of the corporation. *Held*, that L. was liable personally for the infringement of the patent. *Smith v. Standard Laundry Machinery Co.*, 25 O. G., 393.

§ 4856. The prohibition of the service of process out of the jurisdiction of the circuit court is a personal privilege which may be waived. *Prentis v. Ellsworth*, 27 O. G., 623.

§ 4857. Under the statutes of Pennsylvania, a foreign corporation which transacts business in that state through its authorized agents is amenable to suit there, and service of process upon its agents is good service upon it. *Hussey Manufacturing Co. v. Deering & Co.*, 20 Fed. Rep., 795.

See *Bill, to Obtain Patent*, §§ 640-643. *Injunction, Preliminary*, § 3069. *New Trial*, § 4245.

Practice — *Appearance*, §§ 4858, 4859. *Assignment of error*, § 4860. *Case submitted*, § 4861. *Fund paid into court*, §§ 4862, 4863. *Nonsuit*, § 4864. *Proceedings in rem*, § 4865. *Restraining order*, § 4866. *Sureties*, § 4867. *Torts*, 4868. *Transcript of record*, §§ 4869-4873.

§ 4858. The appointment of an attorney, solicitor or agent by whom the plea is put in, is, *per se*, an appearance — an admission that the court has jurisdiction and a submission thereto. *Thayer v. Wales*, 5 Fish., 448.

§ 4859. A party becomes amenable to the jurisdiction of the court by appearing in the suit. *Macaulay v. White Sewing Machine Co.*, 9 Fed. Rep., 698.

See *Bill, to Obtain Patent*, §§ 640, 641.

§ 4860. Since a patent may be invalid for several reasons under the law, an assignment of error which gave no more explicit cause than "that the patent is invalid" was overruled. *Marsh v. Seymour*, 7 Otto, 349.

See *Defenses*, § 1827.

§ 4861. When a suit in equity has been heard and submitted to the court for decision, neither party has a right to file any paper in the cause, except by leave of the court. *Union Sugar Refinery Co. v. Matthieson*, 3 Cliff., 146.

§ 4862. A. licensed B. to use certain patents for a stated fee, on condition that it should be proportionally reduced in case A. licensed others at a lower fee; and A. reserved the right to terminate B.'s license on B.'s non-payment of the fee. B., alleging that A. had granted such other license, brought bill in equity against A. to have his rights determined and the fee reduced, pending which B. obtained a preliminary injunction restraining A. from revoking his license, on condition of B.'s depositing all moneys that shall become due under the license (being the original license fee). This B. did. The court dismissed the bill for want of equity and proper parties, whereon each party moved to have the fund in court paid over to it. *Held*, that while the money belonged to B., A. had an equitable lien on it, in view of the protection arising from the injunction granted B. and the disadvantage thereunder to A. *Florence Sewing Machine Co. v. Singer Sewing Machine Co.*, 8 Blatch., 177.

§ 4863. That the court could make no order disposing of it, until the final determination of the controversy by the proper court. *Ibid.*

§ 4864. Courts of the United States have no power to order a peremptory nonsuit against the will of the plaintiff. *Silby v. Foote*, 14 How., 218.

§ 4865. Where proceedings are had against the infringing machine itself, they must be instituted in the district in which the machine is located. *Wilson v. Sherman*, 1 Blatch., 536.

§ 4866. The function of a restraining order is to protect the plaintiff without unnecessarily opposing or annoying the defendant. *Kirby Bung Mfg. Co. v. White*, 1 McC., 155.

§ 4867. Sureties may stand on the letter of their contract, but are as much bound by its true intent and meaning as the principals. *Read v. Bowman*, 2 Wall., 591.

§ 4868. Torts are joint and several, and plaintiff may recover against one defendant, though the other be acquitted. It is otherwise in contracts. *Reutgen v. Kanowrs*, 1 Wash., 168.

§ 4869. In the court below a bill of review was sustained and the original decree affirming the validity of the patent reversed. At the same term an appeal from the decree to the supreme court was allowed, and the following order made: "And it is ordered by the court that the clerk of this court transmit to the supreme court of the United States the original exhibits, patent certificates, schedules, drawings and models on file along with and as a part of the record and transcript in this cause." In making up the transcript of the record the clerk below omitted all the affidavits filed with the bill of review and answer thereto and sent up the originals. In printing the record for the use of the court those affidavits were omitted, and, the court declining to allow them to be used at the hearing on that account, the appellant moved that they be printed and the hearing suspended until that could be done. *Held*, that the original affidavits attached as exhibits to the bill of review and answer thereto, and thus sent up by the clerk below, were no part of the transcript in the cause, and could not be considered a part of the proof, and that the motion to print them must therefore be overruled. *Craig v. Smith*, 17 O. G., 145.

§ 4870. The court below ordered up what had been *exhibited* below as contradistinguished from what had been read. *Ibid.*

§ 4871. Prudence requires that papers which properly belong to the files of a court should

never be removed, except in case of positive necessity, and anything which has an opposite tendency should be promptly discouraged. *Ibid.*

§ 4872. Construing section 698 of the Revised Statutes in the light of those from which it was taken and the practice that had prevailed in the courts, which it was intended to confirm, the power of the courts below, and of the supreme court, over the transmission of original papers on appeal is and should be confined to such as require actual inspection as originals in order to give them their full effect in the determination of the suit. *Ibid.*

§ 4873. The supreme court will not undertake to control the discretion of the courts below in sending up papers which, in their judgment, require inspection; but where papers come up that ought not to have been sent, the language of the order will be carefully examined to see whether such papers are included within its provisions. *Ibid.*

See *Decree*, § 1789.

Practice — *Surprise*, §§ 4874, 4875. *Waiver*, §§ 4876-4879. *Writ of error*, §§ 4880, 4881.

§ 4874. Defendant is not allowed to surprise patentee with evidence of prior invention of which he has given no notice. *Odiorne v. Denney*, 13 O. G., 965.

§ 4875. If the plaintiff is surprised at the testimony of one of his witnesses, he may ask time to investigate in regard to it, on the ground that no notice of it had been set up in the answer. *Barker v. Stowe*, 16 O. G., 807.

See *Rehearing*, § 5284.

§ 4876. Waiver, express and implied. Effect of. *Ransom v. Mayor of New York*, 4 Blatch., 157.

§ 4877. The objection that a cause of action arose in another judicial district is waived by its omission in the answer. *Black v. Thorne*, 10 Blatch., 66.

§ 4878. The absence of objection on the ground of prior knowledge to evidence clearly admissible as showing the state of the art for the purpose of construing the patent is no waiver of the right to have its use restricted to the purpose for which it was admissible. *Zane v. Loffe*, 2 Fed. Rep., 229.

§ 4879. After a trial all objections which could have been made before or during the same must be considered as waived. *Allen v. Mayor, etc., of City of New York*, 18 Blatch., 239.

§ 4880. Where a writ of error is allowed under act 1836, section 17, providing for appeal in patent cases, it must be to take the whole case up. *Hogg v. Emerson*, 6 How., 437.

§ 4881. The supreme court may, upon a writ of error, re-examine the judgment of a circuit court, rendered upon an agreed statement of facts. *Stimpson v. Baltimore & Susquehanna R. Co.*, 10 How., 329.

See *Mandamus*, § 4126.

Practice — **Motions** — *To amend*, § 4882. *To amend judgment*, § 4883. *To set aside service*, § 4884. *To set aside verdict*, § 4885. *To stay proceedings*, §§ 4886, 4887. *To strike plea from file*, § 4888. *For continuance*, § 4889. *To suppress testimony*, § 4890.

§ 4882. A motion to amend or open after default is addressed to the discretion of the court; its judgment will not be reviewed. *Dean v. Mason*, 20 How., 198.

§ 4883. Where suit was brought on two claims, one of which was abandoned after the evidence was in, and verdict for plaintiff with costs granted upon the other, a motion to amend judgment entered on the verdict by striking out "with costs," was allowed, plaintiff having failed to file disclaimer to such abandoned claim prior to suit brought, as provided by section 973, Revised Statutes. *Proctor v. Brill*, 16 Fed. Rep., 792.

§ 4884. A motion to set aside service in a suit in New York, made upon a defendant in the city of New York, granted, it appearing that he had come there to attend an examination of witnesses, held by stipulation, in a suit then pending in Massachusetts between the same parties upon the same letters patent. *Plimpton v. Winslow*, 22 O. G., 1207.

§ 4885. The substantial identity of two machines must be clearly proven before the court will listen to a motion to set aside a verdict on such ground. *Gray v. James*, Pet. C. C., 476.

§ 4886. Where the plaintiffs, in a bill for infringements, have obtained a decree for an account, and have commenced suits in the courts of other districts for like infringements, it seems that the court will, on motion, stay the accounting in the original suit, as to such matters as the plaintiffs have precluded themselves from recovering in it in consequence of their inequitable proceedings. *Rumford Chemical Works v. Hecker*, 11 Blatch., 552.

§ 4887. But the court will not, on mere motion, enjoin the plaintiffs from prosecuting suits which they have commenced before other courts for the recovery of damages such as they are endeavoring to obtain in the suit pending before it, especially after the plaintiffs have been allowed to proceed so far in the foreign suits as to commence taking accounts. *Ibid.*

§ 4888. Motion to strike a special plea from the files, or that it be ordered to stand as an answer, denied, it appearing that the plea did not merely deny the bill, but set up new matter that displaced the equity of the bill, viz., that the reissued patent relied on is void, being for a process, while the original patent was for a machine. *Hubbell v. De Land*, 22 O. G., 1883.

§ 4889. Motion for continuance, based on sickness of counsel for defense, granted. When an injunction will issue against defendant on allowance of such motion. *Rumford Chemical Works v. Hecker*, 1 B. & A., 135.

§ 4890. A motion to suppress the testimony of a witness on the ground that he was mistaken as to the occasion in regard to which he supposed himself to be testifying, denied when it appeared that the examination was regularly taken in proper form and in a proper manner, on prior notice to the other side, and that the usual oath was administered to the witness by the examiner before the examination began. *Fischer v. Hayes*, 20 O. G., 242.

See *Answer*, § 228. *Damages and Profits*, §§ 1626, 1627.

Practice — Motion to reopen, §§ 4891-4898. See *Decree*, §§ 1761-1812. *Injunction*, §§ 3385, 3434.

§ 4891. After judgment has been pronounced in the supreme court it is too late to move to open the judgment for the purpose of amending the bill of exceptions upon the ground of the omission therein of material evidence offered by plaintiffs in error which might have influenced the judgment of the court. *Gayler v. Wilder*, 10 How., 509 (§§ 385-96).

§ 4892. A motion to reopen case and admit newly discovered evidence, made after final hearing and decree, refused, it appearing that the evidence, if admitted, would have led to no different result. *Adair v. Thayer*, 2 McC., 360.

§ 4893. A motion to reopen a case and to admit newly discovered defenses, based upon certain English letters patent, denied, where it appeared that the pump described in said English patent was a double-acting exhausting air pump for a low pressure engine, and was otherwise different from the lifting pump claimed in the orator's patent. *Adair v. Thayer*, 17 Blatch., 468.

§ 4894. A motion to reopen a case for the consideration of a new reference cannot be granted when there is such difference between the patent and said reference that if the reference had been in evidence upon the trial it would not have changed the result. *Ibid.*

§ 4895. A motion to reopen a case for the introduction of new evidence should not be granted unless the new evidence would vary the case and probably lead to a different result. *McCloskey v. Du Bois*, 9 Fed. Rep., 38.

§ 4896. Where a former suit between the same parties and upon the same issue had been decided before the pending suit was instituted, but by an oversight no decree had been entered, and upon discovery of the defect the prevailing party had obtained leave to enter and had entered said decree, *held*, that the pending case should be opened to permit the party to file in the case a certified copy of the decree. *Barker v. Stowe*, 11 Fed. Rep., 303.

§ 4897. An application to reargue a patent case and to take further proofs, the case being before the court for its decision, refused, being an application for a favor and not a right, and strongly opposed by plaintiff. *Schneider v. Thill*, 18 Blatch., 241.

§ 4898. Motion to reopen case for introduction of further proof as to originality of patentee's invention, denied, because of lack of diligence in procuring the testimony, and because the testimony would not affect the decision. *United States v. Gunning*, 23 Fed. Rep., 668.

See *Art, Lost*, § 396.

Practice — On reference to master, §§ 4899-4904.

§ 4899. Mode of proceeding before a master to whom a patent case has been referred. *Kerosene Lamp-Heater Co. v. Fisher*, 1 Fed. Rep., 91.

§ 4900. Practice on reference to a master to state an account stated. *Union Sugar Refinery Co. v. Matthieson*, 3 Cliff., 146; *Foote v. Silsby*, 3 Blatch., 507; *Silsby v. Foote*, 20 How., 378.

§ 4901. Reference to master; what should be considered by him on an accounting for infringement. *Turrill v. Illinois Central R. Co.*, 5 Biss., 344.

§ 4902. The prevailing practice in United States circuit court (Massachusetts), in cases of accounting upon adjudged infringements, is that the master's compensation is charged upon and borne by complainants in the first instance, and recovered in costs, if the final decree is for them. *McDonald v. Shepard*, 10 Fed. Rep., 919.

§ 4903. The generally accepted procedure is to present all questions arising before the master by objections and exceptions to his report. Before the making of such report, a motion instructing the master in the discharge of his duties will not be entertained by the court. *Lull v. Clark*, 20 Fed. Rep., 454.

§ 4904. A master's report will not be revised by the court except upon good and sufficient grounds. *Steam Stone Cutter Co. v. Windsor Mfg. Co.*, 18 Blatch., 47.

See *Accounting*, §§ 130-133. *Damages and Profits*, §§ 1632; 1633. *Infringer*, § 2994.

Practice — Suit in state court, §§ 4905-4908.

§ 4905. Where a suit is brought in a state court to recover damages for breach of a certain contract, and afterward a suit is brought under the provisions of an act of congress in a federal court for the infringement of letters patent, the question as to the rights of a party under the patent is to be regarded as an original question, as if there had been no former suit. *Oliver, Finnie & Co. v. Rumford Chemical Works*, 109 U. S., 75.

§ 4906. The pendency of a prior suit in a state court is not a bar to a suit in a circuit court of the United States, although between the same parties and for the same cause of action. *Washburn & Moen Mfg. Co. v. Scutt & Co.*, 22 Fed. Rep., 710.

§ 4907. A pending suit in a state court for the rescission of license contracts, *held* no bar to a suit for its enforcement in the circuit court. Though a cross-bill might bring the whole controversy before the state court, complainants are not bound to take that course. *Ibid.*

§ 4908. Where the suit in the state court unites legal and equitable grounds of relief or of defense, as authorized by the statutes of the state, it may, in the federal court, be recast into two cases, one at law and one in equity, and in such a case a replender is necessary. *Perkins v. Hendryx*, 23 Fed. Rep., 418.

Practice — Rules of court, §§ 4909-4926.

§ 4909. Rules of equity practice prescribed by the supreme court are obligatory on the circuit courts. *Jenkins v. Greenwald*, 1 Bond, 126.

§ 4910. Practice of the supreme court in taking proofs in causes in equity under the rules of March, 1842, considered, as also the mode of procedure in England. *Van Hook v. Pendleton*, 2 Blatch., 85.

§ 4911. Circumstances in which the court, in its discretion, will allow the filing of a replication to an answer *nunc pro tunc* on application under equity rule 66. *Robinson v. Randolph*, 4 B. & A., 317.

§ 4912. Eighteenth equity rule; practice on bill taken *pro confesso*. *Thomson v. Wooster*, 114 U. S., 104.

§ 4913. Rule 30 of the supreme court applies only to cases appealed before its adoption, and is practically obsolete. A motion on appeal to dissolve an injunction granted in a court below denied. *White v. Dunbar*, 26 O. G., 353.

§ 4914. By rule 32 in equity a defendant may demur to the whole bill, and may demur to a part of the bill and answer as to the residue; but there is nothing that allows him to demur to the whole bill and at the same time to answer the whole bill, especially where the answer sets up everything that is in the demurrer. Putting in such an answer is a waiver of such demurrer. *Adams v. Howard*, 20 Blatch., 38.

§ 4915. Rule 34 of the rules of practice prescribed by the supreme court for the courts of equity of the United States requires that on overruling a plea the defendant shall be allowed to answer. That leave must be given. *Wooster v. Blake*, 20 O. G., 158.

§ 4916. Under equity rule 37 of supreme court a demurrer will not be overruled on argument on the ground that an answer to the whole bill was filed simultaneously therewith. *Hayes v. Dayton*, 18 O. G., 1406.

§ 4917. Rule 38 of the equity rules prescribed by the supreme court relates to rehearings after a final decree. *Wooster v. Handy*, 21 Fed. Rep., 51.

§ 4918. Equity rule 38 reviewed and construed. *Keller v. Stolzenbach*, 20 Fed. Rep., 47.

§ 4919. Practice under the forty-first and forty-fifth rules of circuit court. *Wren v. Spencer Optical Manufacturing Co.*, 18 O. G., 857.

§ 4920. Excess matter in a replication may be treated as surplusage, leaving the regular part of the replication standing as a traverse. *Ibid.*

§ 4921. Under the rules the answer is not evidence of the special facts alleged in it not responsive to the interrogatories, and the essential facts of the defense being neither responsive to interrogatories nor supported by other evidence, judgment must be given for the plaintiff. *Ibid.*

§ 4922. In administering rule 60 of the supreme court, the good cause for allowing an amendment to an answer, so as to set up a new defense, ought not to be regarded as being shown, when it appears that the matter of the proposed amendment could, with reasonable diligence, have been introduced into the answer. *India Rubber Comb Co. v. Phelps*, 8 Blatch., 85.

§ 4923. It is within the power of the court, in the exercise of its discretion under rules 66 and 69, to direct that the replication filed and proofs taken after the time prescribed in rule 66

shall stand as if the proceedings had severally been had within the time prescribed. *Fischer v. Hayes*, 19 Blatch., 26.

§ 4924. Under equity rule 88 an application for rehearing in a patent case cannot be entertained unless made within the term at which final decree was entered and recorded, such cases being appealable to the supreme court. *Barker v. Stowe*, 16 O. G., 807.

§ 4925. Supreme court rules 77 and 105 construed. *Foot v. Silsby*, 3 Blatch., 507.

§ 4926. Where the case was set for hearing upon bill and answer, and the plaintiffs moved for a decree pursuant to the prayer of the bill, "upon the bill and answer filed herein, and the annexed affidavit and the papers therein referred to," *held*, that the ninetieth rule of the supreme court should be followed. The affidavits were disregarded, and the case heard on bill and answer. *Evory v. Candee*, 17 Blatch., 200.

Practice — In patent office — Rules of patent office, §§ 4927-4934.

§ 4927. Congress, in creating the patent office, has, by express legislation, given that office the power to enact rules for its conduct. Those rules, if within the powers of the office and reasonable, are just as authoritative as the laws of congress. *United States ex rel. Koechlin v. Marble*, 22 O. G., 1365.

§ 4928. There is nothing unreasonable in the requirements of rule 39 of the patent office; and where it has not been complied with, the court will not issue a *mandamus* to compel the issue of a patent, although the invention be new and useful. *Ibid*.

§ 4929. The patent office rule requiring applicants to make known the existence of their foreign patents is made in accordance with law. A failure to comply with the rule renders the application defective, and it remains so, unless the office subsequently accepts and acts upon information respecting such foreign grants. *Ex parte Bland*, 15 O. G., 828.

§ 4930. Whatever may be the meaning or effect of rule 7 of the patent office rules, the law must always be looked to, and whatever principle stated in the rules is not found in the provisions of the law cannot be depended on. *Stephens v. Salisbury*, 1 MacA. Pat. Cases, 379.

§ 4931. A rule which says "that no evidence, statement or declaration touching the matter at issue will be considered upon the day of hearing, which shall not have been taken and filed in compliance with these rules," is a restraint imposed upon the commissioner himself, as much as if the very words of the rule had been contained in the statute. *Arnold v. Bishop*, 1 MacA. Pat. Cases, 28.

§ 4932. Evidence rejected which was not taken in accordance with a rule that provided that all evidence shall be sealed up and addressed to the commissioner of patents by the person before whom it was taken, and so certified thereon. *Ibid*.

§ 4933. After a deposition has been taken while the rules were in force, the dispensation of the commissioner cannot affect that deposition; a revocation of the rules can only affect subsequent proceedings. *Ibid*.

§ 4934. Rules made by the commissioner in conformity with the law, while they remain unabrogated, are as binding upon the commissioner as the law itself. *Ibid*.

Practice — In patent office — Generally, §§ 4935-4941.

§ 4935. The proceedings before the commissioner and before the judge are all initiatory, and relate to the question whether a patent shall issue. They cannot affect a patent already granted. *Pomeroy v. Connison*, 1 MacA. Pat. Cases, 40.

§ 4936. The proceedings in the office are all under the superintendence and control of the commissioner, who acts immediately under the law, and who is uncontrolled in the discharge of the duties of his office, except so far as an appeal is expressly given by law. *Matthews v. Wade*, 1 MacA. Pat. Cases, 143.

§ 4937. Proceedings in the patent office on an application for patent do not constitute a judicial proceeding. *Potter v. Stevens*, 2 Fish., 163.

§ 4938. The long continued usage and practice of one of the departments of the government (the patent office) is entitled to be considered by the courts with great respect. *Badische Anilin & Soda Fabrik v. Hamilton Mfg. Co.*, 13 O. G., 273.

§ 4939. According to the organization of the patent office, the question of patentability of an alleged invention is to be referred for examination first to one of the primary examiners. If his decision be unfavorable the applicant has the right of appeal to the examiners-in-chief; and then (in case of unfavorable decisions) to the commissioner and to the supreme court of the District of Columbia. *Hull v. Commissioner of Patents*, 2 MacArth., 90.

§ 4940. Upon the sufficiency of references, the question is not whether the applicant's invention is more useful than others, but whether it is new and sufficiently useful to justify a patent. *In re Aiken*, 1 MacA. Pat. Cases, 126.

§ 4941. The proceedings of the patent office are presumed to be regular and founded upon proper proceedings; but they must necessarily be founded upon the applications of living persons or their personal representatives, such as the law recognizes, and not upon those of persons who are merely supposed to exist, and should be founded upon the oath of the inventor or his personal representative, in accordance with the statute. *Eagleton Manufacturing Co v. West, Bradley & Cary Manufacturing Co.*, 18 Blatch., 218.

See *Evidence*, §§ 2278-2282.

264. POWER OF ATTORNEY.

See ATTORNEY, POWER OF ATTORNEY.

265. PRELIMINARY INJUNCTION.

See INJUNCTION, PRELIMINARY.

266. PRESUMPTIONS.

See ABANDONMENT, PRESUMPTION AS TO. EXPERIMENT, ABANDONED, PRESUMPTION AS TO. REISSUES, PRESUMPTION OF COMMISSIONER'S ACTS ON. REISSUES, PRESUMPTION OF LAW AS TO IDENTITY. NOVELTY, PRESUMPTION IN FAVOR OF. PATENT, PRESUMPTION OF LAW RAISED BY. UTILITY, PRESUMPTION OF. PATENTS, PRESUMPTION AS TO THE SUBSEQUENT PATENT OF TWO PATENTS. USE, PRIOR PUBLIC, PRESUMPTION AS TO.

267. PRINCIPLE.

See IDENTITY, IN PRINCIPLE.

Principle — *Defined*, §§ 4942-4945. *Its patentability*, §§ 4946-4968.

§ 4942. An abstract principle is unpatentable. *Evans v. Eaton*, Pet. C. C., 322.

§ 4943. A principle is not patentable. *Smith v. Ely*, 5 McL., 76.

§ 4944. A principle is an elementary truth, and is not patentable. *Barrett v. Hall*, 1 Mason, 447.

§ 4945. A principle, in the abstract, is a fundamental truth, and is not patentable. *Le Roy v. Tatham*, 14 How., 156.

§ 4946. The discovery of a new and abstract principle in science or mechanics is not patentable. *Tilghman v. Werk*, 1 Bond, 511; *Morton v. New York Eye Infirmary*, 5 Blatch., 116.

§ 4947. A principle is not patentable. The means of applying and using it are patentable. *O'Reilly v. Morse*, 15 How., 62.

§ 4948. A new principle, without reference to any mode or method of enforcing it, is not patentable. *Smith v. Downing*, 1 Fish., 64.

§ 4949. An abstract principle is patentable only when applied to produce some beneficial result. *Le Roy v. Tatham*, 22 How., 132.

§ 4950. A principle is not patentable, but the embodiment and application of the principle is. *Wintermute v. Redington*, 1 Fish., 239.

§ 4951. A principle is not patentable; but the discovery of a principle and a mode of operation, the mode of carrying the principle into effect, is patentable, and he is an infringer who takes substantially the principle and mode, though he vary the form. *Singer v. Wabnesley*, 1 Fish., 558.

§ 4952. A patent cannot be valid for a principle merely, but must be for the application of a principle to some practical and useful purposes. *Bell v. Daniels*, 1 Bond, 212.

§ 4953. A newly discovered principle or property of matter may be patented, provided a new and useful result has been obtained from the application of it, and the specification describes how the result is to be obtained. *Mitchell v. Tilghman*, 19 Wall., 287.

§ 4954. An idea is not patentable, but a new device by which this idea may be made practically useful is. *Rubber Tip Pencil Co. v. Howard*, 20 Wall., 498.

§ 4955. A principle, when made available by a method whereby it is put to practical use, is patentable as a process. *Andrews v. Carman*, 13 Blatch., 307.

§ 4956. Mere philosophical or abstract theory is unpatentable; it must be reduced to practice in a particular structure or combination to become patentable. *Lowell v. Lewis*, 1 Mason, 182.

§ 4957. A new use of a principle previously applied for the same purpose is not patentable. A new application by new mechanical contrivances and apparatus, by means of which a new and beneficial result is produced in the use of the article to which it has been thus applied, is patentable. *Foote v. Silsby*, 1 Blatch., 445.

§ 4958. What is to be protected is not an abstract or isolated principle, but the embodiment of a principle into a machine or manufacture, as described in the specification; and it is the invention in conformity with that embodiment or representation of its working which the act of congress will protect. *Smith v. Downing*, 1 Fish., 64.

§ 4959. A patent cannot be granted for a principle or for an idea, or for any abstraction whatever. But when the idea is applied to a material thing, so as to produce a useful effect or result, it ceases to be abstract and becomes a proper subject to be covered by a patent. *McComb v. Brodie*, 1 Woods, 153.

§ 4960. There can be no patent for a principle; but for a principle so far embodied and connected with corporeal substances as to be in a condition to act and to produce effects in any trade, mystery or manual occupation, there may be a patent. *Andrews v. Carman*, 13 Blatch., 307.

§ 4961. The most important part of an invention may consist in the conception of the original idea, in the discovery of the principle in science, or of the law of nature, stated in the patent, and little or no pains may have been taken in working out the best manner of practically applying that principle to the purpose set forth in the patent. Still, if the principle is stated to be applicable to any special purpose, so as to produce any result previously known in the way and for the purpose described, the patent is good. *Burrows v. Witherill*, 1 MacA. Pat. Cases, 315.

§ 4962. A well known principle or truth of natural science, as well as a newly discovered one, is patentable to the one who first applies it to the useful arts; but having been once made known and applied, any subsequent application of it, even though more perfect, must, to insure a patent, rest upon the new machinery or combination of machinery, and not upon the principle the novelty of which has been exhausted. *In re Henry*, 1 MacA. Pat. Cases, 467.

§ 4963. The doctrine that a discovery of a fact or principle, when practically applied to produce some new and useful effect in the arts, is patentable, is modified by the condition that the new effect must be produced by means that are new, by some *invention*, some contrivance, or the production of something that did not before exist. *In re Kemper*, 1 MacA. Pat. Cases, 1.

§ 4964. There cannot be a patent for a principle nor for the application of a principle, nor for an effect. Two persons may use the same principle and produce the same effect by different means without interference or infringement, and each would be entitled to a patent for his own invention. *Bain v. Morse*, 1 MacA. Pat. Cases, 90.

§ 4965. The discovery of a new principle is not a new invention, but its application to a practical purpose in the new construction, operation or effects of machinery or composition of matter is a "discovery," "invention" or "improvement" within the act of congress. *Whitney v. Emmett*, 1 Bald., 303.

§ 4966. Where the invention is a *machine*, a patent will not be granted for a "principle," "mode of operation," or an "idea." *Burr v. Duryee*, 1 Wall., 531.

§ 4967. When a specification endeavors to monopolize an idea, a function of the vital system, or any quality of objects in nature, it is void for undue generality, unless cured by disclaimer. *Cushing's Opinion*, 8 Op., 270.

§ 4968. The word "principle" in a claim construed and limited. *Stanley v. Hewitt*, 17 Frank. Jr., 2d Series, 165.

See *Inventor*, § 3729. *Process*, §§ 5051, 5073.

Principle — *Of an invention, defined*, §§ 4969-4972. *Of a machine, defined*, §§ 4973-4979.

§ 4969. Whatever is essential to the result to be obtained by the discovery, independent of mere form and the proportions of the thing used for the purpose, may generally be considered as the principle of the invention. *Treadwell v. Bladen*, 4 Wash., 703.

See *Identity*, §§ 2676-2709.

§ 4970. The word "principle" means the operative cause by which a certain effect is produced, the combination of certain mechanical powers, the mode of operation. *Olcott v. Hawkins*, 2 Am. L. J., 317.

§ 4971. The word *principle* of an invention construed to mean *modus operandi*. *Sickles v. Gloucester Mfg. Co.*, 1 Fish., 222.

§ 4972. The principle of a machine is its peculiar or constituent parts. *Barrett v. Hall*, 1 Mason, 447.

§ 4973. The principle of a machine is its *modus operandi*. *Whittemore v. Cutter*, 1 Gall., 478; *Latta v. Shawk*, 1 Bond, 259.

§ 4974. The "principle" of a machine is its "mode of operation," or that peculiar combination of devices which distinguishes it from other machines. *Burr v. Duryee*, 1 Wall., 531.

§ 4975. The principle of a machine has reference to its mode of operation, not to any abstract principles involved in its proportions or motion. *Judson v. Cope*, 1 Bond, 327.

§ 4976. The principle of a machine, or improvement of a machine, is the peculiar mode, manner or device by which the proposed result or effect is produced. *Pitts v. Wemple*, 1 Biss., 87.

§ 4977. The true legal meaning of the principle of a machine with reference to the patent act is the peculiar structure or constituent parts of such machine. The principles of two machines may be very different, though their external structures may have great similarity. *In re Boughton*, 1 MacA. Pat. Cases, 275.

§ 4978. The principle of a machine is the operative cause by which a certain effect is produced. *Brooks v. Jenkins*, 3 McL., 432.

§ 4979. The word principle, as applied to mechanics, is where two machines or things are made to operate substantially in the same way so as to produce a similar result; they are considered the same in principle. *Roberts v. Ward*, 4 McL., 565.

Principle — Infringement of — *Particular cases*, §§ 4980-4985.

§ 4980. Principle. Improvement in, is no infringement. *Park v. Little*, 3 Wash., 196.

§ 4981. *Semble*, that the new application of the principle by means of mechanical contrivances constitutes of itself a part of the invention; and that any different or improved mode of application is but an improvement upon the discovery, and not available without consent. *Foote v. Silsby*, 1 Blatch., 445.

§ 4982. A chance operation of a principle, unrecognized at the time, and from which no information of its existence and no knowledge of a method of its employment is derived, will not be sufficient to defeat the claim of him who first discovered the principle and put it to a practical and intelligent use. *Andrews v. Carman*, 13 Blatch., 307.

§ 4983. A patent which set forth a naked discovery simply — the production of insensibility to pain by sulphuric ether — *held* not to be for patentable subject-matter, and void. *Morton v. New York Eye Infirmary*, 5 Blatch., 116.

§ 4984. There can be no patent for a mere principle. The discoverer of a natural force or scientific fact cannot have a patent for that; but if he invents for the first time a process by which a certain effect of one of the forces of nature is made useful to mankind, and fully describes and claims that process, and also describes a mode or apparatus by which it may be usefully applied, he is entitled to a patent for the process of which he is the first inventor, and is not restricted to any particular form of mechanism or apparatus by which he carries out that process. *American Bell Telephone Co. v. Dolbear*, 15 Fed. Rep., 448.

§ 4985. Another person, who afterward invents an improved form of apparatus embodying the same process, may indeed obtain a patent for his improvement; but he has no right to use the process in his own or any other form of apparatus without the consent of the first inventor of the process. *Ibid.*

See *Claim, Construction of*, §§ 723, 776, 780. *Construction of Patents*, § 1217.

268. PRIOR INVENTION.

See INVENTION, PRIOR.

269. PRIOR INVENTOR.

See INVENTOR, PRIOR.

270. PRIOR KNOWLEDGE AND USE.

See USE AND KNOWLEDGE, PRIOR.

271. PRIOR FOREIGN KNOWLEDGE AND USE.

See USE, PRIOR FOREIGN KNOWLEDGE AND.

272. PRIOR PATENT.

See INTERFERING PATENTS. NOVELTY. PRIORITY.

273. PRIOR PATENT OF TWO PATENTS, IN GENERAL.

See PATENTS, THE PRIOR PATENT OF TWO PATENTS

274. PRIOR PUBLICATION.

See PUBLICATION, PRIOR.

275. PRIOR PUBLIC USE.

See USE, PRIOR PUBLIC.

276. PRIOR USE, RECOVERY FOR.

See RECOVERY, FOR PRIOR USE.

277. PRIORITY OF INVENTION.

See DELAY, §§ 1878-1882. REDUCTION TO PRACTICE, §§ 5241-5247.

Priority of invention — *Diligence in reduction to practice as between two inventors*, §§ 4986-4996.

§ 4986. Priority of conception, followed by reduction to practice, gives priority of right. *Sayles v. Hapgood*, 2 Biss., 189.

§ 4987. Whoever first perfects a machine capable of useful operation is entitled to a patent. *Agawam Co. v. Jordan*, 7 Wall., 583.

§ 4988. In a race of diligence between two independent inventors, he who first reduces his invention to a fixed, positive and practical form has a priority of right to a patent. *Many v. Jagger*, 1 Blatch., 372; *Parkhurst v. Kinsman*, 1 Blatch., 488; *Reed v. Cutter*, 1 Story, 590; *Ellithorp v. Robertson*, 4 Blatch., 307.

§ 4989. In the race of diligence, he must be held to be the first inventor who, having started later in his experiments than the other two inventors, arrived first at the goal, and first made the completed, successful invention, and followed it up by his patent. *Taylor v. Archer*, 8 Blatch., 315.

§ 4990. In a race of diligence between two independent inventors, he who invents first has the prior right if he is using reasonable diligence in reducing it to practice, although the second inventor is the first to reduce it to positive form. *Reed v. Cutter*, 1 Story, 590.

§ 4991. In a race of diligence between rival inventors, the one who first perfects an invention and embodies it in a distinct form is entitled to priority. *Reeves v. Keystone Bridge*, 1 O. G., 466.

§ 4992. Of two inventors who have conceived of the same invention at the same time, he who first reduces it to practice is entitled to priority. *Siebert Cylinder Oil Cup Co. v. Phillips Lubricator Co.*, 10 Fed. Rep., 677.

§ 4993. Where patentee has used reasonable diligence in perfecting his discovery, he is entitled to priority over those who have intervened between his discovery and the grant of the patent. *Johnson v. Root*, 1 Fish., 351.

§ 4994. Of two original inventors the first will be entitled to a patent unless the other puts the invention into public use more than two years before the application for a patent. *Webster Loom Co. v. Higgins*, 105 U. S., 580.

§ 4995. The determination of the fact of diligence is not to be reached by comparison of the diligence of the two inventors. If the first to conceive of the invention was reasonably diligent in perfecting his idea, it does not matter that the second inventor was exceedingly diligent and made more rapid advances. *Electric R. R. Signal Co. v. Hall R. R. Signal Co.*, 6 Fed. Rep., 603.

§ 4996. Although a third party had conceived of the invention before the plaintiff, and had made some progress toward completing a model, yet, if he then suspended his labors, and, before he resumed them, the plaintiff had perfected the invention and had embodied it in a practical working machine, his patent will be sustained. *Smith v. O'Connor*, 2 Saw., 461.

Priority of invention — Reduction to practice constitutes, §§ 4997-5006.

§ 4997. Reduction to practice is essential to priority of invention in order to defeat a patent. *Parkhurst v. Kinsman*, 1 Blatch., 488.

§ 4998. In order to defeat a patent, it is necessary that another should first have discovered the thing and reduced it to actual practice. *Cox v. Griggs*, 1 Biss., 362.

§ 4999. In order to invalidate a patent, the similar machine which is alleged to have existed previously must have been actually used and successfully operative. *Seymour v. Marsh*, 2 O. G., 675.

§ 5000. A subsequent inventor who reduces his invention to practice will not be defeated by a prior invention which has never been so reduced. *Bedford v. Hunt*, 1 Mason, 302.

§ 5001. A prior application for a patent alone, without evidence to show that such a lantern as is described therein was ever constructed, is not sufficient to defeat a patent. *Adams v. Howard*, 19 Fed. Rep., 317.

§ 5002. An imperfect description, coupled with an incomplete drawing, is insufficient to invalidate a patent. *New Process Fermentation Company v. Koch*, 21 Fed. Rep., 580.

§ 5003. The mere making of a model of an invention held not to constitute invention, as against a patent subsequently granted to another for the same thing. *Stilwell & Bierce Manufacturing Co. v. Cincinnati Gas Co.*, 7 O. G., 829.

§ 5004. A crude and imperfect experiment held insufficient to prove priority of invention over a patent. *Potter v. Wilson*, 2 Fish., 102.

§ 5005. Experiment alone is not sufficient to constitute priority of invention. *Many v. Sizer*, 1 Fish., 17.

§ 5006. An invention relating to machinery may be exhibited as well in a drawing as in a model, so as to lay the foundation of a claim to priority, if sufficiently plain to enable those skilled in the art to understand it. *Webster Loom Co. v. Higgins*, 105 U. S., 580.

Priority of invention — In general, §§ 5007-5010. *Evidence*, §§ 5011, 5012. *Patent office decision*, § 5013. See *Invention, Prior*, §§ 3697-3717. *Interference*, §§ 3435-3474. *Interfering Patents*, §§ 3475-3504. *Publication*, § 5134.

§ 5007. Upon the issue of priority of invention, the question is not whether one of the parties obtained better results than the other, but rather which of the parties first invented or discovered the subject-matter in controversy. *Matthews v. Wade*, 1 MacA. Pat. Cases, 143.

§ 5008. On the question of priority of invention the court cannot, as a matter of law, be required to pronounce upon the identity or diversity of the several inventions described in the patents produced. *Bischoff v. Wethered*, 9 Wall., 812.

§ 5009. Though the defense of prior invention ought to be set out in the answer, yet if the omission to set it out is not objected to at the proper time in the court below, it cannot be objected to in the supreme court. *Webster Loom Co. v. Higgins*, 105 U. S., 580.

§ 5010. In the contest for priority, the date of the patent will be considered as relating back to that of the original discovery. *Dixon v. Moyer*, 4 Wash., 68.

See *Bill, to Obtain Patent*, §§ 638, 639, 644, 646.

§ 5011. Upon an issue of priority of invention in an interference proceeding, it is not true that the machines themselves are the best evidence, and must be produced or their absence satisfactorily accounted for before parol testimony can be admitted to prove their character and construction, and that otherwise the parol testimony is inadmissible. *Screw Co. v. Sloan*, 1 MacA. Pat. Cases, 210.

§ 5012. The question of priority of invention having been determined in a suit in one circuit, the record of such suit is admissible as evidence in a suit in another circuit, and is conclusive as to such question when the defendant in the later suit employed the counsel and paid the expenses in the prior, though not a party thereto. *U. S. & Foreign Salamander & Felting Co. v. Asbestos Felting Co.*, 18 Blatch., 312.

See *Date of Invention*, § 1736. *Infringement*, § 2833.

§ 5013. When on appeal to the judge it appears from the testimony submitted in an interference proceeding between an applicant for a patent and a patentee that the applicant is debarred from receiving a patent by reason of the public use of his invention, it is unnecessary to determine the question of priority of invention. *Justice v. Jones*, 1 MacA. Pat. Cases, 635.

Priority of invention — *Particular cases*, §§ 5014-5023.

§ 5014. That defendant accepted a rejection on his application for patent in the patent office in view of another (plaintiff's) patent, without asking for an interference, is of weight to show that he did not claim priority. *Fay & Co. v. Allen*, 32 O. G., 1355.

§ 5015. The evidence of prior invention is usually entirely within the control of the party asserting it, and so wide is the opportunity for deception or mistake that the authorities are almost unanimous in holding that it must be established by proof clear, positive and unequivocal—nothing must be left to speculation or conjecture. *Thayer v. Hart*, 20 Fed. Rep., 693.

§ 5016. It being found that no one of the principal circumstances relied on by the complainant is free from perplexity, either its own date being uncertain or there being difficulty in connecting it with the invention, the doubt is created which the authorities hold must be absent from the mind of the court, and it follows that the bill must be dismissed. *Ibid.*

§ 5017. Where, on a question of date of invention, patentee testified directly, there being no contradictions or doubts, and delay in applying for the patent was explained, such date was allowed to prevail over a patent prior to hers but subsequent to such date of invention. *McDonald v. Blackmer*, 4 B. & A., 78.

§ 5018. Where a patentee showed, but disclaimed in his original patent, matter shown and claimed by a prior applicant, but on reissue claimed such disclaimed matter, *held*, that the burden was upon him to overcome such facts in order to show priority of invention as against the patent subsequent in date to his granted the prior applicant. *Smith v. Allen*, 2 Fish., 572.

§ 5019. Where the question was one of priority of invention, and the alleged prior invention was testified to after twenty years' uninterrupted use of the valuable patented invention, *held*, that the presumption arising from science, where there was so much interest to assert in favor of the patented invention, had far more strength than any preponderance in the number of witnesses. *Smith v. Fay & Co.*, 6 Fish., 446.

§ 5020. Where, of two interfering patents, the prior inventor was also the one to use diligence in securing his patent, his patent was sustained, and that of the subsequent inventor declared void. *Lockwood v. Cleveland*, 18 Fed. Rep., 37.

§ 5021. Where the patent was attacked on the ground of priority of invention, it being a fact that patentee had not reduced his idea to practice before his application, *held*, that it was necessary to show not only prior conception, with drawings, models and experiments, but also reduction to practice prior to date of patentee's application. *Electric Railroad Signal Co. v. Hall Railroad Signal Co.*, 6 Fed. Rep., 603.

§ 5022. Where, of two interfering applications, it was shown that the prior in date of invention had delayed nine years after perfecting it before applying for his patent, it was held abandoned, and the patent issued to the latter inventor, who had shown reasonable diligence. *Rowley v. Mason*, 2 Am. L. T. (U. S.) R., 106.

§ 5023. W. and T. having filed applications for patents showing substantially the same device, at the respective dates March 31 and April 21, 1868, were rejected. T. persisted in his claim, and upon appeal secured his patent, while W. amended his application, excluding from his claim the common device, and thus, without appeal, obtained a patent of narrow scope. Subsequently, learning of T.'s patent, he filed a second application, broad enough to include the device previously omitted, and in the consequent interference proceedings with T. was adjudged the prior inventor, and thereupon obtained a broad patent. *Held*, in a suit brought by T. against W., that W.'s second application was the commencement of a *new proceeding*, and that alone upon which the patent granted in pursuance of it depends; and, therefore, that the presumption, as regards priority of invention, was with T. *Pelton v. Waters*, 7 O. G., 425.

278. PRIVATE PROPERTY.

See GOVERNMENT. PATENTS.

279. PRIVIES.

§ 5024. Complainants are chargeable with the laches of the former owners of the patent, having succeeded only to the rights of such former owners. *Spring v. Domestic Sewing Machine Co.*, 16 O. G., 721.

§ 5025. Where suit was brought by patentee and his assignee against the assignee of an undivided interest in an interfering patent, which interest had been acquired subsequent to the commencement of the suit on the interference, but prior to rendition of judgment from the party to such suit, *held*, that the defendant in the existing suit was privy to the defendant in the

prior suit, and would be bound by its decision within section 16, act 1836. *Tyler v. Hyde*, 2 Blatch., 308.

§ 5026. Where there is a privity or connection between the different defendants, they are jointly liable upon a bill for infringing a patent. *Wells v. Jaques*, 5 O. G., 364.

§ 5027. Where patentee sued A., B. and C. separately for infringement, and suit against A. went as a test case to final hearing, in which the patent was sustained and infringement found, and A. appealed, but at plaintiff's instance and for a consideration abandoned the appeal, and the other cases were dismissed, since when C. continued the use of the patented device; *held*, in suit brought against C. for infringement that he was not bound by the decision in A.'s case. *McMillan v. Conrad*, 16 Fed. Rep., 128.

See *Parties*, §§ 4489-4545. *Purchaser*, § 5184. *Title*, § 6316.

280. PROCESS.

SUMMARY (*CORNING v. BURDEN*, §§ 5028-5035) — *Process is patentable as an art*, § 5028. — *Machine defined*, § 5029. — *Process defined*, § 5030. — *A result is not patentable*, § 5031; *nor a function*, § 5032. — *Patents should be favorably construed*, § 5033. — *Testimony of experts*, § 5033a. — *Patent office decision as prima facie evidence*, § 5034. — *Defendant's patent in evidence*, § 5035.

(*MOWRY v. WHITNEY*, §§ 5036-5045) — *The patent construed to be for a process*, § 5036. — *Not void for uncertainty in description*, § 5037. — *What is a sufficient specification of a process*, §§ 5038, 5039. — *The patented process held infringed*, § 5040. — *Accounting*, § 5041. — *Apportionment of profits*, § 5042. — *Measure of damages*, § 5043. — *Scope of process patent*, § 5044. — *Interest on profits, when allowed*, § 5045.

(*TILGHMAN v. PROCTOR*, §§ 5046-5059) — *History of the art*, § 5046. — *Novelty, accidental product*, § 5047. — *The patent examined*, § 5048. — *A process is an art*, § 5049. — *Neilson's patent reviewed*, § 5050. — *Principle and process examined*, § 5051. — *Morse's eighth claim considered*, § 5052. — *Process defined*, § 5053. — *Sufficient description of a process*, § 5054. — *Patentee's claim is not for a principle*, § 5055. — *The infringement considered*, § 5056. — *An improvement confers no right to device improved on*, § 5057. — *Variations in degree of heat*, § 5058. — *Antedating patent and foreign patent*, § 5059.

CORNING v. BURDEN.

(15 Howard, 252-271. 1853.)

ERROR to U. S. Circuit Court, Northern District of New York.

Opinion by MR. JUSTICE GRIER.

STATEMENT OF FACTS.—Peter A. Burden, who is assignee of a patent granted to Henry Burden, brought this suit against the plaintiffs in error for infringement of his patent. The declaration avers that Henry Burden was "the first inventor of a new and useful machine for rolling puddle balls," for which a patent was granted to him in 1840, and that the defendants, Corning and Winslow, "made, used, etc., this said new and useful machine in violation and infringement of the exclusive right so secured to plaintiff."

The defendants below, under plea of the general issue, gave notice that they would prove on the trial that Henry Burden "was not the first and original inventor of the supposed new and useful machine for rolling puddle balls, etc.;" that the machine of the plaintiff and the principle of its operation was not new, and that the common and well known machines called nobbling rolls, which were in use long before the application of Burden for a patent, embraced the same invention and improvements used for substantially the same purpose. And after setting forth many other matters to be given in evidence, affecting the novelty of plaintiff's machine, the notice denies that the machine used by the defendants was an infringement of that patented by plaintiff, and avers that the machine used by them was described in a patent issued to the defendant, Winslow, in December, 1847, "for rolling and com-

pressing puddlers' balls," differing in principle and mode of operation from that described in the plaintiff's patent.

To support the issue in his behalf, the plaintiff gave in evidence a patent to Henry Burden, dated 10th of December, 1840, for "a new and useful machine for rolling puddlers' balls and other masses of iron in the manufacture of iron;" and followed it by testimony tending to show the novelty and utility of his machine, and that the machine used by the defendants was constructed on the same principles, and there rested his case. The defendants then offered to read in evidence the patent of Winslow for his "new and useful improvement in rolling and compressing puddlers' balls." The plaintiff objected to this evidence as irrelevant, and the court sustained the objection and overruled the evidence. This ruling of the court forms the subject of defendants' first bill of exceptions.

The defendants then proceeded to introduce testimony tending to show want of originality in the plaintiff's machine; and also that the principle and mode of operation of the defendants' machine was different from that described in the plaintiff's patent; and finally called a witness named Hibbard. This witness gave a history of the various processes and machines used in the art of converting cast-iron into blooms or malleable iron. He spoke of the processes of puddling, shingling and rolling, and attempted to define the difference between a process and a machine. The introduction of this philological discussion seems at once to have changed the whole course of investigation, to the entire neglect of the allegations of the declaration and of the issues set forth in the pleadings, in support of which all the previous testimony had been submitted to the jury. The defendants' counsel then proposed the following question to the witness: "Do you consider the invention of Mr. Burden, as set forth in his specification, to be for a process or a machine?" This question was objected to, overruled by the court, and a bill of exceptions sealed.

The counsel for the defendants then offered to prove by this witness "that the practical manner of giving effect to the principle embodied in the machine used by the defendants was entirely different from the practical manner of giving effect to the principle embodied in Mr. Burden's machine; that the principles of the two machines, as well as the practical manner of carrying out those principles, were different; and that the machine used by the defendants produced, by its action on the iron, a different mechanical result, on a different mechanical principle, from that produced in Mr. Burden's machine." To the introduction of this testimony the plaintiff's counsel objected, and it was overruled by the court, and, at the defendants' instance, a bill of exceptions sealed.

The defendants' counsel then proposed to prove "that the machine used by the defendants differed in point of mechanical structure and mechanical action from the machines described in the plaintiff's specification." This testimony was also overruled and exceptions taken.

After some further examination of witnesses, the learned judge announced his intention of instructing the jury, in the three following propositions, upon which the defendants' counsel declined to give further testimony, and excepted to his instructions:

"1. The letters patent to Henry Burden, which have been given in evidence by the plaintiff, are for a new process, mode or method of converting puddlers' balls into blooms, by continuous pressure and rotation of the ball between converging surfaces; thereby dispensing with the hammer, alligator jaws, and

rollers accompanied with manual labor, previously in use to accomplish the same purpose. And the said letters patent secure to the patentee the exclusive right to construct, use and vend any machine adapted to accomplish the objects of his invention as above specified, by the process, mode or method above mentioned."

"2. The machines for milling buttons, milling coin and rolling shot, which have been given in evidence by the defendants, do not show a want of novelty in the invention of the said patentee, as already described, if the processes used in them, the purposes for which they were used, and the objects accomplished by them, were substantially different from those of the said letters patent."

"3. That the machine used by the defendants is an infringement of the said letters patent, if it converts puddlers' balls into blooms by the continuous pressure and rotation of the balls between converging surfaces, although its mechanical construction and action may be different from those of the machines described in the said letters patent."

As the first instruction of the court contains the most important point in the case, and a decision of it will dispose of most of the others, we shall consider it first in order. Is the plaintiff's patent for a process or a machine?

§ 5028. *A process, as distinguished from a machine, is patentable, and comes under the terms "useful art" in the patent law.*

A process, *eo nomine*, is not made the subject of a patent in our act of congress. It is included under the general term "useful art." An art may require one or more processes or machines in order to produce a certain result or manufacture.

§ 5029. *"Machine" includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain result.*

The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result.

§ 5030. *A "process" is a mode, method or operation by which a result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another.*

But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods or operations are called processes.

§ 5031. *A patent is not issuable for a result, but for the process or machine which produces the result—and the result must be useful.*

A new process is usually the result of discovery; a machine, of invention. The arts of tanning, dyeing, making water-proof cloth, vulcanizing india-rubber, smelting ores, and numerous others, are usually carried on by processes, as distinguished from machines. One may discover a new and useful improvement in the process of tanning, dyeing, etc., irrespective of any particular form of machinery or mechanical device. And another may invent a labor-saving machine by which this operation or process may be performed, and each may be entitled to his patent. As, for instance, A has discovered that by exposing india-rubber to a certain degree of heat, in mixture or connection with certain metallic salts, he can produce a valuable product or manufacture; he is entitled to a patent for his discovery, as a process or improvement in the art, irrespective of any machine or mechanical device. B, on the contrary, may invent a new furnace or stove, or steam apparatus, by which this process

may be carried on with much saving of labor, and expense of fuel; and he will be entitled to a patent for his machine, as an improvement in the art. Yet A could not have a patent for a machine, or B for a process; but each would have a patent for the means or method of producing a certain result or effect, and not for the result or effect produced. It is for the discovery or invention of some practicable method or means of producing a beneficial result or effect that a patent is granted, and not for the result or effect itself. It is when the term process is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations.

But the term process is often used in a more vague sense, in which it cannot be the subject of a patent. Thus we say that a board is undergoing the process of being planed, grain of being ground, iron of being hammered or rolled. Here the term is used subjectively or passively as applied to the material operated on, and not to the method or mode of producing that operation, which is by mechanical means, or the use of a machine, as distinguished from a process. In this use of the term it represents the function of a machine, or the effect produced by it on the material subjected to the action of the machine.

§ 5032. *A patent will not issue for the function or abstract effect of a machine, but only for the machine.*

But it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produces it. It is by not distinguishing between the primary and secondary sense of the term "process," that the learned judge below appears to have fallen into an error. It is clear that Burden does not pretend to have discovered any new process by which cast-iron is converted into malleable iron, but a new machine or combination of mechanical devices by which the slag or impurities of the cast-iron may be expelled or pressed out of the metal, when reduced to the shape of puddlers' balls. The machines used before to effect this compression were tilt hammers and alligator's jaws, acting by percussion and pressure, and by nobbling rolls with eccentric grooves, which compressed the metal by use of the inclined plane in the shape of a cyclovolute or snail cam. In subjecting the metal to this operation, by the action of these machines, more time and manual labor is required than when the same function is performed by the machine of Burden. It saved labor, and thus produced the result in a cheaper if not a better manner, and was therefore, the proper subject of a patent.

In either case the iron may be said, in the secondary sense of the term, to undergo a process in order to change its qualities by pressing out its impurities, but the agent which effects the pressure is a machine or combination of mechanical devices. The patent of Burden alleges no discovery of a new process, but only that he has invented a machine, and, therefore, correctly states the nature of his invention.

The patent law (5 Stats. at Large, 119) requires that "every patent shall contain a short description or title of the invention or discovery, indicating its nature and design," etc. The patent in question recites that: "Whereas Henry Burden, of Troy, New York, has alleged that he has invented a new and useful machine for rolling puddle balls, or other masses of iron, in the manufacture of iron, which he states has not been known or used before his application; has made oath that he is a citizen of the United States; that he does verily

believe that he is the original and first inventor or discoverer of the said machine," etc.

The specification declares that his improvement consists in "the employment of a new and useful machine for rolling of puddlers' balls;" again, he calls it "my rolling machine," and describes his "machine as consisting of a cast-iron cylinder," etc. In fine, his specification sets forth the "particulars" of his invention, in exact accordance with its title in the patent, and in clear, distinct, unequivocal and proper phraseology.

§ 5033. *The construction of the patent should be favorable to the patentee.*

It is true that the patentee, after describing his machine, has set forth his claim in rather ambiguous and equivocal terms, which might be construed to mean either a process or machine. In such case, the construction should be that which is most favorable to the patentee, *ut res magis valeat quam pereat*. His patent having a title which claims a machine, and his specification describing a machine, to construe his claim as for the function, effect or result of his machine would certainly endanger, if not destroy, its validity. His claim cannot change or nullify his previous specification with safety to his patent. He cannot describe a machine which will perform a certain function, and then claim the function itself, and all other machines that may be invented to perform the same function. We are of opinion, therefore, that the learned judge of the court below erred in the construction of the patent, and in his first proposition or instruction to the jury. And as the second and third instructions are based on the first, they must fall with it. Taking the bills of exception to rejection of evidence in the inverse order, it is clear that the last two rulings, being founded on the erroneous construction of the patent, are, of course, erroneous. The testimony offered was directly relevant to the issues trying, and should have been received.

§ 5033a. *Testimony of experts, when admissible.*

The refusal of the court to hear the opinion of experts as to the construction of the patent was proper. Experts may be examined as to the meaning of terms of art on the principle of *cuique in sua arte credendum*, but not as to the construction of written instruments.

It remains only to notice the first bill of exceptions, which was to the rejection of the defendant's patent. This is a question on which there may be some difference of opinion. In some circuits it has been the practice, when the defendant has a patent for his invention, to read it to the jury without objection; in others, it is not received, on the ground that it is irrelevant to the issue, which is a contest between the machine of the defendant and the patent of the plaintiff, and that a posterior patent could not justify an infringement of a prior one for the same invention.

By the patent act of 1793 (1 Stats. at Large, 318), any person desirous of obtaining a patent for an alleged invention, made application to the secretary of state, and received his patent on payment of the fees, and on a certificate of the attorney-general that his application "was conformable to the act." No examination was made by persons qualified to judge whether the alleged invention was new or useful, or had been patented before. That rested wholly on the oath of the applicant. The patent act of 1790 (1 Stats. at Large, 109) had made a patent *prima facie* evidence; but this act was repealed by that of 1793, and this provision was not re-enacted in it. Hence a patent was not received in courts of justice as even *prima facie* evidence that the invention

patented was new or useful, and the plaintiff was bound to prove these facts in order to make out his case.

§ 5034. *Under the acts of 1836 and 1839, by reason of tests and examinations of competent officers, a patent is prima facie evidence of the novelty and utility of the thing patented.*

But the act of the 4th of July, 1836, introduced a new system, and an entire change in the mode of granting patents. It provided for a new officer, styled a commissioner of patents, to "superintend, execute and perform all acts and things touching and respecting the granting and issuing of patents," etc. The commissioner was authorized to appoint a chief clerk, and three examining clerks, machinist, and other officers. On the filing of an application the commissioner is required to make, or cause to be made, an examination of the alleged invention, in order to ascertain whether the same had been invented or discovered by any other person in this country, prior to the application; or whether it had been patented in this or any foreign country, or had been on public use or sale, with the applicant's consent, prior to his application; and if the commissioner shall find that the invention is new and useful, or important, he is authorized to grant a patent for the same. In case the decision of the commissioner and his examiner is against the applicant, and he shall persist in his claim, he may have an appeal to a board of examiners, to consist of three persons, appointed for that purpose by the secretary of state, who, after a hearing, may reverse the decision of the commissioner in whole or in part. By the act of 1839 (5 Stats. at Large, 353), the chief justice of the District of Columbia was substituted to the board of examiners.

§ 5035. — *and the defendant in a suit for infringement was entitled to read his patent as evidence of novelty and utility, on the trial, at least as evidence of good faith to reduce damages.*

It is evident that a patent, thus issued after an inquisition or examination, made by skilful and sworn public officers, appointed for the purpose of protecting the public against false claims or useless inventions, is entitled to much more respect, as evidence of novelty and utility, than those formerly issued without any such investigation. Consequently such a patent may be, and generally is, received as *prima facie* evidence of the truth of the facts asserted in it. And in cases where the evidence is nicely balanced, it may have weight with a jury in making up their decision as to the plaintiff's right; and if so, it is not easy to perceive why the defendant who uses a patented machine should not have the benefit of a like presumption in his favor, arising from a like investigation of the originality of his invention, and the judgment of the public officers that his machine is new, and not an infringement of the patent previously granted to the plaintiff. It shows, at least, that the defendant has acted in good faith, and is not a wanton infringer of the plaintiff's rights, and ought not, therefore, to be subjected to the same stringent and harsh rule of damages which might be justly inflicted on a mere pirate. It is true the mere question of originality or infringement generally turns on the testimony of the witnesses produced on the trial; but if the plaintiff's patent in a doubtful case may have some weight in turning the scale in his favor, it is but just that the defendant should have the same benefit from his; *valeat quantum valeat*. The parties should contend on an equal field, and be allowed to use the same weapons.

We are of opinion, therefore, that the court erred in refusing to permit the defendants' patent to be read to the jury. The judgment of the circuit court is therefore reversed, and a *venire de novo* awarded.

MOWRY v. WHITNEY.)

(14 Wallace, 620-653. 1871.

APPEAL from U. S. Circuit Court, Southern District of Ohio.

Opinion by MR. JUSTICE STRONG.

STATEMENT OF FACTS.—The defenses set up to the complainant's bill for an infringement are, that the patent is void for want of novelty in the invention, and for want of utility, and also that it has not been infringed by the defendant.

To determine how far these defenses are sustained it is important to have a clear apprehension of the state of the art when the patent was granted, and of the invention which it was intended to secure to the patentee. Prior to the 2d of August, 1847, cast-iron railroad wheels had been cast, and cast in chills, that is, they had been cast in sand moulds with an outer circumference of iron. The effect of this outer circumference was to produce a more rapid chill on the periphery of the wheel, thereby crystallizing and hardening it, so that the wheel was made stronger, and more capable of resisting the friction of the rails. But the parts of the wheel were of different thicknesses. The hub and the rim were much thicker than the plate which connected them, and of course they cooled after casting more slowly than the plate. The consequence of this unequal cooling was to produce a strain between the thick and thin parts that greatly impaired the strength of the wheel. Various devices had been made to guard against or to remedy the mischief resulting from this inherent and inevitable strain, caused by unequal contraction in cooling. The most common of these, perhaps, was casting the wheel with the hub in sections, in order that the sections might accommodate themselves to the contraction of the plate. But this was expensive. It required the open space between the sections to be filled up with other metal, and generally it required the hub to be hooped. It is unnecessary, however, to describe these devices. It does not appear that in any of them the idea existed of making a car-wheel with chilled tread, straight plates and solid hub, *annealed* and cooled so as to leave it uninjured by the strain attendant upon the unequal cooling of the thick and thin parts. Annealing some kinds of castings was known and practiced before 1847. This is abundantly proved by the witnesses, and various modes of annealing plain castings had been described by scientific writers both in this country and abroad before that time.

But there is no evidence that we have been able to discover that cast-iron car-wheels had ever been subjected to an *annealing* process, in connection with slow cooling, before the process was discovered or invented by Whitney. In all the experiments made for annealing other castings the object sought was different, and in them all, as well as in the process described in the publications given in evidence, the effect upon the annealed metal or glass was not to leave them in the condition in which it was sought to bring car-wheels, with the crystallization or chill of the periphery unimpaired, and the plate or thin part unaffected by strain. Cast-iron railroad wheels are castings of a peculiar kind. The methods of slow cooling, or of annealing and slow cooling, which were applied to other castings before 1847, were not adapted to their peculiarities or to what they needed. They are not homogeneous throughout. They are of different thickness in their several parts, and hardened at the tread, while the plate and hub are not crystallized, but are soft and tough. These different qualities of the different parts it is necessary to preserve, and what

was needed when Whitney's invention was made, was to preserve them, and at the same time relieve against any strain, caused by unequal cooling, which might impair the strength of the wheel.

§ 5036. *No. 5531, April 25, 1848, granted A. Whitney, for "an improvement in the process of manufacturing cast-iron railroad wheels," was for a process, not for a combination, and a new result was obtained by his method.*

If now we proceed to inquire what Whitney's alleged invention was, as described in his specification and claim, it will be seen that it was a process, not to make a car-wheel, or to destroy any of the advantages which had already been secured, but to add another. Its avowed object was to obtain a new value, or rather exemption from imperfection. It was to remedy the evil of strain resulting from the more rapid cooling of one part of the wheel than the cooling of the other parts. And this was sought to be accomplished by a process that insured the cooling of all parts, both the thick and the thin, with equal slowness. The process consists of several parts. The first is taking the wheels from the moulds after the melted iron has been run into the moulds, before they become so much cooled as to produce strain on any part sufficient to impair their ultimate strength. The second is placing the wheels, immediately after their removal, in a furnace or chamber previously heated to about the temperature of the wheels when taken from the moulds, the heat in the furnace being subject to control. The third is applying heat until the temperature of all parts of the wheels shall again be raised to the same point (indefinitely said to be a little below that at which fusion commences). The fourth and last stage in the process is allowing the wheels, after they have been thus reheated, to cool so fast as, and no faster than, is necessary for every part of each wheel to cool and shrink simultaneously together, and no one part before another.

It is therefore a patent for a process, not for a combination. Neither as a whole or in parts can it be considered without reference to the ultimate object in view, which was to retard cooling by a second application of heat supplied until all parts of the wheel are raised to the same temperature, and then permit the heat to subside so gradually that the cooling of the parts shall not only commence at the same point of temperature, higher than that where hurtful strain begins, but shall continue equable till all artificial heat ceases. The removal from the moulds to the furnace or chamber, the removal at the time described, before the incipient strain has become permanently hurtful, and to a place where more heat may be applied, and where the heat can be under control, are parts of the process to secure equable cooling during the time when cooling without such appliances is likely to produce strain and consequent weakness. It is apparent that this is more than a process for *annealing*. That is included, it is true, but it is only a small part. It is applying foreign heat to a hot chilled wheel, at the point of time when it has reached a particular stage of cooling, by means of such foreign heat bringing the whole casting up to a higher and uniform temperature, and maintaining an equable abatement of heat in a furnace or chamber under the control of the operator. We have sought in vain through the proofs submitted in this case for any satisfactory evidence that this process was known before 1847, when Whitney commenced it, or that anything equivalent to the process was known. Certainly nothing of the kind had ever been applied to cast-iron railroad wheels, and, as we have seen, they are castings of a peculiar character, not admitting of the treatment that may be applied to other castings. What they needed was (what was sub-

stantially described by one of the witnesses), the discovery of the fact that the chilled cast-iron, constituting one part of the wheel, could be subjected to heat less than that which would cause fusion, without producing any material effect upon its hardness, while the cooling of other parts of the wheel could be so prolonged by applying that heat externally, as to enable all parts to cool without being subjected to the strain attendant on unequal contraction, and, in addition to the discovery, they needed the invention of a process by which it could be practically carried out. Such a discovery and such a process were needed for no other castings.

The novelty of the patentee's invention is not therefore disproved by evidence that glass, or speculum metal, or even other iron castings, had been annealed and slow-cooled, prior to the time when it was made. Of this there is very considerable evidence both in the testimony of witnesses and printed publications. The specification disclaims invention of annealing iron castings done in the ordinary mode. It claims annealing when applied to cast-iron railroad wheels, in the mode or by the process described. It is not, therefore, merely an old contrivance or process applied to a new object, a case of double use. A new and previously unknown result is obtained, namely, the relief of the plate of the wheels from inherent strain without impairing the chilled tread, a result which, though anxiously sought, had not been obtained before Whitney's invention. We are therefore of opinion that the defense set up, that the patent was void for want of novelty of invention, is unsustainable.

§ 5037. *Although the chill which has been obtained upon an iron casting will be destroyed at a heat greatly below the point of fusion, but is not affected by the degree of heat at which one part fails to exert an injurious strain upon other parts in consequence of their different thickness and cooling unequally, yet a patent for a process for annealing cast-iron car-wheels by heating them to the latter degree, among other things, is not void for uncertainty in the description of the process because the specification contains a direction that the temperature of the casting "be raised to the same point (say a little below that at which fusion commences)," since those experienced in these matters know that a chill is indispensable in a car-wheel, and the object of the process will be attained with a heat much below that which would destroy the chill. Neither is the patent void for want of utility.*

The validity of the invention is next assailed for the reason that the process described in it, and claimed, is denied to be useful, because it would destroy the hardness of the rim, or tread of the car-wheel known as the chill, and thus greatly detract from the durability and usefulness of the wheels. It is undoubtedly true that a chilled periphery or tread is essential to the usefulness of a car-wheel. Indeed, the evidence is that, whenever car-wheels are spoken of, wheels with chilled tread are meant, and any process which destroys the chill must render them valueless for the purposes for which they are needed.

It is also true that the fusing point of cast-iron is in the neighborhood of two thousand seven hundred and eighty-six degrees of Fahrenheit, twelve or fifteen hundred degrees above the point at which, according to the evidence, the chill of the tread of a car-wheel would be destroyed. If, therefore, the process patented to Whitney requires, after the removal of the wheel to the heated furnace or chamber, the application of a degree of heat closely approximating the point of fusion, it must be conceded that, instead of being beneficial, it is positively hurtful. And this is what is contended by the appellant. The objection seems to be aimed at the sufficiency of the description

of the patentee's invention, which it is abundantly proved he practiced successfully through many years, rather than at its utility. Whitney conceived a process and practiced it. That process may have been a highly useful invention, and therefore patentable, and yet he may have failed so to describe it as to teach the public how to practice it.

§ 5038. *A specification for a process should not mislead those skilled in the art, but may leave something for their skill to supply in applying it, and it may be sufficient, although those who are inexperienced may not be able to understand it.*

The law requires every inventor, before he can receive a patent, to furnish a specification or a written description of his invention or discovery, and of the manner and process of making, constructing, using and compounding the same, in such full, clear and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same. The specification, then, is to be addressed to those skilled in the art, and is to be comprehensible by them. It may be sufficient, though the unskilled may not be able to gather from it how to use the invention. And it is evident that the definiteness of a specification must vary with the nature of its subject. Addressed as it is to those skilled in the art, it may leave something to their skill in applying the invention, but it should not mislead them. The objection here is that, in describing the degree of heat to be applied after the wheels have been deposited in the heated chamber, the patentee states it to be such that the temperature of all parts of the wheels "may be raised to the same point (say a little below that at which fusion commences)," and the defendant insists that this amounts to a direction to raise the heat to a degree that must destroy the chill of the tread, and thus render the casting valueless as a railroad car-wheel. But it is obvious that only vague and uncertain directions could have been given respecting the extent to which the heat is necessary to be raised. It must differ with the difference in the progress of cooling which has taken place before the wheels are removed from the moulds. The process requires this removal before they have become so much cooled as to produce such inherent strain on any part as to impair its ultimate strength. Precisely when such a strain begins cannot be known. Cooling commences the instant the casting is made, and with cooling commences contraction, and strain must soon follow. Plainly it is impossible to describe the point of time when the strain has proceeded so far as to impair the ultimate strength of any part of the wheel. That, in the nature of things, must be left to the judgment of the operator. But before that time the strain may be checked, and this is what is contemplated by raising the temperature of all parts of the wheel to the same point or degree. The moment that is done the strain ceases, and the primary object of the patentee's process is accomplished. The state of things is reproduced which existed before the contraction and attendant strain began, when the slow cooling is allowed to follow in an atmosphere so heated and regulated that each part of the wheel loses its heat at an equal pace with all others.

§ 5039. *Specifications in an application for letters patent, though vague or indefinite, should be read with reference to the object they have in view; and should experts then be able to discover what is intended, the same will be sufficient in law.*

Now, any one skilled in making cast-iron railroad car-wheels in view of this

specification must see that the object of the process is to relieve from and guard against hurtful strain, without destroying the chill, and that heat is applied only for that purpose. It requires no particular science or skill to enable an operator to perceive that the moment all parts of the wheel are raised from a point above where serious strain begins, and where yet the thick and thin parts are in different stages of cooling, to a stage where the degree of temperature of all parts is the same, and above the degree where serious strain commenced, the thing sought has been attained. Then the avowed purpose of the inventor has been accomplished. It would be most unreasonable to read the directions of the specification without reference to the object which they profess to have in view. The evidence is that the chill is formed while the casting is in the mould, and that the hurtful strains commence after the formation of the chill. Indeed, it is manifest there can be no strain until the chill is complete. It must be, therefore, that all the heat which is needed to relieve from the strain is that which suffices to raise the temperature of the thin part, or plate, to the degree at which the strain commenced — a lower temperature than that which existed when the chill was formed. Hence an operator, in following the directions of the specification, would be taught by his practical knowledge that the instant all parts of the wheel had been heated to that temperature no more heat was needed.

And we do not think it a fair construction of the patentee's language to hold that it requires the heat to be raised in all cases to a degree only a little below the point of fusion. He does not attempt to give any more definite direction than that all parts of the wheel must be raised to the same temperature, suggesting in a parenthesis ("say, a little below that at which fusion commences"). He fixes a *maximum*. The heat must not reach the point of fusion; and the prescribed *minimum* is that degree where the heat of the different parts of the wheel is equal. Within those limits the degree is left to the judgment of the operator, and within those limits it is clear from the evidence that the process may be applied without injury to the chill. The proof is that it has been successfully applied in the manufacture of a vast number of wheels, and that failure has been very rare.

There are some witnesses who have testified that the Whitney process, as they understand it, would destroy the chill of the wheel. But they explain their understanding to be that the wheels are to be reheated to a degree far beyond what is required to relieve from strain, and thus heated for no purpose. They keep in sight the *maximum* limit, and approach near to that, overlooking entirely the *minimum*, and disregarding the single object of the process, namely, relief of the plate, or thin part of the wheel, from the strain caused by unequal contraction. We are, therefore, of opinion that the patent is not void for want of utility, and that the specification sufficiently describes the process invented and claimed.

§ 5040. *To take car-wheel castings from the mould as soon as they are cool enough to allow their removal, and place them in a pit surrounded with charcoal, where they are heated by the charcoal taking fire, and then cooled very slowly, is an infringement of a patent for taking such castings from the mould at the same stage and heating them in a furnace, where they are then slowly cooled, both processes being intended to effect the same purpose.*

The remaining defense is a denial that the process conducted by the defendant is an infringement of Whitney's patent. What the process of the defendant was is clearly set out in a patent which he obtained on the 7th of May, 1861.

It consists in placing in a pit the wheels as they are turned out of the moulds red hot, with a layer of charcoal beneath the lowest wheel, and a layer between each wheel as well as above the uppermost, and covering the pit with a perforated metal plate. The charcoal is ignited by the hot wheels, and just sufficient air is admitted to effect combustion of the coal. Thus the wheels are reheated and permitted gradually to cool. There are some minor details which it is unnecessary to mention. So far as relates to reheating the wheels and retarding the cooling by the application of additional heat, it is obvious that the process is substantially the same as that covered by the complainant's patent. The object is the same, and the mode of attaining it is in substance the same. The purpose of the charcoal interlaid with the wheels is avowed to be to heat them in the pit to a proper temperature, prolonging the heat and permitting them to cool gradually in a given time, said to be seventy-two hours, more or less, as may be found necessary for the annealing operation. The rapidity of combustion of the charcoal is regulated by a damper in the flue. And this process is followed, as the specification explains, that the different parts of the wheels may adjust themselves to each other, and accommodate the unequal contraction which results from the process of chilling. It is under this patent, and in accordance with its directions, that the defendant has prepared his car-wheels for market. As the object of the patentees is the same, relief from the strain incident to unequal contraction, the only inquiry is whether the object is attained by substantially the same means.

The idea of Whitney was undoubtedly arresting contraction before any remediless strain had commenced, and regulating the progress of cooling so that all parts of the wheel may maintain an equal temperature at all stages of cooling. Manifestly the process of the defendant embodied the same idea, and carried it out by means identical in principle. It reheats the wheels when removed from the moulds to the chamber or pit. It prolongs the cooling in connection with the reheating, and it subjects the rapidity of cooling to control of the operator. The form or structure of the furnace, chamber or pit is not claimed by either patentee.

It hardly seems necessary to resort to the opinions of experts in order to reach the conclusion that the process of the defendant is only formally different from that of Whitney, while the essential element of the two processes is the same. But the testimony of the experts examined, taken as a whole, clearly supports such a conclusion. It is true some of the witnesses testify that in their opinion the processes are different, but when they attempt to describe the difference they point out only matters which are merely formal, only variances in the mode of using the same process. On the other hand, several witnesses, entirely competent to apprehend the principle of the invention, and the devices for practically using it, have testified that the processes of the defendant and of the complainant are substantially the same in principle, mode of operation, and in the effect produced. We must, therefore, conclude that the charge of infringement made in the bill has been sustained, and that the complainant was entitled to a decree for an injunction and an account.

We come next to the consideration of the account stated by the master and confirmed by the circuit court. The master reported that Mowry, the defendant, used Whitney's process in the manufacture of nineteen thousand eight hundred and nineteen wheels, and the account has been stated on that basis.

For the use of the process in making these wheels the defendant has been charged with \$91,501.86 as profits made by him (more than \$4.60 on each wheel), besides \$19,984.21 interest upon such profits to the 1st day of August, 1868, and the further sum of \$10,980.22, being interest from August 1, 1868, to August 1, 1870.

It is very obvious, in view of what the patentee himself stated, under oath, in 1862, when applying for an extension of his patent, that the account has been erroneously stated. If he was correct in this statement the profits arising from the use of his patent in manufacturing nineteen thousand eight hundred and nineteen wheels (valuing iron at the price proved to have been paid for it by the defendant) must have been less than \$5,500, instead of over \$91,000, decreed in the circuit court — about thirty cents per wheel, instead of \$4.60. It is not an unfair presumption that if the profit to the patentee was no greater than he claimed it was, it could not have been more when the invention was used by an infringer.

§ 5041. *Accounting for infringement of a process.*

Now, it is clear that Whitney is not entitled to receive more than the profits actually made in consequence of the use of his process in the manufacture of the nineteen thousand eight hundred and nineteen wheels. It is the additional advantage the defendant derived from the process — advantage beyond what he had without it — for which he must account. But he has been held liable far above this. The master reported, in the first instance, the difference between the cost of the wheels and the price for which they were sold as the profits realized by Mowry, thus charging him the profit obtained from the entire wheel, instead of that resulting from the use of Whitney's invention in a part of the manufacture; and this, though he found at the same time and reported that Mowry had built up his business before he commenced the use of Whitney's process; that the use of the process did not diminish the cost of making wheels, but increased it; that while he used the process he used the same quality of iron that he had used before, and made no difference in the weight or form of the wheels, or in their price, and that the wheels made by him before he commenced the use of Whitney's invention, and since he has abandoned it, have sold as readily and at the same prices as those manufactured by that process.

Exception was taken to the charge of the profit made by the entire manufacture of the wheel, including not only the selection and mixing of the iron, but its melting, pouring into moulds, forming the chill, removing from the moulds, and cleaning, as well as annealing and slow cooling; and the case was again sent to the master with instructions to inquire: *First*. Whether the wheels made and sold by the defendant had or could have been made to have any market value without being subjected to the process patented to Whitney; and, *Second*. If they had or could have been made to have such value by any annealing or slow-cooling process, outside of the Whitney patent, how much additional value, if any, they derived from being subjected to that patented process.

Upon the findings made by the master on this order, the court decreed against the defendant the entire profits made by him in the manufacture and sale of the wheels from beginning to end, not only the profits resulting from the reheating and regulated slow cooling in connection, but also those which may have resulted from mixing and melting the iron, casting in moulds, mak-

ing the chill, and from the possible advance on the iron above its cost, with interest on the whole. This we think was an error. The findings of the master justified no such decree. It must be conceded that the findings are incomplete, obscure, and in some particulars incongruous, but it is not a legitimate construction of them taken together, that the benefit which the defendant derived from the use of the complainant's invention was equal to the aggregate of profits he obtained from the manufacture and sale of the wheels as entreties, after they had been completed.

§ 5042. *It is as true of a process invented as an improvement in a manufacture, as it is of an improvement in a machine, that an infringer is not liable to the extent of his entire profits in the manufacture.*

It is as true of a process invented as an improvement in a manufacture, as it is of an improvement in a machine, that an infringer is not liable to the extent of his entire profits in the manufacture. *Jones v. Morehead*, 1 Wall., 155; *Seymour v. McCormick*, 16 How., 480. If the wheels made by the defendant would have had no market value above that of cast-iron if they had not been annealed and slow cooled, the same may be said if they had been cast without a chill. The same principle, therefore, which gives to the complainants the aggregate profits of the entire manufacture would give the same profits to a patentee of the process of chilling, if there were one, and as there are many processes in the manufacture, for each of which it is conceivable there might be a patent, and as every one of the processes is necessary to make a marketable wheel, an infringer might be mulcted in several times the profits he had made from the whole manufacture. We cannot assent to such a rule.

§ 5043. *An infringer is responsible only for the profits arising from the benefit derived from the use of the patentee's process over that arising from other processes open to the public.*

The question to be determined in this case is, what advantage did the defendant derive from using the complainant's invention over what he had in using other processes then open to the public and adequate to enable him to obtain an equally beneficial result. The fruits of that advantage are his profits. They are all the benefits he derived from the existence of the Whitney invention. It is found that there were other processes by which the inherent strain caused by unequal cooling could be and was prevented, counteracting which strain was the sole object of the complainant's invention, and a car-wheel could be prepared for similar service, valuable in the market, and salable at a price not less than was obtained for those which the defendant manufactured. The inquiry then is, what was the advantage in cost, in skill required, in convenience of operation, or marketability, in bringing car-wheels by Whitney's process from the condition in which they are when taken hot from the moulds to a perfected state, over bringing them to the same state by those other processes, and thus rendering them equally fit for the same service? That advantage is the measure of profits. It is quite unimportant what name was given to the products of the processes, whether one could be called annealed wheels and the other could not, except so far as affected their marketability.

The record shows that the court overruled the alternative finding of the master, that if there is no infringement of the complainant's patent unless the wheels are subjected to the process of reheating — that is to say, if the process of slow cooling used in connection with reheating is old, and not a part of the complainant's invention, no part of the profit derived by the defendant

from the manufacture and sale of the wheels was due to the use by him of that invention.

§ 5044. *A patentee of a process, the result of two or more constituents, some not being patented by him, cannot claim the exclusive use of the latter used singly.*

One exception taken to this finding was that not only the entire process described in the patent, but each part of such entire process, was the invention of the complainant, and the use of any material, substantial and essential part of such entire process, the slow cooling being a substantial and material part, whereby only an improved chilled cast-iron railroad wheel could be made, and beneficial effects the same in kind if not in degree attained, that were attained by the complainant's entire process, is an infringement of complainant's patent, and the profits derived from the use of such material, substantial and essential part should be accounted for in this case. This exception the court sustained, and thereby held that the defendant is chargeable with the profits he derived from slow cooling alone. We cannot assent to this. The patent is for an entire process, made up of several constituents. The patentee does not claim to have been the inventor of the constituents. The exclusive use of them singly is not secured to him. What is secured is their use when arranged in the process. Unless one of them is employed in making up the process, and as an element of it, the patentee cannot prevent others from using it. As well might the patentee of a machine, every part of which is an old and known device, appropriate the exclusive use of each device, though employed singly, and not combined with the others as a machine. The defendant was not, therefore, responsible for slow cooling alone, or for the profits he derived from it. He was liable to account for such profits only when he used slow cooling in connection with reheating in the manner described in Whitney's claim substantially, or when extraneous heat was employed to retard the progress of cooling. We have said that slow cooling is not claimed in the specification as the invention of the patentee. And it is found by the master that there are other modes of slow cooling, and even other modes of relieving against the inherent strain caused by unretarded cooling, than that practiced by the complainant and claimed by him. Though, therefore, slow cooling is an essential part of the complainant's process, it is an equally essential part of other processes which the defendant was at liberty to use in preparing his car-wheels for market.

§ 5045. *Where infringement is not wanton, interest on the profits, called more truthfully unliquidated damages, recoverable against the infringer, will not be given.*

We add only that in our opinion the defendant should not have been charged with interest before the final decree. The profits which are recoverable against an infringer of a patent are in fact a compensation for the injury the patentee has sustained from the invasion of his right. They are the measure of his damages. Though called profits, they are really damages, and unliquidated until the decree is made. Interest is not generally allowable upon unliquidated damages. We will not say that in no possible case can interest be allowed. It is enough that the case in hand does not justify such an allowance. The defendant manufactured the wheels of which the complaint is made under a patent granted to him in 1861. His infringement of the complainant's patent was not wanton. He had before him the judgment of the patent office that his process was not an invasion of the patent granted to the

complainant, and though this does not protect him against responsibility for damages, it ought to relieve him from liability to interest on profits.

Decree reversed, and the cause remanded with instructions to proceed in accordance with the rules laid down in this opinion.

TILGHMAN *v.* PROCTOR.

(12 Otto, 707-735. 1880.)

APPEAL from U. S. Circuit Court, Southern District of Ohio.

Opinion by MR. JUSTICE BRADLEY.

STATEMENT OF FACTS.—This case involves a consideration of the same patent which was the subject of litigation in the case of *Mitchell v. Tilghman*, reported in 19 Wallace, 287. The evidence in the present case, which is quite an unwieldy mass, is much the same as in that, being supplemented, however, by the testimony of the patentee respecting the nature of his original experiments and the practicability of using profitably the coil apparatus described in the patent, together with certain exhibits relating to the novelty of the alleged invention. Upon the renewed consideration which has been given to the subject, the court is unanimously of opinion, contrary to the decision in the *Mitchell* case, that the patent of Tilghman must be sustained as a patent for a process, and not merely for the particular mode of applying and using the process pointed out in the specification, and that the defendants have infringed it by the processes used by them.

The patent in question relates to the treatment of fats and oils, and is for a process of separating their component parts so as to render them better adapted to the uses of the arts. It was discovered by Chevreul, an eminent French chemist, as early as 1813, that ordinary fat, tallow and oil are regular chemical compounds, consisting of a base which has been termed glycerine, and of different acids, termed generally fat acids, but specifically stearic, margaric and oleic acids. These acids, in combination severally with glycerine, form stearine, margarine and oleine. They are found in different proportions in the various neutral fats and oils; stearine predominating in some, margarine in others, and oleine in others. When separated from their base (glycerine) they take up an equivalent of water, and are called free fat acids. In this state they are in a condition for being utilized in the arts. The stearic and margaric acids form a whitish, semi-transparent, hard substance, resembling spermaceti, which is manufactured into candles. They are separated from the oleic acid, which is a thin, oily fluid, by hydrostatic or other powerful pressure, the oleine being used for manufacturing soap and other purposes. The base, glycerine, when purified, has come to be quite a desirable article for many uses.

The complainant's patent is dated the 3d day of October, 1854, and relates back to the 9th day of January of that year, being the date of an English patent granted to the patentee for the same invention. It has but a single claim, the words of which are as follows: "Having now described the nature of my said invention, and the manner of performing the same, I hereby declare that I claim, as of my invention, the manufacturing of fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure."

In the case of *Mitchell*, the majority of the court was of opinion that in the application of the process thus claimed, the patentee was confined to the

method of using the process particularly pointed out in the specification, and as, by that, it was proposed to produce a very rapid separation of the fatty elements by the use of a high degree of heat, the operation being effected in the space of ten minutes by forcing the fat, mixed with water, through a long coil of strong iron tube passing through an oven or furnace where it was subjected to a temperature equal to that of melting lead, or six hundred and twelve degrees Fahrenheit; it was concluded by the court that the producing of the same result in a boiler subjected to only four hundred degrees Fahrenheit, and requiring a period of several hours to effect the desired separation, was not an infringement of the patent, although the process by which the effect was produced — namely, the action of water, in intimate mixture with the fat, at a high temperature and under a sufficient pressure to prevent the formation of steam — was undoubtedly the same. On further reflection, we are of opinion that, in the case referred to, sufficient consideration was not given to the fact that the patent is for a process, and not for any specific mechanism for carrying such process into effect.

§ 5046. *History of the art.*

In order to have a clearer understanding of the question, it is necessary to advert briefly to the history of the art, and then to examine the terms of the patent in greater detail. It is conceded by the complainant that two different processes for effecting a decomposition of fats into their component elements had been in practical operation prior to his invention. These processes were called respectively the alkaline saponification process, and the sulphuric-acid distillation process. The first consisted of the manufacture of the fat into soap by the use of lime or other alkali; and then, of the decomposition of the soap so produced, into the fat acids by the aid of hydrochloric or dilute sulphuric acid. The decomposition of the soap was, by a subsequent improvement, effected by distillation in an atmosphere of steam. The other process, called the sulphuric-acid distillation process, consisted of the direct saponification of fat by means of concentrated sulphuric acid, and the subsequent distillation over of the resulting fatty acids. By this process, however, the glycerine was destroyed.

The first of these processes was patented by Gay Lussac and Chevreul in 1825, but was not brought into successful operation in the manufacture of stearic candles, until improved by De Milly in 1831. The second process was proposed and developed between 1840 and 1850. It was extensively used during and after that period by the large manufacturing firm of E. Price & Co., of London, and their successors, Price's Patent Candle Company. Mr. G. F. Wilson, one of the shareholders in that establishment, and apparently a man of accurate knowledge on this subject, read various papers illustrative of the history of the manufacture before learned societies in England, extracts from which are contained in the record, and throw considerable light on the matter. It appears from his statements that the distillation of the saponified fat, whether saponified by an alkali or by sulphuric acid, was often accompanied by prejudicial effects from the access of atmospheric air to the contents of the still. To remedy this, he and his associates adopted and patented the introduction of superheated steam into the still or vat containing the fat acids, which excluded atmospheric air, and carried over the fatty vapors into the receiver in a more perfect condition than they had before been able to obtain them. These patents were taken out in 1843. In the following year, the same parties, Gwynne and Wilson, found what Dubrunfaut had found two or

three years before, that palm-oil, which is very fusible and manageable, can be distilled in its crude state, in the manner last described, that is, by the introduction of steam into the still, without the intervention of saponification; and the distilled product being then steam-boiled in water, acidulated with sulphuric acid, and the water allowed to settle and separate, the resulting substance would be a fat acid. It is not shown that this process was ever carried into successful operation prior to Tilghman's patent; and judging from what was done by the Price Patent Candle Company in the way of improvement immediately after becoming acquainted with Tilghman's process, it is to be inferred that the steam-distillation process (without saponification) was still an unsuccessful experiment when his patent was issued. This experiment, however, must be regarded as the nearest approach to the process of Tilghman of anything done in the art prior to it.

§ 5047. *Where a product was accidentally made, and the process by which it was formed never fully understood, and no hint was derived therefrom as to a practical process for the formation of the same product, it was not regarded as an anticipation of the patented process.*

We do not regard the accidental formation of fat acid in Perkins' steam cylinder from the tallow introduced to lubricate the piston (if the scum which rose on the water issuing from the ejection pipe was fat acid) as of any consequence in this inquiry. What the process was by which it was generated or formed was never fully understood. Those engaged in the art of making candles, or in any other art in which fat acids are desirable, certainly never derived the least hint from this accidental phenomenon in regard to any practicable process for manufacturing such acids.

The accidental effects produced in Daniell's water barometer and in Walther's process for purifying fats and oils preparatory to soap-making, are of the same character. They revealed no process for the manufacture of fat acids. If the acids were accidentally and unwittingly produced, whilst the operators were in pursuit of other and different results, without exciting attention and without its even being known what was done, or how it had been done, it would be absurd to say that this was an anticipation of Tilghman's discovery.

Nor do we regard the patent of Manicler, which was taken out in 1826, as anticipating the process of Tilghman. It is true that he directs a mixture of fat with about one-quarter of its weight of water to be placed in a boiler, and subjected to a heat sufficient to create a pressure equal to one atmosphere above the natural atmospheric pressure (or about two hundred and fifty degrees Fahrenheit); the boiler being provided with a safety-valve which would secure that degree of pressure. But, subject to this pressure, the patent directed that the mixture should be made to boil, and of course that the water should be converted into steam; the words are, "Apply fire to this digester to melt and digest the contained tallow or fat and water, and keep up a rapid ebullition during about six hours." It is probable, therefore, that any decomposition of the fat which may have been produced by this process was due to the steam formed and passing through the fat, as no means appears to have been adopted for keeping up the mixture of the fat and water. But we have no evidence that the process was ever successful in practice. One of the defendants' witnesses testifies that he tried it, and though he got some results, he adds this pregnant observation: "To transform all the fat in this way at so low a temperature would have required many days." He only pretends

that the sample which he obtained showed by its appearance, as well as by its acid action, that the separation had commenced. Evidently, therefore, this was but an abandoned experiment, since we never hear any more of it from 1826 down to the trial of this cause.

It is unnecessary to examine in detail other alleged anticipations of Tilghman's process. We believe that we have specified the most prominent and reliable instances. Tilghman's discovery was made in 1853, and was in brief this: "That the fat acids can be separated from glycerine, without injury to the latter, by the single and simple process of subjecting the neutral fat, whilst in intimate mixture with water, to a high degree of heat under sufficient pressure to prevent the water from being converted into steam, without the employment of any alkali or sulphuric acid, or other saponifying agent; the operation, even with the most solid fats, being capable of completion in a very few minutes when the heat applied is equal to that of melting lead, or six hundred and twelve degrees Fahrenheit; but requiring several hours when it is as low as three hundred and fifty or four hundred degrees Fahrenheit. The only conditions are, a constant and intimate commixture of the fat with the water, a high degree of heat, and a pressure sufficiently powerful to resist the conversion of the water into steam. The result is, a decomposition of the fatty body into its elements of glycerine and fat acids, each element taking up the requisite equivalent of water essential to its separate existence, and the glycerine in solution separating itself from the fat acids by settling to the bottom when the mixed products are allowed to stand and cool. In this process a chemical change takes place in the fat in consequence of the presence of the water and the active influence of the heat and pressure upon the mixture.

We are satisfied that Tilghman was the original discoverer of this process. His priority was acknowledged at the time by those most interested to question it. Mr. Wilson, to whose statements reference has been made, and who is perhaps more justly entitled than any one else to claim an anticipation of Tilghman's discovery, makes no such pretension, but, on the contrary, concedes Tilghman's right to priority; and, indeed, Price's Patent Candle Company, of which Mr. Wilson was a member and director, took a license under Tilghman's English patent.

As having some bearing upon the proper construction of the patent in suit (which will presently be more particularly examined), it is proper to observe that Tilghman's actual invention, as demonstrated in his experiments made in 1853, before making any application for a patent, was not confined to the use of a coil of pipe in a heated chamber or furnace for effecting the process which he claims, but was frequently exhibited by using a simple digester, filled nearly full with a mixture of fat and water, and heated in a gas stove, or in a vertical position over a gas lamp; the mixture of fat with the water being kept up by a loose metallic rod or jumper, which thoroughly mixed the contents when the digester was shaken. Sometimes the digester was heated in a horizontal position, and, being provided with thin copper partitions fixed inside, was made to revolve in order to cause a more perfect mixture of the materials. In using the digester, it not being provided with a safety-valve, a small space was left at the top for the formation of sufficient steam to prevent, by its elasticity, the vessel from exploding.

In making these experiments Tilghman not only varied the apparatus, but applied different degrees of heat in the operation. The following is his account of some of these proceedings. He says: "Before applying for my pat-

ent I had made many experiments in decomposing by water at temperatures below melting bismuth, sometimes in the coil form of apparatus, but most frequently in digesters. The lowest temperature tried by me was three hundred and fifty degrees Fahrenheit (350° F.), or one hundred and twenty pounds pressure continued for four hours. The digester was as usual in a vertical position, but the heat was in this case given by an oil-bath. I obtained both fat acids and glycerine in this experiment, but in such small quantities as to prove that though the decomposition did go on at that heat, yet it was very slow compared with the higher heats. I find notes of another experiment, July 15, 1854, in the coil apparatus, with palm-oil, made at the melting point of tin, four hundred and forty degrees Fahrenheit, three hundred and sixty pounds pressure. It was pumped through the coil very slowly, so as to give about thirty minutes' heat, and found to be partly decomposed, so that it was returned to the inlet end of the apparatus and pumped through a second time at the same rate and heat, which produced perfect decomposition of the palm-oil into fat acids and solution of glycerine. Ten minutes' exposure would have perfectly decomposed palm-oil at the heat of melting bismuth, five hundred and ten degrees Fahrenheit. Yet I found seventy degrees lower heat required six times as long to produce the same effect. I had often decomposed tallow at five hundred and ten degrees Fahrenheit before taking out my patent, not in the coil apparatus, but in the simple vertical digester. In this case I had to allow increased time on account of the imperfect contact of the fat and water in addition to that required by the diminished temperature."

In the course of his testimony, Tilghman explains why, in his patent, he specially recommended the use of the high temperature of melting lead in applying his process to practical use. He says: "Many experiments had shown me that at these higher temperatures the decomposition was carried on with the greatest economy of fuel and cost of apparatus. When in London in 1847, I had found Perkins' house-warming apparatus, consisting of coils of hundreds of feet of pipe, containing water at the temperature of melting lead, had long been in extensive domestic use there. On returning to London in 1853, I found the same apparatus largely used for heating bakers' ovens. As I thus found such heats and pressures were perfectly practical and safe, as well as economical, I thought I was bound to describe my invention in what I then believed to be the best mode of carrying it out, and that, as I was the discoverer of the chemical fats, I could then claim broadly as my process the use of water highly heated and under pressure to decompose fats, no matter what temperature or apparatus was used."

And being asked for his present view as to the practicability, economy and safety of the higher temperatures as compared with lower temperatures, he said: "I think the high pressure apparatus is much more economical, both in the first cost and in the expense of working. Its principal disadvantage is that ordinary engineers are not familiar with its management, and consequently dislike it."

In December, 1853, Tilghman, having completed his experiments to his own satisfaction, filed a caveat in the patent office preparatory to taking out a patent for his invention. In this caveat he says: "The invention consists in subjecting animal and vegetable fatty and oily substances containing glycerine to a high temperature and pressure in close vessels, mixed with different agents, according to the effect desired to be produced upon the fatty matter. Thus, when I wish to convert the neutral fatty substances into fatty acids and

glycerine, I pump a mixture of the fat and water, under great pressure, through a series of strong metal tubes, kept at about the heat of melting lead, and provided with a cooling-worm and safety-valve at its outlet. The neutral fatty substance is decomposed by the process, and the fat acid and solution of glycerine which issue through the safety-valve separate by settling."

Tilghman soon after repaired to England and took out a patent there, dated the 9th day of January, 1854, and sealed the 25th of March. He immediately put in operation an apparatus for exhibiting his process on a small scale. Mr. Wilson, before mentioned, witnessed his experiments, and thus speaks of them in a paper communicated to the Journal of the Society of Arts, January 25, 1856:

"In January, 1854, Mr. Tilghman, an American chemist, who has studied all that has been published here and in France on the subject of acidification and distillation of fatty bodies, obtained a patent for exposing fats and oils to the action of water at a high temperature and under great pressure, in order to cause the combination of the water with the elements of the neutral fats, so as to produce at the same time free fat acids and solution of glycerine. He proposed to effect this by pumping a mixture of fat and water, by means of a force pump, through a coil of pipe heated to about six hundred and twelve degrees Fahrenheit, kept under a pressure of about two thousand pounds to the square inch; and he states that the vessel must be closed, so that the requisite amount of pressure may be applied to prevent the conversion of water into steam. This is, all must admit, a beautiful, original, chemical idea, well carried out; it has yet to prove how far it can compete successfully with distillation. We have made an arrangement with Mr. Tilghman which will give us the means of testing its commercial merits."

Mr. Wilson goes on to state that this process of Tilghman suggested to them the idea of distilling fats by passing steam into them at a high temperature whereby to resolve them into glycerine and fat acids. They found the plan successful, and that the glycerine distilled over with the fat acids, but no longer combined with them; and, in July, 1854, they took out a patent for that process. In a paper read before the Glasgow meeting of the British Association for the Advancement of Science, in September, 1855, Mr. Wilson thus refers to the course of discovery which took place in this branch of manufacture:

"By our first improvement in separating the fat acids from neutral fats, the glycerine was decomposed by the direct action of concentrated sulphuric acid at a high temperature, and all that remained of it was a charred precipitate. A new process for decomposing neutral fats by water under great pressure coming under our notice" [referring to Tilghman's process] "led us to look again more closely into our old distilling processes, and the doing this showed, what we had often been on the brink of discovering, that glycerine might be distilled."

"In our new process the only chemical agents employed for decomposing the neutral fat, and separating its glycerine, are steam and heat; and the only agents used in purifying the glycerine thus obtained are heat and steam; thus all trouble from earthy salts or lead is escaped."

"Distillation, however, purifies the impure glycerine of the old sources."

"On the table is a series of products of palm-oil, which will serve to illustrate the process. Steam, at a temperature of from five hundred and fifty degrees to six hundred degrees Fahrenheit, is introduced in a distillery apparatus

containing a quantity of palm-oil. The fatty acids take up their equivalents of water, and the glycerine takes up its equivalent; they then distil over together. In the receiver the condensed glycerine, from its higher specific gravity, sinks below the fat acids."

We quote more fully from this paper, because it is a contemporary acknowledgment, made by a man who stood in the front rank of those who understood, and whose interest it was to understand, the most advanced process of resolving fats and oils into their component parts, that Tilghman's "process for decomposing neutral fats by water under great pressure" was "a new process;" and who, with his associates, took hints from it for making new departures and improvements in the art. The statements of Mr. Wilson on this subject are corroborated by other witnesses. Indeed, nearly all those competent to speak on the subject state, or admit, that the process of decomposing fats into glycerine and fat acids by mixing them with water, and subjecting the mixture to a high degree of heat under a pressure sufficient to prevent the conversion of the water into steam, was not known in the arts prior to Tilghman's discovery. The testimony of some experts to the contrary is based upon their construction of certain patents and publications produced in evidence, the most important of which have already been adverted to.

The question then arises, Has Tilghman secured the exclusive right to the process of which he was thus the inventor?

§ 5048. *Patent No. 11,766, R. A. Tilghman, October 3, 1854, purifying fat bodies, examined.*

An examination of the patent itself, which the preceding remarks will enable us better to understand, will show, we think, that it was intended to and does cover and secure to the patentee the general process which has been described, although only one particular method of applying and using it is pointed out. The specification describes the invention as follows:

"My invention consists of a process for producing free fat acids and solution of glycerine from those fatty and oily bodies of animal and vegetable origin which contain glycerine as their base. For this purpose, I subject these fatty or oily bodies to the action of water at a high temperature and pressure, so as to cause the elements of those bodies to combine with water, and thereby obtain at the same time free fat acids and solution of glycerine. I mix the fatty body to be operated upon with from a third to a half of its bulk of water, and the mixture may be placed in any convenient vessel in which it can be heated to the melting-point of lead, until the operation is complete. The vessel must be closed and of great strength, so that the requisite amount of pressure may be applied to prevent the conversion of the water into steam.

"The process may be performed more rapidly and also continuously by causing the mixture of fatty matter and water to pass through a tube or continuous channel, heated to the temperature already mentioned; the requisite pressure for preventing the conversion of water into steam being applied during the process; and this, I believe, is the best mode of carrying my invention into effect. In the drawing hereunto annexed are shown figures of an apparatus for performing this process speedily and continuously, but which apparatus I do not intend to claim as any part of my invention."

The specification then goes on to describe, by the aid of the drawing referred to, the particular device mentioned. But it is evident, and, indeed, is expressly announced, that the process claimed does not have reference to this particular device, for the apparatus described was well known, being similar to that used

for producing the hot-blast and for heating water for the purpose of warming houses. It consists of a coil of iron pipe, or other metallic tubing, erected in an oven or furnace, where it can be subjected to a high degree of heat; and through this pipe the mixture (of nearly equal parts of fat and water), made into an emulsion in a separate vessel, by means of a rapidly vibrating piston, or dasher, is impelled by a force-pump in a nearly continuous current, with such regulated velocity as to subject it to the heat of the furnace for a proper length of time to produce the desired result; which time, when the furnace is heated to the temperature of six hundred and twelve degrees Fahrenheit, is only about ten minutes. The fat and water are kept from separating by the vertical position of the tubes, as well as by the constant movement of the current; and are prevented from being converted into steam, by weighting the exit valve by which the product is discharged into the receiving vessel, so that none of it can escape, except as it is expelled by the pulsations produced by the working of the force-pump. Before arriving at the exit valve, the pipe is passed in a second coil, though an exterior vessel filled with water, by which the temperature of the product is reduced. After the product is discharged into the receiving vessel, it is allowed to stand and cool until the glycerine settles to the bottom, and separates itself from the fat acids. The latter are then subjected to washing and hydraulic pressure in the usual way.

After describing this apparatus it is added: "Although the decomposition of the neutral fats by water takes place with great quickness at the proper heat, yet I prefer that the pump should be worked at such a rate, in proportion to the length or capacity of the heating tubes, that the mixture, while flowing through them, should be maintained at the desired temperature for ten minutes before it passes into the refrigerator or cooling part of the apparatus."

It is evident that the passing of the mixture of fat and water through a heated coil of pipe standing in a furnace is only one of several ways in which the process may be applied. The patentee suggests it as what he conceived to be the best way, apparently because the result is produced with great rapidity and completeness. But other forms of apparatus, known and in public use at the time, can as well be employed without changing the process. A common digester or boiler can evidently be so used, provided proper means are employed to keep up the constant admixture of the water and fat, which is a *sine qua non* in the operation. Tilghman himself, as we have seen, often used such digesters in making his experiments before applying for his patent; and, in putting up machinery for his licensees after his patent was obtained, he did the same thing when the parties desired it. Yet surely the identity of the process was not changed by thus changing the form of apparatus. No great amount of invention was required to adapt different forms of well-known apparatus to the application of the process. The principal difficulty would be in providing an internal arrangement in the boiler or digester, for successfully keeping up the intimate commixture of the fat and water. It is evident that this could be accomplished by means of revolving reels armed with buckets, or of a force-pump constantly transferring the heavy stratum of water from the bottom of the mass to the top, aided by horizontal diaphragms partially sectionizing the digester. These devices were resorted to by Tilghman and others, when they used a boiler instead of a coil of pipe.

Whilst Tilghman in his patent recommends the high degree of heat named, he does not confine himself to that. It had been fully developed in his experiments, and was well known to him, that a lower degree of heat could be em-

ployed by taking longer time to perform the operation; and this would be necessary when boilers or digesters of considerable size were used instead of the coil of pipe, on account of the decreasing power of large vessels to resist the internal pressure. The specification, after describing the use of a metallic coil of pipe, proceeds to add:

“The melting-point of lead has been mentioned as the proper heat to be used in this operation, because it has been found to give good results. But the change of fatty matters into fat acid and glycerine takes place with some materials (such as palm-oil) at or below the melting point of bismuth [five hundred and ten-degrees Fahrenheit]; yet the heat has been carried considerably above the melting-point of lead without any apparent injury, and the decomposing action of the water becomes more powerful as the heat is increased. By starting the apparatus at a low heat, and gradually increasing it, the temperature giving products most suitable to the intended application of the fatty body employed can easily be determined.”

Now, when we find it stated, as we do in this specification, that the patentee subjects “fatty or oily bodies to the action of water at a high temperature and pressure, so as to cause the elements of those bodies to combine with water;” that “the mixture may be placed in any convenient vessel in which it can be heated to the melting-point of lead, until the operation is complete;” that “the vessel must be closed and of great strength, so that the requisite amount of pressure may be applied to prevent the conversion of the water into steam;” that “the decomposition of the neutral fats by water takes place with great quickness at the proper heat;” that “the melting-point of lead has been mentioned as the proper heat to be used in this operation, because it has been found to give good results;” that “the change of fatty matters into fat acid and glycerine takes place with some materials at or below the melting-point of bismuth;” that “the decomposing action of water becomes more powerful as the heat is increased;” that “by starting the apparatus at a low heat and gradually increasing it, the temperature giving products most suitable to the intended application of the fatty body employed can easily be determined;” and when we then find that the patentee categorically claims, in general terms, as his invention, “*the manufacturing of fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure;*” and being satisfied that he was, in fact, the inventor of the general process described and bodied forth in the specification,—how can we, by any fair rule of construction, circumscribe this claim in such a manner as that it shall only cover the process when applied in the use of a coil of pipe heated to six hundred and twelve degrees Fahrenheit? Or, if we allow it to embrace any “convenient vessel,” and do not confine it to a coil of pipe, how can we confine it to a particular degree of heat? What did Tilghman discover? And what did he, in terms, claim by his patent? He discovered that fat can be dissolved into its constituent elements by the use of water alone under a high degree of heat and pressure; and he patented *the process* of “manufacturing fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure.” Had the process been known and used before, and not been Tilghman’s invention, he could not then have claimed anything more than the particular apparatus described in his patent; but being the inventor of the process, as we are satisfied was the fact, he was entitled to claim it in the manner he did.

§ 5049. *A patent for a process, irrespective of the particular mode or form of apparatus for carrying it into effect, is admissible under the patent laws of the United States, and it is clearly an art within the meaning of the law.*

That a patent can be granted for a process there can be no doubt. The patent law is not confined to new machines and new compositions of matter, but extends to any new and useful art or manufacture. A manufacturing process is clearly an art within the meaning of the law. Goodyear's patent was for a process, namely, the process of vulcanizing india-rubber by subjecting it to a high degree of heat when mixed with sulphur and a mineral salt. The apparatus for performing the process was not patented and was not material. The patent pointed out how the process could be effected, and that was deemed sufficient. Neilson's patent was for the process of applying the hot-blast to furnaces by forcing the blast through a vessel or receptacle situated between the blowing apparatus and the furnace, and heated to a red heat; the form of the heated vessel being stated by the patent to be immaterial. These patents were sustained after the strictest scrutiny and against the strongest opposition.

On the subject of patents for processes, Mr. Justice Grier, in delivering the opinion of this court in *Corning v. Burden*, said: "A process *eo nomine* is not made the subject of a patent in our act of congress. It is included under the general term 'useful art.' An art may require one or more processes in order to produce a certain result or manufacture. The term 'machine' includes every mechanical device or combination of mechanical powers and devices to perform some function or to produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods or operations are called processes. A new process is usually the result of a discovery; a machine of invention. The arts of tanning, dyeing, making water-proof cloth, vulcanizing india-rubber, smelting ores, and numerous others, are usually carried on by processes as distinguished from machines. One may discover a new and useful improvement in the process of tanning, dyeing, etc., irrespective of any particular form of machinery or mechanical device. And another may invent a labor-saving machine, by which the operation or process may be performed, and each may be entitled to his patent. As, for instance, A. has discovered that by exposing india-rubber to a certain degree of heat, in mixture or connection with certain metallic salts, he can produce a valuable product or manufacture, he is entitled to a patent for his discovery, as a process or improvement in the art, irrespective of any machine or mechanical device. B., on the contrary, may invent a new furnace, or stove, or steam apparatus, by which this process may be carried on with much saving of labor and expense of fuel, and he will be entitled to a patent for his machine as an improvement in the art." 15 How., 252, 267 (§§ 5028-35, *supra*).

§ 5050. *Neilson's patent reviewed.*

Neilson's patent above referred to had some features very similar to those of Tilghman's. The strong objection urged against the latter is that the particular apparatus described in the specification is not that which is generally used, and that it cannot be used with much profit or success in large manufacturing operations; whereas the slower method of dissolving fats in a common boiler or digester, at a lower temperature even than that of melting bismuth,

which is not described in the specification, is the one which is generally adopted. Precisely this circumstance existed in reference to the patent of Neilson. The specification directed that the blast or current of air produced by the blowing apparatus should be passed into an air-vessel or receptacle heated to a red heat, and from thence into the furnace. Then, after stating that the air-vessel or receptacle should be increased in size according to the size of the forge or furnace to be supplied, the specification adds: "The form or shape of the vessel or receptacle is immaterial to the effect, and may be adapted to the local circumstances or situation." Now, the most simple and natural form of an air-vessel for heating the blast, as here directed, would be a box or chamber, or a cylindrical vessel; but it turned out in practice that a receptacle of this kind would answer the purpose but very imperfectly, and that the best and most useful method was to heat the blast in a series of tubes placed in a heated oven. This was held to be no ground for invalidating the patent, or for preventing it from covering intermediate tubes, as well as an intermediate box or chamber, the jury being of opinion that a man of ordinary skill and knowledge in the construction of blowing and air-heating apparatus would be able, from the information contained in the specification, to erect a machine which would answer some beneficial purpose in the application of the process, and would not be misled and prevented from so doing by the declaration that the form or shape of the vessel or receptacle was immaterial to the effect. In this view of the subject the patent was sustained after very great consideration.

§ 5051. *Principle and process distinguished.*

Some question has, indeed, been made whether Neilson's patent was sustained as a patent for a process. The court of exchequer, in reviewing the proceedings at the trial, and answering the objection that it was a patent for a principle, said: "It is very difficult to distinguish it from the specification of a patent for a principle, and this at first created in the minds of some of the court much difficulty; but, after full consideration, we think that the plaintiff does not merely claim a principle, but a machine embodying a principle, and a very valuable one. We think the case must be considered as if, the principle being well known, the plaintiff had first invented *a mode of applying it* by a mechanical apparatus to furnaces; and his invention consists in this — *by interposing a receptacle for heated air between the blowing apparatus and the furnace*. In this receptacle he directs the air to be heated by the application of heat externally to the receptacle, and thus he accomplishes the object of applying the blast, which was before of cold air, in a heated state to the furnace." Web. P. C., 275, 371.

In this passage, we think that the court of exchequer (who spoke through Baron Parke) drew the true distinction between a mere principle, as the subject of a patent, and a process by which a principle is applied to effect a useful result. That a hot-blast is better than a cold-blast for smelting iron in a furnace was the principle or scientific fact discovered by Neilson; and yet, being nothing but a principle, he could not have a patent for that. But having invented and practically exemplified a process for utilizing this principle, namely, that of heating the blast in a receptacle between the blowing apparatus and the furnace, he was entitled to a patent for that process, although he did not distinctly point out all the forms of apparatus by which the process might be applied,—having, nevertheless, pointed out a particular apparatus for that purpose, and having thus shown that the process could be practically and usefully

applied. Another person might invent a better apparatus for applying the process than that pointed out by Neilson, and might obtain a patent for such improved apparatus; but he could not use the process without a license from Neilson. His improved apparatus would, in this respect, stand in a relation to the process analogous to that which an improvement on a patented machine bears to the machine itself.

That Neilson's patent was regarded as for a process is apparent from what is said by the judges who had it under consideration. Thus Baron Parke at the trial had said: "The specification and patent together make it clear what the discovery was: it was the introduction of hot air by means of heating it before it was introduced into the furnace, between the blowing apparatus and the furnace." Web. P. C., 275, 312. And when the matter came before the house of lords, after a trial in Scotland, Lord Campbell said: "After the construction first put upon it [the patent] by the learned judges of the court of exchequer, sanctioned by the high authority of my noble and learned friend now upon the woolsack, when presiding in the court of chancery, I think the patent must be taken to extend to all machines, of whatever construction, whereby the air is heated intermediately between the blowing apparatus and the blast furnace. That being so, the learned judge was perfectly justified in telling the jury that it was unnecessary for them to compare one apparatus with another, because, confessedly, that system of conduit pipes was a mode of heating air by an intermediate vessel between the blowing apparatus and the blast furnace, and therefore it was an infraction of the patent." Id., 715.

This case of the hot-blast was commented upon in the great case of *O'Reilly v. Morse*, and is there recognized and approved in the opinion of this court delivered by Chief Justice Taney. After quoting the remarks of Baron Parke in the court of exchequer, cited above, the chief justice says: "We see nothing in this opinion differing in any degree from the familiar principles of law applicable to patent cases. Neilson claimed no particular mode of constructing the receptacle, or of heating it. He pointed out the manner in which it *might* be done; but admitted that it might also be done in a variety of ways, and at a higher or lower temperature; and that all of them would produce the effect in a greater or less degree, provided the air was heated by passing through a heated receptacle. . . . Whoever, therefore, used this method of throwing hot air into the furnace used the process he had invented, and thereby infringed his patent, although the form of the receptacle of the mechanical arrangements for heating it might be different from those described by the patentee. For whatever form was adopted for the receptacle, or whatever mechanical arrangements were made for heating it, the effect would be produced in a greater or less degree, if the heated receptacle was placed between the blower and the furnace, and the current of air passed through it. . . . The patent was supported because he [Neilson] had invented a mechanical apparatus by which a current of hot air, instead of cold, could be thrown in. And this new method was protected by the patent. The interposition of a heated receptacle of any form was the novelty he invented." 15 How., 62, 115, 116.

§ 5052. *Morse's eighth claim considered.*

We have quoted these remarks of the chief justice more fully because they show most clearly that he put the same construction upon Neilson's patent that was put upon it by Lord Campbell, and that he fully acquiesced in the legality and validity of a patent for a process. Yet it has been supposed that

the decision in *O'Reilly v. Morse* was adverse to patents for mere processes. The mistake has undoubtedly arisen from confounding a patent for a process with a patent for a mere principle. We think that a careful examination of the judgment in that case will show that nothing adverse to patents for processes is contained in it. The eighth claim of Morse's patent was held to be invalid, because it was regarded by the court as being not for a process, but for a mere principle. It amounted to this, namely, a claim of the exclusive right to the use of electro-magnetism as a motive power for making intelligible marks at a distance; that is, a claim to the exclusive use of one of the powers of nature for a particular purpose. It was not a claim of any particular machinery, nor a claim of any particular process for utilizing the power; but a claim of the power itself,—a claim put forward on the ground that the patentee was the first to discover that it *could* be thus employed. This claim the court held could not be sustained.

That this was the true ground of the decision will be manifest from the following observations of the chief justice in the opinion already quoted from. He says: "He [Morse] claims the exclusive right to every improvement where the motive power is the electric or galvanic current, and the result is the marking or printing intelligible characters, signs or letters at a distance. If this claim can be maintained, it matters not by what *process* or *machinery* the result is accomplished. For aught that we now know, some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff's specification. . . . In fine, he claims an exclusive right to use a *manner and process* which he has not described, and indeed had not invented, and therefore could not describe when he obtained his patent. The court is of opinion that the claim is too broad, and not warranted by law. . . . It is the high praise of Professor Morse that he has been able by a new combination of known powers, of which electro-magnetism is one, to discover a method by which intelligible marks or signs may be printed at a distance. And for the method or process thus discovered he is entitled to a patent. But he has not discovered that the electro-magnetic current, used as a motive power, in any other method, and with any other combinations, will do as well." After reviewing the statutes and decisions bearing upon the subject, the chief justice makes a summary conclusion of the whole matter, as follows: "Whoever discovers that a certain useful result will be produced, in any art, machine, manufacture or composition of matter, by the use of certain means, is entitled to a patent for it; provided he specifies the means he uses in a manner so full and exact that any one skilled in the science to which it appertains can, by using the means he specifies, without any addition to or subtraction from them, produce precisely the result he describes. And if this cannot be done by the means he describes, the patent is void. And if it can be done, then the patent confers on him the exclusive right to use the means he specifies to produce the result or effect he describes, and nothing more. And it makes no difference, in this respect, whether the effect is produced by chemical agency or combination; or by the application of discoveries or principles in natural philosophy, known or unknown before his invention; or by machinery acting altogether upon mechanical principles. In either case he must describe *the manner or process* as above mentioned, and the end it accomplishes. And any one may lawfully

accomplish the same end without infringing the patent, if he uses means substantially different from those described." *Id.*, 119.

§ 5053. *A process is a "means" of producing a useful result in an art which will entitle to a patent; an act or a mode of acting.*

It seems to us that this clear and exact summary of the law affords the key to almost every case that can arise. "Whoever discovers that a certain useful result will be produced in any art by the use of certain means is entitled to a patent for it, provided he specifies the means." But everything turns on the force and meaning of the word "means." It is very certain that the means need not be a machine or an apparatus; it may, as the court says, be a *process*. A machine is a thing. A process is an act or a mode of acting. The one is visible to the eye,—an object of perpetual observation. The other is a conception of the mind, seen only by its effects when being executed or performed. Either may be the means of producing a useful result. The mixing of certain substances together, or the heating of a substance to a certain temperature, is a process.

§ 5054. *What is a sufficient description of a process.*

If the mode of doing it, or the apparatus in or by which it may be done, is sufficiently obvious to suggest itself to a person skilled in the particular art, it is enough, in the patent, to point out the process to be performed, without giving supererogatory directions as to the apparatus or method to be employed. If the mode of applying the process is not obvious, then a description of a particular mode by which it may be applied is sufficient. There is, then, a description of the process and of one practical mode in which it may be applied. Perhaps the process is susceptible of being applied in many modes and by the use of many forms of apparatus. The inventor is not bound to describe them all in order to secure to himself the exclusive right to the process, if he is really its inventor or discoverer. But he must describe some particular mode, or some apparatus, by which the process can be applied with at least some beneficial result, in order to show that it is capable of being exhibited and performed in actual experience.

§ 5055. *Tilghman's claim is not for a mere principle.*

Let us apply these principles to the present case. In the first place, the claim of the patent is not for a mere principle. The chemical principle or scientific fact upon which it is founded is that the elements of neutral fat require to be severally united with an atomic equivalent of water in order to separate from each other and become free. This chemical fact was not discovered by Tilghman. He only claims to have invented a particular mode of bringing about the desired chemical union between the fatty elements and water. He does not claim every mode of accomplishing this result. He does not claim the lime-saponification process, nor the sulphuric-acid distillation process, and if, as contended, the result was accomplished by Dubrunfaut, Wilson and Scharling, by means of steam distillation, he does not claim that process. He only claims the process of subjecting to a high degree of heat a mixture continually kept up of nearly equal quantities of fat and water in a convenient vessel strong enough to resist the effort of the mixture to convert itself into steam. This is most certainly a process. It is clearly pointed out in the specification, and one particular mode of applying it and carrying it into effect is described in detail. But it is not the particular apparatus described which Tilghman desires to secure by his patent. Having pointed out the process

and suggested a particular mode of applying it, he claims as his invention "*the manufacturing of fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure.*" The true construction of this claim is to be sought by comparing it, as we have already done, with the context of the specification; with the statement of the patentee that his "invention consists of a *process* for producing free fat acids and solution of glycerine from those fatty and oily bodies of animal and vegetable origin which contain glycerine as a base;" that, "for this purpose, he subjects these fatty and oily bodies to the action of water at a high temperature and pressure, so as to cause the elements of those bodies to combine with water, and thereby obtain at the same time free fat acids and solution of glycerine;" that he "mixes the fatty body to be operated upon with from a third to a half of its bulk of water, and the mixture may be placed in any convenient vessel in which it can be heated to the melting point of lead" [which is afterwards explained to be only desirable for a quick result, not essential]; that "the vessel must be closed and of great strength, so that the requisite amount of pressure may be applied to prevent the conversion of the water into steam." This is the process which the patentee claims to have invented; and this description of it gives the proper construction and qualification to the claim. It is objected that the particular apparatus described in the patent for carrying the process into effect cannot be operated to produce any useful result. We have examined the evidence on this point, and are satisfied that it shows the objection to be unfounded. A recapitulation of this evidence is not necessary. The testimony of Tilghman himself, of Professor Booth and of Mr. Wilson is directly to the point.

§ 5056. *The infringement considered.*

It only remains that we should express our views on the question of infringement. The defendants advance several reasons for the purpose of showing that their process does not conflict with that of Tilghman. First, because they do not use the apparatus described in the complainant's patent, but use a boiler in which the charge of fat and other materials is placed and heated; and do not mix the fat and water in the manner pointed out in the specification of the patent, but, on the contrary, have inserted in the boiler a pump which forces the water as it settles to the bottom upwards to the top of the mass, and pours it upon the upper surface, whence it again finds its way down through the fat, thus keeping up a constant mixture. It is unnecessary to add anything further on the subject of the form of the apparatus used. The patentee is not confined to a metallic coil of pipe heated in a furnace; but his patent extends to and embraces any convenient vessel for holding the mixture, which is strong enough to sustain the pressure necessary to prevent the water from being converted into steam. The defendants use such a vessel, and use it for the purpose indicated and pointed out in the patent. The vessel which they use has the requisite strength to prevent the water from being converted into steam, and does effect that object. And as to the defendants' using a different method from that suggested in the patent for keeping up the mixture of fat and water, that is of no consequence. The keeping up of the mixture is the important thing. That is a necessary part of the process. They employ such a device for effecting this as is adapted to the form of vessel in which they heat the material. Using a boiler instead of a coil of pipe for this purpose, they are obliged to employ an additional or modified means for keeping up the mixture. They only employ such means as, in view of the

change adopted in the form of the heating apparatus, and of the known appliances in use in analogous processes, would naturally suggest themselves to a mechanic skilled in the art. Or, if the mode of effecting the continued mixture adopted by the defendants should be deemed a new and useful improvement, they might perhaps have a patent for that peculiar device without being entitled to use Tilghman's process, on which it is but an improvement.

Another ground on which the defendants argue that they do not infringe the patent is, that they do not, in their process, use water alone in admixture with fat, but use also some portion of lime; that they formerly used seven per cent. of lime, and now use four per cent. But they do not use lime in the manner and to the extent in which it is used for dissolving fats by the saponifying process. That requires twelve or fourteen per cent. Even if the saponifying process partly takes place, they use Tilghman's process for effecting the balance of the operation. They use water in admixture with fat, heated to a high degree, far above the boiling point, and yet subjected to such pressure as to prevent the water from being converted into steam; and though they may also use other things at the same time, which other things may facilitate the operation, or render a less degree of heat necessary than would be required when water alone is used, and thus actually improve the process of Tilghman, yet this process is included in their operation, and forms the basis of it. It is idle, therefore, to say that they do not infringe Tilghman's patent. It is unnecessary to determine what precise part the lime used by the defendants plays in their process; whether, as the complainant contends, it saponifies the fat to a certain extent, leaving the remainder to be acted upon by the water alone, purely after the process of Tilghman; or whether, as the defendants contend, the lime produces a more perfect and active commixture of the fat and water, or predisposes the fat to unite with the requisite elements of water necessary for producing glycerine and the fat acids,—in either case the process of Tilghman, modified or unmodified by the supposed improvement, underlies the operation performed in the defendants' boilers.

§ 5057. *The introduction of an improvement gives no right to use the primary invention improved upon.*

Another ground assumed by the defendants to avoid the charge of infringement is, that they do not heat the mixed mass in the manner pointed out in Tilghman's specification; but, instead of heating the containing vessel by an outside application of heat, they heat the contents by the introduction of super-heated steam. But we think that this does not alter the essential character of the process. The heating by steam is clearly an equivalent method to that of heating by an external fire. The patent does not prescribe any particular method of applying the heat, except when using the pipe and coil apparatus described in the specification; and, even in the use of this apparatus, the outward application of the heat to the pipe is suggested incidentally and as a matter of convenience rather than as an essential requisite. The patentee showed one method in which the heat could be applied. That was all that was necessary for him to do. If it could be applied in any number of different methods, it would not affect the validity of the patent as a patent for a process. The method of heating the mixture by the introduction of steam may be attended with some beneficial results, in producing an agitation, or automatic circulation helpful to the perfection of the admixture of the water and fat; and so far it may be an improvement on heating from without. Sup-

pose this to be so, as before said, the introduction of an improvement gives no title to use the primary invention upon which the improvement is based.

§ 5058. *Variations in the degree of heat in the infringement of a process.*

Finally, the defendants argue that they only use a low degree of heat and pressure compared with that pointed out by the patent, namely, only about three hundred and ten degrees Fahrenheit instead of six hundred and twelve degrees. The precise degree of heat, as we have seen, is not of the essence of the patent. The specification only claims that a high degree of heat, such as would be sufficient to melt lead, is most effective and rapid in producing the desired result; but suggests a trial of the apparatus employed with different degrees of heat so as to ascertain that which is best for each particular kind of fat. "By starting the apparatus," the language is, "at a low heat, and gradually increasing it, the temperature giving products most suitable to the intended application of the fatty body employed can easily be determined." It is probably true, as contended for by the defendants, that by the use of a small portion of lime, the process can be performed with less heat than if none is used. It may be an improvement to use the lime for that purpose; but the process remains substantially the same. The patent cannot be evaded in that way. The matter may be stated thus: Tilghman discovers a process of decomposing fats by mixing them with water, and heating the mixture to a high temperature under a pressure that prevents the formation of steam. It is a new process, never known before. The defendants seeing the utility of the process, and believing that they can use a method somewhat similar without infringing Tilghman's patent, put a little lime into the mixture, and find that it helps the operation, and that they do not have to use so high a degree of heat as would otherwise be necessary. Still, the degree of heat required is very high, at least a hundred degrees above the boiling point; and a strong boiler or vessel is used in order to restrain the water from rising into steam. Can a balder case be conceived of an attempted evasion and a real infringement of a patent?

And as to the low degree of heat used in the operations of the defendants, this must also be said: that, with the reduction of the temperature, the time of perfecting the operation is more than proportionally increased. Tilghman was aware of this result, and pointed it out in his patent. He expressly says: "The decomposing action of the water becomes more powerful as the heat is increased." What can be done in minutes by the application of a very high degree of heat requires hours to do at the temperature used by the defendant. But the process is still the same, and the defendants fail to evade the patent.

We pass by the fact that the defendants first took a license from the patentee, and under it and under his directions erected substantially the same apparatus which they are yet using. Receiving what they regarded as additional light, they refused to continue the payment of a royalty, and put the complainant to his legal remedy. It is our opinion that the patent is for a process, that it is a valid patent, and that the defendants infringe it.

We have considered the case entirely upon its merits. It is unnecessary to bestow much discussion upon the technical objections that have been raised. They have not been pressed in the argument, and are probably not seriously relied on. One of them is, that no replication was filed in the case. To this it may be answered, that the parties have throughout treated the case as though it were regularly at issue. The various stipulations into which they have entered, with regard to the admission of evidence to be heard on the trial of the

cause, are totally inconsistent with the idea that the case was to be heard merely on bill and answer.

§ 5059. *Antedating of patent and foreign patent.*

Another objection is, that the patent was dated more than six months prior to the filing of the application for it. But under the law then in force (1854) with regard to the antedating of patents where a foreign patent had been obtained, this was admissible. The sixth section of the act of March 3, 1839, entitled "An act in addition to an act to promote the progress of the useful arts," expressly declared "that no person shall be debarred from receiving a patent for any invention or discovery . . . by reason of the same having been patented in a foreign country more than six months prior to his application: *Provided*, that the same shall not have been introduced into public and common use in the United States prior to the application for such patent: *And provided, also*, that in all cases every such patent shall be limited to the term of fourteen years from the date of publication of such foreign letters patent." Now, we know by the proceedings on the application in this case that the attention of the commissioner of patents was expressly called to the fact of the issuing of the English patent, and that the question of the date of the patent in suit was submitted to and considered by him. Under the laws then in force, he determined that the patent ought to be antedated as of the date of the English patent. It must be presumed that his decision was right according to the facts of the case, at least until the contrary is shown; and nothing has been shown to the contrary by any evidence in the cause to which our attention has been called.

The decree of the circuit court will be reversed, and the cause remanded with directions to enter a decree in conformity with this opinion; and it is so ordered.

Process — *Defined*, §§ 5060-5065. *Validity*, §§ 5066, 5067. *Patentability*, §§ 5068-5083. See *Art*, §§ 382-397.

§ 5060. In the language of the patent law, a process is an art. *Cochrane v. Deener*, 4 Otto, 781.

§ 5061. By a process is meant the application or operation of some element or power of nature, or of one subject to another. *Boyd v. Cherry*, 4 McC., 70.

§ 5062. When the result or effect is produced by chemical action, or by the application of some element or power of nature, or of one substance to another, such modes, methods or operations are called processes. *Piper v. Brown*, 1 Holmes, 20.

§ 5063. A process is a mode of treatment of certain materials to produce a given result, an act or a series of acts performed upon the subject-matter to be transformed and reduced to a different state or thing, and, if new and useful, it is patentable. *Cochrane v. Deener*, 4 Otto, 781.

§ 5064. "Mode," when referring to something fugitive, means a method, which may mean engine, contrivance, device, process, instrument, mode and manner of effecting the purpose. *Whitney v. Emmett*, 1 Bald., 303.

§ 5065. The mere operation of a machine does not constitute a patentable process. It is not a chemical process, nor any other, for transforming the subject of it into another state. *New v. Warren*, 22 O. G., 587; *Reay v. Raynor*, 19 Fed. Rep., 308.

§ 5066. It is not essential to the validity of a process patent to state the chemical change, the philosophy of the process. *Cahill v. Beckford*, 1 Holmes, 48.

§ 5067. It is essential to the validity of the process as an invention to show how it may be adapted to practical use. *Piper v. Brown*, 1 Holmes, 20.

§ 5068. A principle, when made available by a method whereby it is put to practical use, is patentable as a process. *Andrews v. Carman*, 13 Blatch., 307.

§ 5069. The intellectual conception of a possible process, without a potential working of it out, is not patentable. *Union Mfg. Co. v. Lounsbury*, 2 Fish., 389.

§ 5070. When the discoverer of a natural force is entitled to a patent for a process. *American Bell Telephone Co. v. Dolbear*, 15 Fed. Rep., 448.

§ 5071. Extent and scope of such a patent. *Ibid.*

§ 5072. A novel and successful process or method of applying known instrumentalities to a practical use is the proper subject of a patent. *Roberts v. Dickey*, 4 Brewster, 260.

§ 5073. The production of insensibility in the human system by anæsthetic agency or otherwise, and the performance of surgical operations during such insensibility, is not patentable as an art in contradistinction to a principle, function or quality of matter. *Cushing's Opinion*, 8 Op., 270.

§ 5074. The process requires that certain things should be done with certain substances and in a certain order; but the tools to be used in doing this may be of secondary consequence. *Cochrane v. Deener*, 4 Otto, 781.

§ 5075. A process *eo nomine* is not made the subject of a patent in the act of congress. . . . It is for the discovery or invention of some practical method or means of producing a beneficial result or effect that a patent is granted, not for the result or effect itself. "Process" and "method," when used to represent the means of producing a beneficial result, are in law synonymous with "art," provided the means are not effected by mechanism or mechanical combinations. *Piper v. Brown*, 1 Holmes, 20.

§ 5076. A patent may be for a mode or method of doing a thing. *Whitney v. Emmett*, 1 Bald., 303.

§ 5077. The patentability of a process is entirely independent of the instrumentalities employed, and it is immaterial whether or not the machinery pointed out as suitable to perform the process be either new or patentable. *Cochrane v. Deener*, 4 Otto, 781.

§ 5078. The elements of a process may be old, but when combined for the purpose of putting to practical use a new idea they constitute a new and useful process within the meaning of the patent law. *Andrews v. Carman*, 13 Blatch., 307.

§ 5079. A new process producing a useful product is patentable. *Goodyear v. Wait*, 5 Blatch., 468.

§ 5080. The inventor of a new method or process which produces a well known product can patent his process only. *Goodyear v. The Railroad*, 2 Wall. Jr., 356.

§ 5081. Though the product may not be new the process may be new, useful and patentable. *Wood-Paper Patent*, 23 Wall., 566.

§ 5082. If a chemical product is not new it is not patentable, even if extracted from a new substance; but the process of extraction, if new and useful, is patentable. *Ibid.*

§ 5083. A process as well as the product may both be new, and in that case each may be patented independently. *Rubber Co. v. Goodyear*, 9 Wall., 788.

See *Invention*, § 3637. *Specification*, §§ 6023-6026, 6070. *Scope of Patent*, § 5969.

Process — As to novelty, §§ 5084-5086.

§ 5084. In support of a claim for a new method or process, it must appear that the result produced is an improvement in the trade — using those words in a commercial sense, as meaning the manufacture of the article as good in quality and at a cheaper rate, or better in quality at the same rate, or with both of these consequences partially combined. *Jones v. Witherill*, 1 MacA. Pat. Cases, 409.

§ 5085. Upon a claim for a process, it is unnecessary to inquire as to the novelty or utility of the arrangement of machinery described in the specification; for however novel or useful the arrangement or combination may be, if it be not the ground of claim, and relied on as such, no patent will be issued for it upon such a claim. *In re Henry*, 1 MacA. Pat. Cases, 467.

§ 5086. The patent being for a process, to deprive complainant of the benefit of his invention it is not sufficient to show that any previous existing apparatus could have been used to practice his process. *Piper v. Brown*, 1 Holmes, 20.

See *Combination*, § 919. *Novelty*, § 4396.

Process — Infringement of, §§ 5087-5101.

§ 5087. *Semble*, that where a patent is obtained without a claim to the invention of the machinery, through which a valuable result is produced, a precise specification is required; and the test of infringement is whether defendants have used substantially the same process to produce the same result. *Le Roy v. Tatham*, 14 How., 156.

§ 5088. Where an individual has discovered a new principle and a process by which it is made practical and operative, his patent covers all modes and processes by which the principle of his invention is made operative in practice, and is infringed by adopting the principle to an available or practical extent. *Tilghman v. Werk*, 1 Bond, 511.

§ 5089. It seems that the use of a new process, involving patented machinery, must be by the license or permission of the patentee or his assigns. *Jones v. Witherill*, 1 MacA. Pat. Cases, 409.

§ 5090. In considering the question as to the infringement of a process, it is immaterial whether defendant's machinery is the same as that described by plaintiff, as that forms no part of the invention; the inquiry is, does defendant, whatever his machinery is, produce the same result according to plaintiff's process. *Tilghman v. Mitchell*, 2 Fish., 518.

§ 5091. Doubted whether an action will lie for the infringement of a machine used in a combination, when the grant is for the art and not for the individual machines. *Evans v. Eaton*, Pet. C. C., 322.

§ 5092. Construing the claim in question as for a process, every successive step enumerated must be regarded as an essential part, and must be employed by defendants to render them liable for infringement. *Hammerschlag v. Garrett*, 10 Fed. Rep., 479.

§ 5093. A process consisting of one stage is not avoided by using a process of two steps, one of which is the same as that of the patented process. *American Wood Paper Co. v. Fibre Disintegrating Co.*, 6 Blatch., 27.

§ 5094. If the process described in a patent is an infringement of a prior patent, it will not protect those who practice the process from the charge, although it disclaims all that is shown and described in the prior patent. *Tilghman v. Morse*, 9 Blatch., 421.

§ 5095. The use of a process which omits one of the essential parts of that patented, and does not employ a chemical equivalent in its place, is not an infringement. *Dittmar v. Rix*, 1 Fed. Rep., 342.

§ 5096. Where defendant's process is not the patented process, but omits a patented step, and in its stead includes one which the patentee intended to avoid, it is not an infringement. *Cotter v. New Haven Copper Co.*, 23 O. G., 740.

§ 5097. A patent for a chemical process is not infringed by a different process, although the same article is produced by it. *Rumford Chemical Works v. Lauer*, 10 Blatch., 122.

§ 5098. Where a claim embraced a complete method, of which part only was used, *held*, that it was not infringed. *Byam v. Farr*, 1 Curt., 260.

§ 5099. Where the defendant did not vary the process or the mode of working, or its essential conditions, but applied a new solution, worked in the same way and under the same conditions as the solution of the plaintiff, it is an infringement of plaintiff's claim. *United Nickel Co. v. Pendleton*, 15 Fed. Rep., 739.

§ 5100. Where the same process was used, for the same purpose and with the same result, although with a higher degree of heat, it was held an infringement of the patented process. *Cary v. Wolff*, 32 O. G., 257.

§ 5101. Where a patent stated that a certain process conducted at a certain pressure and temperature would involve the saving of a certain quantity of the chemical used, which saving would increase with an increase of pressure, it was held infringed by a process employing heat and pressure below the minimum given. *American Wood Paper Co. v. Heft*, 3 Fish., 316.

See *Substitution*, § 6207.

Process — Generally, §§ 5102-5104. See *Claims, Construction of Particular*, §§ 780-785, 787, 791, 796. *Equivalent, Chemical*, §§ 2132-2138. *Reissue*, §§ 5335, 5551-5562. *Specification*, §§ 6023-6026.

§ 5102. If the process consists of a chemical combination by which the particular result is produced, that does not prevent another inventor from making a mechanical combination which produces the same result. *New Process Fermentation Co. v. Maus*, 20 Fed. Rep., 725.

§ 5103. The patent for a process will include every application of the principle that involves the use of the process described and claimed by the patentee, and this does not include the particular machine or apparatus described by the patentee, but the mode of operation which is carried out by means of the apparatus. *Ibid.*

§ 5104. This process puts to a practical use the new principle of forcing water, in the water-bearing strata of the earth, from the earth into a well-pit by the use of artificial power applied to create a vacuum in the manner described. This idea or principle, though new, is not by itself patentable. The idea, when made available by a method whereby it is put to a practical use, is patentable as a process, and is thus secured to the person who has conceived the idea and invented the process. *Andrews v. Carman*, 13 Blatch., 307.

See *Claims, Construction of*, § 741. *Damages and Profits*, §§ 1670-1672.

281. PROCESS AND PRODUCT.

SUMMARY (SMITH *v.* GOODYEAR DENTAL VULCANITE CO., §§ 5105-5110) — *The patent considered*, § 5105. — *General use evidence of patentability*, § 5106. — *Non-invention; substitution of material*, § 5107. — *Patent evidence of inventorship*, § 5108. — *Presumptions arising on a reissue*, § 5109. — *Continuing application*, § 5110.

(MERRILL *v.* YEOMANS, §§ 5111-5115) — *Process not infringed*, § 5111. — *Patent construed*, § 5112. — *The claims as distinguished from the specification*, § 5113. — *Remedy for failure to claim is by reissue*, § 5114. — *Claims should be limited to the invention*, § 5115.

SMITH *v.* GOODYEAR DENTAL VULCANITE COMPANY.

(3 Otto, 486-502. 1876.)

APPEAL from U. S. Circuit Court, District of Massachusetts.

Opinion by MR. JUSTICE STRONG.

STATEMENT OF FACTS.— A brief review of the history and nature of the patent which the complainants allege has been infringed will aid materially in solving the questions presented by this appeal. On the 14th day of May, 1852, Dr. John A. Cummings, a dentist of Boston, filed in the patent office a caveat to protect an invention he claimed to have made, of certain new and useful improvements in the setting and plates of artificial sets of teeth. The description accompanying the caveat indicated with very considerable clearness what the alleged invention was, and the objects sought to be gained by it. The improvement was declared to “consist in forming the plate, and also the gums in which the teeth are inserted, of rubber, or some other elastic substance so compounded with sulphur, lead and other similar substances as to form a hard gum or whalebone gum rigid enough for the purposes of mastication, and pliable enough to yield a little to the mouth.” “By this improvement,” the caveator said, “the teeth can be easily baked into the gums, which form one piece with the plate.” Subsequently, on the 12th of April, 1855, he applied for a patent, reciting in his application that he had previously entered a caveat. His accompanying specification declared the invention to consist in “forming the plate and gums to which the teeth are attached of rubber, or some other elastic material so indurated as to be rigid enough for the purpose of mastication, and pliable enough to yield a little to the motions of the mouth, and in one piece, the teeth being embedded in the elastic material while the material is in a soft condition, and then baked with the gums and plate, so that the teeth, gums and plate will all be connected, forming, as it were, one piece.”

This application for a patent was rejected on the 19th of May next following; and the applicant was referred to two printed publications, one suggesting the use of gutta-percha as a base for artificial sets of teeth, and the other suggesting pastes, analogous to porcelain paste, as well as gutta-percha. Cummings then amended his specification by striking out all reference to gutta-percha or other merely elastic material, disclaiming the use of gutta-percha and any material which is merely rendered plastic by heat and hardened by cooling, and he claimed the improvement in sets of mineral or other artificial sets of teeth which consists in combining the teeth with a rubber plate and gums, which, after the insertion of the teeth, are vulcanized by Goodyear's process or any other process, forming thereby a cheap, durable and elastic substitute for the gold plates theretofore used. This amendment, however, proved ineffectual. The application for a patent was again rejected;

and a third rejection followed, a reconsideration for which the applicant had asked. This third rejection was on the 3d day of February, 1856. From that time onward for several years, indeed, until the patent was finally granted, the evidence very satisfactorily shows that Dr. Cummings was in a condition of extreme poverty, utterly unable to bear the necessary expenses of prosecuting his case further. But he did not withdraw his application. He did not ask for a return of part of the fee he had paid, nor by any act of his did he indicate acquiescence in the unfavorable action of the patent office. On the contrary, he continued to assert his expectation of ultimately obtaining a patent, formed plans for his own action after it should be obtained, and complained of what he supposed to be the negligence of his solicitor. The proof of his extreme poverty is ample. His ill-health interfered with his working successfully in the line of his profession, and his family was subjected to great privations. He seems never to have had any considerable money. He borrowed, sometimes, small sums to purchase underclothing for himself. He made frequent applications to his friends for advances to enable him to prosecute his application for a patent, offering as a compensation for such advances sometimes one quarter and sometimes one-half of the patent when obtained. He appears never to have remitted his efforts until, in 1864, he induced Dr. Flagg, who had been his partner in former years, and Dr. Osgood, to advance, first, \$100, and afterwards \$720, by means of which the patent was obtained. Even then he had not the \$20 necessary to be paid when it was allowed. For the assistance he thus received he gave one quarter of his invention. Before this time, between the third rejection of his application and his obtaining the advances mentioned, everything was done which was within his power.

In February, 1859, in the midst of his pecuniary embarrassments, his solicitor applied to the patent office, not for a return of any portion of the fee paid, nor for a withdrawal of the application, but that the specification and one drawing might be sent to him. This request was refused. An attempt was then made for an appeal to the board, but that not being allowed by the commissioner, nothing further was done in the patent office until the applicant was enabled, by the funds obtained from Drs. Flagg and Osgood, to renew his endeavors. Then, on the 1st of March, 1864, he presented a petition for the grant of a patent to himself for the same invention which he had endeavored to secure in 1855 (the application for which remained in the office unwithdrawn), and accompanied his petition with a specification and drawings corresponding exactly with those he had previously made. This final effort was successful. The office practically acknowledged that the prior rejection had been an error, and declared that, in justice to his rights as an inventor, the admission of his claim, limited to the use of hard rubber or vulcanite, as he had before limited it, would not be objected to. Accordingly the patent was granted on the 7th of June, 1864, and by sundry conveyances it subsequently became vested in the complainants. Two surrenders and reissues have since been made, the last dated March 21, 1865, and it is for an alleged infringement of this second reissue that the present suit has been brought. The bearing of this history upon the merits of the controversy will appear as we proceed to examine the several defenses set up.

§ 5105. *Reissue No. 1904, March 21, 1865, of original patent No. 43,009, J. A. Cummings, June 7, 1864, artificial gums, construed.*

Among these the one perhaps most earnestly urged is the averment that the device described in the specification was not a patentable invention, but that

it was a mere substitution of vulcanite for other materials, which had previously been employed as a base for artificial sets of teeth,—a change of one material for another in the formation of a product. If this is in truth all that the thing described and patented was, if the device was merely the employment of hard rubber for the same use, in substantially the same manner, and with the same effect, that other substances had been used for in the manufacture of the same articles, it may be conceded that it constituted no invention. So much is decided in *Hotchkiss v. Greenwood*, 11 How., 248. But such is not our understanding of the device described and claimed. In the specification it is declared that the invention “consists in forming the plate to which the teeth, or teeth and gums, are attached, of hard rubber, or vulcanite, so called, an elastic material, possessing and retaining in use sufficient rigidity for the purpose of mastication, and at the same time being pliable enough to yield a little to the motions of the mouth.” This is immediately followed by a description of the manner of the proposed use; that is, of making the hard rubber plates; and the claim, as stated, is “the plate of hard rubber, or vulcanite, or its equivalent, for holding artificial teeth, or teeth and gums, substantially as described;” that is, plainly, formed as described. The invention, then, is a product or manufacture made in a defined manner. It is not a product alone separated from the process by which it is created. The claim refers in terms to the antecedent description, without which it cannot be understood. The process detailed is thereby made as much a part of the invention as are the materials of which the product is composed.

We shall not quote at large the description of the mode of making the plate. Such a quotation would unnecessarily prolong this opinion. It plainly shows a purpose of the inventor to secure what had not been secured before,—a combination of a plate with artificial teeth, or with gums and teeth, in such a manner as to be free from the objections and defects or inconveniences attending the method before practiced, of attaching such teeth to a metallic plate fitted to the roof of the mouth. Some of these objections are stated; such as expense, hurting the mouth, impeding mastication, and obstruction to perfect articulation. In carrying out the purpose proposed, the materials employed were all old. The teeth, the wax, the plaster, the moulds, the soft rubber, and the hard rubber, were none of them new. It is also true that the steps in the process were not all new. Plaster had been used for formation of moulds. The process of forming a plate by the use of such moulds was well known, and so was the process of converting a vulcanizable compound into vulcanite by heating it and allowing it to cool in moulds. But the process of Dr. Cummings extended beyond the use of known materials and the employment of the processes mentioned. It was vulcanizing soft rubber in a mould, and in contact with artificial teeth inserted in place into it while it remained in a soft condition. It was well described by the circuit judge as “the making of a vulcanite dental plate out of a vulcanizable compound, into which the teeth were embedded in its plastic condition, and the rubber compound, with the teeth thus embedded in it, afterwards vulcanized by heat, so that the teeth, gums and plate should be perfectly joined without any intervening crevices, and the plate should possess the quality of hard rubber or vulcanite.”

The combination thus resulted in a manufacture which was “one piece.” If, then, the claim be read, as it should be, in connection with the preceding part of the specification, and construed in the light of the explanation which that gives, the invention claimed and patented is “a set of artificial teeth as

a new article of manufacture, consisting of a plate of hard rubber, with teeth, or teeth and gums, secured thereto in the manner described in the specification, by embedding the teeth and pins in a vulcanizable compound so that it shall surround them while it is in a soft state, before it is vulcanized, and so that when it has been vulcanized the teeth are firmly and inseparably secured in the vulcanite, and a tight joint is effected between them, the whole constituting but one piece." It is evident this is much more than employing hard rubber to perform the functions that had been performed by other materials, such as gold, silver, tin, platinum, or gutta-percha. A new product was the result, differing from all that had preceded it, not merely in degree of usefulness and excellence, but differing in kind, having new uses and properties. It was capable of being perfectly fitted to the roof and alveolar processes of the mouth. It was easy for the wearer, and favorable for perfect articulation. It was light and elastic, yet sufficiently strong and firm for the purposes of mastication. The teeth, gums and plate constituting one piece only, there were no crevices between the teeth and their supporters into which food could gather, and where it could become offensive, and there could be no such crevices so long as the articles lasted. They were unaffected by any chemical action of the fluids of the mouth. Besides all this, they were very inexpensive as compared with other arrangements of artificial teeth. To us it seems not too much to say that all these peculiarities are sufficient to warrant the conclusion that the device was different in kind or species from all other devices. We cannot resist the conviction that devising and forming such a manufacture by such a process and of such materials was invention. More was needed for it than simply mechanical judgment and good taste. Were it not so, hard rubber would doubtless have been used in the construction of artificial sets of teeth, gums and plates long before Cummings applied for his patent. To find a material, with a mode of using it, capable of being combined with the teeth in such a manner as to be free from the admitted faults of all other known combinations, had been an object long and earnestly sought. It had been a subject for frequent discussion among dentists and in scientific journals.

The properties of vulcanite were well known; but how to make use of them for artificial sets of teeth remained undiscovered, and apparently undiscoverable, until Cummings revealed the mode. But when revealed its value was soon recognized, and no one seems to have doubted that the resulting manufacture was a new and most valuable invention. The eminent dentists and experts examined in this case uniformly speak of it as such. Not one has ventured to testify that it was not an invention. They speak of it as "a novel and desirable thing;" as "the greatest improvement in dentistry" made in many years; and as an invention which is "a great benefaction to mankind, whereby both health and comfort are promoted." The evidence also shows that it has wrought a revolution in dental practice, and that many thousands of operators are using it in preference to older devices. All this is sufficient, we think, to justify the inference that what Cummings accomplished was more than a substitution of one material for another; more than the exercise of mechanical judgment and taste,—that it was, in truth, invention.

§ 5106. *That a device has gone into general use, displacing all other devices, is evidence that it is patentable.*

Undoubtedly the results or consequences of a process or manufacture may in some cases be regarded as of importance when the inquiry is whether the

process or manufacture exhibits invention, thought and ingenuity. Webster, on the subject-matter of patents, page 30, says: "The utility of the change, as ascertained by its consequences, is the real practical test of the sufficiency of an invention; and, since the one cannot exist without the other, the existence of the one may be presumed on proof of the existence of the other. Where the utility is proved to exist in any degree, a sufficiency of invention to support the patent must be presumed." We do not say the single fact that a device has gone into general use, and has displaced other devices which had previously been employed for analogous uses, establishes in all cases that the later device involves a patentable invention. It may, however, always be considered; and, when the other facts in the case leave the question in doubt, it is sufficient to turn the scale.

§ 5107. *The substitution of one known material for another, the result being greater cheapness merely, is not invention.*

We have, therefore, considered this branch of the case without particular reference to *Hotchkiss v. Greenwood*, 11 How., 248. The patent in that case was for an improvement in making door and other knobs for doors, locks and furniture, and the improvement consisted in making them of clay or porcelain, in the same manner in which knobs of iron, brass, wood or glass had been previously made. Neither the clay knob nor the described method of attaching it to the shank was novel. The improvement, therefore, was nothing more than the substitution of one material for another in constructing an article. The clay or porcelain door-knob had no properties or functions which other door-knobs made of different materials had not. It was cheaper and perhaps more durable; but it could be applied to no new use, and it remedied no defects which existed in other knobs. Hence it was ruled that the alleged improvement was not a patentable invention. The case does decide that employing one known material in place of another is not invention, if the result be only greater cheapness and durability of the product. But this is all. It does not decide that no use of one material in lieu of another in the formation of a manufacture can, in any case, amount to invention, or be the subject of a patent. If such a substitution involves a new mode of construction, or develops new uses and properties of the article formed, it may amount to invention. The substitution may be something more than formal. It may require contrivance, in which case the mode of making it would be patentable; or the result may be the production of an analogous but substantially different manufacture. This was intimated very clearly in the case of *Hicks v. Kelsey*, 18 Wall., 670, where it was said: "The use of one material instead of another in constructing a known machine is, in most cases, so obviously a matter of mere mechanical judgment, and not of invention, that it cannot be called an invention, unless some new and useful result, as increase of efficiency, or a decided saving in the operation, be obtained."

But where there is some such new and useful result, where a machine has acquired new functions and useful properties, it may be patentable as an invention, though the only change made in the machine has been supplanting one of its materials by another. This is true of all combinations, whether they be of materials or processes. In *Crane v. Price*, 1 Webst. Pat. Cases, 393, where the whole invention consisted in the substitution of anthracite for bituminous coal in combination with a hot-air blast for smelting iron ore, a patent for it was sustained. The doctrine asserted was, that if the result of the substitution was a new, a better, or a cheaper article, the introduction of

the substituted material into an old process was patentable as an invention. This case has been doubted, but it has not been overruled; and the doubts have arisen from the uncertainty whether any new result was obtained by the use of anthracite. In *Kneass v. Schuylkill Bank*, the use of steel plates instead of copper for engraving was held patentable. So has been the flame of gas instead of the flame of oil to finish cloth. These cases rest on the fact that a superior product has been the result of the substitution,—a product that has new capabilities and that performs new functions. So in the present case the use, in the manner described, of hard rubber in lieu of the materials previously used for a plate, produced a manufacture long sought but never before obtained,—a set of artificial teeth, light and elastic, easily adapted to the *contour* of the mouth, flexible, yet firm and strong, consisting of one piece, with no crevices between the teeth and the plate, impervious to the fluids of the mouth, unaffected by the chemical action to which artificial teeth and plates are subjected when in place, clean and healthy,—peculiarities which distinguish it from everything that had preceded it. These differences, in our opinion, are too many and too great to be ascribed to mere mechanical skill. They may justly be regarded as the results of inventive effort, and as making the manufacture of which they are attributes a novel thing in kind, and consequently patentable as such.

§ 5108. *A patent is prima facie evidence that the patentee is the inventor, and the burden of proof is upon the infringer.*

A second objection urged by the defendant against the validity of the complainant's patent is alleged want of novelty of the invention; and a strenuous effort has been made to convince us, that, although hard rubber had not been used in the manner described for the production of the manufacture, equivalent materials and processes had been, and that a plate substantially the same as that of Dr. Cummings had been made before his improvement. We are not, however, convinced. The patent itself is *prima facie* evidence that the patentee was the first inventor; at least it casts upon him who denies it the burden of sustaining his denial by proof. We do not find such proof in the case. Though the patent was not granted until June 7, 1864, the invention was completed at least as early as April 12, 1855, when the application for a patent was made. Indeed, as we have noticed, a caveat to protect it was filed on the 14th of May, 1852, which clearly foreshadowed the invention. Yet taking the spring of 1855 as the time when it was completed, we find nothing in the proofs to justify a conclusion that Dr. Cummings was not the first inventor. It would answer no good purpose to review the voluminous evidence supposed to bear upon this branch of the case. We shall refer only to that which is deemed most important, and which has been most pressed upon us in this argument. Of the English patent of Charles Goodyear it is enough to say, that, though the provisional specification was filed March 14, 1855, the completed specification was not until the 11th of September following. It was, therefore, on the last-mentioned date that the invention was patented.

The experiments made by George E. Hawes, it must be admitted, closely resembled the process described in the reissued patent to the complainants. He cast in moulds sets of teeth on a tin base, in a manner very like that in which the vulcanite plate is formed by the Cummings process. But the experiments resulted in nothing practical. Hawes cast sets of teeth for the lower jaw only, the weight of the metal making the plate unfit for the upper. In consequence of the shrinkage of the metal in cooling, a tight joint could not

be obtained between the teeth and the base. The sets were, therefore, liable to become offensive in consequence of deposits of food and the secretions of the mouth in the crevices. The shrinkage also prevented a close fitting of the plate to the roof of the mouth, and the tin base was affected by the chemical action of the secretions. In consequence of these and other objections the manufacture was soon abandoned, and it may properly be considered an abandoned experiment. It not only was not the same manufacture as that of Cummings, but it was not suggestive of it; and Dr. Hawes, who cast the tin plates, testifies that the use of vulcanite for dental purposes is the greatest improvement in his profession that he knew of in twenty-five years. He adds, "that vulcanite may be used by dentists in many ways which could not be accomplished by tin or platinum." In his opinion, therefore, the cast-tin base was not substantially the same thing as the Cummings manufacture. So, also, Dr. Royce, who cast plates of tin for artificial teeth in a manner very similar to that of Dr. Hawes, testifies that the solid tin base was found practically unfit for the purpose, except in rare instances. He made but a few sets, none after 1850, and adopted the vulcanite, agreeing to pay for a license to use it in manufacturing dental plates.

We need go no farther into a consideration of the various devices and publications offered to show that the manufacture patented was known before Cummings invented it. Suffice it to say, that none of them, in our opinion, suggest or exhibit in substance such a manufacture. The defense of want of novelty is, therefore, not sustained.

§ 5109. *What presumptions arise in favor of a reissued patent from the action of the commissioner in reissuing it.*

It is further insisted by the defendant that the reissued patent on which this suit is founded is not a patent for the same invention which was described in the specification of the original patent, and, therefore, that the reissue is unauthorized and void. To sustain this position the defendant must overcome the presumption against him arising from the decision of the commissioner of patents in granting the issue; and this he can do only by showing, from a comparison of the original specification with that of the reissue, that the former does not substantially describe what is described and claimed in the latter. This must plainly appear before we can be justified in pronouncing the reissued patent void. But this, in our judgment, does not appear. The first specification describes a set of artificial teeth having a hard-rubber plate made by a process substantially the same as that indicated in the later patent. The description of the process is not quite so minute; but it is sufficiently full to be understood, and to enable an operator to make the manufacture. Certainly it is not another process; and as its result is the same, it is impossible to hold that the reissued patent is for a different invention from the one protected by the original patent. It is true, the specification of the reissue describes also another process not described in the specification of the first,—namely, a mode of making the moulds,—but that is not claimed as a part of the invention.

§ 5110. *When a renewed application for a patent may be held a continuation of an older and rejected one.*

The remaining defenses to the bill rest mainly on the assumption that the new petition presented to the patent office in 1864 cannot be regarded as a continuation of the application made for a patent on the 12th of April, 1855. But this cannot be conceded. The history of the application, as we have given it, forbids such an assumption. No act of Cummings' amounted to a with-

drawal of his first petition, or to an acquiescence in its rejection. It is true, he filed a second petition in 1864; but he accompanied it with substantially the specification that remained in the office, and with the same drawings. It was a mode of procuring another consideration of his rejected claim; and the commissioner regarded it as such. The act of March 2, 1861, gave him authority thus to regard it. He replied to the application, that his claim was embraced in an application filed by him in 1855, and rejected for want of novelty, admitted that it had been improperly rejected, and suggested an amendment to make it correspond with his former amended claim. It is impossible, in view of these facts, to regard the effort to obtain a new patent in 1864 as a new and independent application, disconnected from the application made in 1855. It was but one stage in a continuous effort. In *Godfrey v. Eames*, 1 Wall., 317, the first application was actually withdrawn, and a new petition was presented at the time of the withdrawal, with a different description of the invention; but as the thing patented under the second might have been engrafted as an amendment of the first, it was ruled that all the proceedings constituted one application. This court said: "If a party choose to withdraw his application for a patent, and pay the forfeit, intending at the time of such withdrawal to file a new petition, and he accordingly does so, the two petitions are to be considered parts of the same transaction, and both as constituting one continuous application." We are not aware that filing a second petition for a patent, after the first has been rejected, has ever been regarded as severing the second application from the first, and depriving the applicant of any advantage he would have enjoyed had the patent been granted without a renewal of the application. The contrary was decided by the circuit court for the southern district of Ohio, in *Bell v. Daniels*, 1 Fish., 372, and in *Blandy v. Griffith*, 3 id., 609; and these decisions are founded in justice and sound reason.

If, then, as we think it must be held, the proceeding to obtain the patent was a continuous one from 1855 until it was granted; if the application of 1855 is not severable from the proceedings of 1864,—there is no foundation whatever for the allegation that the invention was abandoned to the public, and that it was in public use or on sale for more than two years before the inventor's application. The first use of it proved, by any other than Dr. Cummings, was in 1859; and there is no evidence that this was with his consent. And the proof respecting his health and pecuniary condition, together with his constant efforts to obtain the necessary means to prosecute his right, rebuts all presumption that he ever abandoned, actually or constructively, either his invention or his application for a patent. That he never intended an abandonment of his invention is perfectly clear; and it was not his fault that granting the patent was so long delayed.

The conclusion of the whole matter is, that the patent is a valid one; and, therefore, that the decree of the circuit court should be affirmed.

Decree affirmed.

Dissenting opinion by Mr. JUSTICE BRADLEY, JUSTICES MILLER and FIELD concurring.

I dissent from the judgment of the court in this case, on the ground that the patentee, having duly made his application for a patent in 1855, and the same having been three times rejected, must be considered as having abandoned the same, inasmuch as no further effort was made to obtain a patent until eight years afterwards, without any pretense that the patentee was en-

gaged in perfecting his invention, and in the meantime the invention which he claims as his had come into general public use. The application for a patent made in 1864 was a new and independent application, and should be treated as such. As the public had enjoyed the use of the invention for more than two years prior to this application, the patent should be declared invalid. Great injustice will, in my judgment, be done to the public to allow a patent obtained under such circumstances to stand. The public had a right to suppose that no further application would be made. The levy of a tribute now on all the dentists of the country who have brought the plate into public notice and use seems to me a species of injustice. The delay of the patentee, in fact, is made to operate to his benefit instead of his prejudice, his patent being made to run eight years longer than it would have done had it been granted when first applied for; so that the public is still further injured by sustaining the patent as finally granted. It is too common a case that associated companies, in order to maintain some valuable monopoly, look about to see what abandoned invention or rejected application, or ineffective patent, can be picked up, revamped, and carried through the patent office, and by the aid of ingenious experts and skilful counsel succeed in getting the desired protection. I think that the courts ought to be strict in maintaining the rights of the public in such cases. And the present case seems to me to be one in which we ought to hold the patent invalid as against those rights.

MERRILL *v.* YEOMANS.

(4 Otto, 568-574; 11 Official Gazette, 970. 1876.)

APPEAL from U. S. Circuit Court, District of Massachusetts.

Opinion by MR. JUSTICE MILLER.

STATEMENT OF FACTS.—The appellant in this case, who was complainant in the circuit court, obtained a patent, in May, 1869, for a new and useful invention, which relates to the heavy hydrocarbon oils, and he sued the appellees, who were defendants in that court, for an infringement of his patent.

§ 5111. *A patent for a process is not infringed by the sale of an article similar to that produced.*

The defendants were dealers in oils and not manufacturers of them. If the appellant's patent was for a new oil, the product of a mode of treating the oils of that character which he describes in his application, the defendants may be liable, for they bought and sold, without license or other authority from him, an oil which is proved to be almost, if not quite, identical with the one which he produced. If, however, appellant's patent is only for the mode of treating these oils invented and described by him—in other words, for his new process of making this new article of hydrocarbon oil—then it is clear the defendants have not infringed the patent, because they never used that process, or any other, for they manufactured none of the oils which they bought and sold. The counsel for appellant here maintain that his patent is for the new article, and is not for the process, though he describes it fully, by which that article is produced. The appellees insist with equal earnestness that the patent is exclusively for the process by which the new oil is made.

§ 5112. *Patent No. 90,284, of Merrill, May 18, 1869, hydrocarbon oils, construed to have claimed a process and not a product.*

The issue thus presented must be decided solely upon a correct construction of the plaintiff's patent, and the accompanying specifications, in which, as

required by the act of congress, he makes the statement of his invention. No such question could have arisen if appellant had used language which clearly and distinctly points out what it is that he *claims* in his invention.

§ 5113. *The claims in a patent are to be considered as distinct from the description contained in the specification, and as representing what part of the matter described the patentee claims as his invention, and for which he asks protection.*

We use the word claim as distinct from description. It must be conceded that the appellant's specification describes with minuteness and precision both the instrumentality and the process by which he makes the oil in question. And in regard to a part of the apparatus which he uses he makes a distinct claim for its invention, and that is not in dispute here. He also describes with fullness and accuracy the process of distillation by which he produces this oil. He gives the temperature to be used, the mode of heating, the degree of rapidity or delay to be used in distilling, the introduction, and the advantage of that introduction, of superheated steam into contact with the oils to be distilled during the process. He also describes, though in short terms, the article produced, the main feature of which he declares to be its freedom from the offensive odor which, before his invention, seemed to be an inseparable quality of those oils; and he mentions some of the more important uses to which this deodorized oil is applicable in the arts.

It is fairly to be inferred from this statement that if all which is described as new in these specifications is really so, the inventor has a right to a patent for three inventions: 1. For a modification or improvement in the distilling apparatus. 2. For a new process or mode of distilling heavy hydrocarbon oils, by which they are deprived of their offensive odors. 3. For the product of this new process of distillation, namely, the deodorized heavy hydrocarbon oils fitted for use in the arts.

When a man supposes he has made an invention or discovery useful in the arts, and therefore the proper subject of a patent, it is nine times out of ten an improvement on some existing article, process or machine, and is only useful in connection with it. It is necessary, therefore, for him in his application to the patent office to describe that upon which he engrafts his invention, as well as the invention itself, and in cases where the invention is a new combination of old devices he is bound to describe with particularity all these old devices, and then the new mode of combining them, for which he desires a patent. It thus occurs that in every application for a patent the descriptive part is necessarily largely occupied with what is not new, in order to an understanding of what is new. The act of congress, therefore, very wisely requires of the applicant a distinct and specific statement of what he claims to be new, and to be his invention. In practice this allegation of the distinct matters for which he claims a patent comes at the close of the schedule or specification, and is often accompanied by a disclaimer of any title to certain matters before described, in order to prevent conflicts with pre-existing patents. This distinct and formal claim is, therefore, of primary importance in the effort to ascertain precisely what it is that is patented to the appellant in this case.

In this part of his application he makes two separate claims, the second of which relates to a modification of the distilling apparatus, and is not in dispute here. Turning our attention to the first claim, we are compelled to say that the language is far from possessing that precision and clearness of statement with which one who proposes to secure a monopoly at the expense of the

public ought to describe the thing which no one but himself can use or enjoy without paying him for the privilege of doing so. It is as follows: "I claim the above described new manufacture of the deodorized heavy hydrocarbon oils suitable for lubricating and other purposes, free from the characteristic odors of hydrocarbon oils, and having a slight smell like fatty oil, from hydrocarbon oils, by treating them substantially as is hereinbefore described."

The word manufacture in this sentence is one which is used with equal propriety to express the process of making an article, or the article so made. "The manufacture of hydrocarbon oils" means primarily the making of hydrocarbon oils. It may mean the thing made also. Are there other words in the sentence calculated to throw light on the meaning of this one? "I claim the above described new manufacture of hydrocarbon oils, . . . by treating them substantially as hereinbefore described." It seems to us that the most natural meaning of these words is that "I claim this new mode of manufacturing hydrocarbon oils, by treating them as hereinbefore described."

This is the meaning which would first suggest itself to the mind. If the product is meant, the words "by treating them substantially as hereinbefore described" are useless. They are not only useless, but embarrassing, for by the well settled rules of construing all instruments, some importance must be attached to them; and if they are to be regarded at all, they must either refer to the process of making the oils for which the applicant is claiming a patent, or they are intended to limit his claim for a patent for the product to that product only, when produced by treating the oils in the manner before described. The counsel for appellant disclaim this latter construction, and allege that the patent covers the oil described, by whatever mode it may be produced. It is necessary to insist on this view, because it is made to appear in the case that the oils sold by defendants were produced by a process very different from that described by appellant.

We can see no reason why the applicant for the patent, if he had in his mind a claim for the article produced, should have intended so to limit his claim. If the *article* was the discovery which he sought the exclusive right to make, use and sell, he was entitled to that monopoly, however produced. If, however, he had in his own mind only a claim for the process of manufacture by which the article was made, then his reference to the mode of treating the oils from which it came was evidently proper and intelligible.

But the language in the specifications aids us in construing the claim. In the sentence next preceding this claim he says: "It will also be evident to those skilled in the art, that *my invention* will be used, if the above mentioned process be worked, to produce the deodorized heavy oils above described from distilled hydrocarbon oils," etc.

It is very clear that what he here calls his *invention* is a thing which produces the deodorized oils, and not the oil itself. So, again, he says: "From the above it will be obvious that my invention consists *in producing* heavy hydrocarbon oils, suitable for lubricating and other purposes, and free from the characteristic odor, *by distilling from them the volatile matter from which objectionable odors arise.*" Again, he says: "In carrying on my new manufacture of deodorizing heavy oils with this apparatus, I place the oil to be deodorized in the still, and heat it by the fire beneath to the required temperature to commence the operation, the steam being shut off from the coil, and the outlet-cock being opened to admit of the expulsion of any water from within the coil."

Here the word "manufacture" is used in the sense of the word "process," a word which could be substituted for it, without a shade of change in the meaning. As it can here mean nothing else but process, we have a definition of the meaning to be attached to it in other parts of the same paper, if that meaning were otherwise doubtful. But apart from these verbal criticisms, all of which are just, and tend strongly to show what was the invention claimed by appellant, it is impossible to read the four printed pages of specifications in which appellant minutely describes his invention, without observing that they are almost wholly directed to the apparatus, the mode of using it, and the peculiar process of distillation, by which the more volatile parts of the heavy oils, which contain the offensive odors, are separated from the main body of the oil, pass over in that process, and leave the remainder free from this great drawback in its use in the arts. Why should this be so, if the applicant for the patent was only looking to the products as his invention, the deodorized heavy hydrocarbon oils? If the oil alone was to be patented, by whatever process made, this elaborate description of one particular process was unnecessary.

A strong appeal is made by counsel to give the appellant the benefit of a liberal construction in support of the patent. Cases are cited in which this court has held, that rather than defeat a patent where it appears that a valuable invention has really been made, this court, giving full effect to all that is found in the application on which the patent office acted, will uphold that which was really invented, and which comes within any fair interpretation of the patentee's assertion of claim.

§ 5114. *The remedy for failure to claim the product of the process claimed is by reissue.*

We are not disposed to depart from this rule in the present case. There is no question here, but that the patent is good for the second claim, for the superheating coil, with its steam-pipe, etc. And we are all of opinion that it is good for the process of distillation described in the specifications, by which the heavy hydrocarbon oils are deodorized. It is, therefore, a valid patent for two important matters well set forth and described. If the patentee is also entitled to a patent for the product of this distillation, and has failed, as we think he has, to obtain it, the law affords him a remedy by a surrender and reissue. When this is done the world will have fair notice of what he claims — of what his patent covers, and must govern themselves accordingly.

§ 5115. *The interests of the public demand that the claims in a patent should clearly and distinctly define and limit the actual invention claimed by and secured to the patentee.*

The growth of the patent system in the last quarter of a century in this country has reached a stage in its progress where the variety and magnitude of the interests involved require accuracy, precision and care in the preparation of all the papers on which the patent is founded. It is no longer a scarcely-recognized principle struggling for a foot-hold, but it is an organized system with well-settled rules, supporting itself at once by its utility, and by the wealth which it creates and commands. The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, leave no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to belong to it without being clearly told what it is that limits these rights. The genius of the inventor constantly making improvements in existing patents, a process

which gives to the patent system its greatest value, should not be restrained by vague and indefinite descriptions of claims in existing patents from the salutary and necessary right of improving on that which has already been invented. It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand and correctly describe just what he has invented, and for what he claims a patent.

In consistency with these views, we are of opinion that the appellant in this case has described and claimed a patent for the process of deodorizing the heavy hydrocarbon oils, and that he has not claimed as his invention the product of that process. The judgment of the circuit court is affirmed.

Dissenting opinion by MR. JUSTICE CLIFFORD.

I dissent from the opinion and judgment in this case upon the ground that the invention, when the claim is properly construed, is an invention of the described new manufacture, and not merely for the process as decided by a majority of the court.

Process and product — Interrelation of, §§ 5116-5118.

§ 5116. If an inventor, after obtaining his first patent for the machine, waits for more than two years before applying for the process and product patents, there may intervene such disclosure and public use that the patent office will be compelled, under the provisions of the supplement of 1839, to reject the subsequent applications; but where no such time has elapsed, it is competent for the patentee, within the two years, to take out his process and product patents, and thus to guard himself against the danger and loss that might arise from others using the process to accomplish other results or securing the product by the agency of other means or instrumentalities. *McKay v. Dibert*, 5 Fed. Rep., 587.

§ 5117. While the product patent continues in existence the manufacture of the product by any instrumentality is prohibited; and it is no answer to the charge of infringement to say that the machine patent has expired and that the particular mechanism employed is public property. *Ibid.*

§ 5118. If the machine in its ordinary and natural operation can only be used to manufacture the patented product, the public must abstain from its use until the time comes when it may be used without infringing the rights of others. *Ibid.*

See *Claim, Right to Broad*, § 683. *Construction of Patents*, § 1229. *Estoppel*, § 2233. *Invention*, §§ 3574, 3575, 3627-3629. *Invention, Joinder of*, §§ 3684-3690. *Process*, §§ 5047, 5083. *Reissues*, §§ 5559-5562, 5622, 5666-5668.

Process and product — Product — Patentability, §§ 5119-5125. Novelty, § 5126. Infringement, §§ 5127, 5128. See Article of Manufacture, §§ 398-418. Composition of Matter, §§ 1117-1145. Sale, §§ 5918-5925.

§ 5119. Although an inventor has obtained a patent for a process, he may have another for the product. *Jones v. Sewall*, 3 Cliff., 563.

§ 5120. A patent may be good for a product, although no patent has been obtained for the machine or process by which it is produced. *Waterbury Brass Co. v. Miller*, 9 Blatch., 77.

§ 5121. A product made by a machine which has before been made by hand is not patentable. *Wooster v. Calhoun*, 11 Blatch., 215.

§ 5122. *Quære*: Whether the artificial production of a composition identical with one found in nature would not entitle the inventor to a patent for the product. *Badische Anilin & Soda Fabrik v. Cochrane*, 16 Blatch., 165.

§ 5123. The improved quality of an old product, an effect of the machine making it, is not sufficient to support a patent for the product. *McCloskey v. Du Bois*, 9 Fed. Rep., 38.

§ 5124. While a new process for producing the old article (alizarine) was patentable, the product itself could not be patented, even though it was a product made artificially for the first time, in contradistinction to being eliminated from the madder-root. Calling it "artificial alizarine" did not make it a new composition of matter, and patentable as such, by reason of its having been prepared artificially for the first time from anthracene, if it was set forth as alizarine — a well known substance. *Cochrane v. Badische Anilin & Soda Fabrik*, 111 U. S., 293.

§ 5125. Where an article is produced by a machine, and, remaining temporarily in the machine, co-operates therewith to produce certain mechanical effects upon the articles subsequently produced, it cannot be claimed in combination with the machine. Notwithstanding its remaining in the machine and co-operating therewith, it is still merely the product, and the machine must be claimed independently of it. *Dederick v. Cassell*, 9 Fed. Rep., 306.

§ 5126. Where the invention sought to be patented is a product, it is anticipated by a similar product, independent of the process by which it is made. *McCloskey's Appeal*, 3 MacArth., 14.

See *Publication*, § 5143.

§ 5127. When the product is independent of the process, the patent is infringed by the unlicensed manufacture of the new product by any mode of manufacture, the process of manufacture being wholly unimportant. *Merrill v. Yeomans*, 1 Holmes, 331.

§ 5128. If it be capable of being produced by various different processes, yet when the product is new, independent of the process, the patent is infringed by the unlicensed manufacture of the new product by any mode of manufacture, the process of manufacture being wholly unimportant. *Badische Anilin & Soda Fabrik v. Hamilton Manufacturing Co.*, 13 O. G., 273.

See *Claims, Construction of*, §§ 714, 782. *Construction of Patents*, § 1226. *Identity*, § 2704. *Process*, § 5082. *Reissues*, §§ 5559-5568.

282. PRODUCT, SALE OF PATENTED.

See SALE OF PATENTED PRODUCT.

283. PRODUCT OF PATENTED PROCESS OR MACHINE, SALE OF.

See SALE, OF PRODUCT OF PATENTED PROCESS OR MACHINE.

284. PRODUCT AND PROCESS PATENTS, INTERRELATION OF.

See PROCESS AND PRODUCT, INTERRELATION OF.

285. PROFERT.

§ 5129. The weight of authority is in favor of the proposition that where profert is made of a paper in the complaint, it is for all purposes presented to the court as a part of the pleading, and objection may be taken by demurrer. *Bogart v. Hinds*, 33 O. G., 1268.

§ 5130. The profert of letters patent makes them, when produced, a part of the declaration, and gives all the certainty as to the invention patented required by law. *Pitts v. Whitman*, 2 Story, 609.

286. PROFITS.

See DAMAGES AND PROFITS. DAMAGES, MEASURE OF, PROFITS.

287. PROFITS AND DAMAGES, RECOVERY OF FULL.

See RECOVERY, OF FULL DAMAGES AND PROFITS.

288. PROVISIONAL INJUNCTION.

See INJUNCTION. PROVISIONAL.

289. PUBLIC USE, EXPERIMENTAL.

See USE, EXPERIMENTAL PUBLIC.

290. PUBLICATION.

See APPLICATIONS, REJECTED, §§ 366-372. VOID PATENT, § 6719.

Publication — *Defined*, § 5131. *What is not a publication*, §§ 5132-5137. *Insufficient description does not constitute a prior publication*, §§ 5138-5140.

§ 5131. Publication means put into general circulation or on sale. *Cottier v. Stimson*, 20 Fed. Rep., 906.

§ 5132. An unpublished description of an invention is no bar to a subsequent discoverer's obtaining a patent. *N. W. Fire-Extinguisher Co. v. Phila. Fire-Extinguisher Co.*, 6 O. G., 34.

§ 5133. Where one of the anticipations relied upon consisted of an article made in London, described in a circular issued and published by the maker, *held*, that the circular to the trade is not a printed publication or a public work within the meaning of the patent law. *Parsons v. Colgate*, 15 Fed. Rep., 600.

§ 5134. Business circulars which are sent only to persons engaged, or supposed to be engaged, in the trade, are not such publications as section 4886 of the law contemplates, and in a contest of priority will not afford a basis for a claim of prior invention as against a patentee. *New Process Fermentation Co. v. Koch*, 21 Fed. Rep., 580.

§ 5135. Where a certain book was put in evidence as a printed publication, but there was no other evidence than that furnished by the copy that the work was ever on sale or in circulation, doubted that the evidence was sufficient to prove a publication under the statute. *Cottier v. Stimson*, 20 Fed. Rep., 906.

§ 5136. It seems that a published drawing of an invention is not such a published description of it as will bar a patent to one who originates it afterward. *Reeves v. Keystone Bridge Co.*, 1 O. G., 466.

§ 5137. *Semble*, that a mere drawing, without any description whatever, is not admissible under notice of prior publication. *Judson v. Cope*, 1 Bond, 327.

§ 5138. Prior publication showing nothing more than suggestions and speculations of scientific writers, who had never tested their practicability or demonstrated their truth, *held*, not to anticipate a patented invention. *Jensen v. Keasbey*, 24 Fed. Rep., 144.

§ 5139. Where the alleged prior publication remotely suggested the device, but it was not described in such terms that the public could construct and put it to the use designed by patentee without further invention, it was *held* not to show a want of novelty. *McComb v. Ernest*, 1 Woods, 195.

§ 5140. The suggestion, in a prior publication, of an untried invention, wholly unaccompanied by any explanations to show that it could be constructed and adapted to act like patentee's invention, *held* insufficient to establish a want of novelty. *Howe v. Williams*, 2 Cliff., 245.

See *Invention*, §§ 3555, 3556.

Publication — Prior — *A description of the thing patented is a*, §§ 5141-5144.

§ 5141. Although the inventor of a prior compound may have abandoned his invention as a failure, yet, if he published substantially the formula of the plaintiff, it is fatal to his right. *Allen v. Hunter*, 6 McL., 303.

§ 5142. A patent is invalid if the invention claimed is found to be patented or described in a printed publication prior to the patentee's invention or discovery thereof; and it is enough if the thing patented is described, and not the steps necessarily antecedent to its production. *Cohn v. United States Corset Co.*, 3 Otto, 366.

§ 5143. When the invention claimed is an article, it is not necessary, in order to render the patent void, that the prior publication should also contain a description of the process by which such article was made. *Ibid.*

§ 5144. A prior patent or publication, to anticipate a patent, must appear in the description to embody substantially the same organized mechanism, operating substantially in the same manner, as that described in the patent claimed to have been anticipated. *Gottfried v. Phillip Best Brewing Co.*, 17 O. G., 675.

See *Patents*, § 4754.

Publication — Prior — *What is a sufficient description*, §§ 5145-5155.

§ 5145. A prior publication, to avoid a patent, must contain an intelligible description of an organization substantially like that in the patent. *Washburn v. Gould*, 3 Story, 122.

§ 5146. Sufficient description in a prior publication to defeat a patented invention must have been so full and precise as to enable a mechanic to construct it, and it must also have been in

all material respects like that covered by or described in the patent. *Parker v. Stiles*, 5 McL., 44.

§ 5147. The description in a prior publication should be to some degree in the nature of a specification, so far as to enable a skilled mechanic in the art to construct the machine. It should not be vague references to, or suggestions of, the thing described. *Hays v. Sulzor*, 1 Bond, 279.

§ 5148. A prior publication, in order to invalidate a patent, must be such as to admit of the construction of the patented device without the exercise of further invention. *Carr v. Rice*, 1 Fish., 198.

§ 5149. A prior description, to invalidate a patent, must be such as to show that the article described in the patent can be certainly arrived at by following the prior description. *Atlantic Giant Powder Co. v. Parker*, 16 Blatch., 281.

§ 5150. Printed publications, in order to defeat a patent, must furnish such clear and definite information as to enable a skilled person, beyond any reasonable doubt, by following them, without aid from anything not known when they were made, to construct an apparatus like that patented. *Bignall v. Harvey*, 18 Blatch., 353.

§ 5151. If the description in a prior publication is sufficient to show the structure of plaintiff's device in the particulars covered by his claim, it is not necessary to show otherwise the existence or use of the prior described device. *Cohn v. United States Corset Co.*, 12 Blatch., 225.

§ 5152. It is only when a published description of a process is sufficient to give the public a practical knowledge of the invention that it will avail to defeat a patent for it obtained afterward by a new discoverer. *Roberts v. Dickey*, 4 Brewster, 260.

§ 5153. When the defense relied on is that the patented invention has been described in a printed publication before the patentee's invention thereof, the sufficiency of the publication as an anticipation must be determined by the rule laid down in *Seymour v. Osborne*, 11 Wall., 516, and *Cohen v. U. S. Corset Co.*, 93 U. S., 336. The construction put in those cases upon the words "described in any printed publication in this or any foreign country," appearing in section 7 of the act of 1836 (5 Stats., 117), in reference to the same subject, is equally applicable to the similar expression made use of in section 24 of the act of 1870. The description relied on should be in such clear, full and exact terms as to enable any person skilled in the art or science to which it relates to make, construct and practice the invention. *Downton v. Yaeger Milling Co.*, 108 U. S., 466.

§ 5154. A patent is not invalidated by statements in an earlier publication, unless those statements are full and definite enough to inform those skilled in the art how to put in practice the invention now patented. *Hood v. Boston Car-spring Co.*, 21 Fed. Rep., 67.

§ 5155. Unless the earlier printed and published description does exhibit the later-patented invention in such a full and intelligible manner as to enable persons skilled in the art to which the invention is related to comprehend it without assistance from the patent, or to make it, or repeat the process claimed, it is insufficient to invalidate the patent. *Cohn v. U. S. Corset Co.*, 3 Otto, 366.

Publication — Prior — Date of, §§ 5156-5159.

§ 5156. Under act of 1836, prior publication, to invalidate a patent, must be prior to the "discovery," not date of application. *Adams v. Edwards*, 1 Fish., 1.

§ 5157. Neither defendant nor respondent can be permitted to prove that the invention described in the alleged prior patent or printed publication was made prior to the date of such patent or publication. *Kelleher v. Darling*, 4 Cliff., 424.

§ 5158. If the patent introduced as proof of prior publication, whether foreign or domestic, was duly issued, or the complete description of the invention was published in some printed publication prior to the supposed invention or discovery, the patent or printed publication will be held to be prior if it is of prior date to the patent in suit, unless the latter is accompanied by the application for the same, or other evidence of plaintiff's priority of invention over such publication is produced. *Ibid.*

§ 5159. A printed publication is a bar to a patent for what it described therein only from the time it is shown to have been put in circulation, and the imprint on the title page is not evidence of the date of circulation. *Reeves v. Keystone Bridge Co.*, 1 O. G., 466.

Publication — Prior — Foreign works, § 5160. Foreign patents, §§ 5161-5170. See Use, Prior Foreign Knowledge and, §§ 6415-6420.

§ 5160. Under the law, act 1870, the publication in an English work is put on the same footing with a patent taken out at the time of publication. *Webb v. Quintard*, 9 Blatch., 352.

See *Reissues*, § 5319.

§ 5161. Inventions patented in the United States cannot be superseded by the mere introduction of a foreign patent or publication, though of prior date, unless the description or drawing contain and exhibit a substantial representation of the patented matter in such full, clear and exact terms as to enable any person skilled in the art or science to which it appertains, without the necessity of resorting to experiments, to make, construct and practice the invention, as he would be enabled to do from a prior patent for the same invention. *Cahill v. Brown*, 15 O. G., 697.

§ 5162. A description in a prior foreign publication which was co-extensive with that in the patent, *held*, such a sufficient description as would conform to the requirements of the statute. *Woven Wire Mattress Co. v. Whittlesey*, 8 Biss., 23.

§ 5163. A patent for an invention originated in this country after it had been described by an English publication is void. *Webb v. Quintard*, 9 Blatch., 352.

§ 5164. To give an inventor precedence over an English publication describing his invention he must have previously made it, and then exercised reasonable diligence in adapting and perfecting it. *Ibid.*

§ 5165. An English provisional specification is a bar to a patent only as a printed specification describing the invention. The patent constitutes no objection. *Cohn v. U. S. Corset Co.*, 12 Blatch., 225.

§ 5166. In order to be an effectual bar the description must be so full as to leave no doubt as to the identity of the device. *Ibid.*

§ 5167. It is incumbent on the defendant in such a case to make out the sufficiency of the description. *Ibid.*

§ 5168. An English provisional specification is not a bar to the grant of a patent in this country, and when relied on as a printed publication under section 4920, Revised Statutes, it seems that the defendant must show that it was actually published before the date of the patentee's invention. *Coburn v. Schroeder*, 11 Fed. Rep., 425.

§ 5169. The knowledge derived from a prior publication must, in order to defeat a patent, be sufficient to enable those skilled in the art to practice the invention, failing which requisite, English provisional specification No. 496, of 1863, was declared to be inadequate to invalidate the patent in suit. *Goff v. Stafford*, 14 O. G., 748.

§ 5170. Where an invention has been patented in a foreign country, or described in a public work, the alleged inventor here is presumed to have been acquainted with that invention as it was known in the foreign country. *Swift v. Whisen*, 2 Bond, 115.

See *Use*, § 6378.

Publication — Prior — Defense, §§ 5171, 5172.

§ 5171. When properly pleaded and proven, the statutory defense "that the invention had been patented or described in some printed publication prior to the supposed invention or discovery" by the patentee to the suit, is sustained, if the conflicting patent, whether foreign or domestic, was duly issued or the complete description was published prior to the date of the patent in contest. *Kelleher v. Darling*, 4 Cliff., 424.

§ 5172. It is not necessary to allege or prove, in order to sustain the defense of prior patent or printed publication, that such patent or publication was issued or given two years earlier than the patentee's invention. *Parks v. Booth*, 12 Otto, 96.

Publication — Prior — Statutory notice, §§ 5173, 5174.

§ 5173. Notice of prior publication contained in a special plea, previously stricken out by the court, is not such as will entitle the work to be given in evidence. *Foote v. Silsby*, 1 Blatch., 445.

§ 5174. Failure of notice of prior publication (act 1836, section 15) to specify page or heading in the public work in which the invention had been previously described, *held* sufficient ground for rejection of it as evidence of prior knowledge. *Ibid.*

See *State of the Art*, § 6100.

Publication — Prior — Statute, § 5175. How proved, § 5176. Evidence, § 5177.

§ 5175. Act 1836, section 7, prior publication, construed. *Webb v. Quintard*, 9 Blatch., 352.

§ 5176. A prior publication may be proved, as to its contents and the fact of publication, by the production of the book, or by parol testimony. *Allen v. Hunter*, 6 McL., 303.

§ 5177. Where a prior publication described a partially successful working of a machine, and a witness testifies to a successful working at a subsequent date, the work is no evidence from which a successful operation of the machine in the intermediate time may be inferred. *Seymour v. McCormick*, 19 How., 96.

See *Abandonment*, § 82. *Plea in Equity*, § 4790.

291. PUNITIVE DAMAGES.

See DAMAGES, PUNITIVE.

292. PURCHASER.

Purchaser — Of invention — *Prior to application*, §§ 5178, 5179.

§ 5178. Act 1839, section 7, “purchaser of invention prior to application,” construed. *Pier-son v. Eagle Screw Co.*, 3 Story, 402.

§ 5179. Act 1839, section 7, which allows any one to use or vend a machine which he has purchased or constructed before the inventor applied for his patent, construed to mean a purchase of the inventor or his grantee, or a construction by their consent, or by his own ingenuity. *Hovey v. Stevens*, 1 W. & M., 290.

Purchaser — Of rights under a patent, §§ 5180-5185.

§ 5180. The purchaser of all the right, title and interest which the vendor has in a patent takes nothing by his purchase if the vendor had previously parted with it. *Ashcroft v. Walworth*, 1 Holmes, 152.

§ 5181. The purchaser of an interest in a patent who has notice that it has been assigned to another is not a *bona fide* purchaser, and acquires no title, although the previous assignment has not been recorded in the patent office. *Ibid.*

§ 5182. Where defendants were innocent purchasers, without notice of plaintiff's claim, of the alleged infringing patent, the validity of which had not been determined in prior suits where plaintiff's patent was sustained, the court refused to order a peremptory injunction, but directed bonds to be given to abide a final decision. *U. S. Annunciator Co. v. Sanderson*, 3 Blatch., 184.

§ 5183. The voluntary purchaser of a licensee's right should inform himself as to the extent of his right, and he cannot set up his failure to do so as a defense for invading the rights of another. *Chambers v. Smith*, 5 Fish., 12.

§ 5184. The purchaser of a patent stands in full privity to a decree obtained by the former owner in a suit for infringement. *Dayton v. Wright & Herring*, 11 O. G., 197.

§ 5185. The interest of a purchaser of right to make, use and vend for use in a particular place a patented device, expires with the limitation of the patent, unless otherwise stipulated for in the contract. *Aiken v. Manchester Print Works*, 2 Cliff., 435.

Purchaser — Of patented article.

SUMMARY (*ADAMS v. BURKE*, §§ 5186, 5187) — *Sale by vendor in restricted territory*, §§ 5186, 5187.

ADAMS v. BURKE.

(17 Wallace, 453-460. 1873.)

APPEAL from U. S. Circuit Court, District of Massachusetts.

STATEMENT OF FACTS.—Burke bought patented articles from persons authorized to sell them within certain limits. He used or sold them outside those limits. The party holding the general patent sued him for infringement, and his bill having been dismissed he appealed.

Opinion by MR. JUSTICE MILLER.

The question presented by the plea in this case is a very interesting one in patent law, and the precise point in it has never been decided by this court, though cases involving some of the considerations which apply to it have been decided, and others of analogous character are frequently recurring. The vast pecuniary results involved in such cases, as well as the public interest, admonish us to proceed with care, and to decide in each case no more than what is directly in issue.

We have repeatedly held that where a person had purchased a patented

machine of the patentee or his assignee, this purchase carried with it the right to the use of that machine so long as it was capable of use, and that the expiration and renewal of the patent, whether in favor of the original patentee or of his assignee, did not affect this right. The true ground on which these decisions rest is that the sale by a person who has the full right to make, sell and use such a machine carries with it the right to the use of that machine to the full extent to which it can be used in point of time.

§ 5186. *Where a patented article whose sole value is in its use is lawfully sold within a district to which its vendor is limited, it may be used anywhere.*

The right to manufacture, the right to sell and the right to use are each substantive rights, and may be granted or conferred separately by the patentee. But, in the essential nature of things, when the patentee, or the person having his rights, sells a machine or instrument whose sole value is in its use, he receives the consideration for its use and he parts with the right to restrict that use. The article, in the language of the court, passes without the limit of the monopoly. *Bloomer v. McQuewan*, 14 How., 549; *Mitchell v. Hawley*, 16 Wall., 544. That is to say, the patentee or his assignee having in the act of sale received all the royalty or consideration which he claims for the use of his invention in that particular machine or instrument, it is open to the use of the purchaser without further restriction on account of the monopoly of the patentees. If this principle be sound as to a machine or instrument whose use may be continued for a number of years, and may extend beyond the existence of the patent, as limited at the time of the sale, and into the period of a renewal or extension, it must be much more applicable to an instrument or product of patented manufacture which perishes in the first use of it, or which, by that first use, becomes incapable of further use, and of no further value. Such is the case with the coffin-lids of appellant's patent.

It seems to us that, although the right of Lockhart & Seelye to manufacture, to sell and to use these coffin-lids was limited to the circle of ten miles around Boston, that a purchaser from them of a single coffin acquired the right to use that coffin for the purpose for which all coffins are used. That so far as the use of it was concerned, the patentee had received his consideration, and it was no longer within the monopoly of the patent. It would be to engraft a limitation upon the right of use not contemplated by the statute, nor within the reason of the contract, to say that it could only be used within the ten miles circle. Whatever, therefore, may be the rule when patentees subdivide territorially their patents, as to the exclusive right *to make* or *to sell* within a limited territory, we hold that in the class of machines or implements we have described, when they are once lawfully made and sold, there is no restriction on their *use* to be implied for the benefit of the patentee or his assignees or licensees.

A careful examination of the plea satisfies us that the defendant who, as an undertaker, purchased each of these coffins and used it in burying the body which he was employed to bury, acquired the right to this use of it freed from any claim of the patentee, though purchased within the ten-mile circle and used without it. The decree of the circuit court dismissing the plaintiff's bill is, therefore, affirmed.

Dissenting opinion by MR. JUSTICE BRADLEY, JUSTICES SWAYNE and STRONG concurring.

The question raised in this case is whether an assignment of a patented in-

vention for a limited district, such as a city, a county, or a state, confers upon the assignee the right to sell the patented article to be used outside of such limited district. The defendant justifies under such a claim. He uses a patented article outside of the territory within which the patent was assigned to the persons from whom he purchased it. The plaintiff, who claims under the original patentee, complains that this is a transgression of the limits of the assignment.

§ 5187. *Where an assignment has been of a right to make and sell a patented article within a limited district, a purchaser from the assignee cannot use the article outside of that district.*

If it were a question of legislative policy, whether a patentee should be allowed to divide up his monopoly into territorial parcels, it might admit of grave doubt whether a vendee of the patented article, purchasing it rightfully, ought to be restrained or limited as to the place of its use. But the patent act gives to the patentee a monopoly of use, as well as of manufacture, throughout the whole United States; and the eleventh section of the act (of 1836) expressly authorizes not only an assignment of the whole patent, or any undivided part thereof, but a "grant and conveyance of the exclusive right under any patent, to make and use, and to grant to others to make and use, the thing patented within and throughout any specified part or portion of the United States." *Washburn v. Gould*, 3 Story, 131; *Blanchard v. Eldridge*, 1 Wall. Jr., 339.

If an assignment under this clause does not confer the same rights within the limited district which the patentee himself previously had in the whole United States, and no more, it is difficult to know what meaning to attach to language however plain.

On the 26th day of May, 1863, letters patent were granted to Merrill & Horner for a certain improvement in coffin-lids, giving to them the exclusive right of making, using, and vending to others to be used, the said improvement. On the 13th day of March, 1865, Merrill & Horner, the patentees, by an assignment duly executed and recorded, did assign to Lockhart & Seelye, of Cambridge, in Middlesex county, Massachusetts, all the right, title and interest which the said patentees had in the invention described in the said letters patent, for, to, and in a circle whose radius is ten miles, having the city of Boston as a center. By necessary consequence (as it seems to me), the right thus assigned consisted of the exclusive right to make, use and vend the improved coffin-lid within the limited territory described; but did not include any right to make, use or vend the same outside of those limits. As the assigned right to make the lids was a restricted right, limited to the territory, so the assigned right to use them was a restricted right limited in the same manner. Each right is conveyed by precisely the same language. A different construction would defeat the intent of the parties. For if the assignees, after making any number of lids within the limited district, could use them or authorize others to use them outside of the district, the balance of the monopoly remaining in the hands of the patentees might be rendered of little value.

If it be contended that the right of vending the lids to others enables them to confer upon their vendees the right to use lids thus sold outside of the limited district, the question at once arises, how can they confer upon their vendees a right which they cannot exercise themselves? The only consistent construction to be given to such an assignment is, to limit all the privileges conferred by it to the district marked out. It is an assignment of the manu-

facture and use of the patented article within that district, and within that district only.

Difficulties may, undoubtedly, be suggested in special cases. If the patented thing be an article of wearing apparel, sold by the assignee within his district, it is confidently asked, cannot the purchaser wear the article outside of the district? The answer to acute suggestions of this sort would probably be found (in the absence of all bad faith in the parties) in the maxim *de minimis non curat lex*.

On the other hand, the difficulties and the injustice which would follow from a contrary construction to that which I contend for are very obvious. Take the electric telegraph for example. Suppose Professor Morse had assigned his patent within and for the New England States. Would such an assignment authorize the vendees of his assignees to use the apparatus in the whole United States? Take the planing machine; would an assignment from Woodworth of his patent within and for the state of Vermont authorize the assignees to manufacture machines *ad libitum*, and sell them to parties to be used in other states? So of Hoe's printing press, and a thousand other machines and inventions of like sort.

Such a doctrine would most seriously affect not only the assignor (as to his residuary right in his patent), but the assignee also. For if it be correct, there would be nothing to prevent the patentee himself, after assigning his patent within a valuable city or other locality, from selling the patent machine or article to be used within the assigned district. By this means the assignment could be, and in numberless instances would be, rendered worthless. Millions of dollars have been invested by manufacturers and mechanics in these limited assignments of patents in our manufacturing districts and towns, giving them, as they have supposed, the monopoly of the patented machine or article within the district purchased. The decision of the court in this case will, in my view, utterly destroy the value of a great portion of this property.

I do not regard the authorities cited as establishing a different doctrine from that now contended for. The remark of Chief Justice Taney, in *Bloomer v. McQuewan*, that "when a machine passes to the hands of a purchaser it is no longer within the limits of the monopoly; it passes outside of it, and is no longer under the protection of the act of congress," is perfectly true in the sense and application in which the chief justice made it. He was speaking of time, not territory; of the right to use a machine after the original patent had expired and a renewal had been granted, not of using it in a place outside of the grant. All the effects mentioned by the chief justice would undoubtedly follow so far forth as it was in the power of the vendor to produce them, but no further. And he would never have contended that those effects would follow any further than the vendor's power to produce them extended. That is the very question in this case. How far did the assignee's interest, and therefore his power, extend? In my judgment it was limited in locality, both as to manufacture and use, and that he could not convey to another what he did not have himself. I hold, therefore, that the decree should be reversed.

Purchaser—Of patented article—Acquires unqualified right, §§ 5188–5193. Limitations as to term, §§ 5194–5198. Limitation as to locality, §§ 5199–5201. See *Repairs*, §§ 5825, 5826. *Sale*, §§ 5912–5944.

§ 5188. Purchaser of a patented device for use in the ordinary pursuits of life takes it outside of the monopoly of the patent act; and his redress in case of injury is under state law. *Aiken v. Manchester Print Works*, 2 Cliff., 435.

§ 5189. A patented article purchased from one who has unqualified authority to sell it becomes like other property, and the purchaser may use it as he pleases without any liability under the patent. *McKay v. Wooster*, 2 Saw., 373.

§ 5190. The purchase of a patented article from the patentee confers upon the buyer the right to use the article to the same extent as though it were not the subject of a patent, but the sale does not import the permission of the vendor that it may be used in a way that will violate his exclusive property in another invention. *Roosevelt v. Western Electric Co.*, 20 Fed. Rep., 724.

§ 5191. When the article is of such peculiar characteristics that it cannot be dealt in as a trade commodity, and cannot be used practically at all unless as a part of another patented article of the vendor's, it would be against good conscience to allow an injunction to a vendor under such circumstances; but this is not true of the article in question. *Ibid.*

§ 5192. The purchaser of a patented article does not acquire any right in the monopoly, but he does acquire the right of unrestricted ownership in the article he buys as against the vendor, including as an inseparable incident the right to use and enjoy it and to transfer his title to others. *Holliday v. Matheson*, 24 Fed. Rep., 185.

§ 5193. By the act of 1870 the right of a person constructing or purchasing a patentable article before the application for a patent is limited to the right to use or vend the specific thing, and this, whether it be regarded as a legislative construction of the former acts or not, may properly govern the right of recovery in actions brought since its passage. *Brickill v. City of New York*, 18 Blatch., 273.

See *Sale*, §§ 5926-5932.

§ 5194. A patentee may stipulate, in licensing another to sell the patented article, that his licensee shall not sell it to be used beyond the original term of the patent; and a purchaser from such licensee will be guilty of infringing if he use it during the extended term. *Mitchell v. Hawley*, 16 Wall., 544.

§ 5195. A purchaser from such a licensee is entitled to no notice of the limited extent of his authority; he should inquire into it, and if he neglects to do so he purchases at his own risk. *Ibid.*

§ 5196. Where such a licensee gave the purchaser a license to use the patented article in terms sufficient to put him upon inquiry, it was held that he was entitled to no further notice of the limited authority of the licensee. *Ibid.*

§ 5197. The purchaser of a patented machine from one who is authorized to make such machines, and to use them, and to license others to use them during the term of the original patent, has no right to use it during the extended term. *Hawley v. Mitchell*, 1 Holmes, 42.

§ 5198. If one who purchases a patented article from those who have no authority to sell it obtains an assignment for his territory of the patent for the original term, he is not liable for using the article after the patent is extended. *Eunson v. Dodge*, 18 Wall., 414.

§ 5199. The purchase of a patented article lawfully manufactured and sold without restriction or condition within his territory, by the territorial assignee of a patent-right, conveys to the purchaser the right to use or sell the article in another territory for which another person has taken an assignment of the same patent. *Adams v. Burks*, 1 Holmes, 40.

§ 5200. Where the owner of a patent sells the entire interest in it for a specified territory, and the assignee sells the patented article therein, purchaser is not restricted in his use of it to that territory, neither is he liable to the patentee for using it in the territory reserved. *McKay v. Wooster*, 2 Saw., 373.

§ 5201. Neither is he liable to one to whom the right for the territory reserved is sold by an assignment subsequent to the other. *Ibid.*

See *Purchaser*, § 5185.

Purchaser — Abroad, § 5202.

§ 5202. The owner of a patent in the United States who has sold the patented article in England without restrictions or conditions cannot treat as an infringer one who has purchased the article in England of the vendee, or restrain him from using or selling it in the United States. *Holliday v. Matheson*, 24 Fed. Rep., 185.

Purchaser — Of patented article — In general, §§ 5203, 5204.

§ 5203. The purchaser of articles made under contract by a party with an infringing machine is not liable as infringer unless the contract is colorable only (act 1800). *Keplinger v. De Young*, 10 Wheat., 358.

§ 5204. The purchaser of the product of a patented machine is not an infringer. *Blanchard Gun-Stock Turning Factory v. Jacobs*, 2 Blatch., 69.

See *Decree*, § 1768. *Estoppel*, §§ 2206, 2207. *Jurisdiction*, § 3957.

293. RACE OF DILIGENCE.

See PRIORITY OF INVENTION.

294. REASONS OF APPEAL FROM COMMISSIONER.

See APPEAL, FROM COMMISSIONER, REASONS OF.

295. REBELLION.

See ABANDONMENT, §§ 25, 54. OWNERS, JOINT, §§ 4482, 4483.

296. RECEIVER.

§ 5205. The peril of a fund in litigation is cause for the interference of the court to rescue and protect it by the appointment of a receiver. *Parkhurst v. Kinsman*, 2 Blatch., 78.

§ 5206. An assignment of a patent by a receiver in a proceeding in which the defendant did not appear, and where no step was taken to bring him before the court, is a nullity. *Railroad Co. v. Trimble*, 10 Wall., 367.

§ 5207. Where a receiver of a firm, under direction of a court, had used a patented device, which being a personal license to the firm he had no right to use, *held*, that application should be made to such court to correct such order before proceeding against him in a federal court. What will be done by the federal court in the absence of such an application stated. *Curran v. Craig*, 22 Fed. Rep., 101.

§ 5208. The rule that a receiver cannot convey title to a patent, unless the owner of the legal title joins, does not apply to the transfer of a mere equitable title. *Adams v. Howard*, 22 Fed. Rep., 656.

§ 5209. Where a bill for infringement of a patent had been dismissed, with costs to defendant, for which an execution issued and was returned wholly unsatisfied, a motion by defendant for a receiver of the patents as equitable assets to be disposed of for the satisfying of the decree was denied. *Thayer v. Hart, Jr.*, 24 Fed. Rep., 558.

§ 5210. A receiver of a corporation, by the law of Pennsylvania, is a mere custodian of its property, and has no title in a patent passed to him, by virtue of which he can bring suit in his own name. *Dick v. Stuthers*, 25 Fed. Rep., 103; *Dick v. Oil Well Supply Co.*, 25 Fed. Rep., 105.

See *Assignments*, § 473. *Sale*, § 4916.

297. RECORDING ASSIGNMENTS.

See ASSIGNMENTS, RECORDING.

298. RECORDING LICENSE.

See LICENSE, RECORDING.

299. RECORDS OF PATENT OFFICE, ADMISSIBILITY IN EVIDENCE.

See EVIDENCE, ADMISSIBILITY OF PATENT OFFICE RECORDS.

300. RECOVERY.

See DISCLAIMER, §§ 1991-2065. OWNERS, JOINT, §§ 4476, 4477. SURRENDER OF PATENTS, §§ 6240, 6241.

Recovery — *At law*, § 5211. *In equity*, § 5212.

§ 5211. In the absence of an assignment plaintiff may recover at law, notwithstanding a private agreement (act 1793). *Park v. Little*, 3 Wash. C. C., 196.

§ 5212. Benefits derived by the defendant from the use of the plaintiff's patented invention constitute valid ground for a recovery by the plaintiff. *Sargent v. Yale Lock Manufacturing Co.*, 17 Blatch., 249.

Recovery — Of profits and damages, §§ 5213-5221.

§ 5213. In equity plaintiff may seek and recover the gains and profits derived by defendant by the unlawful infringement, and he is not prejudiced because he says that those gains and profits are the damages which he has suffered. *Perry v. Corning*, 7 Blatch., 195.

§ 5214. In equity under the existing laws (§ 4921, R. S.) a complainant can recover both profits and damages. *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 9 O. G., 497.

§ 5215. Where the plaintiff, when the suit was commenced, owned the patent, and the entire interest in the claim for profits and damages sought to be recovered, he has a right by virtue of such ownership to recover in the suit the profits and damages for infringements committed in the district before he owned the patent. *Consolidated Oil Well Packer Co. v. Eaton*, 12 Fed. Rep., 865.

§ 5216. A claim to recover profits or damages for past infringement cannot be severed from the title by assignment or grant so as to give a right of action for such claim in disregard of the statute. *Gordon v. Anthony*, 16 Blatch., 234.

§ 5217. The act of 1837, section 9, which allows a recovery upon such claims of a patent as are valid, though other claims are not, does not apply to inventions which are not specified in distinct claims. *Rumford Chemical Works v. Lauer*, 10 Blatch., 122.

§ 5218. Although the second claim of the patent is invalid for want of novelty, the plaintiff can recover on the first claim, although no disclaimer had been made to the second claim, provided that prior to the entry of a decree as to the first claim a disclaimer is entered as to the second claim, there not appearing to have been unreasonable neglect or delay; but he will not be entitled to costs. *Christman v. Rumsey*, 17 Blatch., 148.

§ 5219. Where, after action at law brought on two claims of a patent, a bill was filed and an injunction decreed in equity on one of the claims, and no claim was made on the second claim before the master, though the bill was broad enough to include it, and there was a final decree entered for the sum found; and the suit at law was continued on the second claim, *held*, that the cause of action in both suits was identical, and that damages would not lie in the suit at law. *Child v. Boston & Fairhaven Iron Works*, 19 Fed. Rep., 258.

§ 5220. Where recovery has been had from an infringer who manufactured and sold the patented invention for use, there can be no further recovery from his vendee of profits for the use of the device. A recovery could be had for either but not for both. *Steam Stone Cutter Co. v. Sheldons*, 21 Fed. Rep., 875.

§ 5221. There cannot be a recovery by decree for both profits and damages. *Williams v. Leonard*, 9 Blatch., 474.

Recovery — At law — Creates no license for continued use, §§ 5222-5226.

§ 5222. Recovery at law gives no license for continued use. Every subsequent use is an infringement. *Whittemore v. Cutter*, 1 Gall., 478.

§ 5223. A recovery at law for the use of an infringing machine does not operate as a license to continue the use of the machine. *Hayden v. Suffolk Mfg. Co.*, 4 Fish., 86.

§ 5224. Where no patent fee being adopted, the damages recovered for infringement are the profits for the use of the machine prior to recovery. Such recovery does not vest the title to the machine in the defendant. *Spaulding v. Page*, 1 Saw., 702.

§ 5225. When a patentee gets his remuneration in the exclusive use of his machine and the sale of its products, a recovery will not give the infringer any right to the further use of the infringing machines. *Perrigo v. Spaulding*, 13 Blatch., 389.

§ 5226. The damages recovered in a suit for infringement are merely a satisfaction for prior use, and do not free the parties infringing from the operation of a patent. *Matthews v. Spangenberg*, 15 Fed. Rep., 813.

See *Use, Right to*, §§ 6601-6603.

Recovery — Of full damages and profits — When it will vest title, §§ 5227-5237.

§§ 5227-8. Where a patentee does not use the patented machine himself, nor establish a patent fee but manufactures the patented article and sells at fixed prices, and another party infringes by making and selling the patented article, and patentee sues him and recovers the full amount of profits he would himself have obtained, he adopts the sale of the infringer, and the title to the article on which the profits were recovered vests in the purchaser from the infringer. *Spaulding v. Page*, 1 Saw., 702.

§ 5229. When a patentee claims and recovers not only the actual gains and profits of the manufacture and sale of the infringing machine, but all the damages which he has sustained therefrom, it is at least to be presumed that such recovery embraces all the profit which the

patentee would have received had he made and sold the machine with the incidental and consequential right to use it. *Gilbert & Barker Manufacturing Co. v. Bussing*, 12 Blatch., 426.

§ 5230. When a patentee gets his remuneration by patent or license fees, a recovery of the license or patent fee from an infringer, and its payment, authorizes the defendant to use the particular articles for which such recovery has been had. *Perrigo v. Spaulding*, 13 Blatch., 389.

§ 5231. When a patentee gets his remuneration by the sale of his patented machine for use by others, a recovery of profits and damages from the manufacturer of an infringing machine is a full compensation for his injury, and places the patentee in the same position as if he had made and sold the machine himself, and confers on third parties the right to use the machine while it lasts. *Ibid.*

§ 5232. When a full recovery and satisfaction from one party has been had the patentee has obtained all that the law gives him, and the particular article or machine becomes, in effect, licensed by the patentee, and may be used so long as it lasts, free from any further claim by the patentee. *Ibid.*

§ 5233. On recovery of profits in equity, the infringing sales must be adopted by the orator upon the very terms upon which defendant made them, and as much right to the inventions must follow, as if the sales had been made by the orator instead of defendant. *Steam Stone Cutter Co. v. Windsor Mfg. Co.*, 17 Blatch, 24.

§ 5234. The recovery of the profits of the sale for use vests the title to the use in the purchaser of the infringing machines. *Steam Stone Cutter Co. v. Sheldons*, 21 Fed. Rep., 875.

§ 5235. The recovery of profits and damages from the manufacturers of an infringing machine debars the patentee from recovering from a user for the use of the same machine. *Booth v. SeEVERS*, 19 O. G., 1140.

§ 5236. Where a patentee recovers from an infringing manufacturer full damages and profits on account of the infringement, the purchaser from such manufacturer, who is a user of the machine, will be protected in such use from a suit for infringement, as he would be were he a licensee from the patentee, but only on showing clearly that it was the same machine involved in the prior suit. *Allis v. Stowell*, 16 Fed. Rep., 783.

§ 5237. While the patentee may, if he choose, confine himself to a recovery for past infringement, and insist that the further use of the infringing machine be enjoined, yet, if he elect as his measure of damages the full license fee established by himself, the payment thereof operates to vest in the defendant the right to use the machine during the term of the patent, or until that particular machine is worn out. *Stutz v. Armstrong*, 25 Fed. Rep., 147.

See *Damages and Profits*, §§ 1531, 1615. *Decree*, § 1806. *Injunction*, § 3370. *License*, § 4047.

301. REDUCTION TO PRACTICE.

SEE DELAY, DILIGENCE IN REDUCTION TO PRACTICE. PRIORITY OF INVENTION, REDUCTION TO PRACTICE.

SUMMARY (*COFFIN v. OGDEN*, §§ 5238-5240) — *Prior knowledge and use, act 1836*, § 5238; *that of a single person is sufficient*, § 5239; *what constitutes such use*, § 5240.

COFFIN v. OGDEN.

(18 Wallace, 120-125. 1873.)

APPEAL from U. S. Circuit Court, Southern District of New York.

Opinion by MR. JUSTICE SWAYNE.

STATEMENT OF FACTS.—The appellant was the complainant in the court below, and filed this bill to enjoin the defendants from infringing the patent upon which the bill is founded. The patent is for a door lock with a latch reversible, so that the lock can be applied to doors opening either to the right or the left hand. It was granted originally on the 11th of June, 1861 [No. 32,521], to Charles R. Miller, assignee of William S. Kirkham, and reissued to Miller on the 27th of January, 1863. On the 10th of June, 1864, Miller assigned the entire patent to the complainant. No question is raised as to the complainant's title, nor as to the alleged infringement by the defendants. The answer alleges that the thing patented, or a material and substantial part thereof, had been, prior to the supposed invention thereof by Kirkham, known and used by divers persons in the United States, and that among them were

Barthol Erbe, residing at Birmingham, near Pittsburg, and Andrew Patterson, Henry Masta and Bernard Brossi, residing at Pittsburg, and that all these persons had such knowledge at Pittsburg. The appellees insist that Erbe was the prior inventor, and that this priority is fatal to the patent. This proposition, in its aspects of fact and of law, is the only one which we have found it necessary to consider.

Kirkham made his invention in March, 1861. This is clearly shown by the testimony, and there is no controversy between the parties on the subject. It is equally clear that Erbe made his invention not later than January 1, 1861. This was not controverted by the counsel for the appellant, but it was insisted that the facts touching that invention were not such as to make it available to the appellees, as against the later invention of Kirkham and the patent founded upon it. This renders it necessary to examine carefully the testimony upon the subject.

Erbe's deposition was taken at Pittsburg upon interrogatories agreed upon by the parties and sent out from New York. He made the lock marked H. E. (It is the exhibit of the appellees, so marked.) He made the first lock like it in the latter part of the year 1860. He made three such before he made the exhibit lock. The first he gave to Jones, Wallingford & Co. The second he sent to Washington, when he applied for a patent. The third he made for a friend of Jones. He thinks the lock he gave to Jones, Wallingford & Co. was applied to a door, but is not certain.

Brossi. In 1860 he was engaged in lockmaking for the Jones & Nimmick Manufacturing Company. He had known Erbe about seventeen years. In 1860 Erbe was foreman in the lock shop of Jones, Wallingford & Co., at Pittsburg. In that year, and before the 1st of January, 1861, he went to Erbe's house. Erbe there showed him a lock, and how it worked, so that it could be used right or left. He says: "He (Erbe) showed me the follower made in two pieces. One piece you take out when you take the knob away. The other part — the main part of the follower — slides forward in the case of the lock with the latch, so you can take the square part of the latch and turn it around left or right, whichever way a person wants to." He had then been a lockmaker eight years. He examined the lock carefully. He had never seen a reversible lock before. He has examined the exhibit lock. It is the same in construction. The only difference is, that the original lock was made of rough wrought iron. It was a complete lock, and capable of working. Erbe thought it a great thing. Erbe showed him the lock twice afterwards at Jones, Wallingford & Co.'s. He saw such a lock attached to the office door there, and working, but don't know whether it was the first lock made or one made afterwards.

Masta. In 1860 he was a patternmaker for Jones, Wallingford & Co. Had known Erbe fourteen or fifteen years. Erbe showed him his improvement in reversible locks New Year's day, 1861. He examined the lock with the case open. "You had to pull out the spindle, and the hub was fitted so that it would slide between the spindle and the plate and let the latch forward."
"The whole hub was made of three pieces. One part was solid to the spindle or hub shanks, and then the hub that slides between the plate and case, and a washer at the other side of the spindle." "There is not a particle of difference between the exhibit and the original lock. It is all the same." He identifies the time by the facts that he commenced building a house in 1861, and that year is marked on the water conductor under the roof.

Patterson. Until recently he was a manufacturer of locks and other small hardware. In the year 1860 he was the superintendent of the lock factory of Jones, Wallingford & Co. and their successors in Pittsburg. He had known Erbe since 1856. About the 1st of January, 1861, Erbe showed him an improved reversible lock of his invention like the exhibit lock. The improvement "consisted in constructing the hub or follower so that when the spindle was withdrawn the hub would slide forward between the cases so that the head of the latch would protrude beyond the face of the lock, so as to permit its reversal from right to left; the latch-head being connected with the yoke by a swivel joint, so that it might be reversed. . . . It was our uniform practice to put our new locks on the doors about the office to test them, and I believe that one was put on; but at this distance of time I cannot say positively that it was."

There is no proof that Erbe made any locks according to his invention here in question but those mentioned in his testimony. He applied for a patent in 1864 and failed to get it. Why is not disclosed in the record.

The appellants called no witnesses at Pittsburg or elsewhere to contradict or impeach those for the appellees. Brossi was subjected to a rigorous cross-examination, but, in our judgment, it in nowise diminishes the effect of his testimony in chief. The counsel for the appellants asked with emphasis, in the argument here, why the defendants had not called Jones, of the firm of Jones, Wallingford & Co.? The question was well retorted, why was he not called by the other side? He does not appear in a favorable light. He prevented Erbe, who was in his employ, from going to New York to testify in behalf of the defendants, and avowed a determination to prevent, if it were possible, their obtaining the testimony of Brossi, Masta and Patterson. It is difficult not to regard him with a feeling akin to that which attends the presumptions *in odium spoliatoris*. We entertain no doubt that the testimony of all these witnesses is true in every particular, including the statement of Brossi as to putting the lock on the door. If that were false, doubtless Jones would have been called to gainsay it. His hostility to the defendants is a sufficient reason for their not calling him for any purpose.

§ 5238. *What will constitute prior knowledge and use, under the patent act of 1836, such as will defeat a patent.*

The case arose while the patent act of 1836 was in force and must be decided under its provisions. The sixth section of that act requires that to entitle the applicant to a patent his invention or discovery must be one "not known or used by others before his invention or discovery thereof." The fifteenth section allowed a party sued for infringement to prove, among other defenses, that the patentee "was not the original and first inventor of the thing patented, or of a substantial and material part thereof claimed to be new."

The whole act is to be taken together and construed in the light of the context. The meaning of these sections must be sought in the import of their language, and in the object and policy of the legislature in enacting them. *Gayler v. Wilder*, 10 How., 496 (§§ 385-96, *supra*). The invention or discovery relied upon as a defense must have been complete, and capable of producing the result sought to be accomplished; and this must be shown by the defendant. The burden of proof rests upon him, and every reasonable doubt should be resolved against him. If the thing were embryotic or inchoate; if it rested in speculation or experiment; if the process pursued for its develop-

ment had failed to reach the point of consummation, it cannot avail to defeat a patent founded upon a discovery or invention which was completed, while in the other case there was only progress, however near that progress may have approximated to the end in view. The law requires not conjecture, but certainty. If the question relate to a machine, the conception must have been clothed in substantial forms which demonstrate at once its practical efficacy and utility. *Reid v. Cutter*, 1 Story, 590.

§ 5239. *Prior knowledge and use by a single person is sufficient.*

The prior knowledge and use by a single person is sufficient. The number is immaterial. *Bedford v. Hunt*, 1 Mason, 302. Until his work *is done*, the inventor has given nothing to the public. In *Gayler v. Wilder* the views of this court upon the subject were thus expressed: "We do not understand the circuit court to have said that the omission of Conner to try his safe by the proper tests would deprive it of its priority; nor his omission to bring it into public use. He might have omitted both, and also abandoned its use and been ignorant of the extent of its value; yet if it was the same with Fitzgerald's, the latter would not, upon such grounds, be entitled to a patent; provided Conner's safe and its mode of construction were still in the memory of Conner before they were recalled by Fitzgerald's patent." Whether the proposition expressed by the proviso in the last sentence is a sound one, it is not necessary in this case to consider.

§ 5240. *If at least three perfect specimens of an improvement have been completed and exhibited to as many witnesses, and if one of them has been applied in actual use, it is fatal to a patent obtained by a subsequent inventor for the same improvement.*

Here it is abundantly proved that the lock originally made by Erbe "was complete and capable of working." The priority of Erbe's invention is clearly shown. It was known at the time to at least five persons, including Jones, and probably to many others in the shop where Erbe worked; and the lock was put in use, being applied to a door, as proved by Brossi. It was thus tested and shown to be successful. These facts bring the case made by the appellees within the severest legal tests which can be applied to them. The defense relied upon is fully made out.

Decree affirmed.

Reduction to practice — *Defined*, §§ 5241, 5242. *What amounts to*, §§ 5243-5245; *what does not*, §§ 5246, 5247.

§ 5241. Reduction to practice in practical form as distinguished from a model. *Electric R. R. Signal Co. v. Hall R. R. Signal Co.*, 6 Fed. Rep., 603.

§ 5242. The expression "reduced to practice" does not import the bringing the invention into actual use. When applied to an invention, it generally means the reducing it into such form that it may be used so as not to be a mere theory. A small model, demonstrating the practicability of the invention, is a sufficient reduction to practice. Size is of no importance. *Heath v. Hildreth*, 1 MacA. Pat. Cases, 12. •

§ 5243. Where the invention is not of a mere philosophical speculation, abstraction or theory, but of something corporeal, something to be manufactured, the applicant need not show that he has reduced his invention to practice otherwise than by filing his specification and furnishing drawings and a model, as required by the statute, where the nature of the case admits of drawings or of a representation by model. *Screw Co. v. Sloan*, 1 MacA. Pat. Cases, 210.

§ 5244. An inventor has reduced his invention to practice when he has so described it upon paper, with such drawings or models as will enable any person skilled in the art to make and use the same; but he is not obliged to furnish drawings or model until he makes his application. *Perry v. Cornell*, 1 MacA. Pat. Cases, 68.

§ 5245. Where an inventor has complied with the provisions of the law by duly filing an application clearly showing and describing the nature and operation of the invention by speci-

fication and drawings verified by oath, he has reduced the principle of the invention to practice for the purpose of obtaining a patent; and if the invention is patentable, he is entitled to the grant of a patent therefor. *Burrows v. Witherill*, 1 MacA. Pat. Cases, 315.

§ 5246. Experiments tried upon an arrangement of materials corresponding to the structure of a new armor for ships is not such a perfecting of the invention as will sustain a patent for it if it is described in a foreign publication before anything further is done toward reducing it to practice. *Webb v. Quintard*, 9 Blatch., 352.

§ 5247. Neither will a letter written to the British admiralty, asking their aid in making experiments, obviate the effect of a published description of the invention. *Ibid.*

See *Drawings*, §§ 2076-2080. *Invention*, §§ 3544-3557.

Reduction to practice — *Not essential to securing patent*, §§ 5248-5255; *nor to validity of patent*, §§ 5256-5258.

§ 5248. Reducing to practice differs from bringing into use. There is no law requiring the applicant to reduce his invention to actual use before he can obtain a patent. *Perry v. Cornell*, 1 MacA. Pat. Cases, 68.

§ 5249. There is no express requirement in the patent laws that an inventor shall reduce his invention to actual use before he can obtain a patent, nor is there any time limited within which he is to disclose his invention before application for a patent. *Stephens v. Salisbury*, 1 MacA. Pat. Cases, 379.

§ 5250. None of the patent laws has ever required that the invention should be in use or reduced to practice before the issuing of the patent otherwise than by a model, drawings, and specification containing a written description of the invention. *Heath v. Hildreth*, 1 MacA. Pat. Cases, 12.

§ 5251. By the seventh section of the act of 1836 the commissioner is bound to issue a patent upon the compliance on the part of the applicant with the conditions there named, and upon the appearance of certain facts; and the reduction of the invention to practice is not named as one of these conditions. *Ibid.*

§ 5252. There being no law which requires the inventor to put his invention into practice or use before obtaining his patent, it is immaterial to him whether the second inventor has put it in practice or not. That fact cannot affect his rights when involved in interference with a patentee under the eighth section of the act of 1836. Neither that section nor any other section of that or any other act makes the right of the patentee or of the applicant depend upon the fact of the invention being reduced to actual practice, except in the case of the *alien patentee*. *Ibid.*

§ 5253. For the purpose of obtaining a patent it is not necessary to show that the invention has been reduced to practice, if it appear that the invention was devised and explained to others, and was not subsequently abandoned. *Hill v. Dunklee*, 1 MacA. Pat. Cases, 475.

§ 5254. Although an invention has not been reduced to actual practical use, yet if it appear to be capable of being so reduced, it will be sufficient to entitle the party to a patent. *Chandler v. Ladd*, 1 MacA. Pat. Cases, 493.

§ 5255. The conception of the idea of a new invention is not sufficient. It must be reduced to some practical use before it can be patented, or set up and relied upon to defeat a patent. *Many v. Jagger*, 1 Blatch., 372.

§ 5256. It is no objection to the validity of a patent to a citizen that the thing described in the specification has never been reduced to actual practice, either before or since the date, provided that it is capable of useful and successful operation when constructed as described. *Wheeler v. Clipper Mower & Reaper Co.*, 10 Blatch., 181.

§ 5257. If the invention be such that, when the thing invented shall be constructed according to the model and specifications filed, it will operate successfully, as a practical and useful thing, the inventor has satisfied the law, and his patent is valid. He is not bound by law to construct it in order to preserve his patent. *Broadnax v. Central Stock Yard & Transit Co.*, 4 Fed. Rep., 214.

§ 5258. Mere discovery of an improvement does not make it a proper subject of a patent unless it be embodied in a working machine and adapted to practical use. Whoever first perfects a machine and makes it capable of operation is entitled to a patent. *Judson v. Bradford*, 16 O. G., 171.

Reduction to practice — *In general*, §§ 5259, 5260. See *Priority of Invention*, §§ 4986-5006. *Delay*, §§ 1878-1882.

§ 5259. The patentee has the right to take up the improvement at the point where it was left by his predecessor; and if, by the exercise of his own inventive skill, he is successful in first perfecting and reducing to practice the invention which his predecessor undertook to make,

is entitled to the merit of such an improvement as an original inventor. *Union Paper Bag Machine Co. v. Pultz & Walkley Co.*, 15 Blatch., 160.

§ 5260. A putting of an invention into use is generally strong evidence of a reduction of it to practice. If the adaptation to use, or even the use itself, is merely experimental, the invention is not perfected. But use is not necessarily required in order to show perfection or completion, if capable from its structure of successful working. *Coffin v. Ogden*, 7 Blatch., 61.

See *Date of Invention*, §§ 1726-1730. *Invention, Prior*, §§ 3697-3713. *Inventor, Prior*, §§ 3744-3761. *Reissues*, § 5317.

302. REFERENCE TO MASTER, PRACTICE.

See PRACTICE, REFERENCE TO MASTER.

303. REHEARINGS.

Rehearings — Particular cases — Orders, §§ 5261-5264. *Denied*, §§ 5265-5271.

§ 5261. Where it appeared doubtful whether under the averments in the answer a decree adverse to one of plaintiff's patents could be passed on the ground of insufficient description, on which the court had held it void, a rehearing was ordered so far as that patent was concerned, with leave to amend answer. *Schneider v. Thill*, 5 B. & A., 595.

§ 5262. After interlocutory decree and reference to a master for an account, a rule to show cause why the decree should not be opened and a rehearing ordered granted, it being alleged that a court of equity, in view of *Root v. Lake Shore & Michigan Southern R. Co.*, 21 O. G., 1112, had no jurisdiction, and that the defendants had newly discovered evidence to prove that the complainants' patent was invalid. *Spring v. Domestic Sewing Machine Co.*, 22 O. G., 1445.

§ 5263. A rehearing granted to review a decision upon which the decree for an accounting rested, in view of the decisions of the supreme court relating to reissues, and found sufficient to change that made in the former case without prejudice to the proceedings before the master. *American Diamond Rock-Boring Co. v. Sheldons*, 32 O. G., 1240.

§ 5264. Where the claims of the patent sued on, upon which a decree had been directed for plaintiff, had been disallowed during the pendency of another application of the same inventor, the disallowance acquiesced in and all right of appeal waived by him, but were none the less subsequently patented, a rehearing was granted to introduce such evidence, though the petition failed to show that petitioners were entitled to it as a matter of right, because in view of the newness of the patent it was desirable that the cases should be as full as may be in respect to the validity of the claims sued upon. *Railway Register Mfg. Co. v. Broadway & 7th Ave. R. Co.*, 32 O. G., 257.

§ 5265. Jordan and Smith, being joint applicants and patentees, sold their patent to plaintiffs, who, after suit, obtained an interlocutory decree. On petition of defendants to open the case and file an additional answer setting up the newly-discovered fact that Jordan was the sole inventor of the subject-matter covered by the patent, said petition being based upon Jordan's affidavit that he was the sole inventor, coupled with affidavits of other parties who swear that they have heard Jordan speak of himself as the inventor, and never heard Smith make any such pretension, *held*, that if the defendants' affidavits, alone and uncontradicted, were the evidence at a final hearing, they could hardly avail to persuade the court that the invention was wholly Jordan's. *Collins Co. v. Coes*, 8 Fed. Rep., 517.

§ 5266. Defendants' affidavits being met by proof that Jordan and Smith repeatedly spoke of the invention as joint, and by affirmative evidence that Smith made a wrench before Jordan began to experiment, in which the step-plate was sustained by a set-screw, the defendants contend that Smith is the sole inventor. *Held*, that the wrench which Smith made would be an infringement of the patent, but that that fact does not prove that it anticipated the patent, and that as made by Smith it was merely an experiment on the way to the completed invention, and has no effect at all. Leave to open the case refused. *Ibid*.

§ 5267. *Held*, on motion for rehearing and application to amend answer, that in no class of cases should the practice of allowing rehearings be more strictly guarded than in cases where the defense of prior use is relied on to defeat the novelty of a patented invention, since it is seldom that a defendant cannot make it appear that he has discovered additional evidence; and reasonable diligence not having been exercised, the motion was denied. *Hicks v. Ferdinand*, 20 Fed. Rep., 111.

§ 5268. Demurrer to a petition for a rehearing in a patent case sustained, on the ground of laches in the discovery of the matters therein set forth; that the new proofs were immaterial; of want of equitable grounds for sustaining the petition. *Hoe v. Kahler*, 25 Fed. Rep., 271.

§ 5269. Application for rehearing based on alleged newly-discovered evidence, made three years after discovery of the evidence, refused for laches, it appearing that such evidence was known to defendant on the former trial. *Colgate v. Western Union Telegraph Co.*, 19 Fed. Rep., 828.

§ 5270. An application to reopen case for further hearing and to amend answer, the petition thereof appearing defective in the particulars enumerated, denied; but conditional leave granted, for reasons stated, to amend defective petition and to use certain of the affidavits and exhibits accompanying the same. *Allis v. Stowell*, 18 O. G., 465.

§ 5271. Where petition for rehearing was asked on the ground that, since the interlocutory decree was entered, decisions of the supreme court had laid down a rule for ascertaining the validity of reissues, the motion was denied on the ground that the reissue patent was good for the single claim of the original repeated therein. *Cote v. Moffitt*, 15 Fed. Rep., 345.

Rehearing — In general, §§ 5272-5285.

§ 5272. Equity practice on rehearing. *American Giant Powder Co. v. Cal. Vigorit Powder Co.*, 6 Saw., 508.

§ 5273. A rehearing should not be granted for newly-discovered evidence, where the evidence could have been obtained by reasonable diligence on the first hearing, nor when it is merely cumulative to that previously received, nor when, if presented, it would not have changed the result. *Ibid.*

§ 5274. A rehearing may be granted at any time before final decree. *Reeves v. Keystone Bridge Co.*, 9 O. G., 885.

§ 5275. The practice to ask for a rehearing is by petition to court for leave to file a supplemental bill, setting forth the newly-discovered evidence, and for a rehearing of the cause at the time when the supplemental bill may be ready for hearing. *Ibid.*

§ 5276. The defendants must satisfy the court that the omission to produce the evidence is not due to any negligence on their part. *Ibid.*

§ 5277. The new evidence must be material. *Ibid.*

§ 5278. A rehearing having been granted and new evidence introduced, rendering necessary the opening of the whole record, the old and new evidence will be considered together. *Henry v. Francetown Soapstone Co.*, 2 Fed. Rep., 78.

§ 5279. It is a valid objection to a motion for rehearing upon the ground of newly-discovered testimony, that, so far as the motion and accompanying affidavits disclose, there is no adequate reason, even if the supposed new matter had been presented in time, for changing the decree. *Brown v. Deere*, 2 McC., 425.

§ 5280. It is a valid objection to a motion for rehearing that it is not presented within the time prescribed by law. *Ibid.*

§ 5281. A rehearing will not be granted on the ground that the record on which the case was heard was imperfect, where it appears that the omitted matter presents nothing material to the merits of the case or matter further establishing that held sufficiently proved by the court in giving its decree. *Ambler v. Whipple*, 23 Wall., 278.

§ 5282. On motion for rehearing after an interlocutory decree, on the ground of newly-discovered evidence, the burden is on defendants to show that omission to produce testimony was not due to any negligence on their part, and that they were diligent in their efforts to obtain it; and no such diligence being shown, the motion was refused, although in the stipulation filed plaintiff admitted diligence on the part of defendants, and though on construction of the patent the evidence was material. *Gillette v. Bate Refrigerating Co.*, 12 Fed. Rep., 108.

§ 5283. A motion for a rehearing on the ground of new and further evidence is properly demurrable, unless sustained with an allegation that such proof could not have previously been obtained by the defendant with reasonable diligence. *Page v. Holmes Burglar Alarm Telegraph Co.*, 18 Blatch., 118.

§ 5284. A rehearing cannot be obtained on the ground of surprise, because an adversary's counsel argued otherwise than was expected. *Everest v. Buffalo Lubricating Oil Co.*, 22 Fed. Rep., 252.

§ 5285. An application for rehearing in a court of original jurisdiction, after entry of a final decree, is not an *ex parte* proceeding, but must be presented on notice and considered after the other side has had an opportunity to answer it. *American Giant Powder Co. v. Cal. Vigorit Powder Co.*, 6 Saw., 508.

See *Affidavits*, §§ 173, 177.

Rehearing — In patent office, §§ 5286-5291.

§ 5286. The commissioner, in the exercise of his discretionary power, may set aside his own decision in an interference proceeding and rehear the parties thereto. It is an act over which

the judge has no control nor jurisdiction, and cannot form a valid ground of appeal. *Matthew v. Wade*, 1 MacA. Pat. Cases, 143.

§ 5287. The commissioner may, therefore, rehear the parties to an interference upon the same question and revise his former decision in the case. *Ibid.*

§ 5288. Motions to rehear in chancery and for new trials at law are motions addressed to the discretion of the court, from the refusal to grant which there lies no appeal. *In re Rouse*, 1 MacA. Pat. Cases, 286.

§ 5289. The filing of a second application by the defeated party to an interference is in effect an effort to have the decision reviewed and reversed upon a rehearing or new trial of the first case; and from the refusal of the commissioner to declare a new interference thereon between the same parties no appeal lies to the judge. *Ibid.*

§ 5290. When the decision of the commissioner was reversed by the judge upon the ground that the depositions of the prevailing party were improperly taken, it is competent for the commissioner to grant a new trial to afford the parties the opportunity of having their testimony fully and impartially taken. *Nichols v. Harris*, 1 MacA. Pat. Cases, 362.

§ 5291. When a new party is included in such rehearing or new trial of an interference, it does not become a new case within the spirit of the rule excluding depositions taken in another case not between the same parties. Following the chancery rather than the common law practice, the new party applicant comes in subject to the depositions already taken; and as between the original parties there is no lack of *mutuality*, since the parties and the subject-matter are the same. *Carter v. Carter*, 1 MacA. Pat. Cases, 388.

304. REISSUES.

See DISCLAIMER, IN RESPECT TO REISSUES. FRAUD, IN PROCURING REISSUES, DEFENSE OF.

SUMMARY (*SEYMOUR v. OSBORNE*, §§ 5292-5322) — *Importance of patent suit*, § 5292. — *The patents examined*, §§ 5293-5297. — *Patent prima facie evidence of inventorship*, § 5298; and *casts on defendant the burden of proof*, § 5299. — *Statutory notice*, § 5300. — *Oath; conclusively presumed on patent issued*, § 5301. — *Specification, sufficiency of*, §§ 5302-5305. — *What will authorize a reissue*, § 5306. — *Commissioner's decision final as to "inadvertence or mistake" on reissue and matters of fact*, §§ 5307, 5310. — *Patents not impeachable collaterally*, § 5308. — *Identity of reissue and original essential, else reissue is void*, §§ 5309, 5311. — *Originals in evidence to prove want of identity with reissue*, § 5312. — *"Substantially as described" construed*, § 5313. — *Practice on filing general replication*, § 5314. — *Patentability*, §§ 5315, 5316. — *Experiment will not defeat a patent*, § 5317. — *Who is an inventor*, § 5318. — *Foreign publication*, § 5319. — *Combinations*, § 5320. — *Patentee's right to doctrine of equivalents*, § 5321. — *Patents and infringement reviewed*, 5322.

(*MILLER v. BRASS CO.*, §§ 5323-5329) — *The patent considered*, § 5323. — *Right to reissue may be lost by delay*, § 5324. — *Expanded reissue claims condemned*, § 5325. — *Omission to claim constitutes abandonment*, § 5326. — *Effect of laches in reissuing*, § 5327. — *Office of a reissue*, § 5328. — *When a reissue may be broader than original*, § 5329.

(*JAMES v. CAMPBELL*, §§ 5330-5336) — *The patent cannot be used by government*, § 5330. — *Compensation for government infringement; how obtained*, § 5331. — *The patent considered*, § 5332. — *Reissue with expanded claim*, § 5333. — *The reissue considered*, § 5334. — *A machine cannot be reissued for a process*, § 5335. — *Subsequent and prior patent to same inventor*, § 5336.

SEYMOUR v. OSBORNE.

(11 Wallace, 516-560. 1870.)

APPEAL from U. S. Circuit Court, Northern District of New York.

STATEMENT OF FACTS.—Seymour was the owner of five patents relating to the machinery of harvesters, two of them for his own inventions, and the other three he held as assignee of Palmer and Williams. The bill in this case was filed by Seymour against Osborne for infringement of the patents. The bill was dismissed and complainants appealed. Further facts appear in the opinion of the court.

§ 5292. *Importance of suits relating to patent-rights.*

Opinion by MR. JUSTICE CLIFFORD.

Controversies respecting the infringement of letters patent possess, in many cases, a degree of importance much beyond the profits or damages claimed for

the alleged unlawful use of the invention, as the pleadings usually put in issue, in one form or another, the validity of the letters patent alleged to be infringed, and frequently involve, directly or indirectly, the same inquiry in regard to the letters patent set up in defense as superseding the patent on which the suit is founded. Such being the state of the pleadings, the result, whatever it may be, whether for the party suing or for the party defending, must oftentimes determine rights of property of much greater value than the amount of the profits or damages claimed for the alleged infringement of the letters patent.

Inventions secured by letters patent are property in the holder of the patent, and as such are as much entitled to protection as any other property, consisting of a franchise, during the term for which the franchise or the exclusive right is granted.

Letters patent are not to be regarded as monopolies, created by the executive authority at the expense and to the prejudice of all the community except the persons therein named as patentees, but as public franchises granted to the inventors of new and useful improvements for the purpose of securing to them, as such inventors, for the limited term therein mentioned, the exclusive right and liberty to make and use and vend to others to be used their own inventions, as tending to promote the progress of science and the useful arts, and as matter of compensation to the inventors for their labor, toil and expense in making the inventions, and reducing the same to practice for the public benefit, as contemplated by the constitution and sanctioned by the laws of congress.

Five several letters patent were owned by the complainants when the present suit was commenced, and they allege in the bill of complaint that the respondents have infringed their exclusive rights as secured to them in each and every one of those letters patent. Four of the letters patent are reissued letters patent, and are numbered and described as follows: (1) Reissued letters patent No. 4, dated January 1, 1861, for a new and useful improvement in harvesters, being one of a second reissue in two separate patents, on amended specifications, as more fully explained in the pleadings and the patents annexed to the printed record. (2) Reissued letters patent No. 1682, dated May 31, 1864; also for a new and useful improvement in harvesters, being the second reissue from the before-mentioned reissue when the invention was divided into two parts. They both purport to be founded upon the original patent granted to Aaron Palmer and Stephen G. Williams, dated July 1, 1851, which was for a new and useful improvement in harvesters, and the reissued patents were fully extended for seven years from the expiration of the original term. (3) Reissued letters patent No. 72, dated May 7, 1861, being a reissue of one of three parts of a prior reissue of the original patent, dated July 8, 1851, which was granted to William H. Seymour for a new and useful improvement in reaping machines. (4) Reissued letters patent No. 1683, dated May 31, 1864, being a reissue of another of the three parts of the prior reissue of that patent, as more fully explained in the pleadings; the charge being that the respondents have infringed the first claim. (5) Superadded to those several charges against the respondents is the further one that they have also infringed certain original letters patent owned by the complainants, dated January 24, 1854, which secures to them, as assignees of Palmer and Williams, certain other new and useful improvements in grain harvesters besides those embodied in the several reissued letters patent to which reference has been made.

Founded upon those several letters patent, the bill of complaint, which is drawn in the usual form, alleges that the respondents have unlawfully made and used, and vended to others to be used, the respective inventions therein described, and the complainants pray for an account and for an injunction. Service was made upon the respondents, and they appeared and filed an answer, setting up several defenses to each of the patents described in the bill of complaint. Responsive to the answer the complainants filed the general replication, and the cause being at issue they put in evidence the five several letters patent on which the suit is founded, the respondents consenting that copies of the same, and of the respective certificates of extension mentioned in the pleadings, might be substituted in the record in the place of the originals as introduced in evidence.

Other proofs were introduced and the parties were fully heard, but the circuit court was of the opinion that the proofs introduced by the complainants were not sufficient to show any infringement of their rights, and accordingly entered a decree for the respondents, dismissing the bill of complaint. Dissatisfied with that conclusion, the complainants appealed to this court and now seek to reverse that decree. Separate defenses having been set up in the answer to each of the five letters patent, it will be necessary to a clear understanding of the controversy, and to prevent any misunderstanding as to the views of the court, to describe somewhat more fully the nature of the several inventions and the objects which they were designed to accomplish.

§ 5293. *Reissued patent No. 1110, January 1, 1861, original patent No. 8192, Palmer & Williams, July 1, 1851, harvester, examined.*

I. Explained in general terms, the invention secured in the first mentioned reissued patent, numbered 4, consists in arranging an automatic sweep-rake in a harvesting machine in such relation to a quadrant-shaped platform, upon which the cut grain falls as it is cut, that it shall vibrate over the same at suitable intervals to discharge the cut grain in gavels upon the ground.

Specific description is given, in the first place, of the frame of the machine, which, as represented, is composed of three longitudinal beams and two transverse beams securely fastened to each other at their points of intersection. Next follows a reference to the driving-wheel, which, as represented, is placed between the outer longitudinal beam and the central beam, having its bearings on arched supports or brackets rising from each of the beams composing the frame. Guard fingers through which a sickle vibrates are secured upon the front edge of a platform shaped like a quadrant or sector of a circle, of which the arm or lever that carries the rake-head forms the radius, and the fulcrum-pin on which the arm or lever vibrates constitutes the center, the whole operating so that the grain is swept round on an arc of a circle and discharged in gavels upon the ground behind the driving-wheel.

Minute details of all the other elements of the machine are also given in the subsequent parts of the specifications, and of their modes of operation, and the specification concludes with the claim which, in substance, is discharging the cut grain from a quadrant-shaped platform on which it falls as it is cut, by means of an automatic sweep-rake vibrating over the same, substantially as described, which must be understood as referring back to the description contained in the body of the specification.

§ 5294. *Reissued patent No. 1682, May 31, 1864, original patent No. 8192, examined.*

II. Two combinations are mentioned in the specification of the reissued

letters patent No. 1682, but it is only necessary to refer to the first, as it is not alleged that the respondents have infringed the second claim. Described separately, the ingredients of the first claim are as follows: (1) The cutting apparatus to sever the standing stalks of grain. (2) The quadrant-shaped platform arranged behind the cutting apparatus to receive the severed stalks of grain as they fall. (3) The sweep-rake and the described mechanism to operate the same in such manner that the teeth shall move in circular curves over the platform when they are acting on the grain.

Reference must also be made to the other two reissued letters patent embraced in the pleadings. Both have respect to an improvement made in reaping machines, and they were both granted to secure material parts of an original invention once before surrendered and reissued because the letters patent were defective and inoperative. Before the term of the original patent expired the patents were extended for the further term of seven years.

§ 5295. *Reissued patent No. (72) 1177, March 7, 1861, original patent No. 8212, W. H. Seymour, July 8, 1851, harvesters, examined.*

III. Number 72 consists in constructing the platform of a reaping machine, upon which the cut grain falls as it is cut, in the shape of a quadrant, or of a sector of a circle, placed just behind the cutting apparatus, and in such relation to the main frame that the grain, whether raked off by hand or by machinery located behind the cutting apparatus, can be swept around on the arc of a circle and be dropped, heads foremost, on the ground far enough from the standing grain to leave room for the team and machine to pass between the gavels and the standing grain without the necessity of taking up the gavels before the machine comes round to cut the next swath.

§ 5296. *Reissued patent No. 1683, May 31, 1864, original patent No. 8212, examined.*

IV. They also acquired title to the invention secured in the remaining reissued letters patent mentioned in the bill of complaint, to wit, number 1683; but it will be sufficient to refer to the first claim of the same, as the second is not the subject of controversy in this suit. As described in the specification, the ingredients of the first claim are the cutting apparatus to sever the stalks, the reel to incline the heads of the stalks towards the cutting apparatus, and the quadrant-shaped platform, located in the rear of the cutting apparatus, to receive the cut stalks as they fall before the operation of the sweep-rake begins. Designed as the improvements were to accomplish the same object as the other two improvements previously described, the patentees or owners of the several letters patent elected to compromise rather than litigate, and the result was that the entire interest became ultimately vested in the appellants.

§ 5297. *Further improvements patented.*

V. Patented improvements in the method of transferring motion from the driving-wheel of a reaping machine to the rake on the platform of the machine, and in the method of hanging the reel so as to dispense with any post on the side of the machine next the grain, were also acquired by the appellants as a part of the same arrangement, and they charge in the bill of complaint that the second claim of the original letters patent, embodying that improvement, is also infringed by the respondents.

§ 5298. *A patent is prima facie evidence that the patentee is inventor and lawful owner of the invention.*

Power to grant letters patent is conferred by law upon the commissioner of

patents, and when that power has been lawfully exercised, and a patent has been duly granted, it is of itself *prima facie* evidence that the patentee is the original and first inventor of that which is therein described and secured to him as his invention. *White v. Allen*, 2 Cliff., 228. Persons seeking redress for the unlawful use of letters patent, in which they have an interest, are obliged to allege and prove that they, or those under whom they claim, are the original and first inventors of the improvement embodied in the letters patent on which the suit is founded, and that the same have been infringed by the party against whom the suit is brought.

Undoubtedly the burden to establish both of those allegations is, in the first place, upon the party instituting the suit, as they lie at the foundation of every such claim; but the law is well settled that the letters patent in question, where they are introduced in evidence in support of the claim, if they are in due form, afford a *prima facie* presumption that the first-named allegation is true; and the rule is equally well settled that that presumption, in the absence of satisfactory proof to the contrary, is sufficient to entitle the party instituting the suit to recover for the alleged violation of the exclusive rights secured to him in the letters patent.

§ 5299. *After a patent has been given in evidence, the burden of proof is upon the defendant.*

Availing themselves of that rule of law, the complainants in this case introduced the five several letters patent on which the suit is founded, and they contend, and well contend, that their effect as evidence is to cast the burden of proof upon the respondents to show that the respective patentees are not the original and first inventors of the improvements embodied in the several letters patent, as they have alleged in their answer.

§ 5300. *Thirty days' notice of defense assailing the validity of the patent is required.*

Parties defendants, sued as infringers, are not allowed in an action at law to set up the defense of a previous invention, knowledge or use of the thing patented, unless they have given notice of such a defense thirty days before the trial and have stated in the notice "the names and places of residence of those whom they intend to prove to have possessed a prior knowledge of the thing, and where the same had been used;" and the settled practice in equity is to require the respondent, as a condition precedent to such defense, to give the complainant substantially the same information in his answer. *Agawam Co. v. Jordan*, 7 Wall., 596; *Teese v. Huntingdon*, 23 How., 10.

Notices of the kind were given by the respondents in this case, but it will be more convenient to examine certain special defenses set up in the answer before entering upon that inquiry, as the decree must be affirmed, in any event, if any one of those defenses is well founded, whether the issues of novelty and of infringement are determined in favor of the complainants or respondents. All of the special defenses apply to the original patent as well as to those which have been reissued, except such as are founded upon the acts or omissions of the commissioner in granting the reissues, which, of course, are not applicable to the former. They are eight in number, as exhibited in the answer, the respondents alleging in each that the letters patent are void and of no effect for the reasons therein set forth and they will be briefly examined in the order in which they are pleaded.

§ 5301. *Recitals in letters patent that the required oath was taken before the same was granted are, in the absence of fraud, conclusive evidence that it was so taken.*

1. That the letters patent are void and of no effect because the patentees did not make oath, before the patents were granted, that they did verily believe that they were the original and first inventors of the improvements for which the letters patent were solicited.

Congress possesses the power to pass laws to secure to inventors, for limited times, the exclusive right to their inventions, and congress, in pursuance of that article of the constitution, has conferred the power to grant letters patent for that purpose upon the commissioner of patents. Persons who have made an invention, and who desire to obtain an exclusive property therein, may make application in writing to the commissioner of patents, and the provision is that the commissioner, on due proceedings had, may grant a patent for the said invention.

Inventors of machines are required, before they receive a patent, to deliver a written description of their inventions, and of the manner and process of making, constructing and using the same, in such "full, clear and exact terms" as to enable any person skilled in the art or science to make, construct and use the same, and fully to explain the principle by which the invention may be distinguished from others of like kind; and they are also required to specify and point out the part, improvement or combination which they claim as their invention.

Doubtless these several requirements may be regarded as conditions precedent to the right of the commissioner to grant the application, as they must appear on the face of the letters patent, and are always open to legal construction as to their sufficiency. Drawings are also required in certain cases; and where the invention is such that it may be represented by a model, the applicant for a patent is required to furnish a model of the same; and the further requirement is that he shall make oath or affirmation that he does verily believe that he is the original and first inventor of the improvement for which he solicits a patent, and that he does not know that the same was ever before known or used.

Importance, it is conceded, must be attached to the latter requirement, but it is certain that the oath or affirmation may be taken elsewhere than before the commissioner, as the same section provides that it "may be made before any person authorized by law to administer oaths." 5 Stat. at Large, 119.

Extended examination of the question, however, is unnecessary, as every one of the letters patent on which the suit is founded contains the recital that the required oath was taken before the same was granted, and the court is of the opinion that those recitals, in the absence of fraud, are conclusive evidence that the necessary oaths were taken by the applicants before the letters patent were granted.

§ 5302. *What applicants are required to specify and point out in their claims and specifications.*

2. That the letters patent are void and of no effect, because the patentees did not specify and point out in their specifications and claims the parts, improvements or combinations which they claim as their respective inventions. Grant the theory of fact assumed in the proposition and the conclusion would follow, but the whole theory of the proposition as applied to the present case is founded in error.

§ 5303. *Sufficient description of a machine.*

Inventions secured by letters patent sometimes, though rarely, embrace an entire machine, and in such cases it is sufficient if it appear that the claim is co-extensive with the invention. Other inventions embrace only one or more parts of a machine, as the coulter of a plough, or the divider or sweep-rake of a reaping machine; and in such cases the part or parts claimed must be specified and pointed out so that constructors, other inventors and the public may know how to make the invention, and what is withdrawn from general use.

§ 5304. — *of a combination of new and old elements.*

Patented inventions are also made which embrace both a new ingredient and a combination of old ingredients embodied in the same machine. Even more particularity of description is required in such a case, as the property of the patentee consists, not only in the new ingredient, but also in the new combination, and it is essential that his invention shall be so fully described that others may not be led into mistake, as no other person can lawfully make, use or vend a machine containing such new ingredient or such new combination. They may make, use or vend the machine without the patented improvements, if it is capable of such use, but they cannot use either of those improvements without making themselves liable as infringers.

§ 5305. *Sufficient description of a combination of old elements.*

Improvements in machines protected by letters patent may also be mentioned, of a much more numerous class, where all the ingredients of the invention are old, and where the invention consists entirely in a new combination of the old ingredients, whereby a new and useful result is obtained, and many of them are of great utility and value, and are just as much entitled to protection as those of any other class. *Union Sugar Refinery v. Matthiessen*, 2 Fish. Pat. Cas., 605. Such a combination is sufficiently described if the ingredients of which it is composed are named, their mode of operation given, and the new and useful result to be accomplished pointed out, so that those skilled in the art and the public may know the extent and nature of the claim, and what the parts are which co-operate to produce the described new and useful result. Tested by these rules, it is clear that the objection under consideration cannot prevail in respect to any one of the several letters patent on which the suit is founded.

§ 5306. *What is necessary to authorize a reissue of a patent.*

3. That the reissued letters patent are void and of no effect, because the commissioner of patents never obtained jurisdiction to receive the surrender of the originals, nor to grant the reissues, as no evidence was produced before him to show that the originals were inoperative or invalid for any reason or cause whatsoever. Whenever any patent is inoperative or invalid, by reason of a defective or insufficient description or specification, if the error arose by inadvertency, accident or mistake, and without any fraudulent or deceptive intention, it is lawful for the commissioner, upon the surrender to him of such patent, and of the payment to him of a certain duty, to cause a new patent to be issued to the inventor *for the same invention* for the residue of the term then unexpired, in accordance with the patentee's corrected description and specification. 5 Stat. at Large, 122.

Whether adjudged to be valid or invalid, it is clear that the several reissued letters patent are all in due form, and that they contain all the usual recitals asserting a compliance with the requirements specified in the patent act, and

it is equally certain that the respondents did not introduce any proofs to establish the theory of fact assumed in the answer.

Authority to accept the surrender of original patents in certain cases, and to grant new patents to the inventor, was conferred upon the commissioner by the act of the 3d of July, 1832, and in a case arising under that act it was held by this court, more than thirty years ago, that where an act was to be done or a patent granted, upon proofs to be laid before a public officer, upon which he was to decide, the fact that such public officer had done the act or granted the patent was *prima facie* evidence that the proofs had been regularly made, and that they were satisfactory, even though the patent did not contain any recitals that the prerequisites to the grant had been fulfilled; and such continued to be the rule until the question came up again for consideration under the existing patent act, when it was held by this court that the fact of the granting of the reissued patent closed all inquiry into the existence of inadvertence, accident or mistake, and left open only the question of fraud for the jury. *Railroad v. Stimpson*, 14 Pet., 458; *Stimpson v. Railroad*, 4 How., 384; 4 Stat. at Large, 559.

§ 5307. *Upon a question of a reissue of a patent for inadvertency, accident or mistake, the decision of the commissioner is final.*

Since that time it has been definitively settled that neither reissued nor extended patents can be abrogated by an infringer, in a suit against him for infringement, upon the ground that the letters patent were procured by fraud in prosecuting the application for the same before the commissioner. *Rubber Company v. Goodyear*, 9 Wall., 797; S. C., 2 Cliff., 375.

§ 5308. *Patents cannot be impeached collaterally.*

Where the commissioner accepts a surrender of an original patent and grants a new patent, his decision in the premises, in a suit for infringement, is final and conclusive, and is not re-examinable in such a suit in the circuit court, unless it is apparent upon the face of the patent that he has exceeded his authority, that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent. *Battin v. Taggart*, 17 How., 83; *O'Reilly v. Morse*, 15 id., 111, 112; *Sickles v. Evans*, 2 Cliff., 222; *Allen v. Blunt*, 3 Story, 744.

§ 5309. *Reissued patents must be for the same invention as the original.*

4. That the reissued letters patent are void and of no effect because they were not granted for the same invention as that embodied in the original letters patent, nor for any invention made by the patentees before the original letters patent were granted.

Reissued letters patent must, by the express words of the section authorizing the same, be *for the same invention*, and consequently where it appears, on a comparison of the two instruments, as matter of law, that the reissued patent is not for the same invention as that embraced and secured in the original patent, the reissued patent is invalid, as that state of facts shows that the commissioner, in granting the new patent, exceeded his jurisdiction. Power is unquestionably conferred upon the commissioner to allow the specification to be amended if the patent is inoperative or invalid, and in that event to issue the patent in proper form; and he may, doubtless, under that authority, allow the patentee to redescribe his invention and to include in the description and claims of the patent not only what was well described before, but whatever else was suggested or substantially indicated in the specification or drawings

which properly belonged to the invention as actually made and perfected. Interpolations of new features, ingredients or devices, which were neither described, suggested nor indicated in the original patent, or patent office model, are not allowed, as it is clear that the commissioner has no jurisdiction to grant a reissue unless it be for the same invention as that embodied in the original letters patent, which necessarily excludes the right on such an application to open the case to new parol testimony and a new hearing as to the nature and extent of the improvement, except in certain special cases, as provided in a recent enactment not applicable to the case before the court. 16 Stat. at Large, 206; *Cahart v. Austin*, 2 Cliff., 536; *Curtis on Patents* (3d ed.), 276; *Woodworth v. Stone*, 3 Story, 753.

Corrections may be made in the description, specification or claim, where the patentee has claimed as new more than he had a right to claim, or where the description, specification or claim is defective or insufficient; but he cannot, under such an application, make material additions to the invention which were not described, suggested nor substantially indicated in the original specifications, drawings or patent office model.

§ 5310. *Conclusiveness of commissioner's decision as to matters of fact and of construction.*

Prior to the decision of this court, that a person sued as an infringer cannot abrogate a reissued or extended patent by showing that the commissioner had been induced to grant it by fraudulent representations, it had sometimes been supposed that every such new patent was open to that defense, and that the question was one of fact dependent upon evidence; but since it has been determined that such a party cannot be heard to make such a defense to the charge of infringement, it has come to be regarded as the better opinion that all matters of fact involved in the hearing of an application to reissue a patent, and in granting it, are conclusively settled by the decision of the commissioner granting the application. Matters of construction arising upon the face of the instrument are still open, but all matters of fact connected with the surrender and reissue are closed in such a suit by the decision of the commissioner in granting the reissued patent. *Rubber Co. v. Goodyear*, 9 Wall., 796; *Stimpson v. Railroad*, 4 How., 404; *Railroad v. Stimpson*, 14 Pet., 458.

§ 5311. *A reissued patent is void if it is for a different invention from that of the original.*

Letters patent reissued for an invention substantially different from that embodied in the original patent are void and of no effect, as no jurisdiction to grant such a patent is conferred by any act of congress upon the commissioner, and he possesses no power in that behalf except what the acts of congress confer. Whether a reissued patent is for the same invention as that embodied in the original patent, or for a different one, is a question for the court in an equity suit to be determined as a matter of construction, on a comparison of the two instruments, aided or not by the testimony of expert witnesses, as it may or may not appear that one or both may contain technical terms or terms of art requiring such assistance in ascertaining the true meaning of the language employed. *Sickles v. Evans et al.*, 2 Cliff., 203.

Where the specification and claim, both in the original and reissued patents, are expressed in ordinary language, without employing any technical terms or terms of art, the question whether the reissued patent is for the same invention as that described in the original patent, or for a different one, is purely a question of construction; but where both or either contain technical terms or

terms of art, the court may hear the testimony of scientific witnesses to aid the court in coming to a correct conclusion. Cases doubtless arise where the language of the specification and claim, both of the surrendered and reissued patents, is so interspersed with technical terms and terms of art that the testimony of scientific witnesses is indispensable to a correct understanding of its meaning. Both parties in such a case would have a right to examine such witnesses, and it would undoubtedly be error in the court to reject the testimony; but the case before the court is not of a character to render it expedient to pursue the inquiry. *Bischoff v. Wethered*, 9 Wall., 814; *Betts v. Menzies*, 4 Best & Smith, Q. B., 999.

§ 5312. *It is incumbent on the defendant to introduce the original patent in evidence where the defense is that the reissue is not for the same invention.*

Apply the rule to the present case, that the question is one of construction, and it is clear that the defense under consideration is not open to the respondents, as they did not introduce in evidence the original letters patent from which the reissued patents were derived. Persons owning reissued letters patent, and seeking redress from those who have invaded their exclusive rights, are not obliged to introduce in evidence the surrendered patent, and, if the old patent is not introduced by the party sued, he cannot have the benefit of such a defense.

§ 5313. *Construction of words "substantially as described" in a claim.*

5. That the several letters patent are void and of no effect because the claims therein patented are for an effect, and not for any particular machinery. Founded, as the defense is, upon an obvious misconstruction of the claims of the several patents, it does not seem to require much explanation. Omit the words "substantially as described," or "substantially as set forth," and the question presented would be a very different one; but inasmuch as those words, or words of equivalent import, are employed in each of the claims, the defense is without merit. Where the claim immediately follows the description of the invention it may be construed in connection with the explanations contained in the specifications, and where it contains words referring back to the specifications, it cannot properly be construed in any other way. *Curtis on Patents* (3d ed.), secs. 225-227.

6. That the several reissued letters patent are void and of no effect because the claims therein made are too broad and embrace that of which the patentees were not the original and first inventors prior to the granting of the original letters patent. Properly understood the defense is substantially the same as that set up in the fourth defense, and it must be overruled for the same reasons, which need not be repeated.

§ 5314. *Where a general replication has been filed, respondents must prove the new matter alleged in their answer.*

7. That the several letters patent are void and of no effect because what is claimed therein as new was in public use, with the consent and allowance of the original patentees, more than two years before they applied for the several patents. Such a defense set up in a case where the complainants file the general replication is of no avail unless sustained by proof, and the respondents did not introduce any proofs to sustain it, which is all that need be said upon the subject.

8. That the combination claimed in each of the several letters patent is a combination of old parts, the combining of which involved no invention, but merely the skill of an intelligent mechanic or other person skilled in the manufacture and use of harvesting machines.

Reduced to a proposition, the defense, as set up in the answer, is that the several improvements were old and not patentable on that account, as no improvements were made which required invention. Specific objection is made under this head to each of the four reissued letters patent, but the grounds of the several objections are substantially the same, so that the several propositions may be considered together.

§ 5315. *To be patentable an article must be new and useful.*

New and useful machines are the proper subjects of an application for a patent, and so, by the express words of the act of congress, are new and useful improvements on any machine. All of the patents embraced in the suit fall under the second clause of the provision, and are of the fourth class of patents before described, that is, they consist of a new combination of old elements whereby a new and useful result is obtained. Particular changes may be made in the construction and operation of an old machine so as to adapt it to a new and valuable use not known before, and to which the old machine had not been, and could not be, applied without those changes, and, under those circumstances, if the machine, as changed and modified, produces a new and useful result, it may be patented, and the patent will be upheld under existing laws. *Bray v. Hartshorn*, 1 Cliff., 541; *Losh v. Hague*, 1 Webster's Patent Cases, 207; *Hindmarsh on Patents*, 95; *Phillips v. Page*, 24 How., 166; *Norman on Patents*, 25.

§ 5316. *What constitute patentable improvements on an old machine.*

Such a change in an old machine may consist merely of a new and useful combination of the several parts of which the old machine is composed, or it may consist of a material alteration or modification of one or more of the several devices which entered into its construction; and whether it be the one or the other, if the change of construction and operation actually adapts the machine to a new and valuable use not known before, and it actually produces a new and useful result, then a patent may be granted for the same, and it will be upheld as a patentable improvement. *Park v. Little*, 3 Wash., 196.

Improvements for which a patent may be granted must be new and useful, within the meaning of the patent law, or the patent will be void; but the requirement of the patent act in that respect is satisfied if the combination is new and the machine is capable of being beneficially used for the purpose for which it was designed, as the law does not require that it should be of such general utility as to supersede all other inventions in practice to accomplish the same object. *Lowell v. Lewis*, 1 Mason, 182; *Bedford v. Hunt*, id., 302; *Many v. Jagger*, 1 Blatch., 372; *Barrett v. Hall*, 1 Mason, 447.

Unsuccessful in those defenses, the respondents in the next place attack the respective inventions as destitute of originality, and allege that the patentees were not the original and first inventors of the several improvements supposed to be secured in the letters patent. Separate defenses of the kind are set up in the answer to each of the letters patent, but the nature and character of the objections are such that the whole series may properly be considered together.

Prior notice in the answer is required in such a case as a condition precedent to the right to introduce proofs to support such a defense, and it is certainly proper that the respondent should be allowed to comply with that requirement; but it is an abuse of the privilege to give such notices without some reason to suppose that such a defense can successfully be made, and that the proofs, if required, can be obtained, as it exposes the complainant to un-

necessary expense and trouble in preparing his case for trial. Where no proofs were introduced in support of the answer, no mention will be made of the notices, as a notice without proof to support it is of no avail.

Out of all the alleged prior inventions set up in the answer, only four were made the subject of proof to any substantial extent. Two of these are the inventions of Obed Hussey and of Thomas D. Burrall, of the combination of the quadrant-shaped platform located behind the cutting apparatus. Those patents were introduced as tending more particularly to supersede the reissued patent number 72, before described.

Strong doubts are entertained whether any of the patents given in evidence by the respondents as superseding the particular patent of the complainants, involved in this issue, are of a character to have that effect, even if the inventions which they purport to secure were of prior date; but it is not absolutely necessary to decide that point, except as to one of the exhibits, as the court is of the opinion that none of the others antedate the invention secured in that patent. Conclusions are all that will be useful on this branch of the case, especially as the question is one of fact dependent upon the proofs, which are somewhat conflicting, and where a full analysis of the evidence would hardly be practicable, as it would extend the opinion to an unreasonable length.

Proofs entirely satisfactory to the court are exhibited by the complainants showing that their invention, as described in the patent in question, was perfected early in the summer of 1849, as a material part of a harvesting machine, and that the same was reduced to practice as an operative machine during the harvesting season of that year.

Hussey, from 1839 or earlier to the time of his death, in the summer of 1860, was much engaged in the manufacture of reaping machines of various kinds. Most of his machines, however, were constructed without any reel and with square platforms, so as to drop the cut grain at the rear of the platform, differing so widely from the patented machine of the complainants as to require no argument to show that they afford no support to the present defense. Other machines were constructed by him with a straight guide-board on the platform, which was adjustable within certain limits, and the apparatus was doubtless capable, to a limited extent, of causing the cut grain to be moved sufficiently out of the path of the machine to give room for a single team.

Evidence to show that the invention of the complainants is embodied in those machines is entirely wanting, and it is quite clear that if any such had been introduced it could not have been credited, as the differences between them are too palpable and material to be overcome by parol evidence. Machines were also made by him with two platforms, or with a platform in two parts, the one being attached to the rear of the other, but it required two men to do the work which, with the complainants' machine, is easily and much better accomplished by one, which is certainly all the explanation which need be given of those machines in the present case.

§ 5317. *It is not valid evidence against a patented machine that a similar machine had been previously made as an experiment, but not reduced to practice as an operative machine.*

Apart from these he also made one experimental machine, with a square platform, to which was bolted an angular addition, giving the whole, when the addition was attached, an angular form. Examined when the addition is bolted to the main platform, irrespective of the other ingredients of the combination, it approaches much nearer to the invention of the complainants than

any of the other exhibits introduced in evidence by the respondents. Conceding all that, still it would not be difficult to show that the two are substantially different in several respects; but it is unnecessary to enter that field of inquiry, as the proofs are entirely satisfactory to the court, that the machine, as constructed, was merely an experiment, and that it was never reduced to practice as an operative machine. Undoubtedly it was built in the autumn of 1848, subsequent to the close of the harvest season; but the respondents' testimony shows that it was not used for cutting grain during that harvesting season.

Some obscurity surrounds its early history, nor is it of much importance that it should be better known. It appears that it was sent to the railroad depot to be transported to some other place for trial; but there is no positive evidence that it was ever forwarded or used, or that it was capable of any beneficial use. Where it was transported, if at all, from the depot, does not appear; but it does appear that it was returned the next year to the shop of the maker, and that it was set against the wall by the side of the street in front of the shop, where it remained for some time; that it was then removed to the new shop of the maker, where it remained until it was taken to pieces and broken up by his order, and never restored till long subsequent to the complainants' patent.

§ 5318. *Who is an inventor in the sense of the patent law.*

Original and first inventors are entitled to the benefit of their inventions if they reduce the same to practice, and seasonably comply with the requirements of the patent law in procuring letters patent for the protection of their exclusive rights. Crude and imperfect experiments are not sufficient to confer a right to a patent; but in order to constitute an invention the party must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form. Desertion of an invention consisting of a machine, never patented, may be proved by showing that the inventor, after he had constructed it, and before he had reduced it to practice, broke it up as something requiring more thought and experiment, and laid the parts aside as incomplete, provided it appears that those acts were done without any definite intention of resuming his experiments, and of restoring the machine with a view to apply for letters patent. *Johnson v. Root*, 2 Cliff., 123; *Gayler v. Wilder*, 10 How., 498 (§§ 385-96, *supra*); *Parkhurst v. Kinsman*, 1 Blatch., 494; *White v. Allen*, 2 Cliff., 230.

He is the first inventor in the sense of the patent law, and entitled to a patent for his invention, who first perfected and adapted the same to use; and it is well settled that until the invention is so perfected and adapted to use it is not patentable under the patent laws. *Washburn v. Gould*, 3 Story, 122; *Cahoon v. Ring*, 1 Cliff., 612. Argument is hardly necessary to show that nothing else introduced in evidence by the respondents as having been constructed by that inventor is of a character to interfere, in any substantial respect, with the novelty of the invention held by the complainants, as the weight of the evidence plainly tends to disprove the allegations of the answer, and the inferences to be drawn from a comparison of the exhibits would establish the opposite theory even if the other proofs were less decisive to that effect.

Prior invention by Thomas D. Burrall is the next defense set up by the respondents to the particular patent under consideration. They attempt to show that he constructed a harvesting machine having a square platform, to

which he attached an apron, quadrant formed, which would deliver the cut grain, heads foremost, at the side of the machine and out of the way of the team in cutting the next swath.

Concede the fact that the machine, together with the circular apron, was constructed by the person named as alleged, and that the machine in that form antedates the invention held by the complainants, still the court is of the opinion that it is not of a character to defeat the complainants' patent, as it had no reel, was not a self-raker in any view of the case, and consisted beyond doubt of a substantially different combination. Compared with that, the invention described in the complainants' patent is both new and useful, and is plainly sufficient to support a patent as a new arrangement.

Suppose it to be otherwise, still the conclusion as to this defense must be the same, as the court is unhesitatingly of the opinion from the proofs that the supposed inventor did not construct the circular apron, and attach the same to the square platform, and use the two in conjunction, until after the complainants' invention was perfected and reduced to practice as an operative machine.

Evidence was also introduced by the respondents respecting the invention of Nelson Platt, but extended discussion upon that topic is unnecessary, as it is hardly contended by the respondents that the machine contains a quadrant-shaped platform with, and immediately behind, the cutting apparatus, and in such relation to the main frame as that described in the specification of the complainants' patent. They appear to shrink from that proposition, which is the only one involved in this defense, and seek shelter under another of a very different character, which is that the difference between the two is so very slight that it required no invention to pass from the former to the latter, which is a matter appertaining to another head of the defense that has previously been fully considered and the point distinctly overruled.

Properly understood, that machine does not contain a combination of the quadrant-shaped platform with the cutting apparatus in any practical sense. On the contrary, it has a square platform combined with the cutting apparatus, and the quadrant-shaped platform is combined with the square platform; nor does it contain any quadrant-shaped platform to receive the grain as it falls, but the ingredients of the invention, as well as the combination, are different from those in the complainants' machine, and the mode of operation is also different, which is all that need be said in response to that defense.

Substantially the same defenses were also set up to the other reissued letters patent, to the extent that those patents were put in issue in the pleadings, but it will not be necessary to restate the objections to their originality nor to present any response to the same, as to do so would only be to repeat what has been said in respect to the one more particularly assailed in argument.

Attempt is also made to show that the original letters patent described in the bill of complaint are also invalid, because the patentees are not the original and first inventors of the improvements therein secured. Whether they were or were not the original and first inventors of the improvement in the first claim is a matter of no importance in this case, as the pleadings do not put that claim in issue. They only put in issue the second claim, which embodies the described method of hanging the reel so as to dispense with any post or reel-bearer next to the standing grain, to prevent the grain from getting caught between the divider and the reel-supporter, and the only evidence introduced of prior invention is what is contained in an article published in

London in the Mechanics' Magazine. Expert witnesses were examined in respect to it by both sides. One examined by the respondents testified that he did not understand that it had any reel-support on the grain side of the machine, which in that respect is like the machine of the complainants, but three expert witnesses examined by the complainants testify that neither the description nor the drawings of the same, as exhibited in that magazine, show anything which is embodied in the complainants' patent, and the court is of the same opinion.

§ 5319. *Prior foreign publication; when sufficient to defeat a patent.*

Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement in such full, clear and exact terms as to enable any person skilled in the art or science to which it appertains, to make, construct and practice the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent. Mere vague and general representations will not support such a defense, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes place, the account published, to be of any effect to support such a defense, must be an account of a complete and operative invention capable of being put into practical operation. Webster's Patent Cases, 719; Curtis on Patents (3d ed.), § 278a; Hill v. Evans, 6 Law Times (N. S.), 90; Betts v. Menzies, 4 Best & Smith (Q. B.), 999.

None of these defenses, however, were sustained in the court below, but the circuit judges were of the opinion that the proofs failed to show that the respondents had infringed the letters patent of the complainants.

§ 5320. *Combinations.*

Actual inventors of a combination of two or more ingredients in a machine secured by letters patent in due form are entitled, even though the ingredients are old, if the combination produces a new and useful result, to treat every one as an infringer who makes and uses or vends the machine to others to be used without their authority or license. Pitts v. Whitman, 2 Story, 619; Ames v. Howard, 1 Sumn., 487.

They cannot suppress subsequent improvements which are substantially different, whether the new improvements consist in a new combination of the same ingredients, or of the substitution of some newly-discovered ingredient, or of some old one performing some new function not known at the date of the letters patent, as a proper substitute for the ingredient withdrawn from the combination constituting their invention. Mere formal alterations in a combination in letters patent, however, are no defense to the charge of infringement, and the withdrawal of one ingredient from the same, and the substitution of another which was well known at the date of the patent as a proper substitute for the one withdrawn, is a mere formal alteration of the combination if the ingredient substituted performs substantially the same function as the one withdrawn.

§ 5321. *Patentee's right to invoke the doctrine of equivalents.*

Patentees, therefore, are entitled in all cases to invoke to some extent the doctrine of equivalents, but they are never entitled to do so in any case to suppress all other substantial improvements, and the rule which disallows such

pretensions, if properly understood and limited, is as applicable to the inventor of a device, or even of an entire machine, as to the inventor of a mere combination, except that the inventor of the latter cannot treat any one as an infringer whose machine does not contain all of the material ingredients of the prior combination, as in that state of the case the subsequent invention is regarded as substantially different from the former one, unless the latter machine employs as a substitute for the ingredient left out to perform the same function some other ingredient which was well known as a proper substitute for the same when the former invention was patented. *Prouty v. Ruggles*, 16 Pet., 341; *Johnson v. Root*, 2 Cliff., 123.

Bona fide inventors of a combination are as much entitled to suppress every other combination of the same ingredients to produce the same result, not substantially different from what they have invented and caused to be patented, as any other class of inventors. All alike have the right to suppress every colorable invasion of that which is secured to them by their letters patent, and it is a mistake to suppose that this court ever intended to lay down any different rule of decision. Guided by these rules the remaining question for the determination of the court is whether the respondents have infringed the several patents described in the bill of complaint.

§ 5322. *Review of the patents and the alleged infringements.*

Infringement is alleged by the complainants, and the burden is upon them to prove the allegation, as it imputes a wrongful act to the respondents. All controversy as to the character of the machines made and sold by the respondents is closed by their admission set forth in the record. Exhibit 6, it is conceded by the respondents, is an accurate representation of the machines which they made and sold, and the complainants accept the admission as correct. Absolute certainty, therefore, attends that inquiry, and there is very little, if any, more difficulty in ascertaining the construction of the patented machines made and furnished to the public by the complainants, so that the only substantial inquiry is whether the machines made and sold by the respondents infringe the patented machines of the complainants, as the latter embody all the inventions of the complainants except the claims pointed out as not infringed, and the proofs satisfy the court that the exhibits are constructed in accordance with the mechanism described in the several letters patent.

Properly construed, the reissued patent number 4 is the combination of a quadrant-shaped platform located behind the cutting apparatus of the harvester so as to receive the grain as it falls after it is cut, with an automatic sweep-rake so constructed as to sweep over the platform in circular curves, and to move forward and backward, or towards and from the cutting apparatus, so as to seize upon the grain as it falls, after being cut, sweeping it over the platform in circular curves and delivering it upon the ground behind the machine with its stalks at right angles, or nearly so, with the line of progression of the machine, and to return by a forward movement towards the cutting apparatus to the original position when the first operation commenced.

Number 1682 is divided into two parts, the first of which may be used without the second, and it is not charged that the second part has been infringed by the respondents. Briefly described it consists of a combination of the cutting apparatus of a harvester with a quadrant-shaped platform arranged in the rear thereof, and with a sweep-rake operated by mechanism in such a manner that its teeth are caused to sweep over the platform in curves when

acting on the grain and to discharge the stalks crosswise to the direction of the swath and out of the way of the team on the return of the machine.

Two combinations are also contained in the reissued patent 1683, but the respondents are not charged with infringing the second, so that it is only necessary in this connection to refer to the first and describe its operation. It consists of a combination of the cutting apparatus with a reel and with a quadrant-shaped platform located in the rear of the cutting apparatus, operating as follows: The cutting apparatus severing the grain, the reel bearing the grain against the cutting apparatus and insuring its delivery upon the quadrant-shaped platform in the rear thereof, and the quadrant-shaped platform receiving the grain from the cutting apparatus and reel, and supporting it in such a manner that it can be moved from the cutting apparatus, heads foremost, swept round in a curve and discharged upon the ground crosswise to the direction of the swath and out of the track of the horses when the machine comes round to cut the next swath.

Patent numbered 72 is also an arrangement of the quadrant-shaped platform immediately behind the cutting apparatus of a reaping machine, so that the platform will receive the grain as it falls from the cutting apparatus, and will support it in such a manner that it may be swept round in a curvilinear path and discharged, heads foremost, upon the ground at the side of the platform out of the path of the horses when they return.

Reference will only be made to the second part of the original patent embraced in the suit, as it is not charged that the respondents have infringed the other claim. Separated from the second claim, the first consists in a mode of hanging the reel in a reaping machine so as to dispense with any post or reel-bearer on the side next to the standing grain, without any projection of the reel-shaft or bearing therefor on that side of the machine, so that the reel overhangs the bearings on the one side and is without support on the other side.

Prior to the act of congress allowing several patents to be issued for distinct and separate parts of the thing patented, it is not probable that a bill of complaint joining five several patents in the same charge of infringement would have escaped objection from the respondent; but it will be noticed that all the claims appertain to the same general subject, and that it requires all of the inventions in question to constitute a complete self-raking harvester or reaping machine, and that they are all embodied in the machines which the complainants make and furnish to the public. Viewed in that light the court is of the opinion that the objection, if it had been made, could not have been sustained. 5 Stat. at Large, 192.

Where the invention or inventions are embodied in a machine, the question of infringement is best determined by a comparison of the machine made by the respondent with the mechanism described in the complainant's patent or patents, where more than one is embraced in the same suit. *Blanchard v. Putnam*, 8 Wall, 426.

Comparisons of the kind have been carefully made by the court, aided by the evidence of the expert witnesses, as exhibited in the record, and the court is of the opinion that the several inventions of the complainants, excepting the claims pointed out as not infringed, are embodied in the machines made and sold by the respondents. Two of the expert witnesses testify to that effect without qualification, and the reasons which they assign for that con-

clusion are, in the opinion of the court, decisive of the question. Some attempt was made in the cross-examination of those witnesses to elicit an answer that the sweep-rake employed by the respondents operated differently from the corresponding device of the complainants in the several reissued patents, but the attempt was wholly unsuccessful, and called forth explanations which confirm the conclusion that the two devices have substantially the same operation.

Special reference is made in the opinion of the district judge to the means employed by the respondents in supporting the reel, as showing that the machines which they have made and sold do not infringe the second claim of the original patent. His view is that their machines do not infringe that claim because they do not employ but one reel-post instead of two, as shown in the complainants' patent, but it is so obvious that the one post with the frame attached to the upper end is substantially the same thing that it is not deemed necessary to pursue the argument.

For these reasons we are all of the opinion that the complainants are entitled to a decree that their several patents are valid, and for an account and for a perpetual injunction, except as to such, if any, as have expired. Decree reversed with costs, and the cause remanded for further proceedings in conformity to the opinion of the court.

MILLER v. BRASS COMPANY.

(14 Otto, 350-356. 1881.)

APPEAL from U. S. Circuit Court, District of Connecticut.

Opinion by MR. JUSTICE BRADLEY.

STATEMENT OF FACTS.—This is a suit brought by Edward Miller & Co. against The Bridgeport Brass Company to restrain the infringement of a patent and for an account of profits, etc. The patent was for an alleged improvement in lamps, and was originally granted to Joshua E. Ambrose October 16, 1860, for fourteen years, and was extended for seven years longer. It was twice surrendered and reissued, once in May, 1873, and again in January, 1876. The court below dismissed the bill on the ground that the second reissue, No. 6844, on which the suit was brought, was not for the same invention which was described and claimed in the original patent. We agree with the circuit court in the conclusion to which it came.

§ 5323. *Letters patent No. 3038, granted to Joshua E. Ambrose October 16, 1860, for an improvement in lamps, declared void by reason of enlargement of the scope of the original and delay in reissuing.*

The original patent described a combination of devices; amongst other things two domes or reflectors, one above the other, elevated above a perforated cap through which a wick tube and a vapor tube ascended. It was claimed that this combination of devices, especially including the two domes, which admitted the external air between them for producing a more perfect combustion, would make a lamp which, without a chimney and without danger of explosion, would burn those hydrocarbons which are volatile and contain an excess of carbon. The invention proved a failure, but it was found that the use of one of the domes (and the other parts), with the restoration of the chimney, would be a real improvement, and both the complainant and the defendant made such lamps in large quantities. Fifteen years after the original patent was granted, the patentee (or rather his assignee) discovers that

the improved lamp was really a part of his original invention, and that by inadvertence and mistake he had omitted to claim it. We think, however, that the court below was clearly right in holding that the invention specified in the second claim of the reissued patent (which is the one in question here) is not the same invention which was described and claimed in the original patent. The latter was for a double dome without a chimney, the peculiarity of the supposed invention being the use of the double dome as a means of dispensing with the chimney. The reissue is for a single dome with a chimney. It is not only obviously a different thing, but it is the very thing which the patentee professed to avoid and dispense with.

§ 5324. *Right to correct by reissue a mistake, to the effect that the claims of an original patent are not broad enough, may be lost by unreasonable delay.*

But there is another grave objection to the validity of the reissued patent in this case. It is manifest on the face of the patent, when compared with the original, that the suggestion of inadvertence and mistake in the specification was a mere pretense; or if not a pretense, the mistake was so obvious as to be instantly discernible on opening the letters patent, and the right to have it corrected was abandoned and lost by unreasonable delay. The only mistake suggested is, that the claim was not as broad as it might have been. This mistake, if it was a mistake, was apparent upon the first inspection of the patent, and if any correction was desired, it should have been applied for immediately.

§ 5325. *Expanded reissue claims condemned.*

These afterthoughts, developed by the subsequent course of improvement, and intended, by an expansion of claims, to sweep into one net all the appliances necessary to monopolize a profitable manufacture, are obnoxious to grave animadversion. The pretense in this case, that there was an inadvertence and oversight which had escaped the notice of the patentee for fifteen years, is too bald for human credence. He simply appealed from the judgment of the office in 1860 to its judgment in 1876; from the commissioner and examiners of that date, to the commissioner and examiners of this; and upon a matter that was obvious on the first inspection of the patent. If a patentee who has no corrections to suggest in his specification, except to make his claim broader and more comprehensive, uses due diligence in returning to the patent office, and says "I omitted this," or "my solicitor did not understand that," his application may be entertained, and, on a proper showing, correction may be made.

§ 5326. *The making of a claim, and the omission to claim other matter apparent on the face of the patent, is a dedication to the public of the unclaimed matter.*

But it must be remembered that the claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed. It is a declaration that that which is not claimed is either not the patentee's invention, or, if his, he dedicates it to the public. This legal effect of the patent cannot be revoked unless the patentee surrenders it and proves that the specification was framed by real inadvertence, accident or mistake, without any fraudulent or deceptive intention on his part; and this should be done with all due diligence and speed.

§ 5327. *Effect of laches in reissuing a patent.*

Any unnecessary laches or delay in a matter thus apparent on the record

affects the right to alter or reissue the patent for such cause. If two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment, and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public. Nothing but a clear mistake, or inadvertence, and a speedy application for its correction, is admissible when it is sought merely to enlarge the claim.

§ 5328. *Office of a reissue. The statutes construed.*

The power given by the law to issue a new patent upon the surrender of the original, for the correction of errors and mistakes, has been greatly misunderstood and abused. It was first contained in the act of July 3, 1832, chapter 357, and the law was adopted in view of suggestions made in several judgments of this court. But it was carefully confined to cases where the patent was invalid or inoperative by reason of a failure to comply with any of the terms and conditions prescribed by the law for giving a clear and exact description of the invention, and where such failure was due to inadvertence, accident or mistake, without any fraudulent or deceptive intention. This being shown, a new patent, with a correct specification, was authorized to be issued for the same invention. The act of July 4, 1836, chapter 45, enlarged the power to grant reissues by adding an additional ground for reissue; namely, that the patentee had inadvertently claimed in his specification, as his own invention, more than he had a right to claim as new. And, with that addition, the law has continued substantially the same to the present time. The fifty-third section of the act of 1870, chapter 230, which was the law on this subject when the reissue in the present case was granted, is in the following words: "Whenever any patent is inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent, and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee."

It will be observed that whilst the law authorizes a reissue when the patentee has claimed too much, so as to enable him to contract his claim, it does not, in terms, authorize a reissue to enable him to expand his claim. The great object of the law of reissues seems to have been to enable a patentee to make the description of his invention more clear, plain and specific, so as to comply with the requirements of the law in that behalf, which were very comprehensive and exacting. The third section of the act of 1793, chapter 11, required an applicant for a patent "to deliver a written description of his invention, and of the manner of using or process of compounding the same, in such full, clear and exact terms as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings." This careful and elaborate requirement was substantially repeated in the sixth section of the

act of 1836, with this addition: "And shall particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery."

Although it had been customary to append a claim to most specifications, this was the first statutory requirement on the subject. It was introduced into the law several years subsequently to the creation of reissues; and it was in the thirteenth section of this act of 1836 that provision was made for a reissue to correct a claim which was too broad in the original. Now, in view of the fact that a reissue was authorized for the correction of mistakes in the specification before a formal claim was required to be made, and of the further fact that when such formal claim was required, express power was given to grant a reissue for the purpose of making a claim more narrow than it was in the original, without any mention of a reissue for the purpose of making a claim broader than it was in the original, it is natural to conclude that the reissue of a patent for the latter purpose was not in the mind of congress when it passed the laws in question. It was probably supposed that the patentee would never err in claiming too little. Those who have any experience in business at the patent office know the fact, that the constant struggle between the office and applicants for patents has reference to the claim. The patentee seeks the broadest claim he can get. The office, in behalf of the public, is obliged to resist this constant pressure. At all events, we think it clear that it was not the special purpose of the legislation on this subject to authorize the surrender of patents for the purpose of reissuing them with broader and more comprehensive claims, although, under the general terms of the law, such a reissue may be made where it clearly appears that an actual mistake has inadvertently been made. But by a curious misapplication of the law it has come to be principally resorted to for the purpose of enlarging and expanding patent claims. And the evils which have grown from the practice have assumed large proportions. Patents have been so expanded and idealized, years after their first issue, that hundreds and thousands of mechanics and manufacturers, who had just reason to suppose that the field of action was open, have been obliged to discontinue their employments, or to pay an enormous tax for continuing them.

§ 5329. *When a patent may be reissued with enlarged claim.*

Now whilst, as before stated, we do not deny that a claim may be enlarged in a reissued patent, we are of opinion that this can only be done when an actual mistake has occurred; not from a mere error of judgment (for that may be rectified by appeal), but a real *bona fide* mistake, inadvertently committed; such as a court of chancery, in cases within its ordinary jurisdiction, would correct. Reissues for the enlargement of claims should be the exception and not the rule. And when, if a claim is too narrow,—that is, if it does not contain all that the patentee is entitled to,—the defect is apparent on the face of the patent, and can be discovered as soon as that document is taken out of its envelope and opened, there can be no valid excuse for delay in asking to have it corrected. Every independent inventor, every mechanic, every citizen, is affected by such delay, and by the issue of a new patent with a broader and more comprehensive claim. The granting of a reissue for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant reissues, and may justly be declared illegal and void. It will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretense of inadvert-

ence and mistake, apply for such an enlargement of his claim as to make it embrace these new forms. Such a process of expansion carried on indefinitely, without regard to lapse of time, would operate most unjustly against the public, and is totally unauthorized by the law. In such a case, even he who has rights, and sleeps upon them, justly loses them.

The correction of a patent by means of a reissue, where it is invalid or inoperative for want of a full and clear description of the invention, cannot be attended with such injurious results as follow from the enlargement of the claim. And hence a reissue may be proper in such cases, though a longer period has elapsed since the issue of the original patent. But in reference to reissues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied; and no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent. And when this is a matter apparent on the face of the instrument, upon a mere comparison of the original patent with the reissue, it is competent for the courts to decide whether the delay was unreasonable, and whether the reissue was therefore contrary to law and void.

We think that the delay in this case was altogether unreasonable, and that the patent could not lawfully be reissued for the purpose of enlarging the claim and extending the scope of the patent.

Decree affirmed.

JAMES v. CAMPBELL.

(14 Otto, 356-385. 1871.)

APPEALS from U. S. Circuit Court, Southern District of New York.

Opinion by MR. JUSTICE BRADLEY.

STATEMENT OF FACTS.—This case is founded on a bill in equity filed by Christopher C. Campbell, the complainant below, against Thomas L. James, United States postmaster in and for the city of New York, to enjoin him from using a certain implement for stamping letters, which the complainant claims to have been patented to one Marcus P. Norton, by letters patent dated April 14, 1863, and surrendered and reissued on the 23d of August, 1864; and again surrendered and reissued on the 3d of August, 1869, and again, finally, on the 4th of October, 1870. The complainant claims to be assignee of Norton, the patentee. Other persons claiming an interest in the patent were made parties to the suit. The circuit court rendered a decree in favor of the complainant, and adjusted the rights of the several parties to the amount of the decree. The defendant James appealed. The other parties, not being satisfied with the decree as it affected their mutual interests, also appealed. The case is now before us in all its aspects. Supposing the court below to have had jurisdiction of the case, the first question to be considered will be the liability of the principal defendant, James, to respond for the use of the machine or implement in question.

§ 5330. *Government has no right to appropriate or use a patented article without compensation.*

That the government of the United States, when it grants letters patent for a new invention or discovery in the arts, confers upon the patentee an exclusive property in the patented invention which cannot be appropriated or used by the government itself, without just compensation, any more than it can appro-

priate or use without compensation land which has been patented to a private purchaser, we have no doubt. The constitution gives to congress power "to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries," which could not be effected if the government had a reserved right to publish such writings or to use such inventions without the consent of the owner. Many inventions relate to subjects which can only be properly used by the government, such as explosive shells, rams and submarine batteries to be attached to armed vessels. If it could use such inventions without compensation, the inventors could get no return at all for their discoveries and experiments. It has been the general practice, when inventions have been made which are desirable for government use, either for the government to purchase them from the inventors, and use them as secrets of the proper department; or, if a patent is granted, to pay the patentee a fair compensation for their use. The United States has no such prerogative as that which is claimed by the sovereigns of England, by which it can reserve to itself, either expressly or by implication, a superior dominion and use in that which it grants by letters patent to those who entitle themselves to such grants. The government of the United States, as well as the citizen, is subject to the constitution; and when it grants a patent the grantee is entitled to it as a matter of right, and does not receive it, as was originally supposed to be the case in England, as a matter of grace and favor.

§ 5331. *Mode of obtaining compensation for use by government of patented article.*

But the mode of obtaining compensation from the United States for the use of an invention, where such use has not been by the consent of the patentee, has never been specifically provided for by any statute. The most proper forum for such a claim is the court of claims, if that court has the requisite jurisdiction. As its jurisdiction does not extend to torts, there might be some difficulty, as the law now stands, in prosecuting in that court a claim for the unauthorized use of a patented invention; although where the tort is waived, and the claim is placed upon the footing of an implied contract, we understand that the court has in several recent instances entertained the jurisdiction. It is true, it overruled such a claim on the original patent in this case, presented in 1867; but, according to more recent holdings, it would properly now take cognizance of the case. The question of its jurisdiction has never been presented for the consideration of this court, and it would be premature for us to determine it now. If the jurisdiction of the court of claims should not be finally sustained, the only remedy against the United States, until congress enlarges the jurisdiction of that court, would be to apply to congress itself. The course adopted in the present case, of instituting an action against a public officer, who acts only for and in behalf of the government, is open to serious objections. We doubt very much whether such an action can be sustained. It is substantially a suit against the United States itself, which cannot be maintained under the guise of a suit against its officers and agents except in the manner provided by law. We have heretofore expressed our views on this subject in *Carr v. United States*, 98 U. S., 433, where a judgment in ejectment against a government agent was held to be no estoppel against the government itself.

But as the conclusion which we have reached in this case does not render it necessary to decide this question, we reserve our judgment upon it for a more fitting occasion.

§ 5332. *Reissue No. 4143, October 4, 1870, and original patent No. 38,175, M. P. Norton, April 14, 1863, hand-stamp, considered.*

The subject-matter of the patent on which the bill in this case was founded is an implement or stamp for postmarking letters and canceling revenue and postage-stamps. The original patent, dated April 14, 1863, exhibited two stamps connected together by a cross-bar which was attached to a handle; one stamp being intended for printing the postmark, and the other for canceling the postage-stamp,—both operations being performed by a single blow. The stamps consisted of small hollow blocks, or cylinders, in which were inserted and fastened the types which produced the impressions desired. In one were placed the lettered types which produced the postmark, and in the other a single type which blotted or canceled the postage-stamp. The patentee, in his specification, described the invention as follows:

“The nature of my improvements, herein described, consists in the employment and combination of a device for canceling postage or other stamps by means of wood, cork, or similar material inserted in a tube or recess therein, for the purpose of effacing or blotting such stamps with indelible ink. It also consists in the combination of a canceling device, having wood, cork, rubber, or any similar material for the type or blotter therein, with any postmarking device, so as to blot, cancel or efface postage-stamps with indelible ink at the same time and operation of postmarking of letters, packets, etc., etc.

“To enable others skilled in the art to which my invention relates to make and use the same, I will here proceed to describe the construction and operation thereof, which is as follows, to wit: I construct the postmarking stamp (D) of any suitable material. (E), Figure 3, is the mortice or recess of suitable dimensions to receive the type for the month, the day of the month, and the year, around which is the name of the place where used, and is the same as the postmarking device described in my letters patent, bearing date the 16th day of December, 1862, and which is secured to the cross-piece (B) in the same manner and by the same means as described and set forth in the said patent, which is also the case with the canceling device (C).

“I construct the canceling stamp or device (C) of any suitable material, of any size required in diameter, and in length to correspond to the postmarking device (D). (F), Figure 3, is the tube or recess in the device (C) for the purpose of receiving the blotting or canceling device (G), Figures 2 and 5, which device is made of wood, cork, rubber, or similar material, so as to closely fit the said tube or recess (F), Figure 3. The face of this device may contain a plan or form for canceling with indelible ink, like that shown at Figure 2, or it may have any plan or form for that purpose thought best to devise or use. This device (G) may project somewhat below the lower end of the said tube (F), as seen at Figure 5, and may also project below the face of the postmarking or rating device (D), Figures 2 and 3, and it may be driven out of the said tube or recess by means of a pin or bolt operating through the hole (A), Figures 3 and 5, for the purpose of repairs, or to replace it by a new one. The said tube or recess (G) may be any size in diameter required or any depth desired. The said canceling stamp or device (C) being thus constructed with cork, rubber, or other elastic substance for type or blotter, will receive and hold on the face thereof ink in quantities sufficient to blot or cancel the postage-stamp in such manner as to prevent the possibility of the said postage-stamp being cleansed of the canceling ink by any chemical or other process, for the said ink would be so effectually put thereon that any attempts to remove it there-

from would entirely destroy the said postage-stamp, and thereby render the same incapable of a second or re-use. The said cork, rubber, or other elastic substance, as aforesaid, will render the said stamp capable of an easy and rapid use, for there being a yielding of the same when the blow is given, the operator will not tire as soon by a constant or continued use of the same as though it were of solid metal, and the same will greatly aid in raising the entire stamp from the paper and postage-stamp when the impression shall have been given by the operator. The said blotter or type can be more easily repaired or replaced by a new one at less expense than if made of solid metal. The said cork, rubber, or other elastic material may extend upward to the said cross-bar (B), and there be connected to the same by a screw or pin-bolt, if desired, which will be the same in effect and in operation.

“Having thus described my invention and improvements in marking and canceling stamps, what I claim and desire to secure by letters patent of the United State of America, therein, is:

“1. The canceling device (C) with wood, cork, or rubber type or blotter (G) therein, or any device substantially the same, so as to cancel the postage-stamp with indelible ink, substantially as herein described and set forth.

“2. I also claim the canceling device (C) with wood, cork, or similar material forming the type or blotter (G) therein, in combination with the cross-piece (B), and with the postmarking device (D) substantially as herein described and set forth.”

We have given the description and claim in full for the purpose of better comparing it with the reissued patent on which the suit was brought, and which is dated October 4, 1870. It will be seen that the invention claimed is very specific and definite in its character. In the first place, the canceling device is claimed separately, consisting of a hollow tube, in which is inserted the canceling type or blotter made of wood, cork, rubber or other elastic substance. The nature of the substance of which the blotter was to be made is emphasized thus: “The said cork, rubber, or other elastic substance as aforesaid will render the said stamp capable of an easy and rapid use, for there being a yielding of the same when the blow is given, the operator will not tire as soon by a constant or continued use of the same *as though it were of solid metal*, and the same will greatly aid in raising the entire stamp from the paper and postage-stamp when the impression shall have been given by the operator. The said blotter or type can be more easily repaired or replaced by a new one at less expense *than if made of solid metal*.” It is plain, therefore, that elasticity in the material of which the blotter was to be composed was a distinctive feature of the blotting device thus separately claimed. Besides the advantages referred to in the foregoing extracts, its superior adaptability to hold indelible ink was evidently regarded by the inventor as important. From the facts appearing in the case, it is quite clear that a separate claim of this blotting device could not have been sustained had it not presented these special characteristics; had it not, in fact, contained all the elements it did contain. The patentee himself, as will be more fully seen hereafter, had, shortly before his application for this patent, obtained a patent for a double stamp exactly like the one patented in this, except that the blotter type was made of “steel, or other material which would answer the purpose.”

Of course he could not claim a blotter of like material in the patent now under consideration. And the record is full of evidence to show that hand-types for stamping letters and other characters with or without the use of ink

had long been constructed of almost every kind of material. The general form of the instrument was old. Stamps fastened to what is called a brad-awl handle, adjusted thereto centrally, so as to balance the pressure, were used for seals and other instruments for making impressions of every sort from time immemorial; and hand-stamps of the same general description, having a cylindrical type-holder in place of a seal, made hollow for inserting and holding the type, had long been used in the postoffice department. It was not without good cause, therefore, that the separate claim for the canceling device, as a distinct invention, was confined to an elastic type or blotter inclosed in a hollow tube. In like manner, the combination of devices in the entire instrument, forming the subject of the second claim, was necessarily specific in its character, being restricted by the special construction of the canceling device. The specific form of a cross-bar to sustain the type-holder, and balance the effect of the blow or pressure when making the impression, was substantially contained in the common hand-type, long before used for printing names on linen with indelible ink. This instrument consisted of a metallic trough or receiver to hold the type, the bottom of which, at its middle part, was attached to a wooden brad-awl handle. Inserting the types for a postmark in one end of this device, and the type for blotting the postage-stamp in the other, it would be a complete double stamp like that claimed by Norton, the patentee. The fact that it might require a stronger piece of metal for postoffice uses than was required for stamping letters on cloth, or that the type-holder would be better adapted to the purpose by being divided into two compartments, does not detract from the substantial similarity of the instruments. Given the idea of stamping the postmark and blotting the postage-stamp with one instrument at a single blow, it required but little invention, in view of what was then in common use, to adjust the printing apparatus to the handle by means of a block, shoulder or cross-bar, or other similar device. The needs and requirements of the instrument would soon be developed, and manifest themselves to any skilled workman in that branch of mechanics.

The evidence does not show to our satisfaction that Norton was by any means the first inventor of a double postoffice stamp, so constructed as to make the postmark and cancel the postage-stamp at one blow. If that fact was important, the burden of proof was on the complainant to show that Norton's invention antedated those of others proven in the cause, of which there were several independent of each other. But there is no satisfactory proof that Norton ever produced, prior to 1862, or, at most, prior to 1861, any other double stamp than one which he patented in 1859. In connection with one C. A. Haskins, he obtained a patent in October, 1857, for a hand-stamp attached to a standard with a projecting arm, and provided with a spring to lift it from the paper automatically, after the blow which made the impression was given. This stamp was an elaborate and complicated contrivance of wheels and cylinders for arranging and manipulating the types for making letters and figures showing the month and day of the month in the postmark. It had no hint of any secondary apparatus for effacing a postage-stamp at the same time. But in August, 1859, Norton obtained a patent for the use of his assignees, Reynolds and Low, which did contain a device for effacing the postage-stamp. Low seems to have been associated with him in the patent of 1857 in the way of furnishing money, but what was the nature or extent of the assignee's real interest in the patent of 1859 is not made to appear. The application for this patent was dated May 3, 1859, but when filed in the patent

office is not shown. The principal feature of the stamp described in this patent was also an elaborately contrived device for arranging the types for the letters and figures in the postmarking stamp, something in the same line with that described in the patent of 1857; no claim for which, however, was allowed. But to the postmarking stamp, which was fixed to the handle in the ordinary way, was attached, on one side, entirely outside of the bearing of the handle, a flat piece of metal to be used as a blotter, for which, in combination with the postmarking stamp, a claim was allowed. It is clear to us that this was the stamp to which Norton alluded, and which he asked to have the privilege of testing in the postoffice at Troy, in his letter to the assistant postmaster-general of the 11th of April, 1859, on which much stress has been laid by the complainants. The letter does not give a description of the stamp he wished to test, but it concludes with these words: "I herewith inclose you an envelope containing a postmark from the stamp on the left, and an erasure upon the stamp made at the same operation of postmark. As *now* constructed, is believed to work well."

This is a clear intimation that what he desired to have tested had been recently brought to its existing form. In a former part of the letter he had said: "While the order given by your department was in force, I was unable, in consequence of sickness, to thoroughly test my stamp. It was used upon about three thousand letters only during that time. I have since made some changes in it which seem to make it a much better thing for the purpose designed. Now I ask the opportunity to test it without any expense to the government." An order was made by Mr. King, the assistant postmaster-general, on the 4th of May, 1859, authorizing the postmaster at Troy to use for postmarking letters at his office for the term of three months, "Norton's improved marking stamp." The application for the patent had been prepared and sworn to the day previous to this order, namely, May 3, 1859. In this application the description of the invention commences thus:

"The nature of my invention consists in constructing, combining and arranging a hand-stamp, hereinafter described, so as to contain a cylinder with initials of each and every month in a year, and two other cylinders with figures for the respective days of each and every month; also a cylinder with figures to represent ten years, more or less, as the case may be, which cylinders shall revolve upon the same shaft with each, and within a stationary form of type, and thereby print the month, the day of the month, and the year in connection with each, and each in connection with and at the same time of the printing of the subject-matter upon the aforesaid stationary form of type. It also consists in attaching a blotter, hereinafter described, to the hand-stamp aforesaid, upon one or two sides thereof, for the purpose of cutting, blotting, canceling or effacing 'the frank' or postage-stamp, so as to prevent a second use of the same, while at the same time the name of the 'postoffice,' the year, the month, and the day of the month is printed upon the envelope and one side of the said frank or postage-stamp, thereby giving a good impression of the same, and prevent undue wear of the said postmarking-stamp in consequence of being used upon the uneven surface made by the said frank or postage-stamp."

Now, if Norton had, as he pretends, invented, as early as 1854, the stamps for which he took out his subsequent patents in 1862 and 1863, it is hardly conceivable that he should have taken out the patents for 1857 and 1859 in the form in which they stand. The fact that he did take them out reduces it almost to a demonstration that he had not invented any such stamps at this time.

It is true, he produces a caveat filed by him in 1853, which has, or had, an amendment bearing date "Tinnmouth, Vt., August 7, 1854," which amendment contained a full description of the double stamp as finally exhibited in his patent of 1863, and the reissue thereof. But this amendment was shown to have been surreptitiously introduced by him, amongst the papers of the office, certainly as late as 1864, ten years after its pretended date. In his examination as a witness in this cause he admitted that he made the paper referred to in the summer of 1864, when his assignees, Shavor and Corse, were applying for a reissue of the original patent now in question, and that it was used in that application; but he pretends that it was a copy of a paper which he made and sent to the patent office in 1854. No such original paper, however, has ever been found in the patent office, and on a regular charge for the offense of making the surreptitious paper, and introducing it amongst the files, he was found guilty in September, 1871, and debarred, by order of the commissioner of patents, from further access to the papers of the office.

This amendment caveat, therefore, as well as the testimony of Norton on the subject, may be laid out of view.

A witness by the name of Sherwood, a machinist and model-maker, was examined, who produced a sheet or two of items of account, copied from his books, showing charges against Norton for work on "stamps" in 1857, 1859, 1860 and 1862. There were four items in 1857 under date of May, for certain hours of work, charged thus: "May 8. To three hours, finish stamp." There was a large number of items of similar character in the other years named, particularly in January and March, 1859, and August, September, November and December, 1862, corresponding, as will be observed, with the times when Norton must have been getting up his models for his different patents. The witness was unable to distinguish the kind of stamps he worked on at these different dates, except that he professed to feel quite sure that the first one would postmark a letter and cancel a stamp thereon at the same time. Describing, on his cross-examination, the stamp which he thus referred to, he says: "It was a dating wheel stamp, the wheels giving the dates, with a die for the office and year in the top of the frame that held it, blotting or canceling at one end the impression given by a blow on the lever by the hand." Now this description applies aptly to both the stamp patented in 1857 and to that patented in 1859, except that it was the latter only which had the blotting attachment. We think it perfectly apparent that the witness had, by a very natural mental process, confounded the instruments together, and imagined that the blotter was attached to the first instead of the second invention. His examination took place twenty years after the date of the accounts, and he relied solely on his memory as to the character of the articles which he worked upon.

This is really the strongest evidence that can be found in the record affording any ground for the conclusion that Norton ever produced any double stamp at all prior to the one he patented in 1859. The testimony of Mr. King, the former assistant postmaster-general, when compared with his own contemporary letters and other circumstances, clearly indicates that he had, quite naturally, confounded the device of one date with that of a later date. Other evidence was relied on, but all of such a loose and indefinite character that no reliance can be placed on it in support of the complainant's theory. And it is quite significant that no stamp of the kind claimed, made at the period in question, was produced in the examination. Had such stamps ever been in existence, it is strange that they should have altogether disappeared.

Now, there is abundant evidence in the record to show that double stamps were conceived of and used before 1859, and that about that time they sprung up spontaneously in various parts of the country. It was but recently that there had been any demand for their construction, since postage-stamps had not been in general use in the country for any long period. They were first authorized to be issued and used by the act of March 3, 1847, chapter 63 (9 Stat., 188); but it was optional to use them or not. By the act of March 3, 1851, chapter 20, postage on single letters was reduced from five cents to three on being prepaid. 9 Stat., 587. It was not till the passage of the act of March 3, 1855, chapter 173, that all postage, except on letters to or from a foreign country, was required to be prepaid. This law first brought postage-stamps into universal use; and, as they must be canceled, two impressions had to be made on a letter — one for the ordinary postmark, giving the place and date of mailing the letter; the other for canceling or effacing the postage-stamp. This required two blows and produced double work. But without any great exercise of ingenuity, postmasters and clerks in various places improvised double stamps, generally by screwing, welding or binding to the side of the common stamp an appendage to serve as a blotter at the same time. This was done by Ezra Miller, at Janesville, Wisconsin, as early as January, 1859, or in 1858; and by General Dix in New York, and one Powers in Buffalo, in the summer of 1860. There is also evidence that a similar appendage for the purpose of stamping a large figure 5, to show the postage due, was invented and used by one Rees in the Philadelphia postoffice as early as 1845, when the rates of postage were five and ten cents; and that one Ireland devised and used at the same office a like appendage for canceling postage-stamps as early as 1853. Other similar devices were referred to in the evidence. The adoption of a more artistic and convenient form of the instrument thus spontaneously originated, as its use was continued and became more imperative, was a matter of course. Norton's particular form and construction of the double stamp, as described in his patent of 1863, was undoubtedly an improvement; but we should expect to find, as we do find, that he was restricted in his claim to the particular form and construction set forth in his specification.

A reference to Norton's application for the original patent in question in this case, a copy of which is in evidence, and which, being preserved of record in the patent office, may properly be referred to, shows that the functionaries of that office regarded it important that the instrument sought to be patented should be specialized with particularity. This application was presented to the office on the 5th of January, 1863, and was rejected on the 21st of February. On the 21st of March, 1863, the application was renewed in a letter addressed by Norton to the commissioner of patents, and after certain amendments were made to the specification, the patent was allowed to pass. The most important amendment was the insertion of that portion of the specification commencing with the words, "the said canceling stamp or device (C) being thus constructed with cork, rubber or other elastic substance for type or blotter," and so on, to the end of the paragraph. This amendment derives further importance and illustration from the letter of Norton above referred to, in which a renewal of the application was made, and which was dated at the National Hotel in Washington, March 21, 1863. In that letter the writer says:

"I do not understand that the device referred to in your letter of the 21st of February last is 'a common ink canceling stamp, such as has been used for years in our postoffices for blotting and thus canceling postoffice stamps.'

The devices to which you undoubtedly refer have always been made of metal entirely, or of wood entirely. Wood was found to answer no purpose, because not at all durable, so metal ones were used. *Now this device consists of a barrel or tube, into which wood, cork, rubber, or some such material is inserted, for the purpose of holding an indelible ink in quantities sufficient to blot the postage-stamp so thoroughly as to prevent the same being washed or cleansed by a chemical mixture and again being used in payment of postage. This tube or barrel holds firmly the elastic substance therein, and prevents the same from undue wear and exposure. The elastic substance therein being worn out can again be replaced at the office where used, thus saving the trouble and expense of returning the same to the government contractors for such repairs. This, therefore, constitutes a new device, composed of two distinct parts in combination, producing new results, besides blotting the postage-stamp.*

“This device being new, its combination with the postmarking device for the purposes set forth in the specification is of course new. Upon these two claims I, therefore, most respectfully ask a patent.”

On the same day that this letter was received, according to the memorandum on the file-wrapper, the specification was returned to the applicant to enable him to amend it, and was re-examined on the 26th of March, and favorably passed upon on the 1st of April. No one can read the patent in the light of these contemporary documents, and of the previous history of the stamp, without arriving at the conclusion that, so far as the blotting device was separately concerned, the invention consisted of, and was confined to, a tube containing a type-blotter made of an elastic substance, as contradistinguished from iron or other hard substance. The iron or steel blotter had been patented in 1862, as already mentioned, and as will be shown more fully hereafter. There was not, there could not have been, any inadvertence or mistake in confining the invention to the combination described and claimed in the patent.

The second claim is merely that of a combination of this specific device with the other parts of the apparatus. As the patentee says, in his letter to the commissioner, “this device being new, its combination with the postmarking device for the purposes set forth in the application is of course new.” In other words, the substantive invention for which the applicant desired a patent was the blotting device constructed specifically in the manner and for the purpose described. The addition of the combination claim was for the purpose of possibly securing the combination, if the principal claim should be found to be untenable.

§ 5333. *A patent cannot be reissued in order to expand the claim beyond the invention specified in the original patent.*

Perhaps we have gone more minutely into the evidence relating to the progressive improvements in this instrument than was necessary to show that the claim of the patent was not more restricted than it should have been. The court ought not to be called upon to explore the entire history of an art in order to ascertain what a patentee might have included in his patent had he been so disposed. If he was the author of any other invention than that which he specifically describes and claims, though he might have asked to have it patented at the same time and in the same patent, yet if he has not done so, and afterwards desires to secure it, he is bound to make a new and distinct application for that purpose, and make it the subject of a new and different patent. When a patent fully and clearly, without ambiguity or obscurity, describes

and claims a specific invention, complete in itself, so that it cannot be said to be inoperative or invalid by reason of a defective or insufficient specification, a reissue cannot be had for the purpose of expanding and generalizing the claim so as to make it embrace an invention not described and specified in the original. It is difficult to express the law on this subject more aptly and forcibly than in the words of Mr. Justice Grier, in the case of *Burr v. Duryee*, 1 Wall., 531, where, in delivering the unanimous opinion of the court, he says: "The surrender of valid patents, and the granting of reissued patents thereon, with expanded or equivocal claims, when the original was clearly neither 'inoperative nor invalid,' and whose specification is neither 'defective nor insufficient,' is a great abuse of the privilege granted by the statute, and productive of great injury to the public. This privilege was not given to the patentee or his assignee in order that the patent may be rendered more elastic or expansive, and, therefore, more 'available' for the suppression of all other inventions." Of course, if, by actual inadvertence, accident or mistake, innocently committed, the claim does not fully assert or define the patentee's right in the invention specified in the patent, a speedy application for its correction, before adverse rights have accrued, may be granted, as we have explained in the recent case of *Miller v. Brass Company*, 14 Otto, 350 (§§ 5323-29, *supra*). But where it is apparent on the face of the patent, or by contemporary records, that no such inadvertence, accident or mistake, as claimed in a reissue of it, could have occurred, an expansion of the claim cannot be allowed or sustained.

§ 5334. *The reissued patent considered.*

Turning now to the reissued patent on which the present suit was brought, which is the third reissue, dated October 4, 1870, we find the invention described as follows:

"The nature of my said invention and improvements herein contained and described consists in the employment and combination of a device or die used for the more complete and perfect cancellation of postage-stamps or letter-franks by means of soft wood used endwise, or of cork, rubber or other suitable material, whereby such stamp or frank is effaced and canceled, in and by indelible or other ink, in the manner substantially as herein described and set forth.

"It also consists in the combination of a postage-stamp canceling device or die, constructed of wood, cork, rubber or any suitable material, with any suitably arranged and constructed postmarking stamp or device, so as to cancel, efface or destroy the postage-stamp or letter-frank with indelible or any suitable ink at the same time, blow or operation of the stamp or instrument by which the postmark is given or made upon the letter, envelope or packet, substantially as herein described and set forth.

"It also consists of the postmarking of letters, envelopes or packets, and in the cancellation of the postage-stamp or stamps thereon, with, in or by any suitable ink or similar material, by means of some soft wood used endwise against the postage-stamp, or by the means of cork, rubber, iron or steel, or by means of any other suitable material, so combined with the postmarking stamp or instrument as to cancel, efface or destroy the postage-stamp or stamps at one and the same blow or operation of the entire instrument thus constructed for that purpose, whereby to prevent a second or re-use of such postage-stamp or stamps."

After some details as to the mode of construction, the specification proceeds:

“The said canceling type or die can be easily repaired, or replaced by a new one, whenever desired, and at very little expense; and such canceling die or type G may extend upward to the said cross-bar B, and there be connected to the same by means of a screw, pin or small bolt. *In such case there would not be any tube or pipe surrounding said canceling die or type G.* The operation and effect produced would in such case of construction be the same.

“The said postage-stamp canceling device, die or type G may be of any desired distance from the aforesaid postmarking or dating device or stamp D, or it may be securely *fastened to the immediate side* of the said postmarking and dating part or stamp or device D by any convenient and suitable mechanical means.

“The said canceling die, type or device G I prefer to use made of cork, as it will hold a much greater quantity of canceling ink upon and in the lower face thereof, and when it comes in contact with the printed surface of the postage-stamp such surface will become somewhat and sufficiently broken by means thereof, and thus and thereby inject into or impregnate such broken surface with the said canceling ink, whereby such postage-stamp, so operated upon and filled with such ink, cannot be sufficiently cleansed by any means as to enable it to be re-used, or used a second time, in fraud upon the postal revenue, without immediate detection of the same.

“Soft wood, used endwise, will answer nearly the same purpose. Still, long and continued use after the granting of my said patent, April 14, 1863, has fully proven the superiority of the cork for the canceling die or type used upon postage-stamps as aforesaid. . . .

“I also construct my said postage-stamp canceling device, die or type of *cast-iron, steel or other suitable metal*, substantially as shown at G', figures 5 and 6, and which may be secured to the said cross-bar or piece B in like manner as the said tube or cylinder C, figures 2 and 4, and which is done either by screw and nut where the same unites with the said cross-bar, or it may there be firmly fastened by means of suitably constructed and arranged pins or rivets, or the same may be soldered to the under side of said cross-bar or piece B, or otherwise attached thereto. . . .

“The *aforesaid metal canceling device, die or type G'*, figures 5 and 6, *may also be fastened or secured to the immediate side of the said postmarking device by any good and sufficient means*, substantially as hereinbefore described and set forth, in reference to the said device C, or tube or cylinder, constructed to receive and contain the said type or die G, figures 2, 3 and 4.

“Such metallic device, die or type may also have upon its lower face or lower surface any suitable configuration deemed best to use for the purpose of canceling the postage-stamp in, with or by any suitable ink, at the same time, blow and operation of the instrument or apparatus, as hereinbefore stated and set forth.

“In any and every case the postmarking of the letter, envelope or packet, and the effacing or cancellation of the postage-stamp or letter-frank thereon representing value, are done at the same time, and by the same blow or operation of the said several devices and parts, constructed and combined in the manner and by the means substantially as herein described and set forth.

“Both the postmarking and cancellation of the said postage-stamp are done

with indelible or other and suitable ink, used for such cancellation or effacing of the postage-stamp."

Omitting much more of this verbose specification, containing, amongst other things, a dissertation on the supposed advantages and importance of the invention, we add the summary of the patentee's claims, which is as follows:

"What I claim and desire to secure by letters patent of the United States of America is —

"1. The postage-stamp canceling device, cylinder or tube C, containing a die or type, G, made of cork, wood, *or other suitable material, or any equivalent for said cylinder or tube C, or for the said canceling die or type G*, whereby to efface, cancel or destroy the postage-stamp with indelible or other ink, in the manner and for the purposes substantially as herein described and set forth.

"2. The canceling device, cylinder or tube C, with cork or wood, or *any substantial equivalent* thereof, forming the die or type G therein, in combination with the cross-bar or piece B, and with the postmarking device D, substantially as and for the purposes herein described and set forth.

"3. *The postmarking of letters, envelopes and packets, and the cancellation of the postage-stamps* thereon with ink, at one and the same blow or operation of the instrument, in the manner and by the means substantially as herein described and set forth.

"4. *The employment and combination of a postmarking device, with a postage-stamp canceling device*, both being operated by one and the same handle, for the postmarking of letters, envelopes or packets, and for the cancellation of the postage-stamps thereon with indelible or other ink, in the manner substantially as herein described and set forth."

By these extracts from the specification and the summary of claims, it appears perfectly obvious that the patentee has embraced in the reissued patent several matters of supposed invention different from and additional to the invention which formed the subject of the original patent. And it is principally, if not wholly, these new and additional claims which the appellant James, as postmaster of New York, is charged with infringing.

In the first place, a new form of the canceling device is set forth and claimed, different from that described in the original patent, to wit, a canceling type or die attached directly to the cross-bar, without any tube or pipe surrounding and holding the same. This is not contemplated or hinted at in the original patent. The latter does suggest, it is true, that "the cork, rubber or other elastic material may extend upward to the cross-bar, and there be connected to the same by a screw or pin-bolt, if desired;" but this suggestion had reference to a type inclosed, at the same time, by a surrounding cylinder, which formed the distinctive feature of the invention. The context shows that nothing more was intended by the suggestion than the extension of the type upward through the cylinder and fastening it in a particular way. The thought seems to have occurred to the patentee that it might be an advantage, under some circumstances, in addition to fastening the type in the cylinder by compression, to extend it through the cylinder and fasten it to the bar to secure it from any danger of falling out of the cylinder by becoming loose. Not a hint was given that the cylinder could be dispensed with. This was an after-thought. The cylinder was clearly and distinctly set forth as a necessary constituent of the device, and an essential element in the combination of which the blotting device consisted.

The bearing which this new feature in the reissued patent has on the case is evinced by the fact that one of the devices used for several years in the post-office, which is complained of as an infringement of the patent, was a naked blotter made of cork, directly attached to the cross-bar, without any inclosing cylinder to support it; also by the fact that the other device used in the post-office during the defendant's term of office consisted of an iron blotter directly attached to the side of the postmarking stamp without any inclosing cylinder.

In our judgment, this addition to the patent was no part of the original invention, and could not lawfully be embraced in the reissue, and that the claim for it is therefore void. It is true that this particular feature is not made the subject of a distinct claim. But it is described as part of the invention, and would probably be included in the general and sweeping terms employed in the claims that are made. Regarded as not being a part of the original invention, those claims cannot stand if they are construed to include it; if they are construed so as not to include it, then the use of this form of device by the defendant cannot be adjudged an infringement of the patent.

Another new matter, forming no part of the original invention, but expressly disclaimed in the original patent, is the making of the blotter of cast-iron, steel or other suitable material. The original specification, in various forms of expression, excludes such materials. The words "wood, cork, rubber, or any similar material" have this intention, as shown by the context. A claimed advantage is that "the said cork, rubber or other elastic substance, as aforesaid, will render the said stamp capable of an easy and rapid use; for there being a yielding of the same when the blow is given, the operator will not tire as soon by a constant or continued use of the same *as though it were of solid metal*. The said blotter or type can be more easily repaired or replaced by a new one, at less expense, *than if made of solid metal*." This language amounts to an express disclaimer of solid metal. The merit claimed for the invention was that the elastic materials proposed to be used for the blotter, and the use of which the patent throughout supposes possible by the support received from the surrounding cylinder, were far superior to solid metal and other solid and inelastic substances. How, after this, it could be supposed that the use of solid metal as a material for the type-blotter was included in the invention, and that a claim for it was omitted through inadvertence and mistake, it is difficult to understand. Besides, as already seen, and will be again adverted to, the use of steel or other material that would answer the purpose had already been described and claimed in Norton's patent of 1862. We think that any claim in the reissued patent which can be fairly construed to embrace a blotter made of metal is void, and that the use of such a blotter by the defendant did not afford the patentee or the complainant any just ground of complaint.

In connection with this branch of the subject, it is observable that the patentee has added two new diagrams to his drawings for the purpose of exhibiting and illustrating this new ground of claim. This fact, though not decisive, is strongly corroborative of the conclusion which we have reached on the subject.

§ 5335. *A patent for a machine cannot be reissued for the purpose of claiming the process of operating that class of machines, because, if the claim for the process is anything more than for the use of the particular machine patented, it is for a different invention.*

The third addition in the reissued patent to the invention described in the

original is that of the *process* of stamping letters with a postmark and canceling the postage-stamp, at one and the same blow or operation of the instrument, in the manner and by the means described and set forth. Leaving out of view the history of the art prior to the invention claimed by the patentee, what possible pretense can there be for contending that the general process was part of the invention which formed the subject of the original patent? Suppose it be true that Norton was the first inventor of this process, was that process the invention which he sought to secure in the original patent? A patent for a process and a patent for an implement or a machine are very different things. *Powder Company v. Powder Works*, 98 U. S., 126. Where a new process produces a new substance, the invention of the process is the same as the invention of the substance, and a patent for the one may be reissued so as to include both, as was done in the case of Goodyear's vulcanized-rubber patent. But a process, and a machine for applying the process, are not necessarily one and the same invention. They are generally distinct and different. The process or act of making a postmark and canceling a postage-stamp by a single blow or operation, as a subject of invention, is a totally different thing in the patent law from a stamp constructed for performing that process. The claim of the process in the present case, however, is not so broad as this. It is for the process or act of stamping letters with a postmark and canceling the postage-stamp at one and the same blow or operation of the instrument, *in the manner and by the means described and set forth*. Perhaps this claim amounts to no more than a claim to the exclusive use of the patented instrument or device. If it is anything more, it is for a different invention from that described in the original patent. If it is not for anything more, the question is brought back to the instrument or device itself which forms the subject of the patent, and which has been already considered.

The last claim, to wit, "the employment and combination of a postmarking device with a postage-stamp canceling device, both being operated by one and the same handle, for the postmarking of letters, envelopes, or packets, and for the cancellation of the postage-stamps thereon with indelible or other ink, in the manner substantially as herein described and set forth," may admit of two constructions. It may either amount to a claim for a combination of any kind of devices for stamping and blotting, or for a combination of the particular devices described in the patent. Inasmuch as these specified devices, as we have already shown, embrace new devices not described in the original patent, the claim is too broad in either of its aspects to be advanced in a reissue of that patent, unless the patentee was really the inventor of the general combination of such devices in a double stamp, and was entitled to add a claim therefor to such reissue. We have seen that his original patent was for a specific blotting device, and for the combination of such specific device with a post-stamping device in the same instrument. Could he, in a reissue of the patent, lawfully make the broad claim of the combination of any and all devices for blotting and post-stamping, at one and the same time, in one and the same instrument? This would be, it is true, only adding a new claim to his patent, but greatly enlarging its scope and making it to embrace every kind of double stamp that can be conceived. Did he forget to insert this claim in his original patent? Was it omitted through accident and mistake? When we examine his original application, the changes it underwent, the careful exclusions as well as inclusions which it contained, and the particularity of the specific combination which he did claim, could he, after the lapse of more than

a year (if we take the date of his first application for a reissue as the time for consideration), be allowed to return to the patent office and pretend that he had inadvertently omitted the principal claim of the whole thing? If he was, or pretended to be, really the inventor of the entire double stamp, did not the patent, on its face, show that the invention was not secured to him,—that it contained no such claim? And was not this omission obvious on inspection? The truth is, that when he made his original application, and got his original patent, all the documents show demonstrably that he did not intend it to embrace any such broad invention. That was not the invention he sought to secure. Having obtained a patent for his specific device and combination, if he afterwards wished to claim the general combination, and had not already abandoned it by taking a narrower patent, he was bound to make a new application for that purpose. Patentees avoid doing this when they can, and seek to embrace additional matters in a reissue, in order to supersede and get possession of the rights which the public, by lapse of time or other cause, have acquired in the meantime. It is for this very reason that the law does not allow them to take a reissue for anything but the same invention described and claimed in the original patent.

But these broad claims in the reissued patent, if construed according to the latitude in which they are expressed, are void by reason of embracing inventions which had been patented both in England and in this country prior to the patentee's application for the original patent.

A stamp with a postmarking device and a blotting device combined in one instrument was described in an English patent, dated April 24, 1860, granted to one David G. Berri. As shown in the drawing, the postmarker and blotter were attached to one metallic plate, analogous and equivalent to the cross-bar described in Norton's patent, to the center of which plate the handle was attached, so that the instrument was equally balanced. The particular object of the patent was to secure a method of hinging the plate containing the types on to the fixed plate to facilitate the insertion and change of the types. But the double stamp is fully exhibited; and the patentee in the specification says: "In conclusion to the foregoing description, it may be here necessary to note that my improved date-stamp may be employed, either in connection with the double or obliterating mark, as represented, or separately, in conformity with the usual requirements."

The same combination of postmarker and blotter in one instrument was also exhibited in Norton's own patent of August 9, 1859. As he did not then reserve the process of stamping letters with such an instrument, nor the combination of a postmarker and a blotter, and did not make any simultaneous application therefor, he could not afterwards obtain a patent for such process and combination, but would be restricted to such particular combination or process as might be exhibited in a new device or apparatus.

We have already referred to this patent of 1859, and will here only quote from the specification, to show the construction of the stamp and the scope which the patentee claimed his invention to possess. He says:

"*The blotter* (J) is fastened to the frame (B) upon one side thereof by the use of the shaft (D), one end of which passes through the upper part of the said blotter, and which is firmly secured to the said frame by means of the nut (E), or by using it for the nut in place of the said nut (E) as aforesaid. This blotter is then and thereby retained in a fixed and strong position by means of the screw (S) in connection with the said shaft (D), the blotter (J)

or nut (E), and is for the purpose of cutting, inking, blotting, effacing and effectually canceling the frank or postage-stamp, while, at the same time and operation, the name of the postoffice, the year, the month and the day thereof are given upon the envelope or letter at one side of the said frank or postage-stamp, and not upon it as now practiced, in order to efface and to cancel it under the operation of stamping, which unduly wears out the marking stamp, gives a bad and unintelligible impression, and is in direct violation of the rules or statute of the postoffice department. This stamp may have another blotter like (J), which shall be upon the opposite side thereof, by the use of which the frank or postage-stamp would be cut, inked, blotted, effaced and canceled upon any part of the letter or envelope where it may be placed. One blotter like (J), however, is believed to answer the required purpose. *This blotter (J) may be made of any size or shape, and of any material to answer the end or purpose sought to be obtained.* The face, which receives the ink, and which comes directly upon the frank or postage-stamp, is grooved or cut, thereby leaving various projections, which have a sharp or knife edge sufficient for each to cut entirely through the frank or postage-stamp, but not through the envelope immediately under the same, while at the same time the places thus cut are inked by the same sharp-edged projections or cutters on the face of the said blotter as aforesaid. The said blotter (J) should be made of the best kind of *cast-steel*, and in such shape as not to break any part thereof. The projections upon the face of the said blotter may be kept sharp and in cutting order by filing and sharpening them when dull."

The claim of this patent is as follows:

"Having thus set forth and described my invention, what I claim and desire to secure by letters-patent of the United States is:

"The blotter (J), connected or attached to the main part of any 'postoffice postmarking stamp' for the purpose of cutting and inking, blotting and effacing so as to successfully cancel the frank or postage-stamp of any letter or any package at the same time and operation of marking or printing upon such letter or package the name of any postoffice, the year, the month and the day of the month, substantially as and for the purpose herein set forth."

Another patent was taken out by Norton on the 16th of December, 1862, for a double stamp, containing a combination of the postmarker and blotter and the cross-bar connecting them, and to which they were attached. The drawings attached to this patent exhibit exactly the same form of instrument which is exhibited and described in the drawings and specification of the patent sued on in this case. The blotter, however, instead of being confined to wood, cork or other elastic material, was proposed to be made of "steel or other material which will answer the purpose," and to have on its face circular cutters, inclosed in circular rings, to cut the postage stamp at the same time that it defaced it with ink. The invention is described in the specification as follows:

"The nature of my improvement consists in so constructing canceling stamps that the same shall cut the postage-stamp, or any stamp similar thereto, without injury to the contents of the envelope or packet inclosed therein, and at the same time cause a heavy circular mark upon the inside, and one upon the outside of that part of the stamp or letter-frank canceled by the cutting device, so that said postage-stamp or letter-frank shall readily show cancellation in ink, and when removed from the letter or packet on which the same may have been canceled, it shall be reduced to parts or pieces whereby a sec-

ond use of the said stamp or frank is thus prevented, although it may have been previously cleaned by a chemical or other process.

"It also consists in the employment and combination of a canceling stamp with a cutting and inking device thereon, with a postmarking or rating stamp, so that the canceling of the letter-frank and the postmarking on the envelope or packet shall be effectually done by the means fully described hereinafter.

"To enable others skilled in the art to which my invention relates to make and use the same, I will here proceed to describe the construction and operation thereof, which is as follows, to wit: I construct the postmarking stamp (D) of steel or any material which will answer the purpose. (G) is the mortice or opening to receive the type for the month, the day of the month, and the year, around which is the name of the place where used. (E) is a screw for the purpose of holding the type in the said openings (G). This stamp is secured or firmly fastened to the block or cross-piece (B), figures 1, 2 and 3, by means of the screw (K), which is held in its place by means of the small screw (a), figures 1 and 2, which is placed near one side of the said screw (K) so as to prevent the same from becoming loose by reason of turning backwards."

After further directions as to the construction of the canceling stamp, he adds:

"The cross-piece (B) is made of iron or steel, and in width the same as the diameter of the said rating and canceling stamp, and of any thickness required. The said canceling stamp (c) is securely fastened to the said cross-piece (B), and at any desired distance from the said rating stamp (D), as seen at figures 1, 2 and 3, and in the same manner as that of the said stamp (D). (H) is a screw-bolt or stem, the lower end of which is screwed into the center of the said cross-piece (B). The handle (A) is then screwed upon the said bolt or stem (H), and firmly upon the said cross-piece (B), thereby making a strong and reliable joining of the handle to the whole stamp."

The claim in this patent is, first, for the canceling stamp separately, and secondly as follows:

"I also claim the combination of the canceling stamp (c) and the postmarking or rating stamp (D) with the cross-piece (B), substantially as and for the purposes herein described and set forth."

§ 5336. *A patentee cannot include in a subsequent patent any invention embraced in a prior one granted to himself.*

It is hardly necessary to remark that the patentee could not include in a subsequent patent any invention embraced or described in a prior one granted to himself any more than he could an invention embraced or described in a prior patent granted to a third person. Indeed, not so well; because he *might* get a patent for an invention before patented to a third person in this country, if he could show that he was the first and original inventor, and if he should have an interference declared.

Now, a mere inspection of the patents referred to above will show that after December, 1862, Norton could not lawfully claim to have a patent for the general process of stamping letters with a postmark and canceling stamp at the same time; nor for the general combination of a post-stamper and blotter in one instrument; nor for the combination of a post-stamper and blotter connected by a cross-bar; for all these things, in one or other specific form, were exhibited in these prior patents.

Any such claim, therefore, in the reissued patent of 1870 must be inoperative and void, as well because the thing claimed was anticipated in former

patents, as because it would be for a different invention from that contained and described in the original patent. We may, therefore, dismiss from consideration the third and fourth claims of the reissued patent. If they are to be construed as being broader and claiming more than the original patent, they are void; if to be construed as claiming nothing more, they are simply redundant, because the first and second claims embrace all that was in the original, and more.

The case, then, upon the patent, is narrowed down to the claim of the specific device of the blotter as described and claimed in the original patent; and the combination thereof with the postmarking device in one instrument by means of the cross-bar. This being the case, it will be pertinent next to inquire whether the defendant used that device or combination. If he did not, it is unnecessary to pursue the subject further.

As we have already seen, the canceling stamp or device, described in the patent, consisted of a cylinder, corresponding in length to the postmarking device, and containing a type of wood, cork, rubber, or other elastic material, slightly projecting therefrom. It does not appear that this device was ever used by the defendant. The stamp used by him until January, 1876, had a blotter of cork, it is true; but it was not the specific device described in the patent, and to which the patent was restricted. The cork was not inclosed in a cylinder as demanded by the patent. It was a naked piece of cork directly attached to the cross-bar by a common wood screw, passing through a hole in the cross-bar, and driven into the cork, firmly holding it to the bar. This device, of course, was different from that which was patented. The only other stamp used by the defendant had a steel blotter, connected with the postmarker by a solid metallic plate or mass of metal, and having no cylinder. Neither of these devices infringed the complainant's patent, construed as we consider it must be in order to have any validity at all.

The decree of the circuit court will be reversed, and the cause remanded with directions to dismiss the bill of complaint; and it is so ordered.

Dissenting opinion by MR. JUSTICE MILLER.

As regards the right to a patent for an invention like this, which can be of use to no one but the government of the United States, and which is, therefore, in effect a contract by the United States that it will not use that which is essential to some of its most important operations without paying to the patentee whatever he may demand for the use of his invention, I have great doubt,—a doubt which it would have been necessary to solve in this case if the majority of the court had believed the patent sued on valid. In the opinion just delivered they have held that while the original patent to Norton might have been valid for some purposes, the reissued patent is void because it is not for the same invention. In this view I do not concur.

The general postoffice and its branches had long been in search of an instrument which by one blow—one strike of the hand—would mark the name of the place where a letter was mailed and the time, and so deface the postage-stamp on the letter as would make it impossible to be used again. This had been done by the use of a single die, which held the type indicating date, etc., and which was made to cover the stamp also, so that the date obliterated the stamp by covering it. For reasons not necessary to mention this did not answer, and it became desirable to have an instrument which at one stroke defaced the stamp and made beside, but apart from the stamp, the postmark date.

Many attempts to do this had been made with more or less success. Most of them failed because the handle which conveyed the power from the hand of the operator was so placed in regard to these two marking instruments that they did not strike with entire unity, in point of time, on all the space of the letter to be covered by the two instruments. In my opinion the record shows that Norton was the first man to accomplish this result by uniting these two marking instruments by a cross-bar between them, and placing the shank or handle common to them both so precisely in the center between them on the cross-bar that the stroke brought the type and the obliterating device on to the surface of the paper precisely level, and with precision as to time, over the space which they were designed to cover.

This, I think, was the principal merit of his invention. Connected with it, however, and essential to it, was his device for obliterating the stamp. In his original patent this is described as a cylinder into which is fastened something which receives the indelible ink used to obliterate the stamp, and which imparts it to the surface of the stamp by the blow or strike already mentioned. This, he said in his original patent, was made of wood, cork, rubber or other suitable material.

It was discovered, by experience, afterwards, that iron was a more suitable material than wood, or cork, or rubber, and in the reissue of the patent, on which this action is founded, iron is mentioned as one of these suitable materials. I do not think this should invalidate the reissue if the original patent was good. If iron was a suitable material it was covered by the original patent. If better than the material specifically named, that did not exclude it from the original patent nor make the reissue void.

Nor do I concur in the opinion that the combination of the printing and erasing instrument by a cross-bar and shank or handle, which brought the force employed in the stroke to act equally and simultaneously on all the surface to be impressed, was anticipated by any other patent or any other invention.

It would serve no good end to go into all the testimony with the elaborate care which characterizes the opinion of the court on these disputed points. I therefore content myself with stating the principal points in which I differ with that opinion.

Reissues — Statutes, construction of — *Act 1793*, §§ 5337, 5338. *Act 1832*, § 5339. *Act 1836*, §§ 5340-5350. *Act 1870*, §§ 5351-5353. *Act 1871*, §§ 5354, 5355.

§ 5337. Power of secretary of state, under act 1793, to grant reissues on surrender of patent with defective specification through inadvertence or mistake, without fraud on patentee's part. *Grant v. Raymond*, 6 Pet., 218.

§ 5338. In a patent reissued under act 1793, it is not necessary to recite that all prerequisites were complied with. The law makes the presumption. *Phila. & Trenton R. Co. v. Stimpson*, 14 Pet., 448.

§ 5339. Act 1832, section 3, "infringement of reissue," construed. *Stimpson v. Railroad Co.*, 4 How., 380.

§ 5340. Reissue under act 1836. Purpose of the act. *Burr v. Duryee*, 1 Wall., 531.

§ 5341. Act 1836, section 13, "reissue," construed. *Stanley v. Whipple*, 2 McL., 35. *Carver v. Braintree Mfg. Co.*, 2 Story, 432.

§ 5342. Act 1836, section 13, "conclusiveness of commissioner's action in granting reissue," reviewed. *Allen v. Blunt*, 3 Story, 742.

§ 5343. Act 1836, section 13, commissioner's power to reissue an extended patent, considered. *Gibson v. Harris*, 1 Blatch., 167.

§ 5344. A reissue is clearly grantable under ruling in *Grant v. Raymond*, 6 Pet., 218, and act 1833, chapter 162. *Ames v. Howard*, 1 Sumn., 482.

§ 5345. Act 1836, section 13, "reissue by assignee of patentee's executor," construed. *Carew v. Boston Elastic Fabric Co.*, 1 Holmes, 45.

§ 5346. Act 1836, establishing a new system of reissues, by defining the conditions under which the power it confers shall be exercised, necessarily excludes all other cases, except, possibly, correcting errors of the department. *Mini's Assignees v. Adams*, 3 Wall. Jr., 20.

§ 5347. Statute provision of act 1836 as to reissues is remedial and, like all remedial statutes, is to be construed liberally so as most effectually to meet the beneficial end in view and prevent a failure of the remedy. *Carew v. Boston Elastic Fabric Co.*, 1 Holmes, 45.

§ 5348. The law of 1836 has been construed to authorize a patentee to claim on a reissue whatever shall clearly appear to have been a part of his original invention, as described or shown in his original specifications, drawings or models. *Calkins v. Bertrand*, 6 Biss., 494.

§ 5349. Under the law as it stood in 1866, a patent surrendered for reissue was canceled in law as well when the application was rejected as when it was granted. The patentee was in the same circumstances as he would have been if his original application for a patent had been rejected. *Peck v. Collins*, 13 Otto, 660.

§ 5350. Under the law as it then stood, surrender of a patent was an abandonment of it, and an applicant for reissue took upon himself the risk of getting a reissue or of losing all. The question of his right to any patent at all was opened anew the same as upon an original application for a patent. *Ibid.*

§ 5351. The last clause of section 53, act of 1870 (sec. 4916, Rev. Stat.), relates merely to the evidence to which the commissioner may resort, but does not increase his power as to the invention for which a reissue may be granted. Whether said clause relates to any other than machine patents not considered in this case. *Atlantic Giant Powder Co. v. California Powder Works*, 8 Otto, 126.

§ 5352. The last clause of section 53, act 1870, so far as granting a new right is concerned, has no retroactive operation; and it can only apply to reissues of patents originally issued since the passage of that act. *Atlantic Giant Powder Co. v. Cal. Powder Works*, 3 Saw., 448.

§ 5353. Whatever may have been the effect of the new clause introduced in the law by the act of July 8, 1870, that "the surrender shall take effect upon the issue of the amended patent" in cases where a reissue is refused for other reasons, it would still seem that if the patentee's title to the invention is disputed and adjudged against him, the effect of such a decision should be as fatal to his original patent as to his right to a reissue. *Peck v. Collins*, 13 Otto, 660.

§ 5354. Act 1871, reissue to assignee, construed. *National Car Spring Co. v. Union Car Spring Mfg. Co.*, 12 Blatch., 80.

§ 5355. The law authorizing reissues of patents was never intended to allow the scope of a patent to be enlarged so as to include and embrace within it matters and things that were not embraced in the original invention. *Swain Turbine Manufacturing Co. v. Ladd*, 12 Otto, 408.

See *Application*, § 379.

Reissues — Construction of statutes; accident, inadvertence or mistake — *A reissue must be for accident, inadvertence or mistake*, 5356-5368; *what is not accident, etc.*, §§ 5369, 5370.

§ 5356. The right to reissue exists in case of defective description, or error arising from inadvertence or mistake. *Knight v. B. & O. R. Co.*, Taney, 106.

§ 5357. A patentee is not entitled to have his patent reissued unless he shows by satisfactory evidence that the error he seeks to have corrected was owing to "inadvertence, accident or mistake, and without any fraudulent or deceptive intention," and states particularly wherein the inadvertence, accident or mistake consisted. *Conklin and Stafford*, 1 MacArth., 375.

§ 5358. The decisions of the courts sustaining patents against objections for want of such evidence rest upon the principle that it is the province of the commissioner to determine whether sufficient evidence to that effect has been produced; and that his granting a reissue is conclusive on that point, and is not open to revision. *Ibid.*

§ 5359. The supreme court of the District of Columbia is not governed by this principle in determining an appeal from the decision of the commissioner of patents refusing a reissue, but will require the same evidence of inadvertence, accident or mistake that should have been produced before him. *Ibid.*

§ 5360. If it be found that the claims of the original patent were valid, and that the reissue for the same invention states the claim or claims in a different way, the law is well settled that the change does not of itself vitiate the new patent, but that, on the contrary, the original claims are conclusively presumed to have been made, as they were, through inadvertence, accident or mistake. *Smith v. Merriam*, 6 Fed. Rep., 713.

§ 5361. The statute never intended to allow a patent to be enlarged except in a clear case of mistake. *Meyer v. Maxheimer*, 9 Fed. Rep., 99.

§ 5362. The statute of 1870, relating to reissues, authorizes the insertion of new claims, founded upon the original invention as exhibited by the specifications or drawings, in reissues, when the omission results from "inadvertence, accident or mistake," and where the claimant has not by some act or omission estopped himself from exercising the right to amend. *Combined Patents Can Co. v. Lloyd*, 11 Fed. Rep., 149.

§ 5363. The purpose of a reissue is to enable one to secure what he was entitled to in his original patent, but, through inadvertence or mistake, did not obtain; but it cannot be made the means of covering anything which was not in the original invention. *Vogler v. Semple*, 7 Biss., 382.

§ 5364. A reissue can only be had when the original patent is inoperative or invalid from one of two causes — either by reason of a defective or insufficient, specification or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new — and even then only where the error has arisen from inadvertence, accident or mistake, and without any fraudulent or deceptive intention. *Atlantic Giant Powder Co. v. California Vigorit Powder Co.*, 6 Saw., 508.

§ 5365. The statutory provisions concerning reissues require that the original patent must be inoperative or invalid either from a defective or insufficient specification or from claiming as new more than the patentee has the right to claim; and, in addition to this, the error which is sought to be corrected must have arisen by inadvertence, accident or mistake, and without any fraudulent or deceptive intention. If the party interested can bring himself within these conditions and limitations, the commissioner is authorized to issue a new patent for the same invention. When the original shows upon its face that the grounds and reasons for the reissue do not exist, or where a comparison of the letters patent discloses different inventions, the reissue is void, as an act unauthorized by law. *Flower v. Rayner*, 19 O. G., 425.

§ 5366. The rule laid down by the supreme court is that where it is sought merely to enlarge a claim there must be clear mistake and inadvertence and a speedy application for its correction, with no unreasonable delay; that in such a case a patentee cannot wait until other inventors have produced new forms of improvement and then apply for such an enlargement of his claim as to make it embrace those new forms; and that when it is apparent from a comparison of the two patents that the reissue is made to enlarge the scope of the patent, the court may decide whether the delay was unreasonable and the reissue therefore void. *Wooster v. Handy*, 21 Fed. Rep., 51.

§ 5367. A patent cannot be lawfully reissued for the mere purpose of enlarging the claim, unless there has been a clear mistake inadvertently committed in the wording of the claim, and the application for reissue is made within a reasonably short time. Whether there has been such an inadvertent mistake is, in general, a matter of fact for the commissioner to decide; but whether the application is made in reasonable time is matter of law, which the court may determine by comparing the reissued patent with the original, and, if necessary, with the records in the patent office when presented by the record. *Mahn v. Harwood*, 112 U. S., 354.

§ 5368. Where there has been an omission to claim certain devices or combinations apparent on the face of a patent, arising from inadvertence, accident or mistake, the appropriate remedy is by reissue, and a second patent may not be granted for the devices or combination omitted. *Hill v. Commissioner of Patents*, 33 O. G., 757.

§ 5369. The rejection of a claim in the application on an alleged anticipating device is at most an erroneous ruling of an officer having a *quasi* judicial power, which could presumably be corrected by appeal, and not such "mistake and inadvertence" as entitles to reissue. *Putnam v. Hutchinson*, 12 Fed. Rep., 127.

§ 5370. Where additional matter is claimed, however, which does not appear by reference to the patent or contemporary records to be embraced in the invention, or where it appears by such reference that the alleged omission "could not have occurred through inadvertence or mistake," as said by the court in *James v. Campbell et al.*, the case is not within the jurisdiction of the commissioner, and a reissue for additional claims may be declared void. *Combined Patents Can Co. v. Lloyd*, 11 Fed. Rep., 149.

See *Citizenship*, § 673. *Claims*, §§ 809, 848-851.

Reissues — Accident, inadvertence and mistake; particular cases — Involving, §§ 5371-5373. Not involving, §§ 5374-5382.

§ 5371. Where the specification was defective in not fully describing the combination of the thickness and slope of the front and back surfaces of a rib, it was held a proper case for reissue. *Carver v. Braintree Mfg. Co.*, 2 Story, 432.

§ 5372. Where it appears from the original papers in a case that a certain feature was

within the contemplation of the inventor as a valuable element in a patentable combination, and it is proved that a claim embracing such feature was erased from the original application through a misunderstanding of the invention by the solicitors, *held*, that the commissioner of patents committed no error in granting a reissue containing a claim embracing such feature. *Stutz v. Armstrong*, 20 Fed. Rep., 843.

§ 5373. Where the original claim was so ambiguous as to suggest a doubt as to its sufficiency, and was also open to two different constructions, *held*, that it was not a mistake so obvious as to be apparent upon first inspection of the patent, and that the reissue applied for within eleven months was not void for laches and was valid. *Western Union Telegraph Co. v. Baltimore & O. Telegraph Co.*, 25 Fed. Rep., 30.

§ 5374. Where a claim has been made and abandoned on the application for the original patent, its omission cannot be considered an inadvertence, accident or mistake that will justify its insertion in a reissue. *Wicks v. Stevens*, 2 Woods, 310.

§ 5375. Where one of the claims in an original application was rejected upon reference to certain patents, and the applicant, by his attorney, orders the same to be erased, and thus obtains and accepts a patent for the residue of his claims, there has been no inadvertence, accident or mistake within the meaning of the patent law, and the patentee is not entitled to a reissue covering the claim before erased. *In re Hatchman*, 26 O. G., 738.

§ 5376. Where a patent was reissued for an original claim, the rejection of which had been acquiesced in by applicant's solicitor, but without applicant's knowledge, until after the grant; doubted that it was a mistake such as would warrant a reissue, and a preliminary injunction was denied. *Arnheim v. Finster*, 32 O. G., 256.

§ 5377. Where a specific invention, complete in itself, was described fully and clearly, without ambiguity or obscurity, in an original patent, and all the papers in the file-wrapper show it to have been the intention of the patentee to have thus limited his invention, a broad construction of the claims of a reissue would not be justifiable, even though the history of the art shows that such broader invention should have been claimed in the original patent. *Yale Lock Manufacturing Company v. James*, 20 Fed. Rep., 903.

§ 5378. There was no inadvertence, accident or mistake, within the contemplation of the statute, nor was there the nature of defectiveness or insufficiency meant by the statute, although the patentee might have fallen into an error of judgment or into an erroneous conclusion of fact. *Ibid.*

§ 5379. Where an invention covered by the claim of the original patent was clearly and accurately described in the specification of that patent, and there was no defect or insufficiency so far as the description was concerned, and the patent was not invalid or inoperative to cover anything arising out of such description which was set forth as an invention, *held*, there is no evidence that there was, in fact, any inadvertence, accident, or mistake, and hence a reissue with enlarged claims was not authorized. *Wooster v. Handy*, 21 Fed. Rep., 51.

§ 5380. A specification and claim in the original patent having been framed so as to cover accurately and definitely a certain invention, there was no error which had arisen through inadvertence or mistake, nor was there any defectiveness or insufficiency in the specification, and hence there arose no case for a reissue. *American Diamond Drill Co. v. Sullivan Machine Co.*, 21 Fed. Rep., 74.

§ 5381. Where, on comparison of the original and reissued specification, all but two claims of the original appeared in the reissue, with certain additional claims not made in the original, *held*, that it precluded the idea of inadvertence, accident or mistake, and that there was no pretense that the patent was inoperative or invalid as to anything therein claimed as the patentee's invention. *Kells v. McKenzie*, 9 Fed. Rep., 284.

§ 5382. The specification and drawings of the reissue upon which the suit is brought being substantially the same as those of the original patent, it follows that the reissue was not for the purpose of making the original specification more full, accurate, or intelligible, or for the purpose of eliminating from it what the inventor had not the right to claim as new. *McMurry v. Mallory*, 111 U. S., 97.

See *Appeal*, § 302.

Reissues — Who may reissue — Administrator, § 5383. *Assignee*, §§ 5384-5392. *Assignee of executor*, § 5393. *Executor*, §§ 5394, 5395. *Owners of exclusive territorial right*, § 5396. *Patentee*, § 5397.

§ 5383. *Held*, that, under act 1836, section 13, a patent was properly surrendered and reissued to patentee's administrator, and that his right was not restricted because of his having previously made special or limited grants or licenses. *Smith v. Mercer*, 4 West. L. J., 49.

§ 5384. An assignee of a patent cannot reissue the patent except upon proof that the new specifications were invented by patentee and originally intended to have been patented by him and were omitted by mistake. *Taney's Opinion*, 2 Op., 572.

§ 5385. The statute of 1836 authorizes a reissue to an assignee of an assignee, and that without the approbation, or consent, or knowledge of the original patentee. *Swift v. Whisen*, 2 Bond, 115.

§ 5386. Assignees may tender a surrender and apply for reissue. *Forbes v. Barstow Stove Co.*, 2 Cliff., 379.

§ 5387. Assignee of a patent does not take the benefit of a reissue obtained after the assignment to him by inurement, but he must ratify the surrender and this must be proved affirmatively. *Burdell v. Denig*, 2 Fish., 588.

§ 5388. If a part of the whole patent has been vested in another, so as to constitute him an assignee within the meaning of the statute, an efficacious surrender can be made only by the concurrence of both of the owners of the patent; but this may be manifested by the assignee by his direct co-operation in the surrender, or his subsequent ratification of it. *Meyer v. Bailey*, 8 O. G., 437.

§ 5389. Assignee of patent cannot, after long delay, reissue for matter disclaimed by original patentee. *Putnam v. Hutchinson*, 12 Fed. Rep., 127.

§ 5390. The privilege of reissue, under section 4895, Revised Statutes, is not confined to the immediate assignee of the inventor. The word "assignee," as used in the statute, means the "assignee" in any degree, however remote. *Selden v. Stockwell Self-Lighting Gas-Burner Co.*, 19 Blatch., 544.

§ 5391. It is not essential to the validity of a reissued patent that a transferee of an interest in the original patent, who is not an assignee within the meaning of the statute, concur in the surrender. *Meyer v. Bailey*, 8 O. G., 437.

§ 5392. The patentee assigned the state of Pennsylvania to B., and afterward reissued the patent. Subsequently to the reissue B. assigned his title to an interest in the state of Pennsylvania, except as to certain counties, under the *reissued* patent, to the complainants, who, under the title thus acquired, filed a bill in equity against the defendants. Defendants demurred on the ground that B.'s interest was outstanding at the time of the surrender, and that he did not appear to have been a party to or to have assented to or approved of the surrender, and therefore the reissue was void. *Held*, that B. was not an assignee within the meaning of the statute, and therefore it was not necessary for him to concur in the surrender in order to give validity to the reissue. *Ibid*.

See *Assignee*, § 537. *Contracts*, § 1309. *Employer and Employee*, §§ 2108, 2109. *Estoppel*, § 2257. *Title*, § 6319.

§ 5393. The assignee of patentee's executor may reissue the patent. *Carew v. Boston Elastic Fabrics Co.*, 1 Holmes, 45.

§ 5394. Under United States patent laws, where the reissue was granted the executor as such, he may sue on such patent in all respects as if he had been designated in it as trustee instead of executor. *Rubber Co. v. Goodyear*, 9 Wall., 788.

§ 5395. The executor of a deceased patentee may surrender his patent and obtain a reissue. *Carew v. Boston Elastic Fabric Co.*, 3 Cliff., 356.

§ 5396. The owner of an exclusive territorial right under a patent may ratify a reissue thereof in which he did not join, by making an assignment under such reissue. *Meyer v. Bailey*, 8 O. G., 437.

§ 5397. Same reissue privilege pertains to a patentee taking under a special law as under the general law. *Page v. Holmes Burglar Alarm Telegraph Co.*, 17 Blatch., 484.

See *Assignee*, § 557. *Grant*, §§ 2631-2639.

Reissue—Office of— *Is to correct*, §§ 5398, 5399. *The description*, §§ 5400-5405. *To correct omissions*, §§ 5406, 5407. *To omit part of original*, §§ 5408-5410. *To modify or change the claim*, §§ 5411-5415. *To render effectual the original invention*, § 5416.

§ 5398. The law provides for and allows reissues for corrections, but not for alterations. *Doane & Wellington Mfg. Co. v. Smith*, 15 Fed. Rep., 459.

§ 5399. Where in the original patent the inventor, while giving his invention to the public, fails to describe the *rationale* of it, he is entitled to do so on the reissue. *Woodward v. Dinsmore*, 4 Fish., 163.

§ 5400. An amendment in a reissue consisting in greater conciseness and precision in the description of the invention, and in the methodical and separate definition of patentee's claims, is within the statutory warrant, and has the sanction of express adjudication. *Parham v. American Button-hole, etc., Sewing Machine Co.*, 4 Fish., 468.

§ 5401. The reissue of a patent is allowed to enable patentee to more perfectly describe his invention; and where the specifications vary, but the invention and the thing patented is the same, such variation does not make the patent void. *O'Reilly v. Morse*, 15 How., 62.

§ 5402. It is the office of a reissue to correct errors in the specification and claim of the

original patent, but the reissue claim should be confined to the original invention. *Tyler v. Welch*, 18 Blatch., 209.

§ 5403. The word "specification," as employed in section 4916, means description and claim. Therefore a reissue is allowed when the specification is defective or insufficient in regard to either the description or the claim, or to both, to such an extent as to render the patent inoperative or invalid, if the error arose in the manner mentioned in the statute. *Wilson v. Coon*, 18 Blatch., 532.

§ 5404. Where a reissued patent is granted upon a surrender of the original, for its alleged defective or insufficient specification, such specification cannot be substantially changed in the reissued patent, either by the addition of new matter or the omission of important particulars, so as to enlarge the scope of the invention as originally claimed. A defective specification can be rendered more definite and certain so as to embrace the claim made, or the claim can be so modified as to correspond with the specification; but, except under special circumstances, this is the extent to which the operation of the original patent can be changed by the reissue. *Russell v. Dodge*, 3 Otto, 460.

§ 5405. The correction of a patent by means of a reissue, where invalid or inoperative for want of a full and clear description of the invention, is proper. *Sewing Machine Co. v. Frame*, 24 Fed. Rep., 596.

§ 5406. The original patent being unnecessarily restricted, it was the object and the proper office of the reissue to correct this omission, so as to protect the patentee to the full extent of the invention. *Schuessler v. Davis*, 13 O. G., 1011.

§ 5407. If a form of a device embraced in a reissued patent had not been mentioned in the original patent, it might well be said not to have formed any part of the conception of the inventor; but if described in such original patent, although referred to as not being so useful or desirable in the combination as another form of such device, it might nevertheless be properly embraced by the reissued patent. *Campbell v. James*, 17 Blatch., 42.

See *Construction of Patents and Specifications*, § 1233. *Process and Product*, § 5114.

§ 5408. An inventor is always at liberty to omit in his reissue a part of his original invention, if he deems it expedient, and to retain that part only which he deems fit to retain. *Carver v. Braintree Mfg. Co.*, 2 Story, 432.

§ 5409. Minor features of invention relinquished upon reissue — because: 1, unimportant and valueless, and 2, lacking in patentable novelty — will not invalidate the reissue grant. *Gould v. Ballard*, 13 O. G., 1081.

§ 5410. And, further, there is nothing in the policy or terms of the patent act which forbids the omission of part of the original invention from the reissued patent. *McWilliams Mfg. Co. v. Blundell*, 11 Fed. Rep., 419.

§ 5411. It is a legitimate and important function of a reissue to modify or change the claims of the original patent, so as to cover the invention set forth therein. *Westinghouse v. Gardner & Ranson Air Brake Co.*, 9 O. G., 538.

§ 5412. So far as the claim is wanting in rightful scope, the patent is inoperative. To reissue the patent, that a claim to fully cover the invention may be entered, is warranted by the statute. *Badische Anilin and Soda Fabrik v. Higgin*, 15 Blatch., 290.

§ 5413. Although the original patent may contain a satisfactory specification of invention, yet if the specification of claim be inadequate to proper protection, the defect is within the language of the reissue section (4916, Revised Statutes) and may be remedied. *Ibid.*

§ 5414. A patent which fully describes and illustrates the actual invention of the patentee, but fails to claim it, may properly be reissued with claims to such parts as were really the invention of the patentee, such new claims constituting an amendment of the "specification" within the meaning of the law. *Wilson v. Coon*, 18 Blatch., 532.

§ 5415. Where the claim of the original patent was limited by including an element not of the essence of the invention, *held*, that it was a proper case for a reissue, in which the element was optional, the drawing and specification remaining substantially the same. *Crandal v. Walters*, 9 Fed. Rep., 659.

See *Claims*, §§ 809, 837.

§ 5416. The purpose of a reissue is to render effectual the actual invention for which the original patent should have been granted — not to introduce new features. *Union Paper Collar Co. v. Van Dusen*, 23 Wall., 530.

Reissue — Scope of — May include, what, §§ 5417-5421.

§ 5417. Scope of a reissue; what it may include. *Knight v. B. & O. R. Co.*, Taney, 106.

§ 5418. Whatever was the invention of the original patentee, whether expressly claimed in the original patent or not, when incorporated in the reissue patent, will be held to be within the claim of the original patent. *Swift v. Whisen*, 2 Bond, 115.

§ 5419. It is within the scope of a reissue that it contain a fuller description of the state of the art than the original, as well as of the nature of the improvements made by the patentee and the advantages attained through them. *Robertson v. Secombe Manufacturing Co.*, 10 Blatch., 481.

§ 5420. A reissued patent is not valid for everything which might have been claimed in the original patent, nor does its validity depend wholly upon the fact that the new features attempted to be secured thereby were suggested in the models, drawings or specifications of the original patent. Hence, where a patentee in his specifications claims as his invention a particular part of a machine, and his claims are all limited to that part, a reissue embracing other and distinct portions of the machine is not for the same invention, and is *pro tanto* void, although the designs accompanying the original patent show all the features contained in the reissue. *Kells v. McKenzie*, 9 Fed. Rep., 284.

§ 5421. To determine accurately the extent of the invention secured by any reissued letters patent, the state of the art at the time the original patent was granted must be considered. *Garneau v. Dozier*, 12 Otto, 230.

Reissue — Claim — *What may be claimed*, §§ 5422-5424. *When valid*, §§ 5425-5427. *Construction of claim*, §§ 5428-5433. *Description*, §§ 5434-5436. *Claim cannot be departed from*, §§ 5437, 5438. See *Evidence*, §§ 2318, 2319. "*Substantially as Described*," § 6199.

§ 5422. The machine in the reissue being the same as in the original, claims may be made to include whatever was the actual invention, if and so far as the patentee was the first to invent it. *Buffum v. Oak and Mfg. Co.*, 4 B. & A., 599.

§ 5423. It seems that on reissue a patentee may claim something which he had described as one mode of making his machine or article. For the thing which is actually made and exhibited he is to have a patent, though he may have said that an alternative form was equally good. *Atwood v. Portland Co.*, 10 Fed. Rep., 283.

§ 5424. Matter so described in the original specification that it might have been claimed in the original patent may properly be claimed in the reissue. *Washburn & Moen Mfg. Co. v. Haish*, 10 Biss., 65.

§ 5425. A reissue is valid although it claims only one of two modes of construction specified in the original patent. *American Nicholson Pavement Company v. City of Elizabeth*, 3 O. G., 522.

§ 5426. If the original patent is valid to the extent of its claim a reissue is without authority of law. *Atlantic Giant Powder Co. v. California Vigorit Powder Co.*, 6 Saw., 508.

§ 5427. Where the claims of a reissued patent involve a total abandonment of the principles which are stated in the original patent to be those of the invention, the reissued patent is invalid. (*Yale Lock Co. v. Scovill Manufacturing Co.*, 18 Blatch., 248, cited and distinguished.) *Parker & Whipple Co. v. Yale Clock Co.*, 18 Fed. Rep., 43.

§ 5428. The original patent may be referred to to aid in construction of the reissue in case of doubt. *Ely v. Monson & Brimfield Mfg. Co.*, 4 Fish., 64.

§ 5429. Where in a reissue a general term is used to cover an infringing device, it calls for careful scrutiny of the new claims to make sure that they do not exceed the limits of the invention; but if the term is intelligible, or can be made so by expert testimony, it is not necessarily fatal to the patent that it may be used in a new sense. *Crompton v. Knowles*, 7 Fed. Rep., 199.

§ 5430. The claims in a reissued patent are to be construed so as not to embrace any invention broader in its scope than the invention described, or substantially suggested or indicated in the original. *Swain Turbine Mfg. Co. v. Ladd*, 11 O. G., 153.

§ 5431. Claims in a reissue are to be construed, if the language will reasonably bear such an interpretation, so as not to embrace any invention broader in its scope than that in the original. *Brainard v. Cramme*, 12 Fed. Rep., 621.

§ 5432. Where it can be seen that the patentee seeks by apt words of description to secure what he has honestly invented and nothing more, the court should hesitate to regard with favor the accusation now so freely made against reissued patents. *Crandal v. Parker Carriage Goods Co.*, 20 Fed. Rep., 851.

§ 5433. Where the reissue claim omitted certain elements of the original claim, it was held, in view of the words "as specified" appended to the claim, to include such omitted elements, and to be for the same invention as the original. *Hayes v. Bickelhaupt*, 23 Fed. Rep., 183.

See *Equivalents*, § 2159.

§ 5434. A reissue need not describe the invention in the exact language of the original, but may contain a more full and exact description of what was there imperfectly described. *Pearl v. Ocean Mills*, 11 O. G., 2.

§ 5435. A reissue patent need not be rigidly confined in description to what was described

before. It may include whatever else was suggested or substantially indicated as part of the original patented invention. *Herring v. Nelson*, 14 Blatch., 293.

§ 5436. The decision of United States supreme court in *Lehigh Valley Railroad Company v. Mellon*, 20 O. G., 1891, while it limits the effect of the specification to the claim, does not exclude reference to the original specification to correct the claim upon a reissue. *Coburn v. Schroeder*, 22 O. G., 1538.

§ 5437. Where the office of a reissue was to secure a broad claim, the complainant in a suit upon such claim must be held thereto, even though the real invention is not secured thereby. *Wisner v. Grant*, 7 Fed. Rep., 922.

§ 5438. It is immaterial whether or not a certain construction might have been covered by the language of the specification, since the claims are to be dealt with and nothing else. *Turner & Seymour Manufacturing Co. v. Dover Stamping Co.*, 111 U. S., 319.

Reissue — Identity — Must be for same invention as original, §§ 5439-5458.

§ 5439. The reissue must be for an invention substantially the same in principle and mode of operation as that embodied in the original patent. *Knight v. B. & O. R. Co.*, Taney, 106.

§ 5440. Under act 1836, section 13, on reissue patentee might make his specification more accurate or restrict the limits of his claim, but his reissue patent, taking the place of the one he has surrendered, can only be for the same invention. *Battin v. Taggert*, 2 Wall. Jr., 101.

§ 5441. The invention described and claimed in a reissue must be the same as originally patented. And if, by a fair construction, the specification and claim are for something substantially different from those of the original, the patent is void. *Goodyear v. Berry*, 2 Bond, 189.

§ 5442. A reissue is invalid unless for the same invention as original. *Gill v. Wells*, 22 Wall., 1.

§ 5443. A new and different invention cannot be claimed in the reissue. *Crompton v. Belknap Mills*, 3 Fish., 536; *Battin v. Taggert*, 17 How., 74.

§ 5444. A reissue can only be for the invention originally made and intended to be described or claimed, and included in the original patent. *Brown v. Selby*, 2 Biss., 457.

§ 5445. Reissues must be for the same invention as the original patent, and it is the same with respect to a divisional reissue. (Dissenting opinion of CLIFFORD, MILLER and DAVIS, JJ.) *Corn-Planter Patent*, 23 Wall., 181.

§ 5446. Nothing can be interpolated in a patent on a reissue which was not indicated in the specification, model or drawings filed with the application for the original patent. *Carew v. Boston Elastic Fabric Co.*, 3 Cliff., 356.

§ 5447. Nothing can be admitted in a reissued patent for a chemical invention which is not found in the application for the original, and the act of 1870 does not dispense with this requirement. *Tarr v. Webb*, 10 Blatch., 96.

§ 5448. Where, on reissue, the alteration made was in the drawings only to an extent which in no wise affected the mode of operation, the manner of construction, or the function performed by the invention, it was held altogether immaterial, and the reissue sustained as for the same invention as that in the original patent. *McCrary v. Pennsylvania Canal Co.*, 5 Fed. Rep., 367.

§ 5449. A reissued patent must be for the same invention as the original, containing no new matter. *Putnam v. Yerrington*, 9 O. G., 689.

§ 5450. It is not meant by this that no new or different language should be employed. *Ibid.*

§ 5451. There is no safe or just rule but that which confines a reissue patent to the same invention which was described or indicated in the original. *Meyer v. Maxheimer*, 9 Fed. Rep., 99.

§ 5452. A reissue, to be valid, must be for the same invention contained in the original patent, and when, in a suit between the same parties, the supreme court of the United States had decided that the defendants' apparatus did not infringe the invention contained in the original patent, it could not infringe a valid reissue thereof, and the suit was accordingly dismissed. *Cammeyer v. Newton*, 16 O. G., 720.

§ 5453. If the reissues of an original patent are for any other or substantially different invention from that described in such original patent, they are unquestionably void; but the fact that the specifications or claims are different, the invention or discovery remaining the same, is of no consequence. *Campbell v. James*, 17 Blatch., 42.

§ 5454. When the reissue describes only what was described in the original patent, both as to the devices and the nature of the invention, it cannot be said that the invention in one is different from that in the other, although the claims have been changed and enlarged. *Sharp v. Tift*, 18 Blatch., 132.

§ 5455. A reissued patent must be for the same invention as that which formed the subject

of the original patent, or for a part thereof when divisional reissues are granted. It must not contain anything substantially new or different. *Atlantic Giant Powder Co. v. California Powder Works*, 8 Otto, 126.

§ 5456. A reissue can only be granted for the same invention which was originally patented. To show that the patentee, before obtaining his original patent, had made and done all those things which it is proposed to embrace in or cover by the reissued patent is nothing to the purpose. *Swaine Turbine Manufacturing Co. v. Ladd*, 12 Otto, 408.

§ 5457. In cases of reissues of patents, inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, it is imperative that the new patent, when issued, shall be for the same invention, and that no new matter shall be introduced into the specification, when, as in the present case, there is a drawing with reference to which the invention is described. *Heald v. Rice*, 14 Otto, 737.

§ 5458. In this instance the reissue held to be not merely for a broader claim made many years after the original was granted, but for a different invention. By suppressing the description of certain parts of the device, the reissued patent is made to cover by implication an invention described and claimed in a subsequent patent. *Matthews v. Boston Machine Co.*, 15 Otto, 54.

Reissue — Identity — Want of identity with original, void, §§ 5459-5461.

§ 5459. Whenever it appears, upon a comparison of the two specifications and claims, as a matter of law arising on their construction, that the reissue is for a different invention from that secured in the original, the reissue is void and of no effect. *Sickles v. Evans*, 2 Cliff., 203.

§ 5460. Where it appears, on a comparison of the two instruments, as matter of law, that the reissued patent is not for the same invention as that embraced and secured in the original patent, the reissued patent is invalid. *Stevens v. Pritchard*, 4 Cliff., 417.

§ 5461. A reissue for an invention not exhibited in some manner (including, doubtless, an arrangement of the parts to produce the result, without express statement that it will be produced) in the original patent is invalid, and the question of delay in making the application is irrelevant. *Hammond v. Franklin*, 22 Fed. Rep., 833.

Reissue — Identity — Presumption of law is in favor of identity of original and reissue, §§ 5462-5472.

§ 5462. The question of identity of invention in the reissue and original patent is presumptive only and open to rebuttal. *Allen v. Blunt*, 2 W. & M., 121.

§ 5463. The presumption of law is that the reissued patent is for the same invention as the original. *Crompton v. Belknap Mills*, 3 Fish., 536; *Hussey v. McCormick*, 1 Biss., 300; *Morris v. Royer*, 2 Bond, 66.

§ 5464. Reissued patents are presumed to be for the same invention as the original, unless the contrary appear. *Stevens v. Pritchard*, 4 Cliff., 417.

§ 5465. The question is not one of fact, but of legal construction upon a comparison of the two instruments. *Ibid.*

§ 5466. A reissue is presumed to be for the same invention as the original, unless evidence on the face of the patent shows otherwise. *O'Reilly v. Morse*, 15 How., 62.

§ 5467. It is to be presumed that a reissue is for the same invention as the original patent; and it is for the defendant to show that it is not. *Guidet v. Barber*, 5 O. G., 149.

§ 5468. It is to be presumed, from the fact of a reissue, that the inventions described in the original and amended patents are the same. *Bantz v. Elsas*, 6 O. G., 117.

§ 5469. Whenever a patent is reissued or extended the presumption is that it is for the same invention, and the action of the commissioner is conclusive against a charge of fraud in obtaining the extension, or the reissue as well as all other objections, unless it appears upon the face of the papers that the new patent is not for the same invention as the original. *La Baw v. Hawkins*, 6 O. G., 724.

§ 5470. The legal rule is, that *prima facie* a reissue is for the same invention as that originally patented. *United States & Foreign Salamander Felting Co. v. Haven*, 3 Dill., 131.

§ 5471. The legal presumption is always in favor of the reissue, and that it is for the same invention as the original, and where defendant has not produced the original in evidence, the defense that the reissue is for a different invention from that in the original patent must fail. *Bickford v. Laporte*, 2 Fed. Rep., 214.

§ 5472. Reissued patents are presumed to be for the same invention as the original, and will only be adjudged to be void because for a different invention, where it clearly appears that the reissue contains some new feature of a material character not described, suggested, nor substantially indicated in the specification, drawings, or patent office model. *Thomas v. Shoe Machinery Manufacturing Co.*, 16 O. G., 541.

Reissue — Identity — Introduction of original in evidence to establish, §§ 5473-5477.

§ 5473. Where the original patent is not put in evidence there is nothing properly before the court by which to determine whether the original and the reissue are for the same invention or not. As the reissue was granted by the proper officer, the presumption is that it was properly granted, and there is nothing in the case to overcome that presumption. *Searls v. Bouton*, 12 Fed. Rep., 140.

§ 5474. Defendants may read the original patent in evidence at the trial, though not put in before the examiner, in order to show that the reissue is for a different invention in fact from the original, if the evidence cannot surprise the plaintiffs. *Knapp v. Shaw*, 15 Fed. Rep., 115.

§ 5475. Where defendant sets up, in a suit for infringement of a reissued patent, that the reissue is broader than the original, and invalid, he may introduce the original patent on plaintiff's failure to do so. *National Pump Cylinder Co. v. Simmons Hardware Co.*, 18 Fed. Rep., 324.

§ 5476. The defense that a reissued patent covers more than was embraced in the original cannot be sustained without producing the original and comparing it with the reissued patent. *Doherty v. Haynes*, 4 Cliff., 291.

§ 5477. Where one of the defenses set up was that the improvement secured by the reissue was not for the same invention as the original, *held*, 1. That the complainant is not obliged in such a case to introduce the original patent in evidence. 2. That the respondent cannot have the benefit of such a defense if the original patent is not exhibited in the record. *Bates v. Coe*, 8 Otto, 31 (§§ 1816-30).

See *Reissues*, § 5549.

Reissue — Identity — Test of, § 5478. *How determined,* §§ 5479-5490. *A question for the jury,* §§ 5491, 5492; *for the court,* § 5493.

§ 5478. Differences in the description and claims of the old and new specifications are not the tests of substantial diversity, but the description may be varied and the claims restricted or enlarged, provided the identity of the subject-matter of the original patent is preserved. *Parham v. American Button-hole, etc., Sewing Machine Co.*, 4 Fish., 468; *Herring v. Nelson*, 14 Blatch., 293.

§ 5479. In the absence of any allegation as to fraud, the want of identity of the invention in the reissued with that in the original patent can only be proved by showing upon the face of the instruments that one is so different from and repugnant to the other that they cannot be both for the same invention. *Middletown Tool Co. v. Judd*, 3 Fish., 141.

§ 5480. The identity of the invention set forth in the original patent and in the reissue is a matter of legal construction, and is determined by a comparison of the two patents. *Kerosene Lamp Heater Co. v. Littell*, 13 O. G., 1009.

§ 5481. To impeach a reissue, which is *prima facie* evidence that it is for the same invention as that in the original, it must appear, in the absence of fraud, that the invention described therein is repugnant to the original. *Andrews v. Wright*, 13 O. G., 969.

§ 5482. Whether a reissued patent is for the same invention as the original depends upon whether the specification and drawings of the reissued patent are substantially the same as those of the original; and, if not, whether the omissions or additions are or are not greater than the law allows to cure the defect of the original. *Union Paper Collar Co. v. Van Dusen*, 23 Wall., 530 (§§ 398-406).

§ 5483. The validity of the reissue depends upon the fact whether the patents are for the same invention, and the identity of the invention must be determined by the drawings and specifications construed together. *Searls v. Worden*, 11 Fed. Rep., 501.

§ 5484. The identity of the invention in the original and reissued patent is a question to be decided by the evidence. *Morris v. Royer*, 2 Bond, 66.

§ 5485. The question of identity of inventions described in the original and reissue patents is a matter of legal construction, to be determined by the court on a comparison of the two instruments. *Tucker v. Tucker Mfg. Co.*, 4 Cliff., 397.

§ 5486. The courts will in no case declare a reissue patent void if, by the true construction of the two instruments, the invention secured by the reissue is not substantially different from that embodied in the original patent. Inquiries in such a case are restricted to a comparison of the terms and import of the two patents in view of the drawings and models. If from these it results that the invention claimed in the reissue is not substantially different from that described, suggested or indicated in the original specification, drawings or model, the reissued patent must be held valid, as all other alterations and amendments plainly fall within the intent and purpose of the statute which allows a surrender and reissue. *Thomas v. Shoe Machinery Mfg. Co.*, 16 O. G., 541.

§ 5487. The question of identity of invention of the reissue with the original is to be determined by an inspection of the two instruments. *Ball v. Langles*, 12 Otto, 128.

§ 5488. To sustain the position that a reissued patent is not a patent for the same invention which was described in the specification of the original patent, and, therefore, that the reissue is unauthorized and void, the defendant must overcome the presumption against him arising from the decision of the commissioner of patents in granting the reissue, and this he can do only by showing, from a comparison of the original specification with that of the reissue, that the former does not substantially describe what is described and claimed in the latter. This must plainly appear before the court can be justified in pronouncing the reissued patent void. *Smith v. Goodyear Dental Vulcanite Co.*, 3 Otto, 486.

§ 5489. The question of identity as to the claims in two patents—the original and its reissue—is one of construction and comparison, to be determined from the face of the instruments, interpreted according to the principles of law. *Reed v. Chase*, 25 Fed. Rep., 94.

§ 5490. A comparison of an original and its reissue, for the purpose of determining the question of identity of the inventions described in them, requires an interpretation of the original patent in the light of the state of the art at the date when the application for it was filed. *Eachus v. Broomall*, 115 U. S., 429.

§ 5491. Whether the reissue is for a substantially different invention from the original invention is a question for the jury on the evidence. *Stimpson v. Railroad Co.*, 4 How., 380.

§ 5492. In determining the substantial identity of the invention in the original and reissued patent, it is competent for the jury to look into the drawings of the original patent. *Swift v. Whisen*, 2 Bond, 115.

§ 5493. Whether the reissue is for the same invention as the original patent involves a question of fact, and may be properly considered by courts of equity without reference to a jury. *Poppenhusen v. Falke*, 4 Blatch., 493.

Reissue — Identity — Permissible discrepancy, § 5494. *Question of identity*, § 5495; *cannot be raised on demurrer*, § 5496. *Claims in original*, § 5497. *Re-examination as to identity*, § 5498.

§ 5494. Discrepancy in the titles and variations in the description and claims of the reissued and original patent will not avoid the latter. This effect arises only from diversity of subject. *Penna. Salt Co. v. Thomas*, 5 Fish., 148.

§ 5495. In considering the validity of a reissue the only question is as to whether the invention described in the reissue is to be found in the original model, specifications or drawings of the inventor. *Chicago Fruit House Co. v. Busch*, 2 Biss., 472.

§ 5496. The question of identity of invention in original and reissued patent cannot be raised by demurrer. *Adams, etc., Mfg. Co. v. Meyrose*, 12 Fed. Rep., 440.

§ 5497. If any invention claimed or described in the reissue is identical with the claims in the original it is to be protected under *Gould v. Spicer*, 15 Fed. Rep., 346. *Singer Mfg. Co. v. Goodrich*, 15 Fed. Rep., 455.

§ 5498. Questions once decided will not be re-examined, on the ground that the evidence now for the first time shows the identity of the reissued and original structure, the drawings then before the court having been insufficient; it is not enough to show that the disputed structure was shown in the original drawings and specifications. It must be claimed also. *Hayes v. Dayton*, 20 Fed. Rep., 690.

See *Acquiescence*, § 147. *Identity*, § 2719.

Reissue — Valid restriction, §§ 5499-5502. *Valid enlargement*, §§ 5503-5510; *invalid*, §§ 5511-5517. *Permissible change*, §§ 5518-5523.

§ 5499. The inventor or his representative has the right in a reissue to enlarge or restrict the claim so as to give it validity and secure the invention. *Rubber Co. v. Goodyear*, 9 Wall., 788; *Battin v. Taggart*, 17 How., 74.

§ 5500. Claims improperly made, or which had been made too broad, may be restricted, and mistakes inadvertently made — not errors of judgment — may be corrected. *Swaine Turbine Manufacturing Co. v. Ladd*, 12 Otto, 408.

§ 5501. If a patentee might have claimed an element generally and broadly, most assuredly his more limited claim on reissue cannot be successfully impeached. *Stutz v. Armstrong & Son*, 20 Fed. Rep., 843.

§ 5502. When a patent has been judicially declared void for the reason that its claim is too broad, the defect held properly corrected by reissue. *Mathews v. Flower*, 33 O. G., 887.

§ 5503. Extensive division and enlargement of claims afford no legal ground of objection to a reissue unless new matter has been introduced. *Dederick v. Cassell*, 9 Fed. Rep., 306.

§ 5504. The validity of a reissued patent is not affected because it contains a claim not made in the original; neither is that circumstance any evidence that the patentee did not make the invention claimed. *Eickemeyer Hat-Blocking Machine Co. v. Pearce*, 10 Blatch., 403.

§ 5505. An inventor may, in his reissue specification, make his description more full and accurate; but he must not substantially change it so as to describe another device or cover anything not in the original. *Washburn & Moen Manufacturing Co. v. Haish*, 10 Biss., 65.

§ 5506. When it appears, upon comparison, that the specification of the reissue only differs from the original in containing an invention of broader scope, it is clear that the original patent must be valid if the reissue would be. *Atlantic Giant Powder Co. v. Cal. Vigorit Powder Co.*, 6 Saw., 508.

§ 5507. It will not invalidate the reissue that the claim is broader than the claim of the original patent, provided that it is "for the same invention" shown and described in the specification and drawings. *Waring v. Johnson*, 19 Blatch., 38.

§ 5508. A patentee may, under proper circumstances, by reissue, enlarge his claims so as to make them extend to the limits of his invention, but he is bound by those limits. He may not enlarge the invention. *Odell v. Stout*, 22 Fed. Rep., 159.

§ 5509. Where the single original claim was broadly construed with reference to the specifications, drawings and state of the art, the seven claims of its reissue were held to be separately included therein and were sustained. *Reed v. Chase*, 25 Fed. Rep., 94.

§ 5510. If severable claims of the reissue cover the same invention as the original, which contains but a single claim, such claims would seem to be as valid as the original, and would be infringed by whatever would infringe that. *American Diamond Rock-Boring Co. v. Sheldon*, 33 O. G., 1598.

§ 5511. Reissue with expanded claims condemned. *Case v. Brown*, 2 Wall., 320; *Burr v. Duryee*, 1 Wall., 531.

§ 5512. The unwarrantable expansion of the claims in a reissue defeats its validity. *Nye v. Allen*, 15 Fed. Rep., 114.

§ 5513. A reissued patent which enlarges an original patent — *i. e.*, which makes the invention patented other and more inclusive than the original letters patent — is void as against intervening rights and the public as well. *Dunbar v. White*, 15 Fed. Rep., 747.

§ 5514. Any extension of a reissued patent beyond the scope of the invention set forth and fairly indicated in the original specification, drawings and model would be fatal to the patent itself. *Swaine Turbine Manufacturing Co. v. Ladd*, 12 Otto, 408.

§ 5515. A claim in a reissue which covers an invention clearly beyond that shown in the original is invalid, whether the time elapsing between the reissue and original patent is great or not. *Dryfoos v. Weise*, 19 Fed. Rep., 315.

§ 5516. The original patent showed certain devices to which no function was ascribed, and the position of which with reference to a particular part of the machine was not shown with accuracy. The reissue described such devices as occupying a definite position with reference to said particular part of the machine and as having a specified function. *Held*, that a claim in the reissue covering the arrangement described therein embraced an invention different from that shown in the original, was too broad to be added at any time, and was therefore void. *Reay v. Raynor*, 19 Fed. Rep., 308.

§ 5517. The reissue was taken out more than three years after the original, and would seem to be for that reason unseasonable and invalid. *Ibid.*

§ 5518. If in the reissue the description of the parts had only been more full and particular, or if distinct functions of the parts not before mentioned had been newly set forth, or functions before mentioned had been wholly omitted, so long as the devices and their mode of operation, as described, remained the same, the reissue might not be voided for showing a different invention. *Doane & Wellington Manufacturing Co. v. Smith*, 15 Fed. Rep., 459.

§ 5519. To introduce new words or phrases which are more aptly descriptive does not invalidate a reissue, the invention set forth being the same as in the original patent. *Draper v. Potomska Mills Corporation*, 13 O. G., 276.

§ 5520. Where the original specification in a patent for a stamp averred one object to be to stamp the day and month, a reissue may describe one object to be "dating" and "printing dates." *Robertson v. Secombe Manufacturing Co.*, 10 Blatch., 481.

§ 5521. In an original patent for a stamp containing several type-wheels for dates, the suggestion that they might bear any suitable letters or figures warrants describing in a reissue a wheel bearing the date of the year, though it was not otherwise alluded to in the original. *Ibid.*

§ 5522. It was held to be no objection to the reissued patent that it suggested that any material which was the equivalent of india-rubber might be used instead of it, such as animal or vegetable fiber, gutta percha, etc., although those materials were not mentioned in the original. *National Car-Spring Co. v. Union Car-Spring Manufacturing Co.*, 12 Blatch., 80.

§ 5523. Where, on reissue, patentee substituted for his former specification of a material to be used as part of his device a description of materials which may be used by specifying only those which have the two properties in which he had formally declared the utility and availability of the material which he then named to consist, *held*, that there was no enlargement of the thing patented, and that the reissue was valid. *Dunbar v. White*, 15 Fed. Rep., 747.

Reissue — *May include matter shown in the specifications, model or drawings of the original*, §§ 5524-5536. *Parol testimony to enlarge scope beyond matter shown, etc.*, § 5537. See *Drawings*, §§ 2081, 2082. *Model*, §§ 4199, 4200. *Scope of Patent*, § 5967.

§ 5524. Applications for reissue need not be limited to the original drawings and model. If justified by the specification, new drawings may be added. *Hank's Case*, 2 A. L. T. (U. S.) R., 129.

§ 5525. A reissue specification may be amended by the model in a machine patent as well as by the drawings. *Hendy v. Golden State & Miners' Iron Works*, 17 Fed. Rep., 515.

§ 5526. A reissue may include matter shown in the model which was not described or indicated in the original specification or drawing, and it seems that the character of a lost or destroyed model may be established by oral testimony. *Meyer v. Goodyear's India Rubber Glove Manufacturing Co.*, 11 Fed. Rep., 891.

§ 5527. The provision of the act of congress, that new features shall not be introduced, does not take away the right to include in the reissue whatever was substantially suggested or indicated in the surrendered specifications, drawings, or patent office model. *Stevens v. Pritchard*, 4 Cliff., 417.

§ 5528. A reissued patent may embrace whatever was suggested or substantially indicated in the original specification, drawings or model, and the claims may be broader, therefore, than those contained in the first patent. *Seymour v. Marsh*, 2 O. G., 675.

§ 5529. A suggestion in the specification, or an indication in the drawing or model of the original patent, may oftentimes justify an enlarged description of the invention upon reissue; but if the new description embody a distinct invention, enough should be found in the original specification to apprise others that such additional feature is included. *Kelleher v. Darling*, 4 Cliff., 424.

§ 5530. The most natural construction of the law relating to reissues (Revised Statutes, section 4916) would perhaps be that, if a patent should be inoperative by reason of a defective specification, or invalid for claiming too much, the defect might be supplied or the excessive claim be reduced by reissue. *Smith v. Merriam*, 6 Fed. Rep., 713.

§ 5531. But the courts have given a very different interpretation, much wider in most respects and narrower in only one. They do not permit a defective specification to be supplied excepting from the drawings or model; but they do permit the claim to be varied provided the same invention is described in both patents. *Ibid.*

§ 5532. The validity of a reissued patent is not affected because it describes features not described in the original, and points out their functions, if they were shown in the original drawings. *Bantz v. Elsas*, 6 O. G., 117.

§ 5533. Where a reissued patent claimed a feature which was not described in the original specification, nor clearly shown in the drawings, and the model was so injured as to furnish no evidence respecting it, it was held on other proof that the model originally contained the disputed feature, and the patent was held valid. *Aultman v. Holley*, 11 Blatch., 317.

§ 5534. A reissued patent cannot be sustained if it claims devices which are not shown either in the specification, drawing or model of the original application, nor suggested by them, whatever may be the extrinsic proof that they formed a part of the patentee's invention. *Carew v. Boston Elastic Fabric Co.*, 3 Cliff., 356; *Sarven v. Hall*, 9 Blatch., 524.

§ 5535. The applicant for reissue cannot interpolate new features not described, suggested or substantially indicated in his original specification, drawings or model. Such interpolations in a reissue patent, if material, show that the commissioner exceeded his jurisdiction; and where that is done it clearly becomes the duty of the court to declare the patent void. *Thomas v. Shoe Machinery Mfg. Co.*, 16 O. G., 541.

§ 5536. Where the original specifications and drawings did not show the absence or presence of the feature in the enlarged reissue, the latter was sustained in view of the fact that it did not appear whether or not the feature was shown in the original model. *Hendy v. Golden State & Miners' Iron Works*, 17 Fed. Rep., 515.

§ 5537. In an application for reissue, parol testimony is not admissible to enlarge the scope of the invention beyond what was described, suggested or substantially indicated in the original specification, drawings or patent office model. *Union Paper Collar Co. v. Van Dusen*, 23 Wall., 530 (§§ 398-406).

Reissues. — New matter — Defined, §§ 5538-5541. *Cannot be introduced in reissue,* §§ 5542-5544; *except in case of a machine,* § 5545. *What is,* § 5546; *what is not,* § 5547. *Must clearly appear,* §§ 5548, 5549. *Pro tanto recovery in case of,* § 5550.

§ 5538. "New matter," act 1870, supposed to mean new substantive matter, such as would have the effect of changing the invention, or of introducing what might be the subject of another application for a patent. *Atlantic Giant Powder Co. v. California Powder Works*, 8 Otto, 126.

§ 5539. New matter is such an enlargement of the original specification or claims as to include combinations or results which did not necessarily flow from the invention as originally stated and described. *Putnam v. Yerrington*, 9 O. G., 689.

§ 5540. By new matter is not meant merely the introduction of a new ingredient in a patented composition, but any change in the original specification and claim, whereby a new and substantially different composition and results are secured. *United States & Foreign Salamander Felting Co. v. Haven*, 3 Dill., 131.

§ 5541. What is and what is not "new matter" in relation to a reissue. *Yale Lock Mfg. Co. v. Scovill Mfg. Co.*, 18 Blatch., 248.

§ 5542. Section 4916 of the Revised Statutes of the United States prohibits in a reissue not only the introduction of new matter, but also the enlargement of the original claim growing out of the subsequent advancement of the art. This rule controls both the patent office and the courts. *United States & Foreign Salamander Co. v. Haven*, 3 Dill., 131.

§ 5543. The section upon the subject of reissues prohibits the introduction of "new matter" into the specification, even though the new matter was the invention of the patentee and was inadvertently omitted from the original application. *Atwater Mfg. Co. v. Beecher Mfg. Co.*, 8 Fed. Rep., 608.

§ 5544. The prohibition of the statute in relation to reissue applications is limited to the adding of new matter to the specifications, and there is no obligation upon the patentee to claim all things in the reissue which were claimed in the original invention. (*Carver v. Braintree Mfg. Co.*, 2 Story, 438.) *Albright v. Celluloid Harness Trimming Co.*, 12 O. G., 227.

§ 5545. In determining the propriety of the reissue no new matter can be introduced into the specification, except in case of a machine patent. It is only with respect to patents of that character, where no models or drawings exist, that, in our judgment, any notice can be taken by the commissioner of matter outside of the original specification and claim. *Atlantic Giant Powder Co. v. Cal. Powder Works*, 3 Saw., 448.

§ 5546. Where, on an application for reissue, the original reissue application was all erased, except the opening and conclusion, and a second application was substituted, differing in important particulars from the first, but not sworn to, *held*, that the reissue granted thereon was invalid. *Whitely v. Swayne*, 4 Fish., 117.

§ 5547. It is no enlargement of the invention to draw the reissue claim so as to cover various kinds of bell, the original being laid simply to a gong-shaped bell. The drawings and specification clearly show that the form of bell is not an essential characteristic of the invention, and it is manifest that the original claim must have been unnecessarily limited. *Gong Bell Manufacturing Co. v. Clark*, 13 O. G., 274.

§ 5548. It must clearly appear that new matter has been introduced before a reissue or its claims can be rejected. *Dederick v. Cassell*, 9 Fed. Rep., 306.

§ 5549. Where the original patent is not in evidence the question of new matter in the reissue cannot be determined. *Consolidated Oil Well Packer Co. v. Eaton*, 12 Fed. Rep., 865.

§ 5550. Where the new matter introduced in the reissue is so interwoven with the descriptive portion of the claim that it cannot be separated from the other matters therein described, the principle of recovery *pro tanto* on the valid claim, in the absence of a disclaimer, does not apply and there can be no recovery. *Cahart v. Austin*, 2 Cliff., 528.

Reissue — For a process, §§ 5551-5553. *A machine reissued for a process,* §§ 5554-5558. *A process reissued for a product,* §§ 5559-5561; *for an article of manufacture,* § 5562. *For an article of manufacture,* § 5563. *For a product,* §§ 5564, 5565. *For a composition of matter,* §§ 5566-5568.

§ 5551. A reissued patent is not the less valid because it contains a full account of processes which, although adverted to in the original, were not described at length, because they were well known in the art. *Goodyear Dental Vulcanite Co. v. Smith*, 1 Holmes, 354.

§ 5552. A patentee cannot, by obtaining a reissue for a process, enlarge his right to a monopoly beyond the actual invention. *Clark v. Kennedy Manufacturing Co.*, 14 Blatch., 79.

§ 5553. The reissued patent, having been expanded to embrace a claim for purifying mid-

dlings, when no such process was described, suggested or claimed in the original patent, is void. *American Middlings Purifier Co. v. Atlantic Milling Co.*, 5 Dill., 127.

§ 5554. A reissued patent is valid, although the description of a machine to which the invention may be applied is substituted in the specification for the purpose of illustration instead of the description of another contained in the original, which was so imperfect that it failed to show the application. *Aultman v. Holley*, 11 Blatch., 317.

§ 5555. Where a broad claim to a process not found in the original patent is introduced in the reissue, it cannot, by construction, be limited to the mechanism, but must be held to cover the mode of operation generally, and is void. *Hatch v. Moffitt*, 15 Fed. Rep., 252.

§ 5556. The rule reiterated that a patent for a machine cannot be reissued for the purpose of claiming the process of operating that machine, because if the claim for the process is anything more than for the use of the particular machine patented it is for a different invention. *Heald v. Rice*, 14 Otto, 737.

§ 5557. A patent for a machine cannot be broadened on reissue to cover a process described in the original patent. If the process was patentable, it should have been included in the original patent. *New v. Warren*, 22 O. G., 587.

§ 5558. A reissue for a process of an original patent for a mechanism to accomplish a specific result is much broader than the original patent and covers every mechanism which can be contrived to carry on the process. *Wing v. Anthony*, 106 U. S., 142.

§ 5559. A reissue for a product of an original process patent is valid. *Tucker v. Dana*, 7 Fed. Rep., 213.

§ 5560. A patent granted for certain processes of exploding nitro-glycerine will not support a reissue for a composition of nitro-glycerine and gunpowder or other substances, even though the original application claimed the invention of both process and compound. They are distinct inventions. *Atlantic Giant Powder Co. v. California Powder Works*, 8 Otto, 126.

§ 5561. An original patent for a process will not support a reissued patent for a composition, unless the composition is the result of the process, and the invention of the one involves the invention of the other. *Ibid.*

§ 5562. A reissue of a process patent for the article of manufacture distinctly indicated, but not technically claimed in the original, is valid. *Penna. Salt Co. v. Thomas*, 5 Fish., 148.

§ 5563. A claim in an original patent to an article of manufacture is a curable defect, and may be claimed in the reissue as a combination. *Middletown Tool Co. v. Judd*, 3 Fish., 141.

§ 5564. The claimant's original patent claimed glue reduced to minute shavings by a rasping process performed in a machine constructed to give the glue such a form and no other. His reissued patent described the same process and machine, and claimed the product. It was held valid, although it also contained amendments evidently intended to cover glue reduced to fine particles by crushing or other means. *Milligan & Higgins Glue Co. v. Upton*, 4 Cliff., 237.

§ 5565. Reissue patents for the product, after the rejection and withdrawal of an application for a patent for the product and the taking out of a patent for the machine alone, of doubtful validity. *American Carpet Lining Co. v. Manhattan Carpet Lining Co.*, 20 O. G., 372.

§ 5566. A patentee cannot, upon a reissue, appropriate the use in any or all proportions of the ingredients specified in a patent for a composition, although in his original specification he claimed the right to vary the proportions named; he is entitled to only those which will result in a product possessing the peculiar properties of his original compound. *Francis v. Mellor*, 1 O. G., 48.

§ 5567. Where the original patent described a compound consisting of two ingredients, one of which was an inexplusive porous substance, a reissue covering all porous substances, whether explosive or inexplusive, which would form with nitro-glycerine a compound equally safe for handling, is void as for a different invention. *Atlantic Giant Powder Co. v. California Vigorit Powder Co.*, 6 Saw., 508.

§ 5568. A reissued patent for a composition may be valid although some of the ingredients specified in the original patent are omitted, provided the composition possesses substantially the same characteristics and is capable of the same uses. *Francis v. Mellor*, 1 O. G., 48.

Reissue — *A combination claim cannot be reissued for a combination of a less number of elements*, §§ 5569-5578.

§ 5569. A patent for a combination of four elements, which does not suggest any other improvement, cannot be reissued with a claim for a combination of three of those elements, omitting all reference to the fourth. *Gill v. Wells*, 22 Wall., 1.

§ 5570. A suit for the infringement of such a reissued patent cannot be maintained against any one who uses a combination of the three elements embraced in it, even though he uses with them a substitute for the omitted element. *Ibid.*

§ 5571. A patent for a combination of old elements cannot be reissued for the separate elements, because the elements are old, and because it is for a different invention from that in the

original patent. (Dissenting opinion of CLIFFORD, MILLER and DAVIS, JJ.) *Corn-Planter Patent*, 23 Wall., 181.

§ 5572. The omission in a reissue of an element essential to the invention as originally described and patented is fatal to the reissue. *Cammeyer v. Newton*, 16 O. G., 720.

§ 5573. Where the specification of the original patent suggested no invention save the one contained in the entire combination, the claim in the reissue for a less number of elements than it embraced was declared void. *Miller & Co. v. Bridgeport Brass Co.*, 14 Blatch., 282.

§ 5574. Had it been intimated in the original patent that the less number of elements could be used in combination, this would have justified a claim to them on reissue. *Ibid.*

§ 5575. Without such suggestion the claim is invalid, as a departure from the original invention. *Ibid.*

§ 5576. Where complainants in their reissue split up and divided the elements of their invention, and claimed them separately and not as a combination, and the separate claims embraced fewer elements in combination than were embraced in the claim of the original patent, *held*, that this enlarged the scope of the patent, and that the reissue was for a different invention from that embraced in the original patent. *Matthews v. Boston Machine Co.*, 15 Otto, 54.

§ 5577. It is an enlargement of a claim for a combination of several elements (seven) to reissue it for a combination of a less number of them (five). *Gage v. Herring*, 107 U. S., 640.

§ 5578. If a patent containing a single claim for a combination of several elements is, within four months before its expiration, reissued and extended with the same description as before, but with two claims, the one a repetition of the original claim, and the other for a combination of some of the elements only, the reissue is invalid as to the new claim, and valid as to the other. *Ibid.*

Reissue — *A combination may be reissued with claims to the separate elements*, §§ 5579-5582; *to subcombination*, §§ 5583-5589.

§ 5579. A patentee, whose devices are new, is at liberty to claim each, by way of reissue, although he may have represented and claimed them originally as acting conjointly. *Gallahue v. Butterfield*, 10 Blatch., 232.

§ 5580. Where the thing shown and described in the original patent and in the reissue is the same, but in the original has been claimed with all its features in combination, the patentee can in the reissue modify or divide his claims so as to embrace severally the distinct features of the thing invented. *Smith v. Merriam*, 6 Fed. Rep., 713.

§ 5581. When the real invention was a box-loop for carriage-tops of a particular construction, and the claim of the original patent was limited to the use of the box-loop in connection with an adjunct — a new strengthening or stiffening plate — *held*, that the patent might be reissued for the purpose of inserting a claim for the loop itself, without reference to the strengthening plate. *Crandal v. Walters*, 9 Fed. Rep., 659.

§ 5582. The introduction into reissued letters patent of claims for the patentable parts of the combination claimed in the original letters does not invalidate the reissued letters, if the patentee was the first inventor of the patentable parts claimed, although the original patent was for the combination alone, so described and claimed that the parts were not to be used separately, but together and simultaneously. *Odell v. Stout*, 22 Fed. Rep., 159.

§ 5583. When, in the specification of the original patent, the inventor describes a new and useful combination of a number of ingredients, performing, in combination, certain functions less than he has claimed, he may in the reissue claim such combination of the less number which he has described, suggested or substantially indicated as his invention, but failed to include in his claims. *Pearl v. Ocean Mills*, 11 O. G., 2.

§ 5584. The doctrine of *Vance v. Campbell*, 1 Black, that the use of a less number of elements than are contained in the patented combination is no infringement because not the same invention, does not apply to the practice of reissuing patents. It is true the law requires that reissues shall be for the same invention as the originals on which they are based, but it is no departure to make separate claims to subcombinations which were originally joined in one. *Herring v. Nelson*, 14 Blatch., 293.

§ 5585. The validity of a unitary combination which contained a less number of elements than was stated and claimed in the original patent upheld in the reissue. *Herring v. Nelson*, 14 Blatch., 293.

§ 5586. The doctrine in *Herring v. Nelson*, 12 Official Gazette, approved. Separate claim may be laid in the reissue to subcombinations of elements united originally in one general combination claim. *Kerosene Lamp Heater Co. v. Littell*, 13 O. G., 1009.

§ 5587. The original patent claimed the entire combination, and the reissue subcombinations which enter into such general and larger combination. *Held*, that the reissue was for

things contained within the apparatus described in the original patent, on the authority of *Brown v. Guild*, 23 Wall., 181, and *Herring v. Nelson*, 14 Blatch., 293, as against *Gill v. Wells*, 22 Wall., 1, and *Russell v. Dodge*, 3 Otto, 460. *Christman v. Rumsey*, 17 Blatch., 148.

§ 5588. When the specification and drawings of the original and reissued patents illustrate and describe the same mechanical structure, with the same mode of operation, the reissue may lawfully contain claims to combinations of fewer elements than were contained in the combination claimed in the original patent. *Ibid.*

§ 5589. The omission in an original patent to claim subcombinations in the combinations claimed, the existence of such subcombinations being apparent on the face of the original patent, *held*, on the facts in the case, such a dedication of them, if new, to the public, that a reissue to cover such subcombinations in revocation of such dedication cannot avail to the prejudice of rights acquired by the public before the reissue was applied for. *Clements v. Odorless Excavating Apparatus Co.*, 109 U. S., 641.

Reissues — Combination — *Must be for the original combination*, §§ 5590, 5591. *May claim combination shown but not claimed*, 5592-5596. *May omit element not material to combination*, § 5597. *Cannot substitute a new element for an omitted element*, §§ 5599, 5600.

§ 5590. The reissue must be confined to the original combination, and cannot be expanded to make a new combination by the introduction therein of devices new or old, not included in or suggested by the original. *Washburn & Moen Mfg. Co. v. Fuchs*, 16 Fed. Rep., 661.

§ 5591. Where a patentee, in his specifications, claims as his invention a particular part of the machine, and his claims are all limited to that part, a reissue embracing other and distinct portions of the machine, is not for the same invention, and is *pro tanto* void, although the designs accompanying the original patent show all the features contained in the reissue. *Flower v. City of Detroit*, 22 Fed. Rep., 292.

§ 5592. Nothing which is plainly embraced in the specifications, model or drawings of the original patent is regarded by the courts as new matter. Mechanical combination shown but not claimed in the original may be lawfully claimed by reissue. *Dederick v. Cassell*, 9 Fed. Rep., 306.

§ 5593. Although a patented combination proves impracticable, yet the patentee may, upon a reissue, claim such devices and such combinations of devices as are new and are shown in his original application, provided they can be made operative without further invention. *Wheeler v. Clipper Mower & Reaper Co.*, 10 Blatch., 181.

§ 5594. The drawings being identical with those of the original patent, it is no violation of the reissue privilege to include in the new specification and claims what was fairly indicated by the drawings to be within the invention. *Kerosene Lamp Heater Co. v. Littell*, 13 O. G., 1009.

§ 5595. Thus, features of construction shown in combination and in a manner that would enable a skilled mechanic to practice the invention, although neither described nor claimed originally, may be set forth and protected upon reissue. *Ibid.*

§ 5596. It is of no consequence that a reissue states that certain combinations are found in the machine which will act in a certain way and effect certain results, when the original did not state that such combinations were found there, or failed to state that said modes of operation and said results would follow, provided the said combinations in fact existed in a machine made according to the drawings and description in the original patent, or provided the said modes of operation and the said result in fact followed in a machine so made. To supply such defects is the very object and office of a reissue. *Potter v. Stewart*, 18 Blatch., 561.

§ 5597. A patentee is not bound to include in the claim of his reissued patent an element of the original claim — a pin connecting a clamp-piece and a screw — which was not necessary or material to the combination, and which was found to be practically useless. *McWilliams Manufacturing Co. v. Blundell*, 11 Fed. Rep., 419.

§ 5598. Defects in the description of an original patent may be cured by reissue, but the patentee may not strike out the entire description of one of the ingredients of a combination, and insert in lieu thereof a description of other devices, unless it be alleged that such other devices are the equivalents of the device stricken out. *Tucker v. Tucker Mfg. Co.*, 4 Cliff., 397.

§ 5599. A patent for a combination of four elements cannot be reissued for a combination of three of the original elements with a substitute for the fourth, unless it was known at the date of the patent to be a proper substitute; and it should be explained, it seems, that the substitute is an equivalent for the omitted element, and why the change is made. *Gill v. Wells*, 22 Wall., 1.

§ 5600. When the original patent described a certain form of mica chimney united to a glass base, a reissue claiming such glass base in combination with any form of chimney-top was re-

garded as greatly enlarging the scope of the invention by dropping one element from the combination and putting in its place another not its equivalent. *Blackman v. Hibbler*, 17 Blatch., 333.

Reissues — Combinations in general — *New matter*, § 5601. *May include elements implied in original claim*, § 5602. *May include mode not shown in original*, § 5603. *Expansion*, § 5604. *Claiming a combination not so called in original*, § 5605.

§ 5601. Under act 1870, section 53, a reissue with description of combinations of elements of the original other than that contained in the original, is new matter. *Gill v. Wells*, 22 Wall., 1.

§ 5602. Where a reissue claim was to a combination of certain elements claimed in the original patent, and also included elements implied or understood in the original claim, it was held but another mode of formulating such original claim, and not an expanded claim. *Fay & Co. v. Fraser*, 11 Biss., 422.

§ 5603. Where the gist of the invention is the apparatus, or combination of parts, and not any particular instrumentality by which it is put in operation, *held*, that because one mode only was indicated in the original, the patentee was not shut up to the one mode in the reissue as long as it was not the essence of the invention. *Broadnax v. Central Stock Yard & Transit Co.*, 4 Fed. Rep., 214.

§ 5604. A claim to a combination of parts which specifies that such parts are constructed in a particular way for a special purpose cannot be expanded by reissue so as to include combinations of those parts, expressed so as to cover them broadly and without limitation as to their construction or advantages. *McMurray v. Mallory*, 111 U. S., 97.

§ 5605. An arrangement of devices was described in an original patent, although it was not called a combination. *Held*, that a reissue calling it a combination, and containing a statement that the invention consisted also in this combination, does not appear to vary the prior description in effect. *American Diamond Rock-Boring Co. v. Sheldon*, 33 O. G., 1598.

Reissues — Effect of disclaimer in original, § 5606; *actual*, §§ 5607-5612; *constructive*, §§ 5613-5616. See *Disclaimer*, §§ 1994, 2012, 2022, 2026, 2030-2040, 2045. *Errors*, § 2182. *Priority of Invention*, § 5018.

§ 5606. A reissued patent is within the letter and the spirit of the provisions of the patent act relating to disclaimers. *Gage v. Herring*, 107 U. S., 640.

§ 5607. A statement in an original patent that a part is old, or a disclaimer of a part, does not, it seems, necessarily prevent its being claimed on reissue, though it would have that effect if made advisedly. *Hussey v. Bradley*, 5 Blatch., 134.

§ 5608. It is doubtful whether a reissue patent can be sustained in any case where it contains claims that have once been formally disclaimed by the patentee or rejected with his acquiescence, and he has consented to such rejection in order to obtain his patent. *Leggett v. Avery*, 11 Otto, 256.

§ 5609. In such case the rejection (*omission*) of the claim can in no just sense be regarded as a matter of inadvertence or mistake, and even if it were such, the applicant would seem to be estopped from setting it up on an application for a reissue. *Ibid*.

§ 5610. Doubts expressed as to whether reissued letters patent can be sustained when they contain claims which have once been formally disclaimed by the patentee, or rejected with his acquiescence, and he has consented to such objection in order to obtain his patent. *Goodyear Dental Vulcanite Co. v. Davis*, 12 Otto, 222.

§ 5611. Where patentee claimed in the reissue what had been distinctly waived by disclaimer in the original patent, it was held to be new matter and the claim void. *Atwater Mfg. Co. v. Beecher Mfg. Co.*, 8 Fed. Rep., 608.

§ 5612. A statement in the original patent that a part is old, or a disclaimer to a part, made from inadvertence, will not necessarily prevent claiming such matter on reissue. *Hussey v. Bradley*, 5 Blatch., 134.

§ 5613. A patentee is not estopped by words in his original specification which he has omitted in his reissue. *Allen v. Blunt*, 2 W. & M., 121.

§ 5614. Dedication to the public in an original patent may be revoked on reissue. *Battin v. Taggart*, 17 How., 74.

§ 5615. A patentee reissuing his patent has no right to omit something which he had before described as essential. *Atwood v. Portland Co.*, 10 Fed. Rep., 283.

§ 5616. Where it appeared that a reissue granted seventeen months subsequent to grant of original patent was a *deliberate* attempt to contradict leading assertions in the original specification, the enlarged claims to such matter were held invalid. *McKay v. Stowe*, 17 Fed. Rep., 516.

Reissue — *Right may be lost by delay*, § 5617. *Laches, how determined*, § 5618. *Unreasonable delay*, §§ 5619-5621; *particular cases*, §§ 5622-5642.

§ 5617. The right to have corrections made by reissue may be abandoned and lost by unreasonable delay. *Terrell v. Bradford*, 23 O. G., 1623.

§ 5618. Laches in reissuing is determined not merely on a question as to what information respecting their rights parties do actually obtain, but as to what information they might have obtained had they used the means and opportunities directly at their command. *Ives v. Sargent*, 17 Fed. Rep., 447.

§ 5619. A delay of more time than would be reasonably sufficient to read the patent and ascertain its need of amendment should be accounted laches in a case where enlargement of a claim is the only amendment. *Hartshorn v. Eagle Shade Roller Co.*, 18 Fed. Rep., 90.

§ 5620. In determining whether an inventor is guilty of inexcusable delay, the fact that the correction of a mistake by reissue was before any adverse rights had accrued is a consideration of paramount importance, and it ought to count something in his favor that, being of foreign birth, education, and an alien tongue, he encountered difficulties in acquiring a knowledge of our language and laws. *Stutz v. Armstrong & Son*, 20 Fed. Rep., 843.

§ 5621. The settled rule is, where the claim is merely expanded, that a delay of more than two years in applying for a reissue invalidates the reissue, unless such delay is accounted for and excused by special circumstances. It is a question of law arising on the face of the bill where such delay is not therein explained; and the court cannot substitute the decision of the patent office upon that question for its own. *Wollensak v. Reiher*, 115 U. S., 96.

§ 5622. Where a process patent was reissued, after a lapse of four years, to cover the product also, *held*, that it was a mistake apparent upon the first inspection of the claim, and such product claim was held void for laches. *Union Tubing Co. v. Patterson & Co.*, 23 Fed. Rep., 79.

§ 5623. Where there was a delay of nearly four years, and the original patent was plain, simple, and free from obscurity, it was held that the delay in seeking a correction by reissue was unreasonable, and that the commissioner had, therefore, no authority to grant it; and the patent was held invalid so far as the claims were broader than those in the original patent. *Mahn v. Harwood*, 112 U. S., 354.

§ 5624. Where the reissue was obtained five years after grant of the original patent for a mistake apparent at the time, and disclaimed by implication, it was held void for delay in reissuing, and was not for "a mistake and inadvertence" within the scope of a reissue. *Streit v. Lauter*, 11 Fed. Rep., 309.

§ 5625. If an enlargement and alteration of the scope of a patent by reissue is in any case allowable, an unexplained delay of five years must be deemed unreasonable. *Singer Mfg. Co. v. Goodrich*, 15 Fed. Rep., 455.

§ 5626. The enlargement of the scope of a claim six years after the original patent is not valid. *American Diamond Rock-boring Co. v. Sheldon*, 33 O. G., 1598.

§ 5627. Where a patent claiming a combination was reissued six years after, with a claim to one of the parts of the combination, the reissue was held to be for a different invention, and that the part claimed was abandoned, having been six years in use prior to his claim. *Battin v. Taggert*, 2 Wall. Jr., 101.

§ 5628. After a lapse of eight years no amendment can be imported into a reissue to effect a broadening of the claim of the original in the absence of very special circumstances. *Tuttle v. Loomis*, 30 O. G., 344.

§ 5629. An inventor, having in his original patent limited his claim of invention to a specified detail of construction, cannot, after a lapse of nine years, procure a valid reissue embodying the enlarged and comprehensive claims that might have been allowed in the original patent. *Sheriff v. Fulton*, 12 Fed. Rep., 136.

§ 5630. When a process claimed in a reissue granted nine years after the original, which was for the apparatus, is merely the employment of the devices described in such original, and is therefore fully disclosed, and other inventors have in the meantime occupied the ground, such process must be held to be abandoned to the public. *Brainard v. Cramme*, 12 Fed. Rep., 621.

§ 5631. The original patent claiming a type-wheel provided with yielding flanges to permit the types to be impressed upon the surface to be marked, a claim in a reissue granted after the manufacture of non-infringing devices, and nine years after the issue of the original, *held* not to be sustainable to cover rigid flanges. If there were any error in restricting the original to elastic flanges it was a plain one, apparent at once to the patentee, and as capable of prompt correction then as after a lapse of more than nine years. *Holt v. Keeler*, 13 Fed. Rep., 464.

§ 5632. Doubtful whether, after a delay of nine years, the claim of a patent can be materially enlarged upon the suggestion that the original claim was defective in form and required amendment. *Sheriff v. Fulton*, 12 Fed. Rep., 136.

§ 5633. Where a mechanical patent was reissued after a lapse of eleven years so as to include the process, *held*, that the process was a different invention, and that the patent was void for delay in reissuing. *Scrivner v. Oakland Gas Co.*, 22 Fed. Rep., 98.

§ 5634. *Semble*, that, when a patentee has slept upon his rights for thirteen years, it is too late to seek redress by way of reissue. No tribunal ought to encourage or countenance such gross negligence. *In re Cushman*, 1 MacA. Pat. Cases, 577.

§ 5635. Where two reissue patents were reissued, one eleven and the other thirteen years subsequent to the grant of the original, the right to reissue was held lost and abandoned by unreasonable delay. *Pope Mfg. Co. v. Marqua*, 15 Fed. Rep., 400.

§ 5636. Where the only mistake suggested is an omission of a claim, and the patentee neglects for thirteen years to file his application for reissue, *held*, that he must be regarded, in view of his conduct, as intending to dedicate such invention to the public, and he is estopped from asserting his claim to such invention in a reissue. *Combined Patents Can Co. v. Lloyd*, 11 Fed. Rep., 149.

§ 5637. It is incumbent upon the owner of a patent, when a reissue is taken thirteen years after the date of the original, to show that there was some mistake or inadvertence in the original which necessitated a reissue. *Newton v. Furst & Bradley Mfg. Co.*, 14 Fed. Rep., 465.

§ 5638. If the specification of the original patent was defective or insufficient in claiming a combination of several devices, instead of making distinct claim for every device which entered into the combination, the fact was instantly discernible, even by an unpracticed eye, as soon as the patent was read. The correction, if any was to be made under such circumstances, should have been applied for immediately. The right to the correction was lost by unreasonable delay of thirteen and a half years. *Bantz v. Frantz*, 105 U. S., 160.

§ 5639. Where matter claimed in the reissue, made fourteen years after the original patent, was not contained in the original, it was held void. *Sickles v. The Falls Co.*, 4 Blatch., 508.

§ 5640. Where the original patent shows upon its face that certain broad claims were not made, the patentees, if they are the inventors of such subject-matter, when apprised that it was not claimed in the patent, should use due diligence in surrendering the patent and having the mistake corrected. Fourteen years is too long a period of delay. *Matthews v. Boston Machine Co.*, 15 Otto, 54.

§ 5641. Where there was a lapse of more than fourteen years between the grant of the original and the date of the reissued patent, *held*, that the patentee had been guilty of such laches as to invalidate the reissue. *Hyatt v. Southworth*, 15 Fed. Rep., 751.

§ 5642. It appearing that the device in question was in general use throughout the entire life of the original patent, *held*, that there was no error in the original patent caused by inadvertence, accident or mistake which could have escaped the notice of the patentee and his associates for fifteen years, and even if the patentee had the right to a reissue, if applied for in seasonable time, he had lost it by his laches and unreasonable delay. *Johnson v. Railroad Co.*, 105 U. S., 539.

Reissues — *Limitation as to time*, §§ 5643, 5644. *Must be made in reasonable time*, §§ 5645, 5646. *Reasonable delay*, §§ 5647-5649; *particular cases*, §§ 5650-5656.

§ 5643. Limitation as to time within which a patent may be reissued considered. *Hussey v. Bradley*, 5 Blatch., 134.

§ 5644. The fact that a reissue application was filed within two years after the grant of an original patent, while it may not be conclusive against the charge of unreasonable delay, is entitled to some consideration in view of that provision of the patent laws by which nothing less than two full years' public use of an invention is a bar to an application for a patent. *Stutz v. Armstrong*, 20 Fed. Rep., 843.

§ 5645. A reissue must be taken within a reasonable time after the error upon which it is based has been discovered. *Knight v. B. & O. R. Co.*, Taney, 106.

§ 5646. The application for a reissue for the purpose of enlarging the claim must be made within a reasonable time, because the rights of the public, conceded by the original patent, are directly affected and violated by an enlargement of the claim; and the patentee's continued acquiescence in the public enjoyment of such right for an unreasonable time justly deprives him of all right to a reissue, and the commissioner of lawful authority to grant it. *Mahn v. Harwood*, 112 U. S., 354.

§ 5647. *Semble*, that a reissue applied for within two years after the issue of the original patent may include a claim rejected in the original application. *Kells v. McKenzie*, 9 Fed. Rep., 284.

§ 5648. A reissue granted within a few months of the date of the original patent, and before others appear to have done anything in that region of invention, is looked upon favorably. *Dryfoos v. Wiese*, 19 Fed. Rep., 315.

§ 5649. A patent reissue with claims more specifically and clearly describing the invention is valid, although applied for more than two years after the date of the original patent, and although the original claims in connection with the specification were capable of the same construction as the claims of the reissued patent. *Hicks v. Otto*, 19 Fed. Rep., 749.

§ 5650. There is no rule fixing the precise time within which application for a reissue must be made. What is a reasonable time is a question, when a reissue is attacked, to be decided by the court upon the case presented. The rule is equitable, and therefore flexible, and to be applied according to equity. *Odell v. Stout*, 22 Fed. Rep., 159.

§ 5651. Upon the authority of *James v. Campbell* and other decisions of the supreme court, it is clear that the claim of a patent may be enlarged by a reissue if the patentee move promptly and no rights of others have intervened, and the delay in this case of six months is not unreasonable. *Ibid.*

§ 5652. In a suit for infringement of a reissued patent for an improvement in preserving meats, etc., involving two claims which were not in the original patent, it is held as follows: There is not unreasonable delay in applying, between two and three months after date of the original patent, for a reissue enlarging the claims to cover parts of an invention already described, especially where it appears that the application is not made for the purpose of covering the improvements of other inventors. *Hammond v. Franklin*, 22 Fed. Rep., 833.

§ 5653. No invariable rule can be laid down as to what is a reasonable time within which the patentee must seek for the correction of a claim which he considers too narrow. It is for the court to judge in each case, and it will exercise proper liberality toward the patentee; but as the law charges him with notice of what his patent contains, he will be held to reasonable diligence. By analogy to the rule as to the effect of public use before an application for a patent, a delay of more than two years would, in general, require special circumstances for its excuse. *Mahn v. Harwood*, 112 U. S., 354.

§ 5654. Where the original patent was reissued with broader claims within four months from its date of grant, *held*, there was no laches in reissuing and that the reissue was valid. *Worswick Mfg. Co. v. Steiger*, 17 Fed. Rep., 250.

§ 5655. Where the delay in reissuing of nearly eight years resulted from an actual mistake discovered by testimony given in court seven years after the grant of the original patent, and such as could not be accounted as laches on the part of patentee, and was one from which no innocent person could have suffered, the reissue was sustained. *Hartshorn v. Eagle Shade Roller Co.*, 18 Fed. Rep., 90.

§ 5656. Delay of ten years in reissuing a patent is not such laches as will avoid it. *Hussey v. Bradley*, 5 Blatch., 132.

Reissues — Divisional — Are valid, §§ 5657, 5658. When authorized, §§ 5659-5669.

§ 5657. Act 1837, section 5, authorizes the divisional reissue of the thing patented. *Good-year v. Providence Rubber Co.*, 2 Cliff., 351.

§ 5658. A patent may be reissued in divisions, but the patent cannot be broadened in that way any more than if reissued together. *New v. Warren*, 22 O. G., 587.

§ 5659. The patentee cannot reissue a patent which includes several distinct improvements in several reissues, unless there be some error in the specification arising from inadvertency, accident or mistake. *Butler's Opinion*, 3 Op., 165.

§ 5660. By the terms of the statute, a reissue must be for the same invention which is embraced by the original patent, or if the reissue be in divisional parts, each division must be for some distinct and separate part of that invention. *Atlantic Giant Powder Co. v. Cal. Powder Works*, 3 Saw., 448.

§ 5661. Where a patent is reissued in divisions, they are to be treated as but one patent, and the division in no wise impairs the validity of the reissues. *Penna. Salt Co. v. Thomas*, 5 Fish., 148.

§ 5662. It would seem to be a sound principle, that on a divisional reissue under act 1837, section 5, at patentee's desire, for distinct and separate parts of the thing patented, each part covered by the patent should stand by itself as an invention. *Brown v. Selby*, 2 Biss., 457.

§ 5663. When a patent is reissued in several divisions, no one of them is void on the ground that it describes all the mechanism shown in the original, provided the claim in each is for a different device, which is clearly described, and there is no conflict between them. *Wheeler v. McCormick*, 11 Blatch., 334.

§ 5664. On application for a divisional reissue, the commissioner has power to issue one or more divisions, and subsequently others; and until such application is ended in all its divisions, the vitality of the original continues so far as to support that part which remains undecided. *Phillips' Opinion*, 16 Op., 560.

§ 5665. Modified forms of an invention clearly shown in the original patent form "distinct

and separate parts of the thing patented," and may constitute subject-matter of separate patents upon reissue. *Selden v. Stockwell Self-Lighting Gas-Burner Co.*, 19 Blatch., 544.

§ 5666. A divisional reissue of an original patent into two patents, one for the process, and one for the product, is valid. *Tucker v. Burditt*, 4 B. & A., 569.

§ 5667. A new process or method of producing a new article, and the new product or manufacture, are proper subjects of separate and distinct claims in an original patent, and proper subjects for a reissue in divisions. *Goodyear v. Providence Rubber Co.*, 2 Cliff., 351.

§ 5668. The right to reissue a patent in two divisions, one for a new product, and the other for a new process of making it, even though the original patent related to the process alone, is fully sustained. (*Goodyear v. Providence Rubber Co.*, 2 Fish.) *Badische & Anilin Soda Fabrik v. Hamilton Manufacturing Co.*, 13 O. G., 273.

§ 5669. Where the original patent was reissued in two divisions, the divisional reissue was held within the discretion of the patent office and proper. *Bennet v. Fowler*, 8 Wall., 445.

See *Reissues*, §§ 5445, 5455.

Reissues — A reissue of a reissue is valid, §§ 5670-5676.

§ 5670. A reissue of a reissue is not valid unless the improvement described therein is, in its principle and mode of operation, the same with that intended to be described in the first reissue. *Knight v. B. & O. R. Co.*, Taney, 106.

§ 5671. Under act 1836, a reissue of a reissue is valid. *French v. Rogers*, 1 Fish., 133; *Morse v. Bain*, 9 West. L. J., 106.

§ 5672. Notwithstanding the fact that the patent has been reissued seven times, the law presumes that the last patent was granted to correct accidental or inadvertent mistakes in the original. The only test of the validity of the commissioner's action is whether he has allowed a reissue for a different invention from that covered by the original patent, or for what was not therein described, claimed or indicated. *Union Paper Collar Co. v. White*, 7 O. G., 698.

§ 5673. A claim valid in a first reissue is valid in a second reissue, notwithstanding the latter contains an invalid claim. *Dryfoos v. Wiese*, 19 Fed. Rep., 315.

§ 5674. Where an original patent is valid, but the reissue based thereon is invalid, there is no good reason why a second reissue embracing the valid claim alone of the original patent would not be valid. *Giant Powder Co. v. Safety Nitro Powder Co.*, 19 Fed. Rep., 509.

§ 5675. There may be a reissue of a reissue. Section 4916, Revised Statutes, authorizes the reissue of "any patent." A reissue patent is none the less a patent, within this section, because it is a reissued patent. *Selden v. Stockwell Self-Lighting Gas-Burner Co.*, 19 Blatch., 544.

§ 5676. Where a claim of a second reissue is no broader than the claim of the first reissue, it is valid, provided the first reissue was lawful. *Western Union Telegraph Co. v. Baltimore & Ohio Telegraph Co.*, 25 Fed. Rep., 30.

Reissues — Oath, §§ 5677-5683.

§ 5677. The oath of the inventor to the reissue application is necessary under act 1793. Taney's Opinion, 2 Op., 572.

§ 5678. Under the act of March 3, 1871, the oath of the assignees is sufficient upon an application for the reissue of a patent originally issued before July 8, 1870; the oath of the inventor is required only when the original patent issued after that date. *The National Car-spring Co. v. Union Car-spring Manufacturing Co.*, 12 Blatch., 80.

§ 5679. Where, in his application for reissue, applicant made oath that his patent was *not fully valid and available* to him, *held*, that it was not the oath required by the statute; and there being no evidence that the patent was "inoperative or invalid" before the commissioner, the reissue granted thereon was held invalid. *Whitely v. Swayne*, 4 Fish., 117.

§ 5680. Where the affidavit to a petition for reissue averred that the original or prior reissue was not "fully valid and available," *held*, that it was not an equivalent to the affidavit prescribed by the statute, and that the reissue granted thereon was invalid. *Poage v. McGowan*, 15 Fed. Rep., 398.

§ 5681. Where on reissue the petition and oath set out that the patent was "not fully" operative and valid, *held*, that it was not indispensable that the petitioner should use the exact phraseology of the statute, if he employs language which actually conveys its legal meaning. *Gold & Stock Telegraph Co. v. Wiley*, 17 Fed. Rep., 234.

§ 5682. The words "inoperative or invalid," in the statute authorizing reissues (4916, R. S.), mean inoperative or invalid in whole or in part, and consequently the words in an oath, "not fully inoperative," conform to the true intent of the law, if the law required an oath, which it does not. *Hartshorn v. Eagle Shade Roller Co.*, 18 Fed. Rep., 90.

§ 5683. In the matter of reissues there is no law requiring the applicant to take any oath on the subject of the invalidity of the original patent. *Ibid.*

See *Assignee*, § 558.

Reissues — Commissioner's decision — Conclusive, §§ 5684-5698. See *Identity*, §§ 5686, 5695.

§ 5684. The grant of a reissue by the commissioner of patents is conclusive as to the existence of all the facts which were by law necessary to entitle him to issue it; unless it was apparent on the face of the patent itself that he was guilty of a clear excess of authority, or that the patent was procured by fraud between him and the patentee. *Allen v. Blunt*, 3 Story, 742.

§ 5685. The commissioner's decision on reissue is final in all collateral proceedings. *Good-year v. Providence Rubber Co.*, 2 Cliff., 351.

§ 5686. The decision of the commissioner on reissuing a patent is conclusive to the effect that the reissue is for the same invention as the original; and is not re-examinable, unless it is apparent on the face of the patent that he has exceeded his authority, or unless there is a clear repugnancy between the old and new patents, or unless the reissue was obtained by collusion between him and patentee. *Potter v. Hollender*, 4 Blatch., 238.

§§ 5687-8. The decision of the commissioner as to reissues is final and conclusive, unless impeached for fraud in his or the patentee's acts, or for some irregularity arising on the face of the papers, or for a clear repugnance between the original and reissued patents. *Blake v. Stafford*, 6 Blatch., 195.

§ 5689. The grant of a reissued patent is conclusive as to all the facts which by law are necessary to entitle the commissioner to issue it, unless it is apparent on the face of the instrument itself that he was guilty of excess of authority. *French v. Rogers*, 1 Fish., 133.

§ 5690. Proof that the samples deposited in the patent office with the original application do not correspond with the ingredients specified in the reissue will not impair its validity; whether an applicant has complied with the requisites for obtaining a patent is for the commissioner to determine, and the court will not revise his action. *Tarr v. Folsom*, 1 Holmes, 312.

§ 5691. The decision of the commissioner in reissuing a patent is final, and forecloses all inquiry into the existence or sufficiency of the facts, which are prescribed as necessary to authorize him to grant a reissue; fraud even will not warrant a re-examination of his decision at the instance of an infringer. *Parham v. American Button-hole, etc., Machine Co.*, 4 Fish., 468.

§ 5692. All matters of fact involved in the hearing of an application for the reissue of a patent are conclusively settled by the decision of the commissioner in granting the application. Power to grant reissued as well as original patents is vested in the commissioner. When that power has been lawfully exercised and a patent has been duly granted, whether reissued or original, it is of itself, if introduced in evidence, where a party claims redress for alleged infringement, *prima facie* evidence that the patentee is the original and first inventor of that which is therein described and secured to him as his invention. *Judson v. Bradford*, 16 O. G., 171.

§ 5693. The question whether a patent is "inoperative or invalid by reason of defective or insufficient description or specification," and whether such defect has arisen by "inadvertence, accident or mistake, and without any fraudulent or deceptive intention," appears from the decisions of the court to be submitted finally to the judgment of the commissioner wherever the circumstances bring it within the jurisdiction conferred upon him by the statute. *Combined Patents Can Co. v. Lloyd*, 11 Fed. Rep., 149.

§ 5694. The decision of the commissioner of patents in granting a reissue, that, by reason of an insufficient or defective specification, the original patent is inoperative or invalid, and that such error arose from inadvertence, accident or mistake, and without any fraudulent or deceptive intention, conclusively establishes the fact. *Christman v. Rumsey*, 17 Blatch., 148.

§ 5695. The action of the commissioner of patents in granting a reissue within the limits of his authority is not open to collateral impeachment, but his authority being limited to a reissue for the same invention, the two patents may be compared to determine the identity of the invention. If the reissued patent, when thus compared, appears on its face to be for a different invention, it is void, the commissioner having exceeded his authority in issuing it. *Russell v. Dodge*, 3 Otto, 460.

§ 5696. The question as to whether the original patent was inoperative or invalid by reason of the defective or insufficient specification is conclusively decided by the commissioner by the fact of his granting the reissue. *Selden v. Stockwell Self-Lighting Gas-Burner Co.*, 19 Blatch., 544.

§ 5697. The commissioner of patents is invested by law with authority to determine whether surrendered patents are invalid by reason of defective or insufficient specifications, or by reason of the patentee's claiming as his own invention or discovery more than he had a right to claim as new, and whether these errors have arisen by inadvertence, accident or mistake, and without fraudulent intention. His decision as to the existence of these prerequisites is conclusive, and not subject to review by the courts. *Ball v. Langles*, 12 Otto, 128.

§ 5698. The action of the commissioner in accepting the surrender and granting the reissue is final and conclusive, unless it is apparent on the face of the patent that he has exceeded his authority; that it must be held, as a matter of legal conclusion from the repugnancy between them, that the reissued patent is not for the same invention as that embraced in the original patent. *Spaeth v. Barney*, 22 Fed. Rep., 828.

Reissues — Commissioner's decision — *Conclusive on the question of fraud*, § 5699; *not conclusive*, §§ 5700-5703.

§ 5699. The question of fraud in obtaining a reissue must be regarded as settled by the commissioner of patents in granting it. *Corn-Planter Patent*, 23 Wall., 181.

§ 5700. On the grant of a reissue by the commissioner of patents, the only question left open for inquiry is that of fraud. *Stimpson v. Railroad Co.*, 4 How., 380.

§ 5701. The action of the commissioner in granting a reissue cannot be questioned or impeached, unless on the ground of actual fraud in obtaining it, a palpable incongruity between the reissued and original patent, or an excess of authority on the part of the commissioner. *Morris v. Royer*, 2 Bond, 66.

§ 5702. The action of the commissioner in granting a reissue is not open for re-examination by the courts, except on the ground of fraud in its procurement. *Miller & Peters Mfg. Co. v. Du Brul*, 12 O. G., 351.

§ 5703. The question whether there is a fraud in the surrender and application for a reissue is for the officers of the patent office alone to decide, and their determination is conclusive in a collateral proceeding. The court can only examine and pass upon what appears upon the face of the patent, and see whether there is anything to indicate its invalidity or render it void upon its face. All questions of fact behind the patent are to be examined, heard, and conclusively determined by the commissioner of patents. *Giant Powder Co. v. Safety Nitro Powder Co.*, 19 Fed. Rep., 509.

Reissues — Commissioner's decision — *Excess of authority*, §§ 5704-5708. *Not conclusive as to identity*, §§ 5709-5715; *nor as to his jurisdiction*, § 5716. See *Estoppel*, §§ 2257-2259. *Patents*, § 4740.

§ 5704. The power to accept a surrender and issue new letters patent is vested exclusively in the commissioner of patents. He must judge of the sufficiency of the original specification, whether the same is defective in any particular, whether such defect was the result of an unintentional error, and if so to what extent a new or additional specification should be allowed to describe correctly the invention claimed. *Atlantic Giant Powder Co. v. Cal. Vigorit Powder Co.*, 6 Saw., 508.

§ 5705. But this does not preclude the examination by the court of the original and reissued patents to see whether or not they disclose on their face a case in which the commissioner has no jurisdiction to act, or a case in which, by his determination, he has exceeded his jurisdiction. If so, the reissued letters patent must fall. *Ibid.*

§ 5706. The only ground on which the allowance of a reissue is open to objection is, that the commissioner has exceeded his authority in granting it for an invention different from that embraced in the original patent. *Parham v. American Button-hole and Sewing Machine Co.*, 4 Fish., 468.

§ 5707. After reissue the commissioner's decision in the premises *in a suit for infringement* is final and decisive, and is not re-examinable in such a suit in the circuit court, unless it is apparent on the face of the patent that he has exceeded his authority, and that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original. *Thomas v. Shoe Machinery Mfg. Co.*, 16 O. G., 541.

§ 5708. The granting of a reissue is *prima facie* evidence of inadvertence, accident or mistake, as the granting of original letters is *prima facie* evidence of invention. This evidence is not conclusive, nor is the action of the commissioner of patents *res adjudicata*. *Odell v. Stout*, 22 Fed. Rep., 159.

§ 5709. On the question of identity of invention in the reissue and original patent, the commissioner's action is not conclusive, and is a question of fact for the jury. *Allen v. Blunt*, 2 W. & M., 121.

§ 5710. The decision of the commissioner is not conclusive upon the substantial identity of the invention claimed in the original and in the reissued patent. *Goodyear v. Berry*, 2 Bond, 189.

§ 5711. The action of the commissioner is presumed to a certain extent to be conclusive upon the question of identity of the inventions embraced in the original and reissued patent, except in cases of fraud. *Swift v. Whisen*, 2 Bond, 115.

§ 5712. The grant of a reissue by the commissioner is not conclusive upon the identity of the invention with that in the original. *Bridge v. Brown*, 1 Holmes, 53.

§ 5713. The decision of the commissioner on reissue is *prima facie* evidence of the identity of the invention with that in the original patent. The fairness of the transaction and the question of fraud in the surrender are alone open to court and jury. *Hussey v. Bradley*, 5 Blatch., 132.

§ 5714. The decision of the commissioner of patents in granting a reissue is re-examinable only when it appears upon the face of the reissued patent that it is for a different invention from that embraced in the original grant. *Wells v. Gill*, 2 O. G., 590.

§ 5715. Under act 1870, section 53, it is now well settled that the decision of the commissioner reissuing the patent is final and conclusive, and is not subject to review in any court, except as to the identity of the invention. *Kells v. McKenzie*, 9 Fed. Rep., 284.

See *Reissues*, §§ 5686, 5695.

§ 5716. Unless the reissue is for the same invention, the commissioner has no power to grant it; and the commissioner's decision is not conclusive as to his own jurisdiction. *Cahart v. Austin*, 2 Cliff., 528.

Reissues — Presumption as to acts of commissioner — Presumed to have been made legally, §§ 5717-5726. See *Process and Product*, § 5109.

§ 5717. A reissue by the commissioner is presumed to have been made legally. *Allen v. Blunt*, 2 W. & M., 121.

§ 5718. The action of the commissioner upon the right of parties to a reissue is, to a certain extent, presumed to be conclusive. *Swift v. Whisen*, 2 Bond, 115.

§ 5719. The commissioner, in reissuing a patent, is presumed to have performed his duty pursuant to law, and his decision is conclusive, except on the question of fraud. *Jordan v. Dobson*, 2 Abb., 398.

§ 5720. It is to be presumed, until the contrary appear, that the commissioner did his duty correctly in granting the reissued patent. *Klein v. Russell*, 19 Wall., 433.

§ 5721. When a reissue has been granted it is to be presumed that the commissioner has found all the conditions fulfilled on which he is authorized to issue it, and that it is for the same invention that is described in the original patent. *American Nicholson Pavement Co. v. City of Elizabeth*, 3 O. G., 522.

§ 5722. No such presumption can prevail if it appears on the face of the patent that the commissioner has exceeded his authority, or if there has been fraud or collusion between him and the parties. *Ibid.*

§ 5723. The action of the officers in the patent office in granting reissues must be presumed to be right, and the burden of proving the reverse is on the defendants. *American Middlings Purifier Co. v. Atlantic Milling Co.*, 4 Dill., 100.

§ 5724. It is to be presumed, from the decision of the commissioner of patents in granting a reissue, that it embraces the same invention as the original patent; and the contrary can be shown only by a comparison of the papers in the two cases. *Birdsell v. McDonald*, 6 O. G., 682.

§ 5725. The commissioner of patents alone is invested with authority to decide whether a patentee is entitled to a reissue, and after he has exercised this power and granted the reissue it becomes a presumption of law that he has done his duty thoroughly, faithfully and properly. *Miller & Peters Manufacturing Co. v. Du Brul*, 12 O. G., 351.

§ 5726. The action of the commissioner of patents in reissuing letters patent is doubtless of a judicial character, and is presumed to be correct until impeached in a regular way; and yet the court is not obliged to accept his decision as final. *Flower v. Rayner*, 19 O. G., 425.

See *Reissues*, §§ 5769-5776. *Patents*, § 4628.

Reissues — Commissioner's powers in granting, §§ 5727-5738.

§ 5727. If the commissioner grants a reissue for a different invention from that described in the original patent, it is invalid. *Tucker v. Tucker Mfg. Co.*, 4 Cliff., 397.

§ 5728. The commissioner of patents is not authorized to grant a reissue of a patent for an invention in addition to that shown in the original, in cases where there are no drawings nor models, upon proof that the addition was really a part of the same invention sought to be patented in the original. *Averill Paint Co. v. National Paint Co.*, 9 Fed. Rep., 462.

§ 5729. A reissue patent must in all cases be for the same invention as that contained in the original patent, and the last clause of section 4916, Revised Statutes, merely governs the manner of proof, but does not authorize the commissioner to grant a reissue for a different invention, or to determine that one invention is the same as another or different one, or that two inventions essentially distinct constitute but one. *Ibid.*

§ 5730. Whenever it appears, on a comparison of the two instruments, that the original patent is valid, it is clear that the commissioner has exceeded his jurisdiction, and the reissue is without authority of law. *Atlantic Giant Powder Co. v. Cal. Vigorit Powder Co.*, 6 Saw., 508.

§ 5731. The commissioner has no authority to grant a reissue embracing new matter or a broader invention than what was revealed in the original specifications, drawings or models. *Ball v. Langles*, 102 U. S., 128.

§ 5732. In deciding upon a reissue, whether it is for the same invention as the original, the commissioner is not limited to the claims, nor the specification, model or drawing of the original. Any legal proof to show it to be the same invention should be received. *Hussey v. Bradley*, 5 Blatch., 132.

§ 5733. The commissioner may allow a patentee to redescribe his invention in a reissue and to include in the description and claims of the patent not only what was well described before, but whatever else was suggested or substantially indicated in the specification, model or drawings which properly belonged to the invention as actually made and perfected. *Tucker v. Tucker Manufacturing Co.*, 4 Cliff., 397.

§ 5734. Act 1837, section 8, confers on the commissioner of patents the same power respecting the granting of a reissue as that which he possesses in case of an original application. *Potter v. Dixon*, 5 Blatch., 160.

§ 5735. A reissue signed by the acting commissioner held valid on the ground that it should be considered under the circumstances as the "lawful exercise of the officer's authority, unless it is apparent on the very face of the patent that he has exceeded his authority." *Smith v. Mercer*, 4 West. L. J., 49.

§ 5736. A mistake by the commissioner as to the necessity of issuing a new patent is not an excess of jurisdiction, but a mistake in a matter clearly within his jurisdiction, and the real question is whether it is one which the courts will correct by destroying a new patent after the old one has been surrendered. *Smith v. Merriam*, 6 Fed. Rep., 713.

§ 5737. A reissue cannot be affected by subsequent void acts of the commissioner, but must stand or fall upon its own merits. *Atwood v. Portland Co.*, 10 Fed. Rep., 283.

§ 5738. Where there is a doubt as to whether the description in a patent will be misunderstood, the judgment of the patent office as to the necessity for a reissue is entitled to great weight. *Sewing Machine Co. v. Frame*, 24 Fed. Rep., 596.

See *Patents*, § 4740.

Reissue — Term — Relates back to original, §§ 5739-5746.

§ 5739. The term of the reissued patent runs from the date of the original patent. *Grant v. Raymond*, 6 Pet., 218.

§ 5740. The reissued patent (act 1793) and the proceedings on which it issues have relation to the original transaction. *Ibid.*

§ 5741. Under section 13, act 1836, the reissued patent has relation back to the emanation of the first patent, as if it had been issued at the date of the first. *Stanley v. Whipple*, 2 McL., 35.

§ 5742. A reissue patent is a continuation of and relates back to the original patent. *Shaw v. Cooper*, 7 Pet., 292.

§ 5743. A reissued patent relates back to the date of the original patent. *House v. Young*, 3 Fish., 335.

§ 5744. In judgment of law the reissue is only a continuation of the original patent. *Crompton v. Belknap Mills*, 3 Fish., 536.

§ 5745. A reissued patent is generally considered, except in respect to infringement prior to its issue, as if granted at the date of the original patent; and the reissue in respect to subsequent infringements is to take effect as though issued originally, even though the original patent was invalid. *Hussey v. Bradley*, 5 Blatch., 132.

§ 5746. The legal presumption, in the absence of the original patent produced in evidence by defendant, is that complainant is entitled to hold, and to carry back to the date of the original patent all that the reissue claims. *Bickford v. Laporte*, 2 Fed. Rep., 214.

Reissue — Effect in law as to prior infringement, §§ 5747-5759. Infringement of, §§ 5760, 5761.

• § 5747. A suit begun upon one patent cannot be sustained upon a reissue of that patent. *Jones v. Barker*, 11 Fed. Rep., 597.

§ 5748. A suit begun upon one patent cannot be sustained upon a reissue of that patent; hence a suspension of proceedings cannot be had for the purpose of obtaining such reissue. *Brainard v. Cramme*, 12 Fed. Rep., 621.

§ 5749. A reissue, except as to infringements prior to reissue, takes effect as if granted at the date of the original patent with respect to subsequent infringements. *Bloomer v. Stolley*, 5 McL., 158; *Shaw v. Cooper*, 7 Pet., 292; *Stanley v. Whipple*, 2 McL., 35; *Smith v. Pearce*, 2 McL., 176; *Hussey v. Bradley*, 5 Blatch., 134.

§ 5750. On surrender and reissue the patent has always been considered to operate, except as to suits for infringement committed before the reissue, from the commencement of the original term. *Woodworth v. Hall*, 1 W. & M., 248.

§ 5751. A reissued patent has the same effect and operation in law as though it had been originally filed in the corrected form only on the trial of actions brought on it for causes thereafter arising, and has no such effect in any other cause or for any other purpose. *United States Stamping Co. v. King*, 17 Blatch., 55.

§ 5752. A correction amended in a patent could not operate as to third persons against whom prosecutions were pending prior thereto, but only for cases accruing after. *Woodworth v. Hall*, 1 W. & M., 248.

§ 5753. A surrender of a patent for reissue under act 1836, section 13, extinguishes it, and suits for infringement previously brought fall with it. *Moffitt v. Garr*, 1 Black, 273.

§ 5754. Where, after the cause of action had accrued and action commenced, plaintiff reissued his patent, *held*, that the reissue was a solemn admission of the invalidity of the original under which suit was brought, and that plaintiff was not entitled to recover. *Moffitt v. Garr*, 1 Bond, 315.

§ 5755. There can be no recovery of damages on a reissue for infringement prior thereto. *Agawam Co. v. Jordan*, 7 Wall., 583.

§ 5756. Where a reissue is made by mistake, the reissue not being valid, neither is the surrender, and all infringers could be prosecuted under the old and valid patent. *Woodworth v. Edwards*, 3 W. & M., 120.

§ 5757. A reissued patent cannot be availed of to sustain and render effectual a suit, the basis of which is taken away by the act of the party in surrendering his patent; and where, on surrender and reissue during pendency of suit, leave was asked to file a supplemental bill founded on the reissue, the right was denied and motion for injunction refused. *Fry v. Quinlan*, 13 Blatch., 205.

§ 5758. Moneys paid voluntarily or upon judgment upon a patent subsequently surrendered and reissued cannot be recovered back. The title thereto rests on the voluntary payment or the judgment. *Moffitt v. Garr*, 1 Black, 273.

§ 5759. Act of 1836 provides that as to third parties the amended specification shall have the same effect and operation in law on the trial of actions as if it had been originally filed in its corrected form. *Smith v. Mercer*, 4 West. L. J., 49.

See *Damages and Profits*, § 1530.

§ 5760. Whoever erects or uses a patented machine does so at his peril. And where infringer has knowledge of the prior patent, suit can be brought for infringement of the reissue without notice. *Ames v. Howard*, 1 Sumn., 482.

§ 5761. Prior use of an invention under a defective patent cannot take away the right to reissue such patent, or authorize a use under the reissue. *Stimpson v. Westchester R. Co.*, 4 How., 380; *Battin v. Taggart*, 17 How., 74; *Hussey v. Bradley*, 5 Blatch., 134.

See *Infringement*, § 2976.

Reissue — One invalid claim does not invalidate entire reissue, §§ 5762-5768.

§ 5762. The invalidity of a claim in a reissue does not impair the validity of a claim in the original patent which is separately reproduced in the reissued patent. *National Pump Cylinder Co. v. Gunnison*, 17 Fed. Rep., 817; *Gould v. Spicer*, 15 Fed. Rep., 344; *Cote v. Moffitt*, 15 Fed. Rep., 345; *Fetter v. Newhall*, 17 Fed. Rep., 841; *Gage v. Herring*, 107 U. S., 640; *Schillinger v. Greenway Brewing Co.*, 17 Fed. Rep., 244; *Odell v. Stout*, 22 Fed. Rep., 159.

§ 5763. One claim in a reissue may be void without necessarily invalidating the other claims, and may be disclaimed *pendente lite* when there has been no unreasonable neglect or delay. *Tyler v. Galloway*, 12 Fed. Rep., 567.

§ 5764. Whether a reissue is wholly valid or not it may be valid to the extent that claims in the original and in the reissue are alike; and if those claims are infringed an injunction may be granted. *Starrett v. Athol Machine Co.*, 14 Fed. Rep., 910.

§ 5765. The entire reissue will not be void on account of one void claim. *Wood v. Packer*, 17 Fed. Rep., 650.

§ 5766. Invalidity of one claim does not necessarily render the other claims of the reissue invalid. *Reay v. Raynor*, 19 Fed. Rep., 308.

§ 5767. The invalidity of one of the claims of a reissued patent does not invalidate the entire reissue, provided the invalid claim was made in good faith. Where it appears that claims in

a reissued patent were made to broaden the invention and thereby to cover intermediate inventions or improvements, the fraud may so vitiate all the claims in the reissued patent that all will be held to be void; but one claim in a reissue may be void without necessarily invalidating the other claims. *Odell v. Stout*, 22 Fed. Rep., 159.

§ 5768. A reissue claim which conforms with the original is good, notwithstanding that other reissue claims expand the claim of the original patent, or any claims that the patentee might have lawfully made. *Western Union Telegraph Co. v. Baltimore & O. Telegraph Co.*, 25 Fed. Rep., 30.

Reissue — Evidence — *Of what a reissue is*, §§ 5769-5776.

§ 5769. A reissue is *prima facie* evidence of the lawful surrender of the original patent and of its own lawful grant. *Knight v. B. & O. R. Co.*, Taney, 106.

§ 5770. A reissue is *prima facie* evidence that it has been rightfully granted by the commissioner. *Allen v. Blunt*, 3 Story, 742; *Woodworth v. Stone*, 3 Story, 749.

§ 5771. A reissue is *prima facie* evidence, in the absence of fraud on the patent office, that the original patent was not abandoned. *Hoffheims v. Brandt*, 3 Fish., 218.

§ 5772. Although the decision of the patent office is entitled to great weight, the reissue is but *prima facie* evidence of its validity, and the duty devolves on the court to determine whether it claims more than the original specification shows patentee to have invented. *Woodward v. Dinsmore*, 4 Fish., 163.

§ 5773. The decision of the commissioner in reissuing a patent is very strong *prima facie* evidence that it was a proper and lawful case for a reissue; but it is not conclusive on that point. *Seymour v. Osborn*, 3 Fish., 555.

§ 5774. The fact that a reissue patent has been granted is *prima facie* evidence that satisfactory proofs have been given to the commissioner of such a state of facts as warrant the reissue, even though the patent may contain no recitals that the prerequisites to the grant have been fulfilled. *Thomas v. Shoe Machinery Mfg. Co.*, 16 O. G., 541.

§ 5775. The commissioner's decision upon the question of reissue is *prima facie* evidence that it is for the same invention as that in the original patent, and subsequent inquiry before a court and a jury is limited to the question of fraud. *Hussey v. Bradley*, 5 Blatch., 134; *Philadelphia & Trenton R. Co. v. Stimpson*, 14 Pet., 448; *Stimpson v. Westchester R. Co.*, 4 How., 380; *O'Reilly v. Morse*, 15 How., 62; *Battin v. Taggart*, 17 How., 74; *Woodworth v. Stone*, 3 Story, 749.

§ 5776. In a suit for infringement of a reissued patent, on demurrer to the bill for failure to specify the ground of surrendering the original patent, it is held that the reissued patent is *prima facie* evidence that it is founded on sufficient cause and is in accordance with law. *Spaeth v. Barney*, 22 Fed. Rep., 828.

See *Inventor*, § 3812. *Novelty*, §§ 4325, 4384. *Patents*, § 4703. *Process and Product*, § 5109.

Reissue — Defense to — *Want of identity*, § 5777. *Purchase prior to reissue*, § 5778. *Not included in original*, § 5779.

§ 5777. Where the defense against a reissued patent is that it is for a different invention from the original, it cannot be doubted that the latter may be the subject of reference, as to a repealed statute, to aid in the construction of the new patent issued upon the corrected specification. *Reedy v. Scott*, 23 Wall., 352.

§ 5778. Purchase of the patented device prior to reissue, and under the original invalid patent, held no defense to a suit for infringement brought on the reissue. *Bliss v. City of Brooklyn*, 8 Blatch., 533.

§ 5779. Defendant cannot avoid liability by the defense that, when his invention was set up, prior to plaintiff's reissue, it was not covered by the patent. *Carr v. Rice*, 1 Fish., 198.

Reissue — *Fraud in securing*, §§ 5780-5785. *Validity*, §§ 5786-5788.

§ 5780. Actual and constructive fraud in reissues considered. *Swift v. Whisen*, 2 Bond, 115.

§ 5781. A reissue which covers improvements not described or used in the machine under the original patent is a fraud. *Brooks v. Fiske*, 15 How., 212.

§ 5782. A reissued patent can only be impeached for fraud by a bill in equity brought for the purpose by the government. *Birdsell v. McDonald*, 6 O. G., 682.

§ 5783. The validity of a reissue can only be inquired into, 1st, in case of fraud in obtaining it; 2d, where, on its face, the commissioner has exceeded his jurisdiction; where there is a clear repugnance between the original and reissue. *House v. Young*, 3 Fish., 335.

§ 5784. Allegations as to false representations in securing reissue should be made in distinct language, without equivocation, and be the subject of very distinct proof. *Doughty v. West*, 2 Fish., 553.

§ 5785. It is no defense to infringement for the wrong-doer to prove irregularities in the reissue of the patent. *Goodyear Dental Vulcanite Co. v. Wetherbee*, 3 Cliff., 555.

See *Fraud*, §§ 2606-2608.

§ 5786. The validity of a reissue sustained, the object of which was to extend the monopoly beyond the limits assigned to the original by a judicial decision. *Poppenhusen v. Falke*, 5 Blatch., 47.

See *Infringer*, §§ 2995, 2996.

§ 5787. The presumption of law is always in favor of the validity of a reissue patent. *Reissner v. Anness*, 13 O. G., 870.

§ 5788. A reissued patent is not rendered invalid simply because a suit could be sustained on the specification and claim as originally granted. *Wilson v. Coon*, 18 Blatch., 532.

See *Patents*, § 4628.

Reissue — Patentee's right to, §§ 5789-5791. After extension, §§ 5792-5794.

§ 5789. To entitle a patentee to reissue he must have been the first to disclose the invention in the record existing in the patent office. *Ex parte Platt & Walden*, 15 O. G., 827.

§ 5790. Rights of a patentee of a reissue are determined by the law under which the original application was made. *Shaw v. Cooper*, 7 Pet., 292.

§ 5791. On a reissue, the rights of the patentee, except as to prior infringement, are to be ascertained by the law under which the original application was made. *Read v. Bowman*, 2 Wall., 591.

§ 5792. A reissue may be granted after an extension. *Wilson v. Rousseau*, 4 How., 646.

§ 5793. A patent extended by two extensions to fourteen additional years, and reissued on the last extension in the form of a whole term of twenty-eight years, is, in legal effect, a patent for the residue only of the period unexpired at the time it was issued. *Gibson v. Harris*, 1 Blatch., 167.

§ 5794. Where, under act 1833, section 18, a patent was twice extended, and reissued during the last extension as a patent for twenty-eight years, it was held a valid patent for that term. *Woodworth v. Edwards*, 3 W. & M., 120.

Reissues — Generally, §§ 5795-5814.

§ 5795. *Semble*, that a new patent may be granted on the surrender of the prior patent, which was broader than the invention (act 1793). *Morris v. Huntington*, 1 Paine, 348.

§ 5796. Doubted whether it would not be a valid objection to a reissued patent (act 1793) that third parties had acquired rights during the existence of the original invalid patent. *Grant v. Raymond*, 6 Pet., 218.

§ 5797. Reissue granted executor of patentee is a new contract between the government and executor since the decease of the original patentee. *Goodyear v. Providence Rubber Co.*, 2 Cliff., 351.

§ 5798. A reissue applicant cannot be placed in interference with an unexpired patent in which the record date of original application filed is subsequent to that of the reissue patentee, and which does not claim the subject-matter in conflict. *Ex Parte Platt & Walden*, 15 O. G., 827.

§ 5799. But it is not clear that an interference can never be declared in any case of application for reissue. *Ibid.*

§ 5800. The presumption of right arising from public acquiescence in the enjoyment of a patent is not removed by its reissue. *Orr v. Badger*, 7 Law Rep., 465.

§ 5801. Where a patent that has been assigned is reissued to the patentee, it cannot be admitted that the reissue is void, if the assignment was duly recorded in the patent office, and the application for surrender and reissue was made with the knowledge and consent of the assignee. *Goodyear Dental Vulcanite Co. v. Wetherbee*, 3 Cliff., 555.

§ 5802. To surrender the original and obtain reissue letters patent does not impair the judgment of lack of novelty, it appearing that the inventions set forth are the same as those contained in the original patents. *Jones v. McMurry*, 2 Hughes, 527.

§ 5803. A pending reissue application cannot receive such a construction as to supersede the original patent, no matter how nearly the proceedings may have approached consummation, so long as they are not finally completed; and the withdrawal of the application may be allowed by the commissioner for a reasonable cause, where not fraudulently procured and not prejudicial to the rights of third parties. *Forbes v. Barstow Stove Co.*, 2 Cliff., 379.

§ 5804. It is doubtless true that a reissue of a patent to a person not the owner would not affect the title of the owner. The reissue and title should go together to make a good title to the reissue, or, at least, the reissue should be consented to by the true owner. *Campbell v. James*, 17 Blatch., 42.

§ 5805. Decrees sustaining certain claims of a reissue patent having been made when much less strictness in comparing reissued patents with originals was required, they are disregarded, and the claims held to be too narrow to embrace the defendant's invention or too broad for the original invention and claim. *National Wire Mattress Co. v. New York Braided Wire Mattress Co.*, 20 Fed. Rep., 119.

§ 5806. The court cannot say, as a mere matter of law, that a reissue is invalid, because the patent was sustained in several suits, and licenses were taken under it, as alleged in the bill, thereby averring, in substance, that the original patent was valid and operative; whereas a reissue is based on the inoperativeness and invalidity of the patent. *Thomson v. Wooster*, 114 U. S., 104.

§ 5807. Where inventions embraced in a reissue were not exhibited in the original patent, evidence tending to show that, prior to his application for the original patent, the patentee constructed an apparatus embodying them, is immaterial. *Hammond v. Franklin*, 22 Fed. Rep., 833.

§ 5808. The fact that the patent office suggested the application for reissue is without weight where it appears that the suggestion was founded on an application by the patentee for a new patent which did not include the subject-matter of the new claims of the reissue. *Ibid.*

§ 5809. Where a patent was taken out for an invention and subsequently a second improvement patent thereon, and a month later a third patent, claiming a novel combination, shown but not claimed in the first patent, and the first and second patents were surrendered and reissued, claiming that which was claimed in the third patent, and the third patent was surrendered but not reissued, the reissue of the first and second patents was sustained. *Battin v. Taggart*, 17 How., 74.

§ 5810. *Semble*, that a patentee may surrender his patent and take out a new original patent within two years, where the invention has not been in public use more than two years. *Mini's Assignee v. Adams*, 3 Wall. Jr., 20.

§ 5811. The object of the law on the subject of patents is to advance the interest of the public by securing certain exclusive rights to patentees, and among those rights is that of changing, by a surrender or reissue, the language when the idea remains the same. *Dunbar v. White*, 15 Fed. Rep., 747.

§ 5812. Where a reissue had been held to be invalid because the specification did not contain the full, clear and exact description of the invention that the law requires, *held*, that in the light thrown upon the subject-matter of the patent by the evidence introduced, and by the fuller specification of the last reissue, the true character of the invention had been fairly brought out, and the reissue was sustained. *Schneider v. Pountney*, 21 Fed. Rep., 399.

§ 5813. A needless and improper multiplication of claims in a reissue does not vitiate the whole patent, but only the superfluous claims. *Dederick v. Cassell*, 9 Fed. Rep., 306.

§ 5814. Claims in a reissue which, unless limited to less than they express, enlarge the invention beyond that covered by the original patent, are void. *Curtis v. Branch*, 15 O. G., 919.

See *Additional Improvement*, § 151. *Answer*, §§ 212, 221. *Antedating*, § 236. *Appeal*, § 301. *Attorney*, § 576. *Bill*, §§ 584, 623, 626-628. *Contracts*, §§ 1325, 1338. *Decree*, §§ 1763, 1779. *Demurrer*, § 1902. *Errors*, §§ 2183, 2185. *Injunction, Preliminary*, §§ 3055, 3082, 3105, 3108, 3150; *Provisional*, §§ 3212, 3218. *Injunction*, §§ 3297, 3298, 3309, 3320, 3360, 3361, 3396. *Man-damus*, § 4123. *Parties*, § 4489. *Patents*, § 4699. *Pleas*, § 4795. *Practice*, §§ 4851, 4888. *Re-hearing*, §§ 5263, 5271. *Rule of Comity*, § 5894. *Specification*, § 6091. *Surrender of Patent*, §§ 6238-6241. *Term*, §§ 6277, 6278. *Use*, §§ 6561, 6603, 6604. *Void Patent*, § 6730.

305. REJECTED APPLICATIONS.

See APPLICATIONS, REJECTED.

306. RELEASE.

§ 5815. A release executed by the complainants to the defendant of their claims against all persons who had purchased infringing machines of him, without prejudice to their rights against him, will not defeat their suits against him for his infringements. *Graham v. Mason*, 1 Holmes, 88.

§ 5816. When an infringer, by agreement with the owners of a patent, agrees not to make any articles infringing a certain reissued patent, and that engagement, in conjunction with his

contract to pay royalty for certain infringing articles before made, formed the consideration for his release from liability for the making and selling of those articles, it appearing that the release was an absolute release *in præsenti, held*, that such release, until set aside, relieves from all accountability for subsequent infringement by the making and selling of articles like those specified in the release. *Loercher v. Crandal*, 11 Fed. Rep., 872.

See *Answer*, § 211. *Injunction, Violation of*, § 3427. *Parties*, §§ 4509-4512. *Witnesses*, § 6737.

307. REMEDY.

§ 5817. Where the offense is new, and the remedy prescribed, the remedy must be sought in the precise mode and subject to the precise limitations provided by the act which creates the offense. *Pentlarge v. Kirby*, 19 Fed. Rep., 501.

§ 5818. Patentee whose rights are infringed has his election of remedies. What these remedies are stated as to profits and damages. *Cowing v. Rumsey*, 8 Blatch., 36.

See *Contracts*, § 1298. *Right of Action*, § 5878.

308. RENEWAL.

See EXTENSION. REISSUE. SPECIAL ACT. TERM.

§ 5819. Term "renewal" in an agreement construed to signify extended term. *Pitts v. Hall*, 3 Blatch., 201.

§ 5820. The term "renewal" in a deed construed to mean extension and not reissue. *Day v. Cary*, 1 Fish., 424.

§ 5821. Construction of the terms "renewal" and "extension" as used in contracts relating to patents. *Goodyear v. Cary*, 4 Blatch., 271.

309. REPAIRS.

§ 5822. What is and what is not repair of a patented article sold with restrictions as to use. *American Cotton Tie Supply Co. v. Bullard*, 17 Blatch., 160.

§ 5823. The assignee of the right to use a patented machine may make such repairs as do not change the form or destroy the identity of the machine. *Wilson v. Simpson*, 9 How., 109.

§ 5824. Where the patented invention was a machine consisting of a combination, *held*, that licensee had the right to replace the worn out parts, provided the identity of the machine was retained. *Gottfried v. Seipp Brewing Co.*, 10 Biss., 368.

§ 5825. Purchaser of patented article is entitled to repair and improve the articles as long as they will last, but they cannot make new ones, nor can they, in the exercise of their right to repair, infringe another man's patent. *Aiken v. Manchester Print Works*, 2 Cliff., 435.

§ 5826. Purchasers of patented machines are entitled to repair and perfect them and use the same during the extended term of the patent. *Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 11 O. G., 1113.

§ 5827. Where a patented device was repaired by a substitution of a new for an old portion, which was in fact the practice of the entire invention, it was held an infringement. *Goodyear Dental Vulcanite Co. v. Preterre*, 15 Blatch., 274.

See *Combination*, § 1018. *Contract*, §§ 1284, 1285. *Damages and Profits*, § 1670. *Infringement*, §§ 2941, 2944. *License*, § 4039. *Re-use*, §§ 5864-5866.

310. REPEAL OF PATENT.

Repeal of patent — Annulling; canceling; decreeing void — *Act 1793*, §§ 5828, 5829. *Scire facias to repeal*, §§ 5830-5834. *Proceedings under act of 1793*, §§ 5835-5837. *Grounds for repeal*, §§ 5838, 5839. *Jurisdiction*, §§ 5840-5849. *Bill in chancery*, §§ 5850-5852; *by whom brought*, §§ 5853-5858. *Decreeing patents void*, § 5859. See *Commissioner*, §§ 1082, 1086. *Interfering Patents*, §§ 3475-3498.

§ 5828. Act 1793, section 6, voiding patents, reviewed. *Whitney v. Emmett*, 1 Bald., 303.

§ 5829. Under act 1793, section 6, to avoid a patent, the "concealment" or "addition must fully appear to be made for the purpose of deceiving the public." *Grant v. Raymond*, 6 Pet., 218.

§ 5830. Award of process in the nature of a *scire facias*, and proceedings to repeal patent under act 1793, stated. Wood, *Ex parte*, 9 Wheat., 603.

§ 5831. Under act 1793, section 10, the proceedings in repeal of patent, construed. Delano v. Scott, Gilp., 489.

§ 5832. Proceedings under act of 1793, section 10, for the repeal of a patent, are in the nature of a *scire facias* at common law. Stearn v. Barrett, 1 Mason, 153.

§ 5833. *Scire facias* for the repeal of a patent (section 10, act 1793) should directly allege the causes for which the patent is sought to be repealed. *Ibid.*

§ 5834. The judicial authority intended to be given by section 10, act 1793, is vested exclusively in the district judge, and the proceedings under it were intended to be summary. The making of the rule absolute, if sufficient cause is not shown to the contrary, on the return of the rule to show cause, works a repeal of the patent, without further proceedings. Thompson v. Haight, 1 U. S. L. J., 98; McGaw v. Bryan, 1 U. S. L. J., 85.

§ 5835. Under the act 1793 a patent cannot be repealed by a rule to show cause without further proceedings; the proper practice stated. Wood, *Ex parte*, 9 Wheat., 603.

§ 5836. Under act 1793 the United States cannot be made party to a suit for the repeal of a patent by *scire facias*. Wood v. Williams, Gilp., 517.

§ 5837. Under act 1793 a decision in favor of patentee on the issue of a *scire facias* does not prevent his right being contested in any subsequent suit. Delano v. Scott, 1 Gilp., 489.

§ 5838. Knowledge on the part of patentee that he is not the original inventor of the thing patented amounts to "surreptitious and false suggestion," under act 1793, and is sufficient ground for repeal of the patent. *Ibid.*

§ 5839. A patent cannot be declared void (sec. 6, act 1793) for any other defect in the specification than fraudulent concealment or addition. Whitney v. Emmett, 1 Bald., 303.

§ 5840. Under section 10, act 1793, the circuit courts have appellate jurisdiction in proceedings to repeal a patent. Stearns v. Barrett, 1 Mason, 153.

§ 5841. In a civil suit, a circuit court can give a judgment declaring a patent void only in cases provided for under section 6, act 1793. Whitney v. Emmett, 1 Bald., 303.

§ 5842. Under act 1836, section 16, extended act 1839, section 10, a United States court has jurisdiction to declare letters patent void only in the case of interfering patents, and where the granting of a patent is refused by the commissioner of patents or by the chief justice of the District of Columbia on appeal. Merserole v. Union Paper Collar Co., 6 Blatch., 356.

§ 5843. The jurisdiction conferred by the acts of 1790 and 1793 upon the federal courts to repeal a patent, and which without express grant it is believed did not inhere in those courts, is nowhere conferred by the acts of 1836 or 1870, or in the Revised Statutes of 1874. Atty. Gen. *ex rel.* Hecker v. Rumford Chemical Works, 9 O. G., 1062.

§ 5844. The decisions in the federal courts sustaining proceedings in equity to vacate letters patent granting lands obtained by fraud furnish no precedent in case of letters patent for inventions. *Ibid.*

§ 5845. The United States have the same right to vacate a patent for invention obtained by fraud as where the subject is a land grant, or is a franchise or right of a different kind, and may properly proceed by bill in equity to vacate such patent. United States v. Gunning, 18 Fed. Rep., 511.

§ 5846. In the patent act, as it now stands, we find no authority given the courts to set aside or annul a patent for mere want of novelty. Lockwood v. Cleveland, 20 Fed. Rep., 164.

§ 5847. Where the name of the government was only colorably used to cancel a patent for fraudulent oath as to prior public use, and the suit was really prosecuted by private persons, *held*, that the court had no jurisdiction, and *held* further, as the matter could be set up as a valid defense to the validity of the patent on a suit thereunder for infringement, such defense should be left to the parties really interested. United States v. Frazer, 22 Fed. Rep., 106.

§ 5848. Where a bill was filed praying for an injunction and the repeal of the patent enjoined, in case plaintiff was successful in obtaining his patent, the inchoate right of the inventor, arising from the pendency of an application in the patent office, was held insufficient to give a court jurisdiction to decree an injunction against a party already possessed of a patent, and that the patent of the latter could not be collaterally impeached for fraud. Hoeltze v. Hoeller, 2 Bond, 386.

§ 5849. On a suit to repeal a patent, a motion, on the application of the United States, asking for a preliminary injunction to restrain the commencement or prosecution of suits for infringement of the patent during the pendency of the action for repeal, denied. United States v. Colgate, 21 Fed. Rep., 318.

§ 5850. A bill in chancery has become established as the appropriate proceeding for annulling a grant or patent from the government. Mowry v. Whitney, 14 Wall., 434.

§ 5851. The practice that obtains in England as to the mode or forms of procedure for the

cancellation and annulling letters patent by *scire facias* does not obtain in this country. Attorney-General *ex rel.* Hecker v. Rumford Chemical Works, 9 O. G., 1062.

§ 5852. No statute of the United States confers or recognizes the existence of any such right, nor can any precedent be found for the suing out of a writ of *scire facias*, or the bringing of a bill in equity to repeal or cancel the patent by the attorney-general, in the name and behalf of the United States, either with or without a relator. *Ibid.*

§ 5853. No private person can maintain a bill in chancery to set aside a patent, except (under section 16 of the act of 1836) the holder of a patent which is in conflict with another, or an applicant for a patent whose claim has been rejected upon another patent. None but the officers of the government can institute such a proceeding in other cases. Mowry v. Whitney, 14 Wall., 434.

§ 5854. Where a bill in equity, purporting to be brought by the United States, at the instance of certain parties, prayed for the surrender and canceling of certain letters patent, and it did not appear on its face to be filed on behalf of the United States by the district attorney, by whom alone the United States can, under the statute, bring suit, a demurrer thereto was sustained. United States *ex rel.* West v. Doughty, 7 Blatch., 424.

§ 5855. "The attorney-general of the United States, as he is attorney-general," has no authority as such, and in his own name, to file an information, or commence proceedings by bill in equity to repeal a patent. Att'y-Gen. *ex rel.* Hecker v. Rumford Chemical Works, 9 O. G., 1062.

§ 5856. If the court has jurisdiction in cases of this character the information should be in the name and behalf of the United States, and should be filed by the attorney of the United States, in the district in which the information is filed. *Ibid.*

§ 5857. Any other mode of procedure (unless authority is expressly conferred by statute) is neither authorized by law, sanctioned by any precedent, nor supported by the authority of any judicial decision. *Ibid.*

§ 5858. It rests with the attorney-general to say whether proceedings shall be instituted to annul the defendant's patent for want of novelty. There is no absolute duty imposed upon him to do so at the instance of a party asserting its invalidity for want of novelty, and it is no ground for a demurrer to a bill for taking testimony *in perpetuam rei memoriam*. New York & Baltimore Coffee Polishing Co. v. New York Polishing Co., 9 Fed. Rep., 578.

§ 5859. A patent decreed to be void, upon a bill in equity filed for the purpose, on its being found to claim what was embraced in a former patent. Adamson v. Dedrick, 2 O. G., 523.

311. RESULT.

See INFRINGEMENT, DIFFERENCE AND IDENTITY IN RESULT. PATENTABILITY, RESULT.

312. RESULT CLAIMS.

See CLAIMS, RESULT. CLAIMS, CONSTRUCTION OF RESULT.

313. REPLICATION.

§ 5860. When and on what terms leave will be granted, on motion, to file an amended replication setting up a license. Goodyear v. McBurney, 3 Blatch., 32.

§ 5861. Where plaintiffs in their amended declaration averred construction and use of certain infringing machines by defendant, at the date when plaintiffs first acquired title, and defendants pleaded accord and satisfaction with plaintiffs' authorized agent, and plaintiffs, in their replication, filed two pleas alleging that defendants purchased the infringing machines nearly a year before plaintiffs acquired title and from persons unknown to plaintiffs, and that they thereafter used them as alleged in the declaration, the replication was held bad, as an effort to go behind the declaration and add another and different cause of action. Burdell v. Denig, 15 Fed. Rep., 397.

§ 5862. Where a replication is put in to a plea, the parties proceed to the examination of witnesses in the same way as in case of a replication to an answer. Reissner v. Anness, 13 O. G., 7.

§ 5863. This course having been prescribed by order of the court, a motion to revoke was denied. *Ibid.*

See Practice, §§ 4911, 4920.

314. RE-USE.

SUMMARY (COTTON-TIE CO. v. SIMMONS, §§ 5864-5866) — *The patent construed, § 5864. — Re-use amounting to an infringement, § 5865. — Sale of part of combination with intent to procure an infringement, § 5866.*

COTTON-TIE COMPANY v. SIMMONS.

(16 Otto, 89-95. 1882.)

APPEAL from U. S. Circuit Court, District of Rhode Island.

Opinion by MR. JUSTICE BLATCHFORD.

STATEMENT OF FACTS.— This is an appeal by the plaintiffs in a suit in equity from a decree dismissing the bill of complaint. The suit was brought for the infringement of three several letters patent,— No. 19,490, granted to Frederic Cook, March 2, 1858, for an “improvement in metallic ties for cotton bales,” and extended for seven years from March 2, 1872; reissued letters patent No. 5333, granted to James J. McComb, as assignee of George Brodie, March 25, 1873, for an “improvement in cotton-bale ties” (the original patent having been granted to Brodie, as inventor, March 22, 1859, and reissued to him April 27, 1869, and extended for seven years from March 22, 1873); and No. 31,252, granted to J. J. McComb, January 29, 1861, for an “improvement in iron ties for cotton bales,” and extended for seven years from January 29, 1875. They are severally known as the Cook, the Brodie and the McComb patents. The Cook patent expired March 2, 1879; the Brodie patent, March 22, 1880; and the McComb patent, January 29, 1882. The plaintiffs are the American Cotton-Tie Company, Limited, a British corporation; James J. McComb, administrator of Mary F. McComb, deceased; and the said James J. McComb, Charles G. Johnsen and Emerson Foote, each in his own behalf and as a copartner in a firm called the American Cotton-Tie Company. The defendants are Simeon W. Simmons and two other persons, doing business as the Providence Cotton-Tie Company. The Cook patent was assigned to McComb March 21, 1872. The Brodie reissue of 1869, with all rights to reissue, renewal and extension, was assigned to McComb March 19, 1873. On the 22d of June, 1874, McComb assigned to himself, Johnsen and Foote, who composed the firm called the American Cotton-Tie Company, the Cook patent as extended, and the Brodie patent as reissued in 1869 and as extended. Mary F. McComb became, in 1861, the owner of the McComb patent. She died in 1874, intestate, and McComb was appointed her administrator. On the 1st of March, 1876, the firm called the American Cotton-Tie Company assigned to the corporation called the American Cotton-Tie Company, Limited, the Cook patent as extended, and the Brodie patent as extended and as reissued in 1873. On the same day McComb, individually and as administrator, assigned to the said corporation the McComb patent and its extension.

The bill is in the usual form, and was filed in November, 1876. It alleges that the defendants have made, used, and sold to others to be used, the patented inventions, and, also, metallic ties for cotton bales containing the patented inventions. No defense affecting the validity of the patents sued on is set up in the answer. The only defense pleaded or made is as to infringement.

The corporation plaintiff, since it acquired title to the three patents in March, 1876, has carried on the business of making cotton-bale ties under the patents. The form of tie it has principally made is the form of the McComb

patent, which is called the "arrow tie," from the shape of the five-sided hole cut in the plate of the buckle. It has not granted any licenses to make the ties, but has itself supplied the demand for them. The tie consists of a buckle and a band, all made of metal. The band goes around the bale, and the two ends of it are confined by means of the buckle. On each of the buckles which the corporation has made and put upon the market it has placed the words "licensed to use once only," stamped into the body of the metal. This practice was also observed by its predecessor, the copartnership firm. The tie, consisting of buckle and band, is purchased by the person who desires to use it to confine the cotton in the bale, and is placed around the bale on the plantation or at the cotton-press. It remains on the bale until the bale reaches the cotton-mill, and the band of the tie, which is of hoop-iron, is then cut. The buckle and the band, thus free, become scrap-iron, and are sold as such. The hoop is too short for the length required for baling, if it were to be mended by lapping and riveting the two ends at the place of severance, and to bale with it requires that there should be a free end which may be confined at the buckle in the process of baling. The defendants buy the buckles and severed hoops at the cotton-mills, as scrap-iron, the hoops, when bought, being in bundles, bent, and being pieces of unequal lengths, some cut at one distance from the buckle, and some at another. The defendants straighten the old pieces of hoop and roll them by cold rolling, and punch the ends with holes, and rivet the pieces together, and form a band by cutting it to the proper length, which band, with the buckle accompanying it, makes a tie ready for use. In using the tie one end of the band is attached to one end of the buckle by a loop in that end of the band, and then the band is passed around the bale, and its free end is slipped, by a loop made in it, through a slit in the buckle, around the other end of the buckle, while the bale is under pressure. When the pressure is removed the expansive force of the compressed cotton holds the looped ends of the bands in place in the buckle, the looped ends being confined between the bale and the body of the band. The use of the arrow tie has been very extensive. The defendants sell to others to be used the ties which they so prepare, and do not themselves bale cotton with them. Baled cotton is sold in the United States without tare, that is, the iron of the buckle and the hoop is weighed with the cotton and the bagging, and the whole is sold by weight at the price of the cotton per pound. The scrap-iron consisting of the buckles and cut hoops is sold at one cent and a quarter per pound, while the corporation sells its ties at six cents per pound.

§ 5864. *The patents considered.*

The specification of the Cook patent describes a buckle with a slot cut through one of its end bars, so that the end of the band may be slipped through sidewise instead of being pushed through endwise. The third claim is to "the herein-described 'slot,' cut through one bar of clasp, which enables the end of the tie or hoop to be slipped sidewise underneath the bar in clasp, so as to effect the fastening with greater rapidity than by passing the end of the tie through endwise."

The specification of the Brodie reissue states that his invention "relates to the combination with open-slot ties of metallic bands having their ends free, and held in position by the expansion of the bale." Some of the drawings show an open slotted link or buckle in connection with a band, and the specification states that the ends of the band are "turned under the link and held

in position by the pressure exerted by the expansion of the bale." It adds: "In the latter mode of use the slack may be readily taken up by forming the loop in the iron at the moment of making the fastening, and passing the end thus looped through the opening in the side of the link. The band is thus slipped sidewise through the opening into the slot instead of thrusting it through endwise." The third, fourth and fifth claims of the Brodie reissue are in these words: "3. The combination of an open slot for introducing the band sidewise with a link having a single rectangular opening for holding both ends of a metallic band, and the band. 4. An open slotted link, when combined with metallic bands, the ends of which are turned under the link and held in position by the expansion of the bale. 5. The method of baling cotton with metallic bands, and taking up the slack of the band by bending the same at any desired point into the form of a loop, and passing such loop sidewise through an open slit into the slot intended to receive it and over the bar of the clasp intended to hold it."

The specification of the McComb patent states that the nature of his invention "consists in the use of a peculiarly shaped buckle as a fastening or tie for the ends of the iron hoops." It says that the "buckle is a piece of wrought iron or other metallic substance about the eighth of an inch thick, an inch and three-quarters wide, and two inches long (the size being modified to suit the width of the hoop used), with an oblong hole or aperture cut or punched through the center;" that the five sides of the plate of the buckle are equal and parallel; and that the two largest of the five sides of the oblong hole are of equal length, and are equal in length to the width of the hoop. The drawings show the two sides forming the arrow-part as of equal length. The slit or slot is cut through one of the sides of the plate opposite one of the two longest sides of the central hole, so that one of the loops of the hoop stretches across and covers the slit. The claim of the patent is this: "Forming a link or tie with an oblong aperture, one end of which is arrow-shaped, or rather presents two sides of an equilateral triangle, the design of this arrow-shaped end being not only to force the loop or bend of the hoop over the slot, which it does with unerring precision when the bale expands after being released from the press, but, also, to secure an equal bearing upon the separated parts of the slotted side of the tie."

§ 5865. *Reconstruction and re-use of a machine which amounts to an infringement.*

A buckle without a band will not confine a bale of cotton. Although the defendants use a second time buckles originally made by those owning the patents and put by them on the market, they do not use a second time the original bands in the condition in which those bands were originally put forth with such buckles. They use bands made by piecing together severed pieces of the old bands. The band in a condition fit for use with the buckle is an element in the third claim of the Brodie reissue. That claim is for a combination of the open slot arranged to allow of the sidewise introduction of the band, the link or buckle with the single rectangular opening arranged so as to hold both ends of the band and the band. The old buckle which the defendants sell has the slot of Cook, and the slot and rectangular opening of Brodie, and the slot and arrow-shaped opening of McComb. Whatever right the defendants could acquire to the use of the old buckle, they acquired no right to combine it with a substantially new band, to make a cotton-bale tie.

They so combined it when they combined it with a band made of the pieces of the old band in the way described. What the defendants did in piecing together the pieces of the old band was not a repair of the band or the tie, in any proper sense. The band was voluntarily severed by the consumer at the cotton mill because the tie had performed its function of confining the bale of cotton in its transit from the plantation or the press to the mill. Its capacity for use as a tie was voluntarily destroyed. As it left the bale it could not be used again as a tie. As a tie the defendants reconstructed it, although they used the old buckle without repairing that. The case is not like putting new cutters into a planing-machine in place of those worn out by use, as in *Wilson v. Simpson*, 9 How., 109. The principle of that case was, that temporary parts wearing out in a machine might be replaced to preserve the machine, in accordance with the intention of the vendor, without amounting to a reconstruction of the machine.

§ 5866. *One who sells a part of a combination, with the intent to have it used in infringing, is liable therefor.*

The defendants contend that they do not combine the band with the buckle, and do not infringe the third claim of the Cook patent, or the third, fourth and fifth claims of the Brodie reissue, or the claim of the McComb patent, because they do not bale cotton with the tie. But they participate in combining the open slot, the buckle and the band, the whole being so arranged that the ends of the band can be turned under the buckle and held in position by the expansion of the bale, and that the slack of the band can be taken up by bending the band into the form of a loop, and passing the loop sideways through the open slit into the hole and over the holding-bar of the plate. They sell the tie having the capacity of use in the manner described, and intended to be so used. Only the bale of cotton and the press are needed to produce the result set forth in the specifications of the patents, and without the bale of cotton and the press the tie would not be made or sold. The slot through the end bar of the buckle in the Cook patent is of no practical use apart from the band and the bale of cotton, and the same thing is true of the link of the McComb patent with its arrow-shaped aperture; and although a person who merely makes and sells the buckle or link in each case may be liable for infringing those patents, he is so liable only as he is regarded as doing what he does with the purpose of having the buckle or link combined with a band and used to bale cotton. Because the defendants prepare and sell the arrow-tie, composed of the buckle or link and the band, intending to have it used to bale cotton and to produce the results set forth in the Cook and the McComb patents, they infringe those patents. *Saxe v. Hammond*, 1 Holmes, 456; *Bowker v. Dows*, 3 Ban. & Ard., 518. We do not decide that they are liable as infringers of either of the three patents merely because they have sold the buckle considered apart from the band or from the entire structure as a tie.

We are therefore of opinion that the defendants infringed the third claim of the Cook patent, the third, fourth and fifth claims of the Brodie reissue, and the claim of the McComb patent.

Decree reversed, with costs, with directions to enter a decree for the plaintiffs, in respect to those claims, for an account of profits and damages, as prayed in the bill, and to take such further proceedings in the suit as may be in conformity with the opinion of this court.

315. REVIEW, BILL OF.

See BILL, OF REVIEW.

316. REVIVOR, BILL OF.

See BILL, OF REVIVOR.

317. RIGHT OF ACTION.

See ASSIGNEE, RIGHT OF ACTION. CORPORATION, RIGHT OF ACTION FOR INFRINGEMENT.

Right of action — *Act 1870*, §§ 5867, 5868. *Assignee*, §§ 5869, 5870. *Assignment of right of action*, §§ 5871-5873. *Distiller*, § 5874. *On single claims*, §§ 5875-5877. *New cause of action*, § 5878. *Election of remedies*, § 5879. *Right to bring additional suit*, §§ 5880, 5881. See *Assignee*, §§ 562-571. *Corporation*, §§ 1369-1371. *Infringement*, § 2947. *Parties*, §§ 4489-4545. *Recovery*, §§ 5211-5237.

§ 5867. Although the act of 1870 repealed the act of 1836, it preserved unimpaired whatever rights had been acquired under it, and the owners of patents obtained before the passage of the act of 1870 may maintain suits for infringements perpetrated afterward. *Union Paper Bag Machine Co. v. Newell*, 11 Blatch., 379.

§ 5868. All actions on patents commenced before July 8, 1870, are to be prosecuted in accordance with the provisions of the act of 1836; but the remedial provisions of the act of 1870 apply to all actions commenced after that date, though for causes accruing before. *Ibid.*

§ 5869. Section 4919 of the Revised Statutes permits an assignee of a patent, and of all claims for damages and profits accrued thereunder before the assignment, to maintain an action at law in his own name to recover such damages. *Spring v. Domestic Sewing Machine Co.*, 22 O. G., 1445.

§ 5870. A patentee or his assignee, in transferring a part of a patent, may reserve the right to prosecute for piracies. *Bicknell v. Todd*, 5 McL., 236.

§ 5871. Patentee may assign right to recover for infringements occurring before the assignment. *Hamilton v. Rollins*, 5 Dill., 495.

§ 5872. The right to recover for infringement of a patent, like other choses in action, is assignable in equity, and the real owner of the right is entitled to maintain a suit upon it in equity in his own name. *Shaw v. Colwell Lead Co.*, 11 Fed. Rep., 711.

§ 5873. In equity the right to recover gains and profits will pass by assignment after decree without the title to the patent itself. *Quære*, will it before? *Campbell v. James*, 5 B. & A., 630.

§ 5874. A distiller cannot recover from the collector money deposited with him as pay for patented meters prescribed by the internal revenue department. *Nusbaum v. Emery*, 3 Biss., 469.

§ 5875. A patent may contain several distinct claims for different inventions, and a suit may be maintained for the infringement of any one of them as if it was the only one. *McComb v. Brodie*, 1 Woods, 153.

§ 5876. Where complainants' patent covers three separate and distinct inventions, it is competent for the complainants to sue for an infringement of any one of them. *McComb v. Ernst*, 1 Woods, 195.

§ 5877. Where a patent was construed to cover three separate and distinct inventions, it was held competent for complainant to sue for infringement of any one of them. *Cook v. Ernst*, 2 O. G., 89.

See *Assignment*, §§ 444-450.

§ 5878. Where the patent had been infringed by defendants since suit between the same parties in another district, *held*, that it created a new cause of action, which could be enforced either at law or in equity, and the right so to do was not prejudiced by the fact that complainant, if he chose, might proceed against defendants for contempt in violating the injunction. *Roemer v. Neuman*, 23 Fed. Rep., 447.

See *Remedy*, § 5818.

§ 5879. In this case it was competent for the complainants to take either one of the two remedies for the alleged injuries growing out of a violation of the agreement or license. They could bring a bill alleging an injury to their exclusive rights, or could bring a proper suit, setting up the breach of contract as the *gravamen* of their action. *Stover v. Halsted*, 13 Blatch., 95.

See *Damages and Profits*, § 1543.

§ 5880. It is doubtful whether the court will, in any proceeding, enjoin the plaintiffs from prosecuting whatever suits they choose in the courts of other districts. *Rumford Chemical Works v. Hecker*, 11 Blatch., 552.

§ 5881. A complainant who has obtained a decree for an account upon a bill for an infringement may bring another suit, as it seems, for such infringements of the same patent as are not covered by the first. *Ibid.*

318. RIGHT TO USE.

See USE, RIGHT TO.

319. ROYALTY AND LICENSE FEE.

See DAMAGES, MEASURE OF, LICENSE FEE AND ROYALTY.

Royalty and license fee — *Patentee can recover but one royalty*, §§ 5882, 5883. *How established*, §§ 5884-5886. *Equity jurisdiction*, § 5887. *License fee, how established*, §§ 5888-5891. See *Damages and Profits, Measure of*, §§ 1574-1598.

§ 5882. Patentees are entitled to but one royalty for a patented machine. *Bloomer v. Millinger*, 1 Wall., 340.

§ 5883. The patentee is entitled to but one royalty for a patented machine, and he ought to have but one profit for the manufacture and use of a machine. *Spaulding v. Page*, 1 Saw., 702.

§ 5884. No price can be said to be fixed, or royalty established, where the patentee varies his price according to the courage or ability to resist of an infringer, or where there are other circumstances showing the absence of a fixed and established fee. *Black v. Munson*, 14 Blatch., 265.

§ 5885. Where a license under letters patent provided for the payment of a royalty of \$5 a machine, but subject to a reduction of \$3 if promptly paid, etc., it was, on the question of assessing damages against a third party, considered as establishing a royalty at the lower rate, and interest from the date of the interlocutory decree establishing the patent and the fact of infringement, was allowed. *Graham v. Geneva Lake Crawford Mfg. Co.*, 32 O. G., 1603.

§ 5886. In respect to two or more claims in a patent, each of value and distinct from the other, one cannot equal all in value any more than in mathematics a part can equal the whole. A licensee may, if he choose, bind himself to pay the same price whether he use the entire invention or a part only, but at the same time he acquires the right to use all, and so his agreement may not be unreasonable; but if as against an infringer such a license can have any force, reasonably it must be in the way only of establishing a royalty for the entire invention. *Westcott v. Rude*, 19 Fed. Rep., 830.

§ 5887. Where the real damage is in the nature of a royalty there is no remedy in equity. *Hoe v. Boston Daily Advertiser Corporation*, 14 Fed. Rep., 914.

§ 5888. Proof of a single license is not sufficient to establish a market price. *Westcott v. Rude*, 19 Fed. Rep., 830.

§ 5889. Evidence of settlements for infringements of a patent, or of licenses for the future, given wholly or partially in consideration of such settlements, is not competent to show an established royalty or license fee. *Gottfried v. Crescent Brewing Co.*, 22 Fed. Rep., 433.

§ 5890. When the question is close, a revoked or abandoned license may be considered as throwing light upon the value which an inventor has put upon the right to manufacture his patented machine. *Graham v. Geneva Lake Crawford Mfg. Co.*, 32 O. G., 1603.

§ 5891. Agreements made to secure the manufacture and introduction of a patented machine are not to be considered as unqualified licenses fixing a royalty or license fee which can be accepted as establishing, within the language of the court in *Seymour v. McCormick*, 16 How., 480, the average of actual damages sustained by a patentee when his invention is used without license. *Ibid.*

See *Damages and Profits*, § 1520.

320. RULE OF COMITY.

Rule of comity — *Prior decisions* — *Of supreme court*, §§ 5892-5897; *of federal courts*, §§ 5898-5907; *particular cases*, §§ 5908-5910. See *Injunction, Preliminary*, §§ 3047, 3049, 3148-3158.

§ 5892. Decisions of the supreme court are authority in this court, even though none of the parties are the same as in the prior determination. *Richardson v. Lockwood*, 4 Cliff., 128.

§ 5893. The judgment of the supreme court of the United States upon a question of fact arising afterward in a circuit court is entitled to high respect, and, though not binding in law, should be definitive where nothing is alleged which raises a doubt as to its soundness or a suspicion that it would not be repeated on a rehearing. *Seymour v. Marsh*, 2 O. G., 675.

§ 5894. The judgment of the supreme court that a machine is not an infringement of a patent will not hinder its being held an infringement of the same patent when reissued in different terms. *Wells v. Jaques*, 5 O. G., 364.

§ 5895. The decision of the United States supreme court upon a question of law, and sustaining a patent, is entitled to deference, but is not to be followed where the facts appear to be different. *Kirby v. Dodge & Stephenson Manufacturing Co.*, 10 Blatch., 307.

§ 5896. Where the validity of the patent had been established by a prior decision of the supreme court, *ex parte* affidavits to establish its want of validity, presented on a subsequent application for injunction, were not considered. *American Middlings Purifier Co. v. Christian*, 4 Dill., 448.

§ 5897. Decisions of the supreme court of the United States upon questions of patent law are final. Where the question is one of complicated facts, and the facts may be and are controverted in the supreme court, with regard to the validity of the patent, its decision is conclusive upon those facts, so far as the facts are the same. *Ibid.*

§ 5898. The federal courts constitute an indivisible system for ascertaining the rightfulness and limits of the patent, and when, in any co-ordinate department of it, judgment has been pronounced, that duty should be deemed performed until reversed by an appellate tribunal. *Goodyear Dental Vulcanite Co. v. Willis*, 1 Flip., 388.

§ 5899. No circuit court is bound to follow the decisions of the courts of other circuits. Nevertheless, where a patent has been sustained in the circuit courts of four different circuits, and no appeal from the decision has been taken in either case, a strong presumption arises that the parties were satisfied with the soundness of the decisions; and it is incumbent on the party who seeks to bring another court to a different conclusion to point out indisputable grounds for it. *Blake v. Robertson*, 6 O. G., 297.

§ 5900. Where a previous decision has been had by a circuit court with regard to the validity of a patent, the uniform course of decision in the courts of the United States has been to treat it as of the very highest nature, and as almost conclusive in an application for injunction in another case founded on the same patent. *American Middlings Purifier Co. v. Christian*, 4 Dill., 448.

§ 5901. Upon principles of comity, the decisions of courts of co-ordinate jurisdiction upon the same subject-matter of controversy will be adopted as the rule of construction when, after a fair comparison of the testimony in the two cases, there does not appear to be new, or additional, or contradictory evidence which impels the court in the second hearing to a different result. *Rumford Chemical Works v. Hecker*, 10 O. G., 289.

§ 5902. A proper regard for uniformity of decision requires that, where the same evidence as to the state of the art and prior invention is before the court, as in a prior case decided in another circuit, the conclusion then reached should therefore be followed, unless, indeed, plain mistake be shown. *Hammerschlag v. Garrett*, 9 Fed. Rep., 43.

§ 5903. In patent causes, where the same issue has been passed upon by the circuit court sitting in one district, it is only in case of a clear mistake of law or fact, of newly-discovered testimony, or upon some question not considered by such court, that its findings will be reviewed in another district. *Searls v. Worden*, 11 Fed. Rep., 501.

§ 5904. When the record is substantially the same as that in a prior case, the rule of comity prevails, and the findings of the court will be followed; but when the defenses and proofs are not the same, the rule does not apply. *Edgerton v. Furst & Bradley Manufacturing Co.*, 10 Biss., 402.

§ 5905. In hearing a case upon the same issues already passed upon by another circuit court, in which no new question is suggested, or newly-discovered evidence adduced tending to change or modify the adjudication in that case, such prior decision will be assumed to be correct. *Worden v. Searls*, 21 Fed. Rep., 406.

§ 5906. A decision on a preliminary application for an injunction is not of controlling right in another circuit, as was held in the *Sargent Manufacturing Company v. Woodruff*, 5 Bissell, 444. *Cornell v. Littlejohn*, 9 O. G., 837.

§ 5907. The question for decision in all the cases being one of law, on undisputed facts, a decision of it on a motion for a preliminary injunction is of equal weight, on a question of comity, as a decision of it on a final hearing. *American Cotton-Tie Supply Co. v. Bullard*, 17 Blatch., 160.

§ 5908. In view of numerous decrees in other circuit courts sustaining the validity of the Green patent for driven wells, in only one of which appeal has been taken to the supreme court, the court declined to hear argument except as to new features of the particular case. *Green v. French*, 11 Fed. Rep., 591.

§ 5909. The conclusions of the circuit court for the eastern district of New York and the circuit court for the district of Maryland, with respect to the patentability of the invention, adopted, and the validity of the patent sustained, notwithstanding certain testimony offered to show the prior use of the invention. *American Ballast Log Co. v. Cotter*, 11 Fed. Rep., 728.

§ 5910. Where in a suit on a reissue patent certain defenses and evidence were the same as in a prior suit on the same patent, the decision in the former suit as to the matters there considered and passed upon was followed. *Strobridge v. Landers*, 11 Fed. Rep., 880.

See *Construction of Patents*, §§ 1213, 1216.

321. RULES OF COURT.

See PRACTICE, RULES OF COURT.

322. RULES OF PATENT OFFICE.

See PRACTICE, IN PATENT OFFICE, RULES OF.

323. SALES.

See USE, PRIOR PUBLIC USE AND SALE.

Sale — Auction, § 5911.

§ 5911. Where B. purchased a patented machine from A., who also gave him a personal license to use it upon the payment of a certain royalty, on the failure of which the license could be revoked; and on the death of B. parts of the machine were purchased at auction by C., who reconstructed the machine and sold it to D., *held*, that the purchase by C. gave him no right to reconstruct from the loose materials a working machine embodying A.'s invention. *Wortendyke v. White*, 2 B. & A., 25.

Sale — Sheriff's.

SUMMARY (*WILDER v. KENT*, §§ 5912, 5913)—*Fixtures; state law*, § 5912.—*Sheriff's sale passes right to use patented machine*, § 5913.

WILDER v. KENT.

(Circuit Court for Pennsylvania: 23 Official Gazette, 831, 832. 1882.)

§ 5912. *Fixtures.*

Opinion by ACHESON, J.

In Pennsylvania, as between vendor and vendee, heir and executor, and debtor and execution-creditor, machinery, whether fast or loose, of a manufactory which is a constituent part thereof, for the purposes of the business there conducted, and without which the establishment would not be fully equipped, is a fixture, and passes as a part of the freehold. *Voorhis v. Freeman*, 2 W. & S., 116; *Ege v. Kille*, 84 Pa. St., 333; *Morris' Appeal*, 88 id., 368. That the two graining-machines, the subject-matter of this suit, although loose and portable, were fixtures within the above-stated principle, we incline to think; but in our apprehension of the case it is not necessary to pass definitely upon that question. The sheriff's levy upon the real estate, after describing the factory lot, proceeds thus: "And having erected thereon a large two-story brick building, known as the 'Corry Wooden Ware Works,' with machinery for manufacturing tubs, pails, etc., large boilers and engine, pulleys, shafting, belting," etc.

Now, the two graining-machines were then used in said works in the ordinary course of the manufacture of tubs and pails to paint or grain designs thereon, to finish the vessels, and make them marketable wares. Clearly they

were within the scope of the levy. In *Voorhis v. Freeman*, *supra*, where the sheriff's vendee claimed duplicated detached rolls, the premises having been described as "a lot or piece of ground, with one iron rolling mill establishment situate thereon, with the buildings, apparatus, steam-engine, boilers, bellows, etc., attached to the said establishment," Chief Justice Gibson said: "And were it necessary, we would further hold that they might have passed, had they been chattels, by force of the word 'apparatus,' in the description of the premises."

So, in this instance, we decide without hesitation that under the sheriff's levy, sale and deed, the title to the two graining-machines vested in his vendee as part of the designated machinery. Each machine is a patented apparatus, constructed under letters patent granted by the United States to John R. and Alfred J. Cross. The plaintiff, David H. Wilder, having acquired the exclusive territorial right to the patent for the counties of Erie and Warren, Pennsylvania, set up said two machines (one of which he bought from one of the patentees, and the other of which he constructed himself), in the Corry Wooden Ware Works, in the said county of Erie. They were there operated under the patent for a number of years by Wilder & Howe and the Corry Manufacturing and Lumber Company (of both which concerns the plaintiff was a member), and by the plaintiff individually, he having eventually become the sole owner of the works and machinery, including the machines in question. Afterward, upon an execution against Wilder, the sheriff levied upon the works and machinery, and sold the same to Adams Davis, one of the defendants. The sheriff's sale, as already shown, embraced the two graining-machines, and under the title thereby acquired the defendants are operating them at said works. This is the alleged infringement of which Wilder complains. We are, therefore, called upon to decide what rights a purchaser at sheriff's sale takes in a patented machine belonging to and sold as the property of the owner of the patent, the defendant in the execution. The learned counsel agree that the question has never been judicially determined; and upon diligent search no case has been found involving the precise point now presented for decision.

§ 5913. *Whatever right to use the patented machine a defendant in an execution may have passes with the machine when sold by the sheriff to his vendee.*

In *Sawin v. Guild*, 1 Gall., 485; 1 Robb., 47, the sheriff, upon an execution against the patentee, levied on and sold the "materials" of several of the completed patented machines, and such sale was held to be no infringement of the patent-right. "He sold," said Mr. Justice Story, "the materials as such, to be applied by the purchaser as he should by law have a right to apply them. The purchaser must therefore act at his own peril, but in no respect can the officer be responsible for his conduct." The specific ruling in *Chambers v. Smith*, 5 Fisher, 12, was that a purchaser at a marshal's sale of a patented machine was an infringer in operating it outside of the district to which its use was limited by the license granted to the defendant in the execution.

The position taken by the plaintiff's counsel is that when the owner of a patent, who does not manufacture for sale, makes a machine for his own use only, and such patented machine is sold at a forced sale by the sheriff, the right to use it does not pass with it, but only the ownership of the materials of which the machine is constructed. To sustain this proposition reliance is placed upon the cases of *Stephens v. Cady*, 14 How., 528, and *Stevens v. Gladding*, 17 id., 447, in which it was held that the seizure and sale of the copper-plate of a copyrighted map, under an execution against the owner of the

copyright and plate, did not carry with it the right to print and publish the map; but the reason assigned for this is that the copyright — the exclusive and intangible right to multiply copies of the original work — does not inhere in and has no necessary connection with the plate, which is the mere instrument for producing the copies. The copyright and plate are wholly distinct and disconnected subjects of property, each capable of being owned and transferred independent of the other (*Ibid.*), and therefore a judicial sale of one does not carry any title to the other. But the lawful sale of a patented machine takes it out of the monopoly, either altogether or *pro tanto*, according to the nature of the contract. The purchaser of a machine from the patentee acquires no right in the patent itself, and needs none to enable him to enjoy his acquisition. By implication he is invested with a license to use that particular machine, and in the absence of express provision to the contrary, such license passes with the machine to successive owners as an incident of proprietorship. That such is the law in case of a voluntary sale of a patented machine by the patentee is incontrovertible. But wherefore should the rights of the sheriff's vendee under an execution against the patentee be less than those of a purchaser directly from the patentee? The rule is, that the purchaser at the sheriff's sale succeeds to the beneficial rights of the defendant in the execution to the property sold. *Chambers v. Smith, supra.* But why should an exception be made where the subject-matter of sale is a patented machine? To deny to the sheriff's vendee the right to use such machine would in effect prevent its sale upon an execution at law as an operative apparatus, and practically withdraw it from the reach of the owner's execution creditors. The mischievous consequences to such creditors to which the doctrine contended for would lead (now that patented machinery has come into almost universal use) can hardly be estimated. The plaintiff's position is untenable. It is very true that the patent-right itself, being incorporeal and resting exclusively upon statutory grant, cannot be levied on at law, and is available to creditors only by proceedings in a court of equity. *Ager v. Murray*, 105 U. S., 126. But a patented machine is susceptible of manual seizure, and the unrestricted sale thereof does not involve the transfer of any interest in the patent.

The conclusion, therefore, is that whatever right to use the patented machine a defendant in an execution may have, passes with the machine when sold by the sheriff to his vendee. Hence it follows that the plaintiff has no just cause of complaint against these defendants.

The foregoing views being decisive of the case, it is unnecessary to consider the other questions which the counsel have so ably discussed.

McKENNAN, C. J.: I concur fully in the foregoing opinion.

Per CURIAM: Let a decree be drawn dismissing the plaintiff's bill, with costs.

§ 5914. Sheriff's sale on execution of materials of a patented machine is no infringement. *Sawin v. Guild*, 1 Gall., 484.

§ 5915. A license to use a patented invention held a proper subject of sale to satisfy a judgment debt by bill in equity. *Matthews v. Green*, 19 Fed. Rep., 649.

Sale — Judicial.

SUMMARY (AGER *v.* MURRAY, § 5916) — *Patent-right is subject to judgment debt in equity,*
§ 5916.

AGER *v.* MURRAY.

(15 Otto, 126-132. 1881.)

APPEAL from the Supreme Court of the District of Columbia.

Opinion by MR. JUSTICE GRAY.

STATEMENT OF FACTS.— This is a bill in equity by a judgment creditor to subject to the payment of his debt the interest of his debtor in patent-rights. The case was heard in the supreme court of the District of Columbia upon bill and answers, by which it appears to be as follows:

On the 10th of April, 1876, Talbot C. Murray, in an action at law upon a promissory note, recovered judgment against Wilson Ager for the sum of \$2,164.66, with interest and costs. Upon that judgment a writ of *fiери facias* was issued, and returned *nulla bona*. Wilson Ager had no real or personal property in the district subject to execution at law, but was the owner of sundry letters patent issued to him by the United States for useful inventions, which, if sold, would produce more than enough money to satisfy that judgment. On the 26th of September, 1876, he conveyed all his right and interest in these letters patent to the other defendant, Elisha C. Ager, who owned an equitable interest of one-third therein, and who, on the 8th of October, 1877, reconveyed the patent-rights to Wilson by an assignment which was not recorded in the patent office. Wilson Ager resides in the District of Columbia, and the other defendant resides in the state of California, and both have appeared in the cause and answered to the merits of the bill.

The bill prays for an injunction against further assignment pending the suit, and that the patents be sold under the direction of the court, and the proceeds of the sale applied to the payment of the judgment debt, and the defendant, Wilson Ager, be required to execute such assignment as may be necessary to vest title in the purchaser or purchasers, in conformity with the patent laws, and for further relief. The decree is, that in default of his paying by a certain day the judgment mentioned in the bill, with interest and costs, and the costs of this suit, the patent-rights be sold and an assignment thereof executed by him as prayed for, and that, in default of his executing such assignment, some suitable person be appointed trustee to execute the same.

§ 5916. *A patent-right may be subjected in equity to the payment of a judgment debt of the patentee.*

From that decree the original defendants have appealed to this court, and the single question argued before us is whether a patent-right may be ordered by a court of equity to be sold and the proceeds applied to the payment of a judgment debt of the patentee. A patent or a copyright which vests the sole and exclusive right of making, using and vending the invention, or of publishing and selling the book, in the person to whom it has been granted by the government, as against all persons not deriving title through him, is property, capable of being assigned by him at his pleasure, although his assignment, unless recorded in the proper office, is void against subsequent purchasers or mortgagees for a valuable consideration without notice. Rev. Stat., secs. 4884, 4898, 4952, 4955. And the provisions of the patent and copyright acts, securing a sole and exclusive right to the patentee, do not exonerate the right

and property thereby acquired by him, of which he receives the profits, and has the absolute title and power of disposal, from liability to be subjected by suitable judicial proceedings to the payment of his debts.

In England it has long been held that a patent-right would pass by an assignment in bankruptcy, even without express words to that effect in the bankrupt act. *Hesse v. Stevenson*, 3 Bos. & Pul., 565; S. C., Davies, Pat. Cas., 263; *Longman v. Tripp*, 2 New Rep., 67; *Bloxam v. Elsee*, 1 Car. & P., 558; S. C., Ry. & M., 187; 6 Barn. & Cress., 169; 9 D. & R., 215; *Mawman v. Tegg*, 2 Russ., 385; *Edelsten v. Vick*, 11 Hare, 78; *Hudson v. Osborne*, 39 L. J. (N. S.), Ch., 79. In *Hesse v. Stevenson*, Mr. Justice Chambre, in the course of the argument, said: "The right to the patent is made assignable; why, then, may it not be assigned under a commission of bankrupt?" 3 Bos. & Pul., 571. And Lord Alvanley, delivering the unanimous judgment of the court, after observing that it was contended "that the nature of the property in this patent was such that it did not pass under the assignment," and "that although by the assignment every right and interest, and every right of action, as well as right of possession and possibility of interest, is taken out of the bankrupt and vested in the assignee, yet that the fruits of a man's own invention do not pass," said: "It is true that the schemes which a man may have in his own head before he obtains his certificate, or the fruits which he may make of such schemes, do not pass, nor could the assignee require him to assign them over, provided he does not carry his schemes into effect until after he has obtained his certificate. But if he avail himself of his knowledge and skill, and thereby acquire a beneficial interest, which may be the subject of assignment, I cannot frame to myself an argument why that interest should not pass in the same manner as any other property acquired by his personal industry." 3 Bos. & Pul., 577, 578. The recent bankrupt act of the United States, in defining what property should vest in the assignee in bankruptcy, expressly enumerated "all rights in equity, choses in action, patent-rights, and copyrights," and required the assignee to sell all the property of the bankrupt for the benefit of his creditors. Rev. Stat., secs. 5046, 5062-5064. The only difference is, that in England all such rights pass that become vested in the bankrupt before he obtains a certificate of discharge, whereas here only those rights pass which belong to him at the time of the assignment.

It has been said by an English text-writer that "a patent-right may be seized and sold in execution by the sheriff under a *fiery facias*, being in the nature of a personal chattel." Webster on Patents, 23. We are not aware of any instance in which such a course has been judicially approved. But it is within the general jurisdiction of a court of chancery to assist a judgment creditor to reach and apply to the payment of his debt any property of the judgment debtor, which by reason of its nature only, and not by reason of any positive rule exempting it from liability for debt, cannot be taken on execution at law; as in the case of trust property in which the judgment debtor has the entire beneficial interest, of shares in a corporation, or of choses in action. *M'Dermutt v. Strong*, 4 Johns. Ch., 687; *Spader v. Hadden*, 5 id., 280, and 20 Johns., 554; *Edmeston v. Lyde*, 1 Paige, 637; *Wiggin v. Heywood*, 118 Mass., 514; *Sparhawk v. Cloon*, 125 id., 263; *Daniels v. Eldredge*, id., 356; *Drake v. Rice*, 130 id., 410.

In *Stephens v. Cady*, 14 How., 528, and again in *Stevens v. Gladding*, 17 id., 447, the point decided was that, by a sale of the copper-plate engraving of a

map on execution from a state court against the owner of the copyright, the purchaser acquired no right to strike off and sell copies of the map.

Mr. Justice Nelson, in delivering judgment in *Stephens v. Cady*, said: "The copper-plate engraving, like any other tangible personal property, is the subject of seizure and sale on execution, and the title passes to the purchaser the same as if made at a private sale. But the incorporeal right, secured by the statute to the author, to multiply copies of the map by the use of the plate, being intangible, and resting altogether in grant, is not the subject of seizure or sale by means of this process — certainly not at common law. No doubt the property may be reached by a creditor's bill, and be applied to the payment of the debts of the author, the same as stock of the debtor is reached and applied, the court compelling a transfer and sale of the stock for the benefit of creditors." He then cited the cases in Johnson's and Paige's Reports, above referred to, and added: "But in case of such remedy, we suppose, it would be necessary for the court to compel a transfer to the purchaser, in conformity with the requirements of the copyright act, in order to vest him with a complete title to the property." 14 How., 531.

In *Stevens v. Gladding*, Mr. Justice Curtis said: "There would certainly be great difficulty in assenting to the proposition that patent and copyrights, held under the laws of the United States, are subject to seizure and sale on execution. Not to repeat what is said on this subject in 14 How., 531, it may be added, that these incorporeal rights do not exist in any particular state or district; they are co-extensive with the United States. There is nothing in any act of congress, or in the nature of the rights themselves, to give them locality anywhere, so as to subject them to the process of courts having jurisdiction limited by the lines of states and districts. That an execution out of the court of common pleas for the county of Bristol, in the state of Massachusetts, can be levied on an incorporeal right subsisting in Rhode Island or New York, will hardly be pretended. That by the levy of such an execution the entire right could be divided, and so much of it as might be exercised within the county of Bristol sold, would be a position subject to much difficulty. These are important questions, on which we do not find it necessary to express an opinion, because in this case neither the copyright, as such, nor any part of it, was attempted to be sold." 17 How., 451. The difficulties of which the learned justice here speaks are of seizing and selling a patent or copyright upon an execution at law, which is ordinarily levied only upon property, or the rents and profits of property, that has itself a visible and tangible existence within the jurisdiction of the court and the precinct of the officer; and do not attend decrees of a court of equity, which are *in personam*, and may be enforced in all cases where the person is within its jurisdiction. *Massie v. Watts*, 6 Cranch, 148. And the terms in which he refers to the statement of Mr. Justice Nelson show that there was no intention to criticise or qualify that statement.

There are, indeed, decisions in the circuit courts that an assignee in insolvency, or a receiver, of all the property of a debtor, appointed under the laws of a state, does not, by virtue of the general assignment or appointment merely, without any conveyance made by the debtor or specifically ordered by the court, acquire a title in patent-rights. *Ashcroft v. Walworth*, 1 Holmes, 152; *Gordon v. Anthony*, 16 Blatch., 234. But, in *Ashcroft v. Walworth*, Judge Shepley clearly intimated that the courts of the state might have compelled the debtor to execute such a conveyance. And the highest courts of

New York and California have affirmed the power, upon a creditor's bill, to order the assignment and sale of a patent-right for the payment of the patentee's judgment debts. *Gillette v. Bate*, 86 N. Y., 87; *Pacific Bank v. Robinson*, 57 Cal., 520.

In *Carver v. Peck*, 131 Mass., 291, the court reserved the expression of any opinion upon that question, because unnecessary to the decision. And the assumption in *Cooper v. Gunn*, etc., 4 B. Mon. (Ky.), 594, that an author could not be deprived against his will, and in favor of any of his creditors, of any of the rights secured to him by the copyright acts, was merely *obiter dictum*, unsupported by reasoning or authority.

In the case at bar, the bill is filed by a judgment creditor of the patentee, in a court of the United States of appropriate jurisdiction, against the patentee, residing within the District, and holding the entire legal title and two-thirds of the equitable interest in the patent-rights, and against the owner of an equitable interest in the remaining third, who is properly made a party to the bill. Both defendants are before the court, and have filed answers. The debtor's interest in the patent-rights is property, assignable by him, and which cannot be taken on execution at law. The case is thus brought directly within the opinion delivered by Mr. Justice Nelson, in *Stephens v. Cady*, of the soundness of which we entertain no doubt.

The clause of the decree below appointing a trustee to execute an assignment, if the patentee should not himself execute one as directed by the decree, has not been objected to in argument, and was clearly within the chancery powers of the court, as defined in the statute of Maryland of 1785, which is in force in the District of Columbia. Maryland Stat. 1785, ch. 72, secs. 7, 13, 25; 2 Kilty's Laws; Laws of District of Columbia (ed. 1868), pp. 326, 328, 333, 336.

Decree affirmed.

Sale — By order of court, § 5917.

§ 5917. A court of equity may direct the sale of the interest of an inventor in his patent in order to satisfy a judgment obtained against him in a court of law, the writ of execution having been returned *nulla bona*, and for that purpose will require the patentee to make an assignment of the patent, as provided in section 4898 of the Revised Statutes of the United States, and in default of such assignment within a limited time will appoint a trustee, with authority to execute the same. *Murray v. Ager*, 20 O. G., 1311.

Sale — Of product of patented machine, §§ 5918-5921. Of product of patented process, § 5922.
Of patented product, §§ 5923-5925.

§ 5918. An assignee of the exclusive right to make, use and vend a patented machine within a given territory may vend the product elsewhere. *Simpson v. Wilson*, 4 How., 709.

§ 5919. When the sale of the product of a patented machine is connected with the illegal use of the thing patented, the individual is responsible in damage, and an injunction will be allowed. *Boyd v. McAlpin*, 3 McL., 427.

§ 5920. Sale of product of a machine is no violation of the exclusive right to use, construct or sell the machine itself. *Ibid.*

§ 5921. Where there had been an assignment of an exclusive right in a particular territory to make and use patented means for the production of an article, *held*, that the right was not infringed by the sale within the same territory of the product of the patented means, and an injunction was refused. *Boyd v. Brown*, 3 McL., 295.

§ 5922. The sale of the product of a patented process is no infringement where the novelty is in the process and not in the product. *Goodyear v. The Railroad*, 2 Wall. Jr., 356.

See *Process and Product*, § 5111.

§ 5923. A patentee cannot divide his process and product patent in numerous licenses so as to bind purchasers of the product. Every person who pays patentee for a license to use his process becomes the owner of the product and may sell it to whom he pleases, or apply it to

any purpose, unless he binds himself by covenants to restrict his right. *Metropolitan Washing Machine Co. v. Earle*, 3 Wall. Jr., 320.

§ 5924. Whether the inventor has a patent for the article manufactured, or only for the product or the material of which it is composed, the unconditional sale of the manufactured article carries with it the absolute dominion over the material as well as over the manufactured article. *Goodyear v. Beverly Rubber Co.*, 1 Cliff., 348.

§ 5925. Where defendants purchased the patented product of plaintiff's patented process, and modified the product by a different process, *held*, that the patented product became the purchasers' absolute property, and their subsequent use of it for other purposes was no infringement. *Ibid.*

Sale — Unrestricted, of patented articles — Passes unlimited right of user, §§ 5926-5932.

Sale by one not having an exclusive right, § 5933. *Qualified sale*, § 5934. *Licensed to be used once*, §§ 5935, 5936. *Unwarranted sale*, § 5937. *Sale abroad*, § 5938. See *Purchaser*, §§ 5186-5201.

§ 5926. An unrestricted sale of a patented article carries with it the right to its unlimited use; but the reason upon which this rule rests involves a plain distinction between the right to use and the right to manufacture and sell the invention, and is inapplicable to their definition. *Hatch v. Adams*, 22 Fed. Rep., 434.

§ 5927. Unconditional sale of a patented article confers the whole title therein, and impliedly warrants full ownership on the part of the vendor. *Holliday v. Matheson*, 30 O. G., 452.

§ 5928. When a patentee sells the patented article he parts with all his control over it, and the purchaser may treat it like any other property, and use it as long as it lasts without liability to the patentee, although the original term of the patent has expired and it has been extended. *Mitchell v. Hawley*, 16 Wall., 544.

§ 5929. The purchaser has the same right in the article if the person from whom he obtained it was authorized by the patentee, without any conditions, to make and sell or make and use it. *Ibid.*

§ 5930. When a patentee has constructed a machine, and sold it without any conditions, or authorized another to construct, sell, and deliver it, or construct and use and operate it without any conditions, and the consideration has been paid to him for the thing patented, the rule is well established that he must be understood to have parted to that extent with all his exclusive right, and that he ceases to have any interest whatever in the patented machine so sold and delivered, or authorized to be constructed and operated. When such circumstances appear, the owner of the machine, whether he built it or purchased, if he has also acquired the right to use and operate it during the life-time of the patent, may continue to use it until it is worn out, in spite of any and every extension subsequently obtained by the patentee or his assigns. *Wooster v. Siedenbergh*, 13 Blatch., 88.

§ 5931. When a patented article is made and sold by one who has authority to do so, it becomes like other property, and no use or sale of it afterward is an infringement of the patent. *Adams v. Burks*, 1 Holmes, 40; *Hawley v. Mitchell*, 1 Holmes, 42.

§ 5932. When the owner of a patent himself sells a machine constructed for the purpose of using his invention, he is understood to have to that extent parted with his exclusive right to his invention. *Detweiler v. Voegel*, 19 Blatch., 482.

See *Purchaser*, §§ 5188-5193.

§ 5933. A sale by the patentee of the machine gives an implied right to use it. But this inference does not necessarily follow, where the sale is made by a person who has no exclusive right, but a license merely of use, in which latter case the extent of the transfer must depend upon the facts and circumstances proved. *Wilson v. Stolley*, 4 McL., 275.

§ 5934. Where the owner of the patent sells the patented article under circumstances which imply that the purchaser is not to acquire an unqualified property in it, as where a license accompanies the transfer, the purchaser's rights are limited to the extent of the monopoly granted to him. *Holliday v. Matheson*, 24 Fed. Rep., 185.

§ 5935. A buckle or bale-tie, sold for ordinary commercial use, passes beyond the monopoly of the patent, and cannot be followed or controlled in its subsequent disposition. *American Cotton-Tie Co. v. Simons*, 13 O. G., 967.

§ 5936. Though the words "Licensed to use once only" were stamped upon the buckles, and words of like import were contained in the bill-heads and invoices, the nature of the article and of its use are such that there is an implied parting with the unrestricted title at the time of sale, which is inconsistent with any such reservation or limitation. *Ibid.*

See *Re-use*, §§ 5864-5866.

§ 5937. A sale of patented articles in the ordinary course of trade, outside the territorial limits to which the right of sale is restricted by the patentee's grant, is unwarranted. *Hatch v. Adams*, 22 Fed. Rep., 434.

§ 5938. Unconditional sale of a patented article, even where the sale was in a foreign country, is good everywhere and carries the right to use or sell for use anywhere. *Holliday v. Matheson*, 30 O. G., 452.

Sale — In general — *Sale prior to patenting*, § 5939. *Sale for limited use*, § 5940. *Right to use during extension*, § 5941. *Sale to patentee no infringement*, § 5942. *Sale of fraudulent patent*, § 5943. *Acquiescence in sale under foreclosure*, § 5944.

§ 5939. Sale of an invention prior to patenting is recognized as valid by act 1839, section 7. *Rathbone & Co. v. Orr*, 5 McL., 131.

§ 5940. A sale of an invention to be used in making brushes does not authorize the use of it in making mirrors. *Clark v. Scott*, 9 Blatch., 301.

§ 5941. Under a sale of a patented machine from an assignee the purchaser has a right to use it during the extended term of the patent, notwithstanding any words of limitation in the conveyance to the assignee restricting his rights to the original term. *Hawley v. Mitchell*, 1 Holmes, 42.

§ 5942. The sale of a patented article to the patentee or his agent is not *per se* an infringement, and damages cannot be recovered. It may, however, be evidence of infringement if accompanied by other circumstances. *Byam v. Bullard*, 1 Curt., 100.

§ 5943. Where defendant purchased a patent-right covering the whole machine, in the belief that he was entitled to the whole, whereas plaintiff, his vendor, had knowingly included in his patent, together with his improvement, that which had been previously patented to another, *held*, that the sale was a fraud, and a promissory note given in part consideration thereof was void in law. *Turner v. Johnson*, 2 Cr., 287.

§ 5944. Circumstances amounting to acquiescence in sale under foreclosure of patented machines, *held* to have same effect as if owner of the patent had himself sold the machines to defendants and given them the right to use them. *Detweiler v. Voegel*, 19 Blatch., 482.

See *Assignment*, § 517. *Attorney*, § 579. *Damages and Profits*, § 1474. *Title*, § 6313.

324. SCOPE OF PATENT.

Scope of patent — Patentee is entitled to all the uses of which his patented invention is capable, §§ 5945-5950. See *Construction of Patents*, §§ 1146-1256. *Invention*, §§ 3576-3583. *Inventor*, §§ 3777-3780. *Patents*, § 4755.

§ 5945. The man who has made the first invention has made it for all the uses to which it is applicable. *Woodman v. Stimpson*, 3 Fish., 98.

§ 5946. Patentee is entitled to every use to which his invention may be applied. *Union Stone Co. v. Allen*, 14 Fed. Rep., 353.

§ 5947. The patentee has the benefit of all the uses to which his invention can be applied. *Chalmers Spence Patent Non-Conductor Co. v. Pierce*, 9 Fed. Rep., 152.

§ 5948. A patent secures the combination or machine patented for all purposes to which it can be put. *Zinn v. Weiss*, 7 Fed. Rep., 914.

§ 5949. The inventor is entitled to all the uses to which his invention can be applied, whether he or another conceived them. *Odell v. Stout*, 22 Fed. Rep., 159.

§ 5950. The originator of a patented invention has an exclusive right in it, although he may not have contemplated all the uses to which it is applied. *McComb v. Brodie*, 1 Woods, 153.

§ 5951. The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not. *Roberts v. Ryer*, 1 Otto, 150.

§ 5952. The patentee is entitled to all the benefits which result from his invention, whether he has specified all the benefits in his patent or not. *California Artificial Stone Paving Co. v. Perine*, 7 Saw. 190.

§ 5953. A patentee is entitled to all the necessary and legitimate results attained by his invention, including even such as were unexpected. *Wells v. Jaques*, 5 O. G., 364.

§ 5954. A patentee who is the first to make an invention is entitled to his claim for all the uses and advantages which belong to it, and it is immaterial whether he perceived and stated such advantages in his patent. *Stow v. City of Chicago*, 14 Otto, 547.

§ 5955. An inventor is entitled to all the uses to which his patent may be applied, and to all the beneficial results which legitimately follow the use of his instrumentalities, as shown by the statement of his invention, and the figures used to illustrate it; and such uses and results may be stated and described in an application for reissue by the inventor, without subjecting himself to the imputation of incorporating new matter. *Putnam v. Yerrington*, 9 O. G., 689.

§ 5956. The patentee is entitled to the exclusive use of the whole of his patented invention, and if it is of a combination of numerous parts, including in it other new and useful combinations of less of the parts, he seems to be entitled to the exclusive use of these lesser combinations, as well as to the exclusive use of the whole. *Holly v. Vergennes Machine Co.*, 18 Blatch., 327.

§ 5957. Where a patent clearly shows and describes a machine whose use necessarily involves the production of a certain process, no other person can afterward patent that process. The first patentee is entitled to his mechanism for every use of which it is capable, even though he did not foresee all of them. *New Process Fermentation Co. v. Koch*, 21 Fed. Rep., 580.

§ 5958. The invention patented, when for a machine, is the machine itself, and the inventor is entitled to the exclusive use of it — if that invention is a machine, for all the uses and purposes to which that machine, without the exercise of any inventive power, can be applied. *Conover v. Roach*, 4 Fish., 12.

§ 5959. There is no doubt that the patent would give an exclusive right to the patented invention for all uses to which it could be put, whether contemplated by the inventor or discovered by himself or others afterwards. But the invention must in some way be covered by the patent before he can acquire an exclusive right to it for any purpose. *Tinker v. Wilber Eureka M. & R. Mfg. Co.*, 1 Fed. Rep., 138.

§ 5960. A patentee has the exclusive right to all the forms of his device in which the principle of his invention may be embodied, and, although he has described but one of those forms, those who use any other trespass upon his right. *Murphy v. Eastman*, 1 Holmes, 113.

See *Composition of Matter*, § 1144.

Scope of patent — Its limitation — *The patent is limited to the invention patented*, §§ 5961-5970. *Permissible modifications in construction*, § 5971.

§ 5961. Where the inventor is not the first in the field of invention, he is entitled only to his particular means or instrumentalities. *Morgan Elevated R'y Co. v. Pullman*, 14 Fed. Rep., 648.

§ 5962. When a patent is granted, patentee must stand by his patent. He gains no exclusive right except for such a machine as his patent describes and secures, though it may be far less broad and comprehensive than his actual invention. *Waterbury Brass Co. v. Miller*, 9 Blatch., 77.

§ 5963. An inventor must be taken to know of what his invention consists, and his patent does not secure to him the exclusive right to anything more than he claims to have invented. *Rich v. Close*, 8 Blatch., 41.

§ 5964. The scope of a patent must be determined by its claims, and it does not necessarily cover all the descriptive matter in the specification. *McMillan v. Rees*, 1 Fed. Rep., 722.

§ 5965. In the case of patented chemical combinations, the exclusive right to the invention imports nothing but protection against the use of the same, or substantially the same elements compounded and treated on principles substantially the same as those of the patented article. *Goodyear v. Berry*, 2 Bond, 189.

§ 5966. A patent for a mechanical structure producing a new and useful result is no protection against the use of an invention producing the same result by appliances and on principles substantially different from the patented invention. *Ibid.*

§ 5967. A patent for a particular structure, intended to accomplish a particular end, does not necessarily import an exclusive right to every possible mode of accomplishing the same. *Blanchard v. Puttman*, 2 Bond, 84.

§ 5968. A patent for a mechanical structure, or a process to effect a specific purpose, does not embrace every possible means of effecting the same result. . . . A patentee is protected from the use of all plans or devices, which, however seemingly different from the patented invention, are the same in principle and operation. *Whitney v. Mowry*, 2 Bond, 45.

§ 5969. Illustration of modification not involving invention covered by and within the scope of a patent. *Barker v. Stowe*, 15 Blatch., 49.

§ 5970. No patentee is held, in reducing his patent to application, to strictly and entirely follow the mere mechanical device shown in his drawings of the patent. He may deviate so long as he does not violate the principle involved. *Weir v. North Chicago Rolling Mill Co.*, 9 Biss., 508.

§ 5971. A patentee is not limited to the literal import of his description of his invention, but in construction he may make such modifications of it as do not involve a departure from its principle or a material change in its mode of operation. *Grier v. Castle*, 17 Fed. Rep., 523.

See *Construction of Patents*, § 1186. *Process*, § 5044.

Scope of patent — Generally — *Patent is for the discovery described*, § 5972. *In view of state of art at date of invention*, § 5973. *Secures the means patented, not the result*, §§ 5974, 5975; *and the particular devices*, §§ 5976-5978; *and equivalents*, § 5979.

§ 5972. The grant of the patent can only be for the discovery as recited and described in the patent and specification. *Evans v. Eaton*, Pet. C. C., 322.

§ 5973. It is what was known at the date of completed invention, and not when the application was filed, which fixes the scope of a patent. *Sprague v. Adriance*, 14 O. G., 308.

§ 5974. The patent secures the means specified to obtain the result, not the result. *American Pin Co. v. Oakville Co.*, 3 Blatch., 190.

§ 5975. It is the mechanism or contrivance claimed in a patent which is appropriated under it, and not the purpose for which it is intended, nor the results it produces. *Merrill*, 1 MacArth., 301.

§ 5976. A patent covers only the devices which are claimed, although others are described by way of explaining them or illustrating the way in which they operate. *Wheeler v. McCormick*, 11 Blatch., 334.

§ 5977. A patent is not for what is described, suggested or hinted at anywhere in the patent, but is for what is fairly described somewhere and covered by the claims of the patent, although the whole is to be looked at in order to ascertain what the claims do really cover. *White v. Gleason Manufacturing Co.*, 8 Fed. Rep., 917.

§ 5978. The scope of a patented invention may be so narrowed by the prior state of the art that infringement cannot be adjudged to exist unless there has been an appropriation in substantial form of construction of the identical elements which the inventor had a right to claim as new in his patent. *Saladee v. Racine Wagon & Carriage Co.*, 20 Fed. Rep., 686.

§ 5979. A patent, in calling for a specific mode, embraces in law all mechanical equivalents; consequently all modes, however changed in form, which act substantially on the same principle and effect the same end, are within the patent. *Pitts v. Edmunds*, 1 Biss., 168.

Scope of patent — Generally — Limitations generally, §§ 5980-5984.

§ 5980. Patent claiming entire machine is good for the actual invention only. *Goodyear v. Mathews*, 1 Paine, 300.

§ 5981. The discovery of a new mode of operating an old machine to produce a new result does not give the inventor the right to a monopoly of the old machine. *Elastic Fabrics Co. v. Rubber Thread Co.*, 1 Holmes, 372.

§ 5982. No one can take something old and apply it in a new way or in a new form, so as to produce a particular result, and be protected beyond the particular way or form or device, and the application which he has made. *Fuller v. Yentzer*, 6 Biss., 203.

§ 5983. A patent protects the essential structure of an invention, but exterior form, painted color and such non-essentials cannot be the subject of the patent, and an imitation of the latter will not be enjoined. *Fairbanks v. Jacobus*, 14 Blatch., 337.

§ 5984. Where a result similar to that of the patent has been once obtained by one kind of a joint, the invention of a special joint for producing the same result does not make the patent cover a function. The field is still open for others to make other joints to be used in the same place, for accomplishing the same result. *Pattee v. Moline Plow Co.*, 10 Biss., 377.

325. SECRETARY OF THE INTERIOR.

See APPEAL FROM COMMISSIONER, TO SECRETARY OF INTERIOR.

SUMMARY (*BUTTERWORTH v. UNITED STATES ex rel. HOE*, §§ 5985-5993) — *Mandamus*, § 5985. — *Secretary's authority*, § 5986. — *Liability of public officer to judicial process*, § 5987. — *Appeal to supreme court of District of Columbia*, § 5988. — *Revised Statutes, section 4918, considered; interfering patents*, § 5989. — *Appeal from commissioner to secretary*, § 5990. — *History of legislation*, § 5991. — *Commissioner's powers*, §§ 5992, 5994. — *Bill in equity to obtain patent*, § 5993.

BUTTERWORTH v. UNITED STATES ex rel. HOE.

(112 U. S., 50-69; 29 Official Gazette, 615-620. 1884.)

ERROR to the Supreme Court of the District of Columbia.

Opinion by MR. JUSTICE MATTHEWS.

STATEMENT OF FACTS.— This is a writ of error prosecuted for the purpose of reviewing and reversing the judgment of the supreme court of the District of

Columbia awarding a peremptory *mandamus* commanding the plaintiff in error, the commissioner of patents, to receive the final fee of \$20 tendered by the relators, and cause letters patent of the United States to R. Hoe & Co., as assignees of Gill, to be prepared and sealed according to law, for a certain invention therein particularly described, and to be presented to the secretary of the interior for his signature.

The facts upon which the controversy arises are shown by the record to be as follows: On March 12, 1881, Gill, one of the relators, made application in due form to the commissioner of patents for letters patent for certain new and useful improvements in printing machines, of which he claimed to be the original and first inventor. An interference was declared with an unexpired patent, No. 238,720, granted to Walter Scott, March 8, 1881. A hearing was had before the examiner of interferences, who decided in favor of Scott, and, on appeal to the examiners-in-chief, that decision was affirmed. An appeal from that decision was taken by Gill to the commissioner of patents, who decided that Gill was the original and first inventor of the improvements claimed, and was entitled to a patent therefor, and on June 4, 1883, adjudged that such patent should issue to the relators composing the partnership of R. Hoe & Co., as assignees of Gill, the inventor.

On June 14, 1883, an appeal was taken by Scott from that decision of the commissioner of patents to the secretary of the interior, under rules prescribed by that officer, dated May 17, 1883, who, on March 7, 1884, reversed the decision of the commissioner of patents in favor of Gill, adjudged Scott to be the original and first inventor of the improvements claimed, and that Gill was not entitled to a patent therefor.

In his return to the alternative writ the commissioner of patents, admitting that he had refused, in compliance with the demand of the relators, to accept their tender of the final fee, and to prepare the patent for signature, and to take any further steps therein, declares "that he so refused, not because he desired to make further inquiry, or to be further advised in that behalf, no motion or other proceeding for rehearing or review had been taken or was pending before him in that behalf, but that he based his refusal, and does so still, solely upon the ground that the honorable the secretary of the interior had entertained the appeal taken to him from said decision under the rules aforesaid, and had, in pursuance of said appeal, entered a decision reversing that of the commissioner of patents, and awarded priority of invention to Walter Scott."

The return proceeds as follows: "Your respondent further says that for many years, and until 1881, it was held, in pursuance of decisions and opinions of the honorable attorney-general made in that behalf, that the honorable the secretary of the interior had, and therefore has, no legal authority to review on appeal a decision of the commissioner of patents, wherein the commissioner has finally adjudged an applicant to be entitled to a patent as prayed for in his application; in other words, that the judgment of the commissioner of patents upon the right of an applicant to have and receive a patent is final and conclusive, subject only to review by the supreme court of the District of Columbia, and such other courts as have jurisdiction in that behalf, and by the commissioner; and the practice of the patent office and the honorable the secretary of the interior conformed thereto. This question, however, was again raised in the cases of *Nicholson v. Edison* and *Le Roy v. Hopkins*, and the honorable the attorney-general of the United States, to whom the question

was again referred, in an opinion signed on the 20th day of August, 1881, held that the honorable the secretary of the interior had and could, on appeal to him, exercise the jurisdiction to review the decision of the commissioner of patents, and control his action in that behalf; and later, on, to wit, the 26th day of February, 1884, the honorable secretary, in an official letter (a copy of which is hereto attached marked "E"), advised your respondent that he, the honorable secretary, had, in pursuance of the opinion of the honorable attorney-general, exercised jurisdiction on appeal from the judicial action of the commissioner in determining questions devolved upon him by the statute.

"In deference to that opinion and the action of the honorable the secretary of the interior in the case under consideration, your respondent refused, and does refuse, to accede to the demand of the relator. That, in view of the decisions and the uniform practice of the commissioners of patents and the heads of the department of the interior prior to 1881, doubt and uncertainty have arisen touching the legal obligations devolving upon your respondent in the case under consideration, and those of like character.

"Your respondent further says that if the judgment of the commissioner of patents, which is, that the relator is entitled to receive his patent as prayed for, is final, and if upon such judgment it is the lawful duty of the respondent to accept said final fee and take the necessary and proper steps to prepare said patent for issue, as prayed, then your respondent has improperly refused, and does improperly refuse, to prepare said patent for issue; but if his decision is subject to review and reversal on appeal to the honorable the secretary of the interior, then such refusal on the part of your respondent to accept said fee and prepare said patent for issue is right and proper."

The return of the commissioner also sets out as exhibits the decision of his predecessor in office awarding priority of invention to Gill and adjudging him to be entitled to a patent; the appeal of Scott to the secretary of the interior; the rules governing such appeals as adopted and promulgated by that officer; the decision on that appeal by the secretary communicated by letter to the commissioner, reversing the decision of the commissioner and awarding priority of invention to Scott, and a subsequent letter of the secretary to the commissioner, dated February 26, 1884, in which he states that at the request of his predecessor, Mr. Kirkwood, in connection with the cases of *Nicholson v. Edison* and *Le Roy v. Hopkins*, the attorney-general considered the question as to the extent of the supervisory authority of the secretary over the acts of the commissioner, and, in an opinion dated August 20, 1881, reached the conclusion that the final discretion in all matters relating to the granting of patents is lodged in the secretary of the interior; that Secretary Kirkwood concurred in that opinion, and from that time to the present, appeals from the judicial action of the commissioner of patents have been considered by the secretary of the interior; that the attention of congress was particularly directed to this new practice in the annual report of the secretary of the interior for 1881, and that there has not since been any legislative expression of dissent from the interpretation the existing law had received; and that he does not feel justified in discontinuing a practice which he finds thus established.

§ 5985. *Mandamus will not lie to compel a public officer to do a particular thing which his superior in authority has lawfully ordered him not to do.*

It is clear enough that if the action of the commissioner of patents, in the matter of controversy, is subject to the order of the secretary of the interior,

the judgment of the supreme court of the District of Columbia must be reversed, for *mandamus* evidently will not lie to compel a public officer to do a particular thing which his superior in authority has lawfully ordered him not to do. The direct and immediate question, therefore, for our determination, is, whether the secretary of the interior had power by law to revise and reverse the action of the commissioner of patents in awarding to Gill priority of invention and adjudging him entitled to a patent.

§ 5986. *Authority and power of the secretary of the interior considered.*

The authority and power claimed for the secretary of the interior are asserted and maintained upon these general grounds: that he is the head of the department of which the patent office is a bureau; that the secretary is charged by section 441, Revised Statutes, with the supervision of public business relating to patents for inventions, in the same terms and in the same sense as in the cases of the various other subjects which in that section are classed together, to wit, the census, the public lands, the Indians, pensions and bounty lands, the custody and distribution of publications, etc.; that, by section 4883, it is required that all patents shall be signed by the secretary, as the responsible representative of the government, in whose name the grant is made, and countersigned by the commissioner of patents, only to attest the act of his superior; that, by section 481, while the commissioner is required to superintend or perform all duties respecting the granting and issuing of patents directed by law, it is thereby also provided that it must be under the direction of the secretary of the interior—a clause to be read, it is argued, as if it were expressly inserted as a qualification of every statutory duty imposed upon the commissioner; that, by section 483, the regulations which, from time to time, the commissioner may establish for the conduct of proceedings in the patent office are subject to the approval of the secretary; that, by section 487, the reasons for the refusal of the commissioner to recognize any person as a patent agent, either generally or in any particular case, are subject to the approval of the secretary; that this general relation of official subordination, with the accompanying powers of supervision and direction, extends to all the official acts of the commissioner, without regard to any distinction between those which are merely ministerial and those which are judicial in their nature; and that such supervision and direction may be exerted at any stage of a proceeding, in the discretion of the secretary, whether in advance, or during its progress, or after its termination, and embraces, therefore, the mode of appeal, though no appeal, in express terms, is actually given.

And it is claimed that this conclusion is strengthened by the analogy of the other bureaus forming parts of the various executive departments of the government, like that, for example, of the general land office, the commissioner of which is by law subject to the supervision of the secretary of the interior, in respect to which it was decided, in *Magwire v. Tyler*, 1 Black, 195, approved and affirmed in *Snyder v. Sickles*, 98 U. S., 203, that the power of supervision and appeal vested in the secretary extends to all matters relating to the general land office, and is co-extensive with the authority of the commissioner to adjudge.

In reference to this argument from the analogy of the general relation of the heads of executive departments to their bureau officers, it may as well be observed, in this connection, that, although not without force, it will be very apt to mislead, unless particular regard is had to the nature of the duties intrusted to the several bureaus, and critical attention is given to the language

of the statutes defining the jurisdiction of the chief and his subordinates, and the special relation of subordination between them respectively; for it will be found, on a careful examination, too extensive and minute to be entered upon here, that the general relation between them of superior and inferior is varied by the most diverse provisions, so that, in respect to some bureaus, the connection with the department seems almost clerical and one of mere obedience to direction, while in that of others the action of the officer, although a subordinate, is entirely independent, and, so far as executive control is concerned, conclusive and irreversible. And in respect to the particular illustration drawn from the relation of the general land office to the department of the interior, the language of the section of the Revised Statutes (section 453) describes the duties of the commissioner, to be performed under the direction of the secretary, as executive duties, while those which relate to the decision of questions of private right under the pre-emption laws, being *quasi-judicial*, are made by section 2273 expressly subject to an appeal, first from the register and receiver to the commissioner, and from him to the secretary. *Lyttle v. Arkansas*, 9 How., 314; *Barnard's Heirs v. Ashley's Heirs*, 18 How., 43. Each case must be governed by its own text, upon a full view of all the statutory provisions intended to express the meaning of the legislature.

To determine that intention of the legislature in reference to the principal question in the present case, it becomes important, in the first place, to obtain a clear idea of the nature and extent of the jurisdiction involved in the claim, that all the official acts of the commissioner of patents are subject to the direction and superintendence of the secretary of the interior.

§ 5987. *It is a maxim of the law, admitting few if any exceptions, that every duty laid upon a public officer, for the benefit of a private person, is enforceable by judicial process.*

If the secretary is charged by law with the performance of such a duty, he is bound to fulfill it. It is imperative, not discretionary. He cannot discharge it, according to the intention of the statute, in a manner either arbitrary or perfunctory. While it may be admitted that, so far as the public alone have an interest in the proper performance by the commissioner of his duties in the administration of his bureau, the secretary might satisfy his duty of direction and superintendence by prescribing general rules of conducting the public business and securing, by general oversight, conformity to them; yet, on the other hand, it must also be admitted, that whenever a private person acquires by law a personal interest in the performance by the commissioner of any act, he thereby also acquires an individual interest in the direction and supervision of the secretary, to correct any error, or supply any omission or defect in its performance, tending to his injury. It is a maxim of the law, admitting few if any exceptions, that every duty laid upon a public officer, for the benefit of a private person, is enforceable by judicial process. So that the secretary would be bound, upon proper application, in every such instance, to inquire into, and, if necessary, redress, the alleged grievance. And hence the official duty of direction and supervision on the part of the secretary implies a correlative right of appeal from the commissioner, in every case of complaint, although no such appeal is expressly given. Such, indeed, is the practical construction put by the secretary himself upon his own powers and duties; for the rules governing appeals to the secretary of the interior in patent cases, made part of the return here, assume the equal right of all parties to the proceeding, whether *ex parte* or otherwise, to obtain his review of the action of

the commissioner, not only in the final judgment, but upon all interlocutory questions material to the matter, to the decision of which exceptions have been duly taken during the progress of the inquiry.

It is further to be observed, in the same connection, that if the power and duty of the secretary, in directing and superintending the performance by the commissioner of his duties, and those of all other subordinates in the bureau, may be exercised in the form of appeal, it may also be exercised in any other mode, in the discretion of the secretary, suitable to the end in view; for, if directing and superintending includes review by appeal after a decision, they may as well embrace dictating, either in advance of action or from time to time, during its course and progress. So that it follows in every case of an application for a patent, or for a reissue, or for an extension, or in cases of an interference, the secretary may direct the matter to be heard before himself, and thereupon further direct what decision shall be rendered in each matter by the commissioner, so as to meet his approval. This right of interposition, at any stage of the proceeding, is explicitly maintained in the opinion of attorney-general of August 20, 1881, which was made the basis for the reversal of the previous practice of the department in this particular, as will appear by the following extract: "From the right and power of the secretary to withhold his signature from the patent, unless he is satisfied of the claimant's title thereto, plainly follows an equal right to direct the commissioner, while the proceedings are pending, to receive an amendment which will open up a line of evidence that may throw light on that title."

We are led, therefore, immediately to inquire whether such a construction of phrases, employed in establishing the organization of the patent office as a bureau in the department of the interior, is justified by a view of the whole legislation *in pari materia*, and consistent with the integrity of the system of the statutes in relation to letters patent for new and useful inventions. The general object of that system is to execute the intention of that clause of the constitution, article I, section VIII, which confers upon congress the power "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

The legislation based on this provision regards the right of property in the inventor as the medium of the public advantage derived from his invention; so that in every grant of the limited monopoly two interests are involved — that of the public, who are the grantors, and that of the patentee. There are thus two parties to every application for a patent, and more, when, as in case of interfering claims or patents, other private interests compete for preference. The questions of fact arising in this field find their answers in every department of physical science, in every branch of mechanical art; the questions of law, necessary to be applied in the settlement of this class of public and private rights, have founded a special branch of technical jurisprudence. The investigation of every claim presented involves the adjudication of disputed questions of fact, upon scientific or legal principles, and is, therefore, essentially judicial in its character, and requires the intelligent judgment of a trained body of skilled officials, expert in the various branches of science and art, learned in the history of invention, and proceeding by fixed rules to systematic conclusions.

Accordingly it is provided in the statutes (R. S., sec. 4893) that on the filing of any application for a patent the commissioner shall cause an examination to be made of the alleged new invention or discovery, and if on examina-

tion it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner, not the secretary, shall issue a patent therefor, although it must be signed by the secretary. The claim is examined in the first instance by a primary examiner assigned to the class to which it belongs; if twice rejected by him, the applicant is entitled (R. S., sec. 4909) to appeal from his decision to that of the board of examiners-in-chief, constituted a tribunal for that purpose; and from their decision, if adverse, he may appeal to the commissioner in person. R. S., sec. 4910.

§ 5988. *Appeal to supreme court of District of Columbia (R. S., sec. 4911).*

If dissatisfied with his decision, the party, except in cases of interference, in respect to which another provision is made, hereafter to be considered, may appeal to the supreme court of the District of Columbia. R. S., sec. 4911. To that appeal the commissioner is a formal party, the court acting only on the evidence adduced before him, and confining its revision to the points set forth in the reasons of appeal. A certificate of its proceedings and decision is to be returned to the commissioner and entered of record in the patent office, and shall govern — so the statute says — the further proceedings in the case, but without precluding, it continues, any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

It is evident that the appeal thus given to the supreme court of the District of Columbia from the decision of the commissioner is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one step in the statutory proceeding under the patent laws whereby that tribunal is interposed in aid of the patent office, though not subject to it. Its adjudication, though not binding upon any who choose by litigation in courts of general jurisdiction to question the validity of any patent thus awarded, is, nevertheless, conclusive upon the patent office itself, for, as the statute declares (R. S., sec. 4914), it “shall govern the further proceedings in the case.” The commissioner cannot question it. He is bound to record and obey it. His failure or refusal to execute it by appropriate action would undoubtedly be corrected and supplied by suitable judicial process. The decree of the court is the final adjudication upon the question of right; everything after that dependent upon it is merely in execution of it; it is no longer matter of discretion, but has become imperative and enforceable. It binds the whole department, the secretary as well as the commissioner, for it has settled the question of title, so that a demand for the signatures necessary to authenticate the formal instrument and evidence of grant may be enforced. It binds the secretary by acting directly upon the commissioner, for it makes the action of the latter final by requiring it to conform to the decree.

Congress has thus provided four tribunals for hearing applications for patents, with three successive appeals, in which the secretary of the interior is not included, giving jurisdiction, in appeals from the commissioner, to a judicial body, independent of the department, as though he were the highest authority on the subject within it. And to say that, under the name of direction and superintendence, the secretary may annul the decision of the supreme court of the District, sitting on appeal from the commissioner, by directing the latter to disregard it, is to construe a statute so as to make one part repeal another, when it is evident both were intended to co-exist without conflict.

The inference is that an appeal is allowed from the decision of the commis-

sioner refusing a patent, not for the purpose of withdrawing that decision from the review of the secretary, under his power to direct and superintend, but because, without that appeal, it was intended that the decision of the commissioner should stand as the final judgment of the patent office, and of the executive department, of which it is a part.

As already stated, the case of interferences is expressly excepted by section 4911 from the appeals allowed to the supreme court of the District. Further provision, covering such and also all other cases in which an application for a patent has been refused, either by the commissioner of patents or by the supreme court of the District, is found in Revised Statutes, section 4915. It is thereby provided that the applicant may have remedy by bill in equity. This means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is not a technical appeal from the patent office, like that authorized in section 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits. Such has been the uniform and correct practice in the circuit courts. *Whipple v. Miner*, 15 Fed. Rep., 117; *Ex parte Squire*, 3 Ban. & A., 133; *Butler v. Shaw*, 21 Fed. Rep., 321. It is provided that the court, having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing, in the patent office, a copy of such adjudication, and otherwise complying with the requirements of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

It thus appears that, as, in cases of other applications for a patent refused by the commissioner, the judgment, on a direct appeal, of the supreme court of the District is substituted for and becomes the decision of the patent office, so here, in cases of interference, where the commissioner has rejected an application for a patent, the decree of the circuit court of the United States governs the action of the commissioner, and requires him, in case the adjudication is in favor of the complainant, to issue the patent as decreed to him. It certainly cannot be successfully claimed that, to a writ of *mandamus* issued out of a court of competent jurisdiction, commanding the commissioner of patents to record and execute the judgment of the supreme court of the District, reversing, on an appeal, his decision refusing a patent in any case other than an interference, or the decree of a circuit court of the United States in any case under section 4915, Revised Statutes, requiring a patent to be issued to the claimant, it would be a sufficient answer that he had been directed by the secretary of the interior not to do so. If not, it must be, and is, because the decision of the commissioner, as originally rendered, or that correction of it required by the judicial proceedings, specified in the two sections of the statutes referred to, is final and conclusive upon the department.

§ 5989. *Section 4918, Revised Statutes, considered.*

This conclusion is strengthened by the provisions of section 4918, Revised Statutes. It is there enacted that, in case a patent is actually, though erroneously, issued, interfering with another, any person interested in any one of

them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative or invalid, in any particular part of the United States, according to the interest of the parties in the patent or the invention patented; of course, without prejudice to the rights of any person, except the parties to the suit, and those deriving title under them, subsequent to the rendition of the judgment.

Thus, every case is fully provided for, both when the commissioner wrongfully refuses to issue a patent, and when, in cases of interference, he erroneously issues one; and that, by means of judicial proceedings, through tribunals distinct from and independent of the patent office, the integrity and force of whose judgments would be annulled, if not regarded as conclusive upon the commissioner, notwithstanding any power of direction and superintendence on the part of the secretary, which is therefore necessarily excluded.

§ 5990. *In all matters in which the action of the commissioner is judicial or quasi-judicial, the fact that no appeal is expressly given to the secretary is conclusive that none is to be implied, and this is equally true whether or not an appeal is allowed to the courts.*

The law gives express appeals from the decision of the commissioner, or, in cases where technical appeals are not given, other modes of review by judicial process. It gives no such appeal from him to the secretary. If it exists, it is admitted it is only by an implication, which discovers an appeal in the power of direction and superintendence. That power does not necessarily, *ex vi termini*, include a technical appeal; and the principle applies that where a special proceeding is expressly ordained for a particular purpose it is presumably exclusive. It is clear that when the appeal is expressly authorized from the commissioner to the court, either directly or by means of an original suit in equity, another appeal to the secretary on the same matter is excluded; and no reason can be assigned for allowing an appeal from the commissioner to the secretary in cases in which he is by law required to exercise his judgment on disputed questions of law and fact, and in which no appeal is allowed to the courts, that would not equally extend it to those in which such appeals are provided, for all are equally embraced in the general authority of direction and superintendence. That includes all or does not extend to any. The true conclusion, therefore, is, that in matters of this description, in which the action of the commissioner is *quasi-judicial*, the fact that no appeal is expressly given to the secretary is conclusive that none is to be implied.

§ 5991. *History of the legislation.*

The conclusion is confirmed by a review of the history of legislation on the point. The first statute on the subject of patents, act of 1790, chapter 7 (1 Stat., 109), authorized their issue by the secretary of state, the secretary for the department of war, and the attorney-general, or any two of them, "if they shall deem the invention or discovery sufficiently useful and important." The act of 1793, chapter 11, which next followed (1 Stat., 318), authorized them to be issued by the secretary of state, upon the certificate of the attorney-general that they are conformable to the act. The ninth section of the statute provided for the case of interfering applications, which were to be submitted to the decision of arbitrators, chosen one by each of the parties and

the third appointed by the secretary of state, the decision or award of two of whom should be final as respects the granting of the patent.

This continued to be the law until the passage of the act of 1836, chapter 357 (5 Stat., 117), creating, in the department of state, the patent office, "the chief officer of which shall be called," it says, "the commissioner of patents," and "whose duty it shall be, under the direction of the secretary of state, to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions and improvements as are herein provided for or shall hereafter be by law directed to be done and performed," etc. By that act it was declared to be the duty of the commissioner to issue a patent if he "shall deem it to be sufficiently useful and important," the very discretion previously vested in the three heads of departments by the act of 1790; and in case of his refusal the applicant was (section 7) secured an appeal from his decision to a board of examiners, to be composed of three disinterested persons, appointed for that purpose by the secretary of state, one of whom, at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertained. The decision of this board being certified to the commissioner, it was declared that "he shall be governed thereby in the further proceedings to be had on such application." A like proceeding, by way of appeal, was provided in cases of interferences. By the sixteenth section of the act a remedy by bill in equity, as now given in sections 4915 and 4918, Revised Statutes, was given as between interfering patents or whenever an application shall have been refused on an adverse decision of a board of examiners. By the eleventh section of the act of 1839, chapter 88 (5 Stat., 354), as modified by the act of 1852, chapter 107 (10 Stat., 75), it was provided that in all cases where an appeal was thus allowed by law from the decision of the commissioner of patents to a board of examiners, the party, instead thereof, should have a right to appeal to the chief justice or to either of the assistant judges of the circuit court of the United States for the District of Columbia; and by section 10 the provisions of the sixteenth section of the act of 1836 were extended to all cases where patents are refused for any reason whatever, either by the commissioner or by the chief justice of the District of Columbia, upon appeals from the decision of the commissioner, as well as where the same shall have been refused on account of or by reason of interference with a previously-existing patent.

In this state of legislation the patent office, by the act of 1849, chapter 108 (9 Stat., 395), was transferred to the department of the interior, the secretary of which, it was enacted, "shall exercise and perform all the acts of supervision and appeal, in regard to the office of commissioner of patents, now exercised by the secretary of state;" which language, so far at least as appeals, strictly so called, are concerned, was without force, as no appeals had ever been given from any decision of the commissioner to the secretary of state, unless that can be called so which, by section 7 of the act of 1836 (5 Stat., 120), was to be determined by a board of examiners, appointed, *pro re nata*, by the secretary of state, and for which, as we have seen, an appeal to the chief justice of the circuit court of the District of Columbia had been substituted by the act of 1839. 5 Stat., 354.

The act of 1861, chapter 88 (12 Stat., 246), created the office of examiners-in-chief "for the purpose of securing greater uniformity of action in the grant

and refusal of letters patent, . . . to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent; and also to revise and determine, in like manner, upon the validity of the decisions of examiners in interference cases, and when required by the commissioner, in applications for the extension of patents, and to perform such other duties as may be assigned to them by the commissioner; that from their decisions appeals may be taken to the commissioner of patents in person, upon payment of the fee hereinafter prescribed; that the said examiners-in-chief shall be governed in their action by the rules to be prescribed by the commissioner of patents."

The act of July 8, 1870 (16 Stat., 198), revised, consolidated and amended the statutes then in force on the subject, and the substance of its provisions, material to the present inquiry, have been carried into the existing revision.

It will be observed that the judgment and discretion, vested by the original patent law of 1790, in a majority of the three executive officers, the secretary of state, the secretary for the department of war and the attorney-general, who were authorized to cause letters patent to issue, "if they shall deem the invention or discovery sufficiently useful and important," was transferred by the act of 1836, section 7, to the commissioner of patents, it being made his duty to issue a patent for the invention, "if he shall deem it sufficiently useful and important;" and is continued in him by section 4893, Revised Statutes, the language being that he shall cause an examination to be made of the alleged new invention, "and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor."

It thus appears, not only that the discretion and judgment of the commissioner, as the head of the patent office, is substituted for that of the head of the department, but, also, that that discretion and judgment are not arbitrary, but are governed by fixed rules of right, according to which the title of the claimant appears from an investigation, for the conduct of which ample and elaborate provision is made; and that his discretion and judgment, exercised upon the material thus provided, are subject to a review by judicial tribunals whose jurisdiction is defined by the same statute. In no event could the direction of the secretary of the interior extend beyond the terms in which it is vested—that is, to the duties to be performed under the law by the commissioner. The supervision of the secretary cannot change those duties nor require them to be performed by another, nor does it authorize him to substitute his discretion and judgment for that of the commissioner, when, by law, the commissioner is required to exercise his own, and when that judgment, unless reversed in the special mode pointed out, by judicial process, is by law the condition on which the right of the claimant is declared to depend. The conclusion cannot be resisted that, to whatever else supervision and direction on the part of the head of the department may extend, in respect to matters purely administrative and executive, they do not extend to a review of the action of the commissioner of patents in those cases in which, by law, he is appointed to exercise his discretion judicially. It is not consistent with the idea of judicial action that it should be subject to the direction of a superior,

in the sense in which that authority is conferred upon the head of an executive department in reference to his subordinates. Such a subjection takes from it the quality of a judicial act. That it was intended that the commissioner of patents, in issuing or withholding patents, in reissues, interferences and extensions, should exercise *quasi-judicial* functions, is apparent from the nature of the examinations and decisions he is required to make, and the modes provided by law, according to which, exclusively, they may be reviewed.

Such has been the uniform construction placed by the department itself upon the laws defining the relation of its executive head to the commissioner of patents. No instance has been cited in which the right of the secretary to reverse such action of the commissioner in granting or withholding a patent has been claimed or exercised prior to that based upon the opinion of Attorney-General McVeagh in 1881. The jurisdiction had been previously expressly disclaimed, in 1876, by Secretary Chandler (9 O. G., 403), and by his immediate successor, Mr. Schurz, in 1877, 1878 and 1879 (12 O. G., 475; 13 O. G., 771; 16 O. G., 220).

§ 5992. *When the commissioner of patents decided that the relators were entitled to a patent, he had fully exercised his judgment and discretion, and the ministerial duty that remained could not be avoided merely out of deference to the claim of the secretary to reverse and set aside the decision; therefore a mandamus was properly directed to the commissioner to compel him to perform his duty, to wit, to prepare the patent, to lay it before the secretary for his signature, and to himself countersign it.*

Some question is made as to the remedy. We think, however, that *mandamus* will lie, and that it was properly directed to the commissioner of patents. He had fully exercised his judgment and discretion when he decided that the relators were entitled to a patent. The duty to prepare it, to lay it before the secretary for his signature, and to countersign it, were all that remained, and they were all purely ministerial. These duties he had failed and refused to perform merely out of deference to the claim of the secretary to reverse and set aside the decision on the merits in favor of the relators. This we have held not to be a valid excuse. The case falls clearly within the principles acted upon in *Commissioner of Patents v. Whiteley*, 4 Wall., 522.

§ 5993. *Remedy by bill in equity under section 4915, Revised Statutes, not appropriate in this instance.*

The remedy by bill in equity under section 4915 is not appropriate, because it applies only when the commissioner decides to reject an application for a patent, on the ground that the applicant is not, on the merits, entitled to it. So that, if, in such a case, a decree for a patent could be considered, *ex proprio vigore*, as equivalent to a patent, or could be enforced by direct process in execution of it, nevertheless, the present is not a case where such a bill would lie.

§ 5994. *It belongs exclusively to the commissioner to decide whether a patent ought to issue.*

It is suggested that the writ was erroneously awarded by the court below, on the ground that the decision of the commissioner of patents, in favor of issuing the patent to the relators, was erroneous in law upon its face. But that question does not arise upon this record. We have adjudged that it belongs exclusively to the commissioner to decide the question for himself, whether a patent ought to issue. The statute points out the remedy for a party aggrieved by his error, if he has decided erroneously. It is not by an appeal to the

secretary; nor can the question be presented in such a proceeding as the present.

The judgment of the supreme court of the District of Columbia is consequently affirmed.

§ 5995. It is the secretary of the interior who issues the patent, and the commissioner of patents is not liable to a suit for refusing to do so. *Whitely v. Fisher*, 4 Fish., 248.

§ 5996. The secretary of the interior advised to decline to answer the question of an intending applicant, made prior to his application, as to whether or not it will be granted. *Black's Opinion*, 9 Op., 95.

See *Commissioner*, § 1096. *Errors*, §§ 2179, 2180. *Mandamus*, § 4127. *Appeal*, §§ 273-279. *Void Patent*, §§ 6727-6729.

326. SECRET INVENTION.

See INVENTION, SECRET.

327. SECRET PATENT.

See FOREIGN PATENTS. PATENT, SECRET.

328. SERVICE OF PROCESS.

See PRACTICE, SERVICE OF PROCESS.

329. SEVERANCE OF TITLE.

See TITLE, SEVERANCE OF.

330. SHERIFF'S SALE.

See SALE, SHERIFF'S.

331. SPECIAL ACT, PATENTS GRANTED BY.

See PATENTS, GRANTED BY SPECIAL ACT.

332. SPECIAL MATTER, STATUTORY NOTICE OF.

See NOTICE, STATUTORY, SPECIAL MATTER.

333. SPECIAL PLEA, STATUTORY PLEA.

See PLEAS, STATUTORY, SPECIAL PLEA.

334. SPECIFIC PERFORMANCE.

See CONTRACTS.

335. SPECIFICATION.

Specification — *Defined*, § 5997. *Is a part of the patent*, §§ 5998-6001; *except where reference is made to state of the art*, § 6002.

§ 5997. The term "specification" as employed in the patent laws has two meanings: When used without the word "claim," it means the description and claim, and when the "claim" is

mentioned in connection therewith it embraces the description alone. The word "specification," as employed in section 4916, means description and claim. *Wilson v. Coon*, 18 Blatch., 532.

§ 5998. The specification required by act 1836, section 6, is a part of the patent. *O'Reilly v. Morse*, 15 How., 62.

§ 5999. The specification forms part of the letters patent. *Hogg v. Emerson*, 6 How., 437.

§ 6000. It is proper to refer in letters patent to drawings and specifications, and these papers constitute a part of the description. *Hogg v. Emerson*, 11 How., 578.

§ 6001. The long uniform practice of filing the specification with the petition, and the treatment of them as part of and reference to them in the letters patent, sustained. *Hogg v. Emerson*, 6 How., 437.

§ 6002. The statement in a specification in reference to the state of the art, and the relation of the invention to it, is not a substantive part of the specification which by reference is embraced in the claim, but is the mere expression of the inventor's opinion. Its insertion in the reissue does not in any way affect or enlarge the claim of the original, considered or applied to it. *Reed v. Chase*, 25 Fed. Rep., 94.

Specification — Sufficient description — *What constitutes*, §§ 6003-6017. *Knowledge of the scientific principle not necessary*, §§ 6018-6021. *Sufficient description of a machine*, § 6022; *of a process*, §§ 6023-6026. *The statute*, § 6027.

§ 6003. Act 1793, section 3, "description," reviewed. *Evans v. Eaton*, 7 Wheat., 356.

§ 6004. A patentee is bound to describe in what his invention consists in such manner that it can be clearly ascertained by fair interpretation what he intends to claim. *Wyeth v. Stone*, 1 Story, 273.

§ 6005. The United States patent law requires such a description of the invention set out in the specification, that one acquainted with the art may not only understand, but may be enabled therefrom to construct the invention. *Wintermute v. Redington*, 1 Fish., 239.

§ 6006. A patentee should describe his invention with reasonable certainty. *Davoll v. Brown*, 1 W. & M., 53.

§ 6007. The meaning of the requirement of a sufficient description is that the specification may be understood by ordinary mechanics, and the thing described be made from the description and drawings. *Mabie v. Haskell*, 2 Cliff., 507.

§ 6008. A description is sufficient if it enables the court to specify the invention patented from the face of the patent and accompanying papers. *Whitney v. Emmett*, 1 Bald., 303.

§ 6009. A description, although less perfect and complete than would be desired, still, if sufficient to enable a skilful mechanic to attain the end, will not render the patent void on its face. *Carver v. Braintree Mfg. Co.*, 2 Story, 432.

§ 6010. If, with the exercise of ordinary intelligence and skill, the jury believe that the invention could be constructed from the information given by the patent, the description would be sufficient. *Judson v. Moore*, 1 Bond, 285.

§ 6011. If the specification contains such a description as will enable one skilled in the art to accomplish the desired result it is sufficient, without attempting to speculate as to the philosophy of its action. *St. Louis Stamping Co. v. Quinby*, 16 O. G., 135.

§ 6012. The description in a patent must be so full and plain that a fairly competent workman in the art could take it, and, exercising the then existing knowledge of the trade, follow it out, and by it, without invention or addition, construct an operative machine containing the parts mentioned in combination. *Webster Loom Co. v. Higgins*, 15 Blatch, 447.

§ 6013. If it requires experiment and invention to make and use the matter described, the patent is invalid. *Ibid.*

§ 6014. In the description of the improvement and directions for constructing the improved machine, it is not necessary to state those matters which it is apparent would be proper or indispensable in its structure. *Wayne v. Holmes*, 1 Bond, 27.

§ 6015. Where it appeared that a person skilled in the art would readily apply the patented apparatus in the best way for the purpose, it was held a sufficient description, although not shown in the patent drawing arranged for the usual work or in the best manner, but only for rare kinds of work. *Vogeley v. Noel*, 18 Fed. Rep., 827.

§ 6016. The specification should be construed as a whole. *Wayne v. Holmes*, 1 Bond, 27.

§ 6017. And if from the entire instrument the true nature of the improvement, with the mode of carrying it out, is disclosed, the description is sufficient. *Ibid.*

See *Composition of Matter*, §§ 1117-1120.

§ 6018. A patent is not invalid because the theory upon which the applicant's machine operates, as set forth in his specification, is erroneous, provided the machine will accomplish that of which it is represented to be capable. *Hamilton v. Ives*, 3 O. G., 30.

§ 6019. The reason which the patentee gives for the operation or use of his device is not conclusive. *Stow v. City of Chicago*, 8 Biss., 47.

§ 6020. Even if the invention fails to describe accurately the precise law which governs the proper relations and proportions of the parts of the patented invention, yet, if the patentee has obtained the practical result and taught others how to accomplish it, he has made a patentable invention, however imperfectly he may understand the philosophy of it. *Pearl v. Ocean Mills*, 11 O. G., 2.

§ 6021. It may be that an inventor does not know the scientific principle of his invention, or that, knowing it, he omitted, from accident or design, to set it forth; but the patent is not thereby vitiated if he sets forth the process or mode of operation which ends in the result and the means for working out the process or mode of operation. *Andrews v. Cross*, 19 Blatch., 294.

§ 6022. What will amount to a sufficient description of a machine. *Parks v. Booth*, 12 Otto, 96.

§ 6023. It is not necessary to describe in the specification a process well known to those skilled in the art. *Mulford v. Pearce*, 13 Blatch., 173.

§ 6024. It is a sufficient description of a process and product to describe the proportions and way of proceeding, and it is not essential to the validity of the patent to state the chemical change, the philosophy of the process. *Cahill v. Beckford*, 1 Holmes, 48.

§ 6025. It is a sufficient description of a process patent, where a fixed rule is given, which may be safely followed, while it is made known that the rule may to some extent be safely departed from. *Tilghman v. Werk*, 1 Bond, 511.

§ 6026. Courts are liberal in construing descriptions in patents where particular degrees of heat are to be employed; but some approximation ought to be indicated by the patentee, and it should not be so wide of the mark as to involve invention or frequent experiment to ascertain the proper temperature. *Flower v. Rayner*, 19 O. G., 425.

See *Process*, §§ 5036-5040, 5054.

§ 6027. The provision of the statute requiring a full and sufficient description is *express*, and it must appear that it has been complied with, or the patent is rendered a nullity. *Judson v. Moore*, 1 Bond, 285.

See *Article of Manufacture*, § 414. *Defenses*, §§ 1835, 1836, 1845-1847.

Specification — What constitutes a sufficient specification, §§ 6028-6039.

§ 6028. Specifications for an invention should be so distinct, intelligible and certain, that others beside the inventor may understand its nature and use. *Lee's Opinion*, 1 Op., 64.

§ 6029. The specifications must be so full and clear as to enable a competent person to make the compound without experiment. *Allen v. Hunter*, 6 McL., 303.

§ 6030. Patents to be valid must be so clear that by ordinary means they can be worked out by a person skilled in the art. *Downton v. Yaeger Milling Co.*, 1 McC., 26.

§ 6031. If the means known at the time of the patent were not sufficient to execute and carry out the invention, but something had to be contrived or invented to make it operative, the patent is void. *Ibid.*

§ 6032. Specifications must contain reasonable certainty, and must so describe the parts of a machine, or of the improvement, as to enable a person skilled in the construction of machines to build one. *Brooks v. Bicknell*, 3 McL., 250.

§ 6033. What degree of certainty is required in the specification stated. *Davis v. Palmer*, 2 Brock., 298.

§ 6034. Reasonable certainty as to what is claimed as new in the specification is sufficient. *Lowell v. Lewis*, 1 Mason, 182.

§ 6035. A specification in letters patent is sufficiently clear and descriptive when expressed in terms intelligible to a person skilled in the art to which the invention belongs. *Webster Loom Co. v. Higgins*, 105 U. S., 580.

§ 6036. It is not incumbent upon patentee to suggest all the possible modes by which his invention can be varied; but it is sufficient to state the modes which he contemplates to be best, and to add that he deems other mere formal variations are protected by his patent. *Carver v. Braintree Mfg. Co.*, 2 Story, 432.

§ 6037. The omission to mention in the specification something which contributes only to the degree of benefit, providing the apparatus would work beneficially and be worth adopting without it, is not fatal, while the omission of what is known to be necessary to the enjoyment of the invention is fatal. *Sewall v. Jones*, 1 Otto, 171.

§ 6038. If from the patent, specification, drawings, model and old machine, clear ideas are conveyed to men of mechanical skill in the subject-matter, by which they could make or direct the making of the machine by following the directions given, the specification is good within the acts of congress. *Whitney v. Emmett*, 1 Bald., 303.

§ 6039. The specification is intended to inform those who are skilled in the art to which it relates, and it is to be such that the process (invention) may be advantageously used by them, and if it be sufficient for their direction it is all the law requires. *Roberts v. Schreiber*, 2 Fed. Rep., 855.

See *Reissue*, §§ 5302-5304.

Specification — Sufficiency of description — *Is for the court*, §§ 6040-6042; *for the jury*, §§ 6043-6045. *How determined*, §§ 6046, 6047. *Construction of*, §§ 6048-6052.

§ 6040. Whether patentee has described the subject-matter or what he claims as his invention, so as to enable the public to know what his claim is, is in general a question of law for the court on the construction of the patent. *Forbes v. Barstow Stove Co.*, 2 Cliff., 379.

§ 6041. It is a question of law upon the construction of the terms of the patent as to whether the invention is described with reasonable certainty. *Lowell v. Lewis*, 1 Mason, 182.

§ 6042. The sufficiency of the specification in law is a question for the court; in fact, for the jury. *Whitney v. Emmett*, 1 Bald., 303.

§ 6043. The sufficiency of the description to enable a mechanic to construct the machine is for the jury to determine. *Emerson v. Hogg*, 2 Blatch., 1.

§ 6044. Whether the description is so particular as to enable a mechanic to construct the machine is a question for the jury. *Brooks v. Jenkins*, 3 McL., 432.

§ 6045. The sufficiency of the description in the specification is a matter of fact for the jury, and not of law. *Evans v. Eaton*, 7 Wheat., 356.

§ 6046. The question as to the sufficiency of the description and specification must be determined, like a question of construction, from what is written, aided by the drawings, and if need be, by the patent office model. *Hawes v. Nute*, 4 Cliff., 173.

§ 6047. To determine the sufficiency of the description of the invention, it is necessary to take the whole specification together. *Judson v. Cope*, 1 Bond, 327.

§ 6048. The description in the specifications of the operation and effect of each separate element or part of a patented combination must be read and construed with reference to the entire combination and its results, and the effect which the operation of each element or part has upon each of the others. *Hamilton v. Ives*, 3 O. G., 30.

§ 6049. A specification is to be interpreted as it is understood by an expert in the art, and includes all known equivalents of the ingredients employed; but such as were not then known and were discovered afterward may be used without infringing the patent. *Woodward v. Morrison*, 1 Holmes, 124.

§ 6050. The construction which ought to be given to the specification should not be too strict and technical. The proper inquiry is, Has the specification substantially complied with that which the public has a right to require; has the appellee communicated to the public the manner of carrying his invention into effect, so that a skilful workman can carry into execution the plan of the invention? *Stephens v. Salisbury*, 1 MacA. Pat. Cases, 379.

§ 6051. The drawing and model filed with an application are to be taken together in explanation of the specification. *Ibid.*

§ 6052. Where an invention was described in one portion of the specification as compounded of the explosive substance nitro-glycerine and an inexplusive porous substance, and in another portion of the specification a more detailed description of the porous substance was given without mentioning its inexplusive character, *held*, that the two passages are to be read together, and that the invention is a compound of nitro-glycerine with an inexplusive porous substance of the character described. *Atlantic Giant Powder Co. v. California Vigorit Powder Co.*, 6 Saw., 508.

Specification — Ambiguous, §§ 6053-6056. *Vague*, §§ 6057, 6058. *Misleading*, § 6059. *Defective*, §§ 6060-6067. *Insufficient description*, §§ 6063-6070.

§ 6053. Uncertainty in the terms of the specification will render a patent void. *Davis v. Palmer*, 2 Brock., 298.

§ 6054. Where the specification is ambiguous the patent is void. *Kneass v. Schuylkill Bank*, 4 Wash., 9.

§ 6055. The patent is not void for ambiguity because the specification merely says that the cutter is to be "hardened" without specifying what degree of hardness is to be given to it. *Monce v. Adams*, 12 Blatch., 1.

§ 6056. Unless the objection to a patent on the ground of vagueness or ambiguity in the specification is very clear and unmistakable, courts are reluctant to declare a patent void on this ground. *Swift v. Whisen*, 2 Bond, 115.

See *Composition of Matter*, §§ 1117, 1118.

§ 6057. *Held*, that where certain apertures, though not especially described in the specification, were nevertheless shown in the drawings, it removed any objection on the ground of vagueness or uncertainty in the description which might be occasioned by not stating their exact size. *Ibid*.

§ 6058. Where a description of the invention in a specification is so defective that those conversant with the art are unable, by following it, to produce the article claimed, the patent is void, as well as where no proportions are given in which the materials which form a compound are to be used, or where they are too vaguely defined. *Jenkins v. Walker*, 1 Holmes, 120.

§ 6059. Where the utility of the patented invention was demonstrated, the fact that the inventor may have, in his specification, overrated the importance of some of the elements of his invention and underrated others, *held*, not to constitute a deceptive and misleading specification. *Fire Extinguisher Case*, 21 Fed. Rep., 40.

§ 6060. A specification is not fatally defective because it does not mention such modifications as practical use would readily suggest in order to render the machine efficient, such as employing a weight or a spring, or changing the dimensions of the parts. *Union Paper Bag Co. v. Nixon*, 4 O. G., 31.

§ 6061. A defect in a specification should be clear and palpable, to justify the court in saying that the patent was a nullity. *Judson v. Moore*, 1 Bond, 285.

§ 6062. An innocently defective specification will not invalidate a patent. (Act 1793.) *Gray v. James*, Pet. C. C., 394 (*aliter*, act 1836).

§ 6063. Specification defective from insufficient description to invalidate patent must be with deceptive intent. *Park v. Little*, 3 Wash., 196; *Whittemore v. Cutter*, 1 Gall., 429.

§ 6064. A description, to invalidate a patent, must be defective, with the intent to defraud the public (act 1793). *Reutgen v. Kanowrs*, 1 Wash., 168.

§ 6065. A specification, materially defective, with intent to deceive the public, will avoid the patent (act 1793). *Lowell v. Lewis*, 1 Mason, 182.

§ 6066. A patent may be valid and operative with respect to what it claims, and still be inoperative from a defective or insufficient description, because it fails to claim as much as was really invented. *Wilson v. Coon*, 18 Blatch., 532.

§ 6067. Under act 1793, section 3, a defective specification is a good bar to an action for infringement. *Grant v. Raymond*, 6 Pet., 218.

§ 6068. The patent being for a process to be effected without any known means of accomplishing the result, but requiring inventive faculty, whereby rolls to accomplish the purposes and their modes of operation were to be determined by new inventions or discoveries, then the patent does not furnish to any one as then skilled in the art means whereby the beneficial end could be accomplished. *Downton v. Yaeger Milling Co.*, 1 McC., 26.

§ 6069. It is not a sufficiently clear specification if some very skilful artisan could make and use the invention, but persons of ordinary skill could not. The person so skilled must be able not only to construct, but to use the invention for a useful purpose. *Lippincott v. Kelly*, 1 West. L. J., 513.

§ 6070. If the invention is not described with reasonable certainty and precision, the patentee can claim nothing under his patent. *Parker v. Stiles*, 5 McL., 44.

Specification — Of an improvement, §§ 6071, 6072. *Distinguishing old parts from new*, §§ 6073-6083.

§ 6071. Section 3, act 1793, sufficient description of an improvement, reviewed. *Evans v. Hettick*, 3 Wash., 408.

§ 6072. It is the duty of the patentee, under Revised Statutes, section 4888, to point out in his specification the improvement which he claims to be his invention, and the patent must be taken as it reads in the light of common knowledge, until it is shown to cover more by those who claim it does cover more. *McCloskey v. Du Bois*, 19 Blatch., 205; 20 O. G., 371.

§ 6073. Patentee must describe in full and exact terms in what his invention consists. If for an improvement only, he should distinguish the new from the old in his specification. *Lowell v. Lewis*, 1 Mason, 182.

§ 6074. In describing an improvement of a well known machine, it is necessary only to describe the improvement, and not the entire machine. *Brooks v. Bicknell*, 3 McL., 250.

§ 6075. Although, under act 1837, a patent is not void when patentee claims more than he has invented, yet the specification must state in what the improvement consists. *Peterson v. Wooden*, 3 McL., 248.

§ 6076. The law does not require the specification to set forth the old machinery with which the new invention is to be connected. *Emerson v. Hogg*, 2 Blatch., 1.

§ 6077. Where an invention is claimed as an improvement on an old machine, it is properly

taken for granted that a practical mechanic is acquainted with the construction of the machine upon which the improvement is made. *Ives v. Hamilton*, 2 Otto, 426.

§ 6078. Patentee need not describe and disclaim all the old parts, when he particularly describes the parts he claims as inventions. *Hogg v. Emerson*, 6 How., 437.

§ 6079. Applicant need not state what parts of his invention are new and what old; he need only point out what he claims as his invention; this will be considered as claimed by him as new and the rest as old. *Corn-Planter Patent*, 23 Wall., 181.

§ 6080. A reference in general terms to the old instrument on which the patented improvement was made as "a cast-iron spoke wheel," held sufficient to enable a person skilled in the art to distinguish the old device from the improvement. *Many v. Jagger*, 1 Blatch., 372.

§ 6081. It is essential to the validity of a patent that the particular invention be pointed out and distinguished from what is old, and when the invention consists merely of a new combination of old elements or devices, where nothing is or can be claimed except the new combination, it is sufficiently described to constitute a compliance with the letter and spirit of the law if the devices of which it is composed are specifically named, their mode of operation given, and the new and useful result to be accomplished is pointed out, so that those skilled in the art and the public may know the extent and nature of the claim and what the parts are which co-operate to do the work. *Parks v. Booth*, 12 Otto, 96.

§ 6082. When a patent is obtained for parts of a machine involved with other parts which may have been used before, it is essential that the new parts should be so distinctly pointed out that the claim may not cover any old parts. *Blake v. Sperry*, 2 N. Y. Leg. Obs., 251.

§ 6083. It is sufficient for the purpose of distinguishing old parts from new in the specification and claims of a patent to describe each and all of the parts, and claim the mechanism as a whole, so constructed and operated as to produce the result set forth. *Gottfried v. Phillip Best Brewing Co.*, 17 O. G., 675.

See *Improvement*, §§ 2785-2796.

Specification — Generally — *The best method must be shown*, §§ 6084-6086. *The specification controls the grant*, §§ 6087, 6088. *Notice of defense of insufficient specification*, § 6089. 6090. *Enlargement of specification*, § 6090. *Definite description*, § 6091. See *Claims, Construction of*, §§ 743-759. *Drawings*, §§ 2066-2095. *Oyer*, § 4488. *Priority of Invention*, § 5002.

§ 6084. The patentee is bound to disclose in his specifications the best method of making his machine known to him at the time of his application. *Page v. Ferry*, 1 Fish., 298.

§ 6085. Failure to describe the best means for making a patented device will not avoid a patent, unless done with fraudulent intent. *Magic Ruffle Co. v. Douglass*, 2 Fish., 330.

§ 6086. A patentee is not obliged to state everything to which his invention is applicable in order to be protected in his exclusive right to everything to which it is applicable. *Pike v. Potter*, 3 Fish., 55.

§ 6087. Specification controls the grant. *Whittemore v. Cutter*, 1 Gall., 429.

§ 6088. The specification should maintain the patent; the latter should not indicate one thing, and the former describe another, as the subject of the grant. *Sullivan v. Redfield*, 1 Paine, 441.

§ 6089. An objection to the validity of a patent because of an insufficient specification, raised in argument, but not set up as a defense in the answer, cannot be considered. *Rubber Co. v. Goodyear*, 2 Fish., 509; 9 Wall., 793; *Wonson v. Peterson*, 13 O. G., 548.

§ 6090. The law does not permit enlargements of an original specification any more than it does in the case of reissues of patents already granted. It regards with jealousy and disfavor any attempt to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration or improvements which have gone into public use. *Railway Co. v. Sayles*, 7 Otto, 554.

§ 6091. The act of 1837 and the present statutes carefully limit the right of a party in an action to such material and substantial parts of the thing patented as could be definitely distinguished from the parts claimed without right; and where the reissue claims which might cover the infringement were so blended with other parts that they could not be distinguished therefrom, the bill was dismissed. *American Diamond Rock-Boring Co. v. Sheldon*, 33 O. G., 1598.

336. SPECIFICATIONS AND PATENTS, COPIES OF.

See COPIES, OF SPECIFICATIONS AND PATENTS.

337. STATE OF THE ART.

See CLAIMS, CONSTRUCTION IN VIEW OF STATE OF ART

State of the art—*Who chargeable with knowledge of*, §§ 6092-6094. *Evidence of*, §§ 6095-6102; *admissible without notice*, §§ 6103-6107. See *Claims, Construction of*, §§ 769-774. *Construction of Patents*, §§ 1208-1212. *Experts*, §§ 2429, 2430. *Patents*, §§ 4742, 4743. *Reissues*, §§ 5419-5421. *Specification*, § 6002.

§ 6092. Every patentee is chargeable with knowledge of prior patents. *Odiorne v. Winkley*, 2 Gall., 50.

§ 6093. Patentees have, in their description, a right to assume that those who desire to understand all the conditions under which their invention could be operated are acquainted with the preceding state of the art immediately relating thereto. *Tompkins v. Gage*, 5 Blatch., 268.

§ 6094. An intelligent mechanic is chargeable with the state of the art in relation to the subject upon which he is called to exercise his skill. *Treadwell v. Parrott*, 5 Blatch., 396.

See *Inventor*, § 3788. *Publication*, § 5170.

§ 6095. Proof of the state of the art is admissible in equity cases without any averment in the answer touching the subject, and in actions at law, without giving the notice required, when evidence is offered to invalidate a patent. It consists of proof of what was old and in general use at the time of the alleged invention, and may be admitted to show what was then old, or to distinguish what is new, or to aid the court in the construction of the patent. *Dunbar v. Myers*, 4 Otto, 187.

§ 6096. Evidence of the state of the art showing the prior existence of analogous devices for substantially the same purpose, but not fully exhibiting the device patented, operates to narrow the field for the exercise of inventive faculty and limit the range of the patents. *Washburn & Moen Manufacturing Co. v. Haish*, 10 Biss., 65.

§ 6097. The fact that evidence clearly admissible as showing the state of the art at the date of the invention was not objected to is no waiver of the right to have it restricted to the purpose for which it was admissible. *Zane v. Loffe*, 2 Fed. Rep., 229.

§ 6098. Evidence is admissible to show the meaning of terms used in a patent, as well as the state of the art, for the purpose of enabling the court or jury to understand it. *Webster Loom Company v. Higgins*, 105 U. S., 580.

§ 6099. Evidence to prove the state of the art is admissible, and expert testimony to aid in expounding and defining technical words and phrases may be received in the construction of letters patent. *Goodyear Dental Vulcanite Co. v. Gardiner*, 3 Cliff., 408.

§ 6100. Testimony of witnesses examined in a case as to alleged prior use by parties, not set up in the answer, can only be considered by the court for the purpose of showing the state of the art at the time of patentee's invention. The same rule would apply to printed publications by which it is sought to anticipate the invention. *Geir v. Goetinger*, 7 O. G., 563.

§ 6101. The testimony of witnesses of whose names no notice was given to the complainants is admissible to show the state of the art, but will receive no consideration upon the question whether there had been a prior knowledge and use of the invention. *La Baw v. Hawkins*, 6 O. G., 724.

§ 6102. Matter introduced to show the state of the art in construing the patent cannot be permitted to defeat the suit by antedating the invention, when that issue is not raised by the pleadings. *Middletown Tool Co. v. Judd*, 3 Fish., 141.

§ 6103. No notice is necessary in order to introduce evidence relative to the state of the art. *Vance v. Campbell*, 1 Black, 427.

§ 6104. A patent not admissible in evidence on the question of novelty (anticipation), because of no allegation to that effect in the answer, may be properly in evidence to show the state of the art and to restrict the claim. *Delong v. Bickford*, 22 O. G., 2242.

§ 6105. It seems a patent not set up in the answer may be introduced to show the state of the art. *American Saddle Co. v. Hogg*, 1 Holmes, 133.

§ 6106. Though the court in construing the patent may hear evidence of the state of the art at the date of the alleged invention, such evidence, in the absence of notice, cannot be admitted on the question of novelty. *Railroad Co. v. Dubois*, 10 Wall., 47.

§ 6107. Although prior use or knowledge of the invention claimed in a reissue is not specifically set up in the answer as a defense, it is nevertheless admissible to consult the evidence on that point contained in the record for the purpose of defining the limits of the original grant and the scope of the invention described in the specification. *Eachus v. Broomall*, 115 U. S., 429; 33 O. G., 1265.

See *Use, Double*, § 6355.

338. STATE JURISDICTION.

See JURISDICTION, STATE.

339. STATE STATUTES.

See STATUTES, STATE.

340. STATUTES.

See ASSIGNMENTS, CONSTRUCTION OF STATUTES. USE, KNOWLEDGE AND, PRIOR TO APPLICATION, CONSTRUCTION OF STATUTES. USE, PRIOR PUBLIC, CONSTRUCTION OF STATUTES. REISSUES, CONSTRUCTION OF STATUTES.

Statutes — Construction of — *Constitutional provisions*, §§ 6108-6110.

§ 6108. The seventh amendment to the constitution is a provision exclusively for suits at common law. *Motte v. Bennett*, 2 Fish., 642.

§ 6109. *Semble*, that under section 8, article 1 of the constitution, congress may secure to an inventor the exclusive right to his invention for a limited period, beginning at any time after the invention was made, and after it became publicly known. *Jordan v. Dobson*, 2 Abb., 398.

§ 6110. The language of the constitution confers upon congress the power of "securing" "to inventors the exclusive right to their discoveries." It is not empowered to grant to inventors a favor, but to secure to them a right; and the term "to secure a right" by no possible implication carries with it the opposite power of destroying the right, in whole or in part, by appropriating it to the purposes of the government without complying with that other condition of the constitution, the making of "just compensation." *McKeever v. United States*, 14 Ct. Cl., 396.

See *Contracts, Violation of*, § 1352. *Government*, §§ 2627, 2628.

Statutes — Construction of — *Patent acts generally*, §§ 6111-6114.

§ 6111. The patent acts should be construed in the spirit in which they are made. *Grant v. Raymond*, 6 Pet., 218.

§ 6112. In a general act, congress cannot be presumed to decide who is the inventor, without words rendering such construction unavoidable. *Evans v. Eaton*, 3 Wheat., 454.

§ 6113. The purposes of the patent law and of the constitutional provision are answered when the patentee is protected against competition in the use of his invention by others; and when the law prevents others from infringing on his exclusive right to make, use or sell, its object is accomplished. *In re Brosnahan*, 4 Dill., 1.

§ 6114. The statute permitting a disclaimer by patentee is not penal, but remedial. *O'Reilly v. Morse*, 15 How., 62.

Statutes — Construction of — *Act 1793*, §§ 6115-6117. *Act 1800*, §§ 6118, 6119. *Act 1836*, § 6120. *Revised Statutes*, §§ 6121-6125.

§ 6115. Act of 1793, sections 3, 4 and 6, construed. *Whittemore v. Cutter*, 1 Gall., 429.

§ 6116. Act 1793, section 10, construed. *Stearns v. Barrett*, 1 Mason, 153.

§ 6117. Act 1793, chapter 11, reviewed. *Evans v. Eaton*, 7 Wheat., 356.

§ 6118. Act of 1800, section 3, reviewed. *Evans v. Jordan*, 1 Brock., 248.

§ 6119. Act of 1800, chapter 25, construed. *Sawin v. Guild*, 1 Gall., 484; *Whittemore v. Cutter*, 1 Gall., 429.

§ 6120. Section 14, act 1836, is exclusively for actions at law for damages. *Motte v. Bennett*, 2 Fish., 642.

§ 6121. The words "officers of the revenue" in section 989 of the Revised Statutes mean officers of the revenue from customs, and cannot be construed to include postmasters. *Campbell v. James*, 18 Blatch., 196.

§ 6122. Where, therefore, a judgment has been rendered against a postmaster for the infringement of a patented postage-stamp marking and canceling device, and execution has been awarded against him personally, a certificate for his relief, under section 989 of the Revised Statutes, will not be granted. *Ibid.*

§ 6123. Where an act of congress depriving the chief clerk of authority to act as commissioner of patents was signed by the president and indorsed "approved July 23, 1868," and the following day was received at the state department at 4 o'clock; and later on the same day the

chief clerk as commissioner granted the extension of a patent, *held*, that the date of the chief clerk's decision was July 24; and that in view of the act of congress his action was void. *American Wood Paper Co. v. Glen Falls Paper Co.*, 8 Blatch., 518.

§ 6124. The clear purport of the provisions of the Revised Statutes relative to suits for infringement of patents is that such suits must be brought in the name of the real and beneficial party in interest. *Goldsmith v. American Paper Collar Co.*, 18 Blatch., 82.

§ 6125. Where the meaning of the Revised Statutes is plain, the court cannot recur to the original statutes to see if errors were committed in revising them; but it may do so when necessary to construe doubtful language used in the revision. *Cannan v. Pound Mfg. Co.*, 23 Fed. Rep., 185.

Statutes — Special acts — *Reviewed*, §§ 6126-6130. *Construed*, §§ 6131-6139.

§ 6126. Special acts, extending or renewing particular patents, reviewed. *Day v. Union Rubber Co.*, 3 Blatch., 488.

§ 6127. An act of congress is not unconstitutional because it was retrospective in granting a patent. *Blanchard v. Sprague*, 3 Sumn., 535; S. C., 2 Story, 165.

§ 6128. An act authorizing the extension of a patent, passed after the original patent has expired, is valid. *Jordan v. Dobson*, 2 Abb., 398.

§ 6129. Where, in an act of congress renewing a patent, there was error both as to the words and date in the descriptive words of the subject-matter of the patent, *held*, that these variances were fatal and could not be corrected by the court so as to give validity to the letters patent. *Blanchard v. Sprague*, 3 Sumn., 279.

§ 6130. An act of congress, after the expiration of the patent, granting an extended term, is considered as engrafted on the general laws and they must be construed together. *Jordan v. Dobson*, 2 Abb., 398.

§ 6131. Where, under a special act, the court is directed to ascertain, *first*, whether patentee was the original inventor; *secondly*, to determine the amount of compensation, *held*, that congress by such act waived the special defense that patentee was its servant, paid extra and detailed for the purpose and experimenting at its expense; and also other special defenses, as abandonment; and that the finding of the first question in the affirmative is conclusive as to patentee's right to compensation. *Dahlgreen's Case*, 16 Ct. Cl., 30.

§ 6132. Special act for the relief of Evans construed. *Evans v. Eaton*, 3 Wheat., 454.

§ 6133. Special act January 21, 1808, relief of Evans, construed. *Evans v. Weiss*, 2 Wash., 342.

§ 6134. Special act of 1808, for the relief of Evans, construed not to relieve from treble damages those who erected machines in the *interim* between the expiration of the original patent and the act, and continued their use subsequent thereto. *Evans v. Jordan*, 9 Cr., 199.

§ 6135. Where a patent is granted by private act, a user of the invention prior to the grant is liable only from the time he receives notice of the law. *Evans v. Weiss*, 2 Wash., 342; *Evans v. Jordan*, 1 Brock., 248. See *Id.*, 9 Cranch., 199.

§ 6136. Special act 1839, granting Blanchard's patent, does not give damages for breaches prior to grant. *Blanchard v. Sprague*, 3 Sumn., 535; S. C., 2 Story, 165.

§ 6137. The special act of congress passed in 1868 for the benefit of the inventor Page did in effect relieve him from any charge of constructive abandonment growing out of his published description, or from the public use of his invention prior to application for patent, or from his withdrawal of the application upon rejection. Page being the first inventor, congress had full power to exempt him from the operation of the general statutory rule working a forfeiture of right. *Page v. Holmes Burglar Alarm Telegraph Co.*, 17 Blatch., 484.

§ 6138. The proviso of the special act by which apparatus in existence at date of patent grant and involving the invention might be used and sold without liability to patentee, fully protects and preserves all that was property in the constitutional sense at that date. *Ibid.*

§ 6139. Where all rights to apply for and obtain letters patent under the general acts have lapsed by reason of failure to prosecute the application, and a special act has removed the disabilities of a particular class of persons — to wit, the heirs of the inventor — in the way of applying for and obtaining a patent, and at the same time expressly saves to owners of machines the right to the continued use of such machines during the life-time of the patent, *held*, that the rights of those claiming under the original inventor by assignment are not thereby revived. *Fire Extinguishing Mfg. Co. v. Graham*, 16 Fed. Rep., 543.

Statutes — Of limitation, §§ 6140-6150.

§ 6140. The right to plead the statute of limitations does not depend upon the discretion of the court; but a court having the right to prescribe rules for the regulation of its business, any

one excepting to the decision of the court must embody in a bill of exceptions the rule affecting the question, in order to obtain the judicial notice of the supreme court. *Steam Packet Co. v. Sickles*, 19 Wall., 611.

§ 6141. Under act of 1870, where the party sues for any infringement under the original term of the patent, he must bring his suit within six years after the expiration of that term; and when he sues for anything that occurred under the extended term, he must sue within six years after the expiration of that extension. *Sayles v. Chicago, Burlington & Quincy R. R.*, 9 Fed. Rep., 515.

§ 6142. Statute of 1870 bars any claim to damages, unless brought during the term for which they shall be granted or extended, or six years after the expiration thereof. *Sayles v. Dubuque & Sioux City R. Co.*, 5 Dill., 561.

§ 6143. Under act 1870, section 56, the limitation of six years for bringing suit for infringement runs from the original term and extended term of a patent as distinct terms. *Sayles v. Louisville City R. Co.*, 9 Fed. Rep., 512.

§ 6144. The limitation contained in section 55, act 1870, regarding the bringing of infringement suits, was repealed by operation of section 5596, Revised Statutes, except as to causes of action arising prior thereto. *Sayles v. Oregon Central R'y Co.*, 6 Saw., 31.

§ 6145. Where a patent has been granted for fourteen years and extended for seven years, a suit may be brought against an infringer for profits that accrued at any time during the twenty-one years, if brought within six years after the extended patent expires. *Sayles v. Richmond, Fredericksburg & Potomac R. Co.*, 3 Hughes, 172.

§ 6146. Acts of limitation will be construed prospectively only, unless a contrary intention clearly appears. *Vaughn v. East Tennessee, Virginia & Georgia R. Co.*, 1 Flip., 621.

§ 6147. Notwithstanding the repeal of the limitation clause in section 55 of the act of 1870, an action will lie upon a patent expiring before the adoption of the Revised Statutes, if brought within six years after the expiration of the patent. *Ibid.*

§ 6148. Section 5597, Revised Statutes, reserving existing causes of action, so far as limitations are concerned, precisely as though no repeal had been made, *held* to refer to and construed in view of section 55, act 1870, limitations in causes of patent actions, which was repealed by omission from the Revised Statutes. *Hayden v. Oriental Mills*, 22 Fed. Rep., 103.

§ 6149. Where, on suit brought to recover for infringement, more than six years subsequent to termination of original term, *held*, that under the statute of limitations (act 1870, section 56) recovery for extended term only could be had. *Sayles v. Louisville City R. Co.*, 9 Fed. Rep., 512.

§ 6150. Suit for infringement must be brought within six years after expiration of the original term of the patent to cover such term; suit brought within six years after extended term covers such extension only. *Hayden v. Oriental Mills*, 22 Fed. Rep., 103.

Statutes — State statutes of limitation — Cannot apply in United States courts in actions concerning patents, §§ 6151-6163.

§ 6151. *Quere*: Whether the state statute of limitations is applicable to a suit in equity, brought after the expiration of the extension of a patent, to compel an infringer to account for profits. *Stevens v. Kansas Pacific R'y Co.*, 5 Dill., 487.

§ 6152. State statutes cannot limit the time within which action for infringement may be brought in United States courts. In the absence of congressional legislation on the subject, there is no limit to the time for bringing such actions. *Collins v. Peebles*, 2 Fish., 541; *Parker v. Hallock*, 2 Fish., 543.

§ 6153. In the absence of a United States statute of limitations as to suits on patents, a state statute does not apply. *Sayles v. Chicago, Burlington & Quincy R. R.*, 9 Fed. Rep., 515.

§ 6154. State statutes of limitation cannot limit the accountability of infringers. Statutory rights cognizable only by the federal courts can be affected only by laws of congress. *Wetherill v. New Jersey Zinc Co.*, 1 B. & A., 485.

§ 6155. Although in ordinary actions at common law, brought in United States courts, the statutes of limitation of the state where the suit is brought may be pleaded in bar, under the provisions of the judiciary act, such pleadings will not apply to an action for the infringement of a patent, where the right of action is exclusively under the constitution and laws of the United States, and when the form of the remedy is prescribed by the acts of congress, and when the circuit courts of the United States are clothed by statute with exclusive jurisdiction over the whole subject-matter. *Anthony v. Carroll*, 9 O. G., 199.

§ 6156. Should the legislature of a state pass an act in express terms limiting the time for bringing an action in the federal courts for the infringement of patent rights, there can be no reasonable doubt that such a statute would be unconstitutional and void. *Ibid.*

§ 6157. Where congress has by statute of limitation fixed the date in patent cases, whereof

the federal government has exclusive jurisdiction, a state statute cannot be pleaded. *Hayward v. City of St. Louis*, 3 McC., 614.

§ 6158. *Semble*, that the state statute of limitations has no application to suits in respect of the rights granted by letters patent. *Sayles v. Dubuque & Sioux City R. Co.*, 5 Dill., 561.

§ 6159. State statutes of limitation do not apply in suits at law for the infringement of patents. The question, however, considered so doubtful that the court indicated a course by which it might be submitted more speedily to the appellate court. *Adams v. Bellair Stamping Co.*, 25 Fed. Rep., 270.

§ 6160. States cannot pass limitation statutes in respect to suits concerning patents. *Reed v. Miller*, 2 Biss., 12.

§ 6161. A plea setting up the statute of limitations of the state of New York is a good plea in bar to an action for infringement brought in the circuit court of the northern district of New York, congress having prescribed no limitation. *Rich v. Ricketts*, 7 Blatch., 230.

§ 6162. State statutes of limitation are applicable to actions at law for the infringement of a patent. *Hayden v. Oriental Mills*, 24 O. G., 601.

§ 6163. In ordinary actions at law in the United States courts, the statutes of limitation of the state where the suit is brought may be pleaded under section 34 of the judiciary act. *Reed v. Miller*, 2 Biss., 12.

Statutes—State statutes, §§ 6164-6176.

§ 6164. A state has no power to pass laws prohibiting the free sale and use of patented articles, or annexing conditions to the grants of property in inventions, which have been made by congress. *Ex parte Robinson*, 2 Biss., 309.

§ 6165. The right conferred by the patent laws of the United States to inventors, to sell their inventions and discoveries, does not take the tangible property in which the invention or discovery may be exhibited or carried into effect from the operation of the tax and license laws of the state. *Webber v. Virginia*, 103 U. S., 344.

§ 6166. Patented articles are subject to the police jurisdiction of the states, and cannot be sold in such states as may by law forbid their use or sale. *Patterson v. Kentucky*, 7 Otto, 501.

§ 6167. A patent can only be used so far as tolerated by state law. *Ibid.*

§ 6168. Where a licensee was prevented by the terms of his license from establishing telephonic communication between certain parties, *held*, that the right to establish such system under the patent was none the less subject to the laws which control commercial transactions, and as such subject to the control of the state law, and of the courts, and that the licensee was compelled, on tender of equal payment for the privilege, to establish such communication, despite the terms of his license. (Brewer, J.) *State of Missouri v. Bell Telephone Co.*, 23 Fed. Rep., 539.

§ 6169. The licensee stands on a contract, and the courts cannot cause him to violate it. (Treat, J.) *Ibid.*

§ 6170. A tax upon the manufacturers of another state, while those of the state itself are free from such taxation, is invalid, since it discriminates against the rights of the non-resident manufacturer, and violates the constitutional provision vesting all commercial control in the federal government. *Webber v. Virginia*, 103 U. S., 344.

§ 6171. A statute of Indiana requiring that any person who may take any obligation in writing for which any patent-rights, or rights claimed by him to be a patent-right, shall form the whole or any part of the consideration, shall, before it is signed by the maker, insert in the body of said written obligation, above the signature of the maker, the words "given for a patent-right," *held* unconstitutional. *Castle v. Hutchinson*, 25 Fed. Rep., 394.

§ 6172. A statute of Missouri punishing by fine and imprisonment the manufacture and sale of oleomargarine is not in violation of the provision of the constitution which secures to inventors the monopoly in their inventions; and where the prisoner manufactured under such a patent in violation of the state law, the state law was sustained. *In re Brosnahan*, 4 Dill., 1.

§ 6173. Act of state of New York of March 27, 1862, *held* to be without effect to relieve the corporation of the city of Brooklyn from liability to pay complainant for the use of his patent. *Bliss v. City of Brooklyn*, 8 Blatch., 533.

§ 6174. The laws of New York prohibit the suspension of the powers of alienation of both real and personal property by any limitation or condition whatever for a longer period than during the continuance and until the termination of not more than two lives in being. *Ladd v. Mills*, 20 Fed. Rep., 792.

§ 6175. The laws of New York free married women from disability to make an assignment by an instrument in writing, and make their property distinctively their own. Where a married woman by her sole deed assigns an interest in a patent, the assignment is valid, and she may join with such assignee in an action involving their joint rights. *Fetter v. Newhall*, 17 Fed. Rep., 841.

§ 6176. The Ohio statute of May 4, 1869, providing that a note given for a patent-right shall have such words printed upon its face, and be subject in the hands of any purchaser or holder to the same defenses as in the hands of the original holder, is unconstitutional, as an interference with the patent monopoly granted by the United States. *Woolen v. Banker*, 2 Flip., 34.

See *Assignment*, §§ 419, 474, 526. *Executor*, § 2369. *Guardians*, § 2655. *Injunction, Provisional*, § 3229.

Statutes — Foreign, §§ 6177-6179.

§ 6177. The construction of a foreign statute put upon it by its own courts is the proper construction for the courts of this country. *Bate Refrigerator Co. v. Gillette*, 20 Fed. Rep., 192.

§ 6178. Difference between the patent laws of England and the United States. *Hogg v. Emerson*, 6 How., 437; *Mellus v. Silsbee*, 4 Mason, 108.

§ 6179. Congress have declared the intention of the law to be to promote the progress of useful arts by the benefits granted to inventors; not by those accruing to the public after the patent has expired, as in England. *Whitney v. Emmett*, 1 Bald., 303.

Statutes — Construction of generally — *Ex post facto* laws, §§ 6180, 6181. Penal statutes, §§ 6182, 6183. Rules of construction generally, §§ 6184-6189.

§ 6180. An act prescribing conditions as to future use is not *ex post facto*. *Evans v. Jordan*, 1 Brock., 248.

§ 6181. *Ex post facto* law defined. *Evans v. Robinson*, 1 Car. L. R. (N. C.), 209.

§ 6182. Rules for construing penal statutes. *French v. Foley*, 11 Fed. Rep., 801.

§ 6183. The thirty-second section of the crimes act of April 30, 1790, limiting suits for penalties for two years after the fine or forfeiture incurred, is repealed by act February 28, 1839, section 4. *Stimpson v. Pond*, 2 Curt., 502.

§ 6184. An act of congress should be so construed as to be held constitutional and not retrospective, unless absolutely necessary. *Blanchard v. Sprague*, 3 Sumn., 535; S. C., 2 Story, 165.

§ 6185. Rule of construction of statutes, in cases of obscure and doubtful phraseology, stated. *Wilson v. Rousseau*, 4 How., 646.

§ 6186. In the construction of statutes *in pari materia* they are all to be kept alike in view, and construed in the light of each other, and their effect considered under such construction. *United States ex rel. Koechlin v. Marble*, 22 O. G., 1365.

§ 6187. In the construction of statutes every part of the act and acts *in pari materia* are to be taken together for the purpose of discovering the intention of the legislature, which, when ascertained, is to prevail. *Prentiss v. Ellsworth*, 27 O. G., 623.

§ 6188. The construction of a statute which has been adopted for many years by the officers intrusted with its execution is entitled to great consideration. *Gear v. Grosvenor*, 1 Holmes, 215.

§ 6189. Questions raised as to when an act of congress signed by the president takes effect. *American Wood Paper Co. v. Glen's Falls Paper Co.*, 8 Blatch., 513.

341. STATUTORY ABANDONMENT.

See ABANDONMENT, UNDER THE STATUTE.

342. STATUTORY NOTICE.

See NOTICE, STATUTORY.

343. STATUTORY PLEAS.

See PLEAS, STATUTORY.

344. STAY OF INJUNCTION.

See INJUNCTION, STAY OF.

345. SUBSTANTIALLY AS DESCRIBED.

See CLAIMS, §§ 711-806.

§ 6190. "Substantial" signifies that the substance of the thing is looked to rather than the form. *Brooks v. Jenkins*, 3 McL., 432.

§ 6191. "Substantially in the manner herein described," construed in reference to its meaning, limitation and specification. *Hovey v. Stevens*, 3 W. & M., 17.

§ 6192. The words "in the manner described," in a claim, signify *in the manner previously described in his patent*. *McCormick v. Seymour*, 3 Blatch., 209.

§ 6193. The words "substantially as described and shown," in a claim, construed to relate only to material features of the combination specified, and these are to be ascertained by considering the object or purpose of the machine, and what are the elements of the combination which create its distinctive character, and are effective in producing the peculiar result for which the contrivance is made. *Waterbury Brass Co. v. Miller*, 9 Blatch., 77.

§ 6194. The words "substantially as set forth" limit and define the claim by reference to the specification. *Detmold v. Reeves*, 1 Fish., 127.

§ 6195. "Substantially as described," in a claim for an article of manufacture, construed in view of the specification to signify made by a particular process. *Rogers v. Sargent*, 7 Blatch., 507.

§ 6196. The words in a claim, "the equivalent therefor," embrace colorable alterations merely, and cannot be construed to apply to any improvements which are not substantially the same as those described and involve the same principle. *McCormick v. Manny*, 6 McL., 539.

§ 6197. The effect of the words "substantially as described," used in a claim, is to refer to the specification for the description of the elements of the combination which is wanting in the claim. *Knox v. Murtha*, 9 Blatch., 205.

§ 6198. Full effect must be given to the words "substantially as set forth" in a claim. *Piper v. Moon*, 10 Blatch., 264.

§ 6199. The words "substantially as described," appended to certain broad reissue claims, held to limit them to the original so that they could be sustained. *Seymour v. Osborn*, 3 Fish., 555.

§ 6200. The words "substantially as and for the purpose set forth," in a claim, refer it back to the specification for a qualification of the claim and the several elements of which the combination is composed. *Corn-Planter Patent*, 23 Wall., 181.

§ 6201. The words "substantially as described" in the specification and claims must necessarily be implied, and involve a reference to the specification and drawing, to prevent any misunderstanding of the scope and meaning of the claims. *Westinghouse v. Gardner & Ranson Air Brake Co.*, 9 O. G., 538.

§ 6202. Words "substantially as specified," appended to a combination claim, held to mean "substantially as specified in regard to the combination which is the subject of the claim." *Lake Shore & Mich. Southern R'y Co. v. National Car-Brake Shoe Co.*, 110 U. S., 229.

See *Combination*, § 871. *Reissues*, § 5313.

346. SUBSTITUTION OF AN EQUIVALENT.

See COMBINATION, INFRINGEMENT OF, BY SUBSTITUTION OF AN EQUIVALENT. COMPOSITION OF MATTER, §§ 1117-1145. DEFENSES, §§ 1818, 1849. FORMAL CHANGE, § 2526. INFRINGER, § 2999. INVENTION, §§ 3527-3529, 3630.

§ 6203. Substitution of a mechanical equivalent in the construction of a machine is not a substantial change. *Tatham v. Le Roy*, 2 Blatch., 474.

§ 6204. Substitution of an equivalent not involving invention will not avoid infringement. *Gibson v. Harris*, 1 Blatch., 167.

§ 6205. The substitution of a mechanical equivalent to produce the same result is an infringement. *Foss v. Herbert*, 1 Biss., 121.

§ 6206. Substitution of mechanical equivalent will not avoid infringement. *Tompkins v. Gage*, 5 Blatch., 268.

§ 6207. *Semble*, that the substitution of heated air or fire heat in place of steam, as claimed in a process, is an evasion. *American Wood Paper Co. v. Glen's Falls Paper Co.*, 8 Blatch., 513.

§ 6208. The substitution by defendants of a passive agency which performs no useful object in addition to the agency employed by plaintiffs will not alter the character of the machine; and if plaintiff's patent is violated without, it is equally violated by, its substitution. *Waterbury Brass Co. v. New York & Brooklyn Brass Co.*, 3 Fish., 43.

347. SUBSTITUTION OF MATERIAL.

§ 6209. The conditions under which the use of one material instead of another in constructing a known machine or article may be patentable considered and explained. (*Hotchkiss v. Greenwood*, 11 How., 248, and *Hicks v. Kelsey*, 18 Wall., 670, cited and discussed.) *Goodyear Dental Vulcanite Co. v. Willis*, 1 Flip., 388.

§ 6210. It is not an infringement of a patented machine, the first of its class, where the substituted device was not a known equivalent at the date of the patent. *Maynadier v. Tenney*, 2 B. & A., 615.

§ 6211. The substitution of one material for another, where a new and useful result is effected, or an increase of efficiency or a decided saving in the operation is clearly attained (and not a matter of mere mechanical judgment), is a proper subject for letters patent. *Dalton v. Nelson*, 13 Blatch., 357.

§ 6212. Where, by the substitution of one material for another, the same result is produced, and in the same way, and also a new result, differing from the former one materially, the difference between the two cases is one of kind and not of degree; and such an improvement must have been the result of invention, thought, experience and skill, rather than the result of mere mechanical judgment. *Ibid.*

§ 6213. If in place of the element omitted another is substituted which has been newly discovered, or one which was not known at the date of the patent to be an equivalent, and which performs a new function, it constitutes a new invention, and is not an infringement of the combination. *Rees v. Gould*, 15 Wall., 178.

§ 6214. The use of one material instead of another in constructing a known machine is, in most cases, so obviously a matter of mere mechanical judgment, and not of invention, that it cannot be called an invention unless some new and useful result, as increase of efficiency, or a decided saving in the operation, be obtained. But where there is some such new and useful result, where a machine has acquired new functions and useful properties, it may be patentable as an invention, though the only change made in the machine has been supplanting one of its materials by another. This is true of all combinations, whether they be of materials or processes. *Smith v. Goodyear Dental Vulcanite Co.*, 3 Otto, 486.

§ 6215. Insulating a wire with gutta percha in place of india-rubber, *held* to be a substitution involving invention, and more than a mere change of material. *Colgate v. Western Union Telegraph Co.*, 15 Blatch., 365.

§ 6216. Although it is known that both rubber and vulcanite become soft at the temperature at which steam packings are used, it does not follow that the employment of vulcanite for rubber as the skeleton of a packing is a mere substitution of material, particularly in view of the different qualities presented by packings made by the two methods. *Clarke v. Johnson*, 18 Blatch., 450.

§ 6217. Doubted whether substitution of material involves invention. *Wirt's Opinion*, 2 Op., 52.

§ 6218. Non-patentable substitution of material. *Carter v. Messinger*, 11 Blatch., 34.

§ 6219. Mere change of material used in the construction of devices is not invention; it is only the exercise of mechanical judgment, and hardly adds enough to the domain of knowledge to raise the person to the dignity of an inventor who first thought of making such a change. *Putnam v. Yerrington*, 9 O. G., 689.

§ 6220. It is not invention to change one well known material for another, or to apply a well known process, without some adaptation, more than every skilled mechanic could apply to a new art or subject; but a change in the form of a machine or instrument, though slight, if it works a successful result not before accomplished in a similar way in the art to which it is applied, or in any other, is patentable. *Isaacs v. Abrams*, 14 O. G., 861.

§ 6221. Mere substitution of material, the purpose being the same, the means of accomplishing it being the same, and the form of the device and mode of operation being the same, is not a sufficient change to constitute invention. *Hicks v. Kelsey*, 18 Wall., 670.

§ 6222. The mere substitution of one known material for another in a known combination is not the subject of letters patent, though such substituted material is a cheaper and better one for the purpose. *Putnam v. Weatherbee*, 1 Holmes, 497.

§ 6223. The mere substitution of a well known element for another, where it appears that the substituted element was well known as a usual substitute for the element left out, is a mere formal one, and a colorable evasion of the patent. *Union Sugar Refinery Co. v. Matthieson*, 3 Cliff., 639.

See *Invention*, §§ 3616, 3634. *Process and Product*, § 5107.

348. SUGGESTIONS.

Suggestions — *Will not defeat a patent*, §§ 6224-6236. *May entitle to a joint patent*, § 6237.

§ 6224. Suggestions by another person, which do not amount to patentable inventions or improvements, cannot invalidate the patent for the thing to which they are applied. *Pennock v. Dialogue*, 4 Wash., 538.

§ 6225. Suggestions by others as to mere alterations in form or proportions will not affect the validity of a patent. *Watson v. Bladen*, 4 Wash., 580.

§ 6226. Suggestions made to inventor, while experimenting upon, and during the progress of the development and testing of his invention, will not invalidate his patent. *Spaulding v. Tucker*, Deady, 649.

§ 6227. A patent for an invention communicated to the patentee by another person is void; but the mere fact that he received a hint as to how the patented improvement might be made would not affect his right. *Alden v. Dewey*, 1 Story, 336.

§ 6228. It is no evidence of such prior knowledge of the invention as will defeat the patent, that others have made suggestions to the patentee as to the possibility of making the improvement subsequently patented. *Bell v. Daniels*, 1 Bond, 212.

§ 6229. Mere conversations about the practicability of an improvement, or suggestions as to the manner in which it might be carried out or accomplished, will not of themselves defeat the claims to originality of him who perfects the idea and secures a patent; but information to a patentee sufficient to enable him to construct the thing itself would. *Judson v. Moore*, 1 Bond, 285.

§ 6230. To invalidate a patent on the ground that it was not the patentee's idea, it must appear that the suggestions, if any, made to him would furnish all information necessary to enable him to construct the invention. *Pitts v. Hall*, 2 Blatch., 229.

§ 6231. Inquiries made or information or advice received from men of science do not impair patentee's right to the character of an inventor. *O'Reilly v. Morse*, 15 How., 62.

§ 6232. Where an employer has conceived the plan of an invention, and is engaged in experiments to perfect it, no suggestions from an employee not amounting to a new method or arrangement, which is in itself a complete invention, is sufficient to deprive the employer of the exclusive property in the perfected improvement. *Agawam Co. v. Jordan*, 7 Wall., 583.

§ 6233. Where patentee is the first to so combine and arrange his device as to make a practical, efficient and complete invention, and so describes it as to enable others to use it, important suggestions and information in regard thereto will not impair his patent; neither will the fact that others about the time of his invention were experimenting with some of its elements. *Hubbell's Case*, 5 Ct. Cl., 1.

§ 6234. An invention is not the less novel because the patentee developed it from ideas which were suggested to him by others. *Roberts v. Dickey*, 4 Brewster, 260.

§ 6235. The mere suggestion that a given result may be obtained is not patentable, and does not anticipate a patent producing such result. *Graham v. Gammon*, 7 Biss., 490.

§ 6236. Although the efforts of prior unsuccessful experimenters may have suggested to the patentee the construction which he finally adopted and perfected, and may have been of profit to him as far as they went, his patent will not be invalidated thereby. *Whittlesey v. Ames*, 9 Biss., 225.

§ 6237. Where an idea is suggested by one and utilized by another, *semble*, that a joint patent should be taken out. *Thomas v. Weeks*, 2 Paine, 92.

See *Invention, Joint*, §§ 3691-3696.

349. SUIT IN STATE COURT.

See PRACTICE, SUIT IN STATE COURT.

350. SUPPLEMENTAL BILL.

See BILL, SUPPLEMENTAL.

351. SUPREME COURT OF DISTRICT OF COLUMBIA, APPEAL FROM COMMISSIONER TO.

See APPEAL, FROM COMMISSIONER.

352. SURPRISE.

See PRACTICE, SURPRISE.

353. SURRENDER OF PATENT.

See REISSUES, §§ 5292-5814.

§ 6238. The act of congress does not require in terms that the surrender of a patent for re-issue should be in writing. *Goodyear Dental Vulcanite Co. v. Wetherbee*, 3 Cliff., 555.

§ 6239. The surrender of a patent to the commissioner is an act which, in judgment of law, extinguishes it. It is a legal cancellation of it; and hence the patent can no more be the foundation for the assertion of a right, after the surrender, than could an act of congress which had been repealed; and it has frequently been determined that suits pending which rest upon an act of congress fall with the repeal of it. Antecedent suits depend upon the patent existing at the time they were commenced, and unless it exists and is in force at the time of the trial and judgment, the suits fail. *Reedy v. Scott*, 23 Wall., 352.

§ 6240. Surrendered patents cease to be causes of action from the moment of surrender, nor can there be recovery for infringement before surrender unless the same has been reduced to judgment. (Dissenting opinion of CLIFFORD, MILLER and DAVIS, JJ.) *Corn-Planter Patent*, 23 Wall., 181.

See *Reissues*, §§ 5350, 5753.

§ 6241. If a patent is surrendered for reissue after final decree or judgment, the surrender has no effect upon a right passed previously into judgment. The right of the patentee then rests on his judgment or decree, and not on his patent. *Mers v. Conover*, 11 O. G., 1111.

§ 6242. A surrender of a patent by the patentee for the purpose of having it reissued is valid, although he had assigned the patent, if it was made at the request of the assignees. *Wing v. Warren*, 2 O. G., 342.

§ 6243. If a part of the whole patent has been vested in another, so as to constitute him an assignee within the meaning of the statute, an efficacious surrender can be made only by the concurrence of both of the owners of the patent; but this may be manifested by the assignee by his direct co-operation in the surrender, or his subsequent ratification of it. *Meyer v. Bailey*, 8 O. G., 437.

See *Employer and Employee*, § 2097.

354. SURREPTITIOUS PATENTS.

See PATENTS, SURREPTITIOUS.

355. TECHNICAL TERMS.

Generally, §§ 6244-6249. *Particular terms construed*, §§ 6250-6253.

§ 6244. The jury are to judge of the meaning of works of art and technical terms. *Washburn v. Gould*, 3 Story, 122.

§ 6245. Chemical terms must be explained by chemical experts. *Allen v. Hunter*, 6 McL., 303.

§ 6246. The general terms and sometimes special words in the claims must receive such a construction as may enlarge or contract the scope of the claim, so as to uphold that invention, and only that invention, which the patentee has actually made and described, when such construction is not absolutely inconsistent with the language of the claim. *Estabrook v. Dunbar*, 10 O. G., 909; *Fitch v. Bragg*, 8 Fed. Rep., 588.

§ 6247. Evidence may be heard in explanation of technical terms peculiar to mechanics, used in describing an invention. *Brooks v. Jenkins*, 3 McL., 432.

§ 6248. In describing his invention a patentee may misuse words, but, in seeking his meaning, the ordinary signification of the words he uses must have weight. *Root v. Lamb*, 7 Fed. Rep., 222.

§ 6249. Technical terms in a patent construed. *Plastic Slate-Roofing Co. v. Moore*, 1 Holmes, 167.

§ 6250. General and technical meaning of the term *fluid*, used in a patent, limited in view of its application. *Sickles v. Young*, 3 Blatch., 293.

§ 6251. In a limited state of the art, "mounted on" is not the same as "suspended from." *Edgerton v. Furst & Bradley Manufacturing Co.*, 10 Biss., 402.

§ 6252. The terms "shirred or corrugated goods," in certain agreements, construed. *Day v. Cary*, 1 Fish., 424; *Day v. Stellman*, 1 Fish., 487.

§ 6253. The terms "shirred or corrugated goods" construed. *Goodyear v. Cary*, 4 Blatch., 271.

356. TEMPORARY INJUNCTION.

See INJUNCTION, TEMPORARY.

357. TENANTS IN COMMON.

See OWNERS.

358. TERMS, CONSTRUCTION OF.

See CONSTRUCTION OF TERMS.

359. TERM (DURATION) OF LICENSE.

See LICENSE, TERM OF.

360. TERM OF PATENT.

Term of patent—*Length of term in discretion of congress*, § 6254. *Expiration of*, §§ 6255, 6256. *Antedating (act 1836)*, § 6257. *Act 1861*, §§ 6258-6260. *How determined*, § 6261. *Particular cases*, §§ 6262, 6263.

§ 6254. It rests in the sound discretion of congress to say when and how long a patent may run. *Blanchard v. Sprague*, 3 Sumn., 535.

§ 6255. The patent expires on the last hour of the same day of the month on which it is granted. *Johnson v. McCulloch*, 4 Fish., 170. (Overruled.)

§ 6256. The term of a patent expires on the day preceding that of the same date as the date of the grant. The term of a patent granted June 15, 1844, and extended June 15, 1858, *held* to have expired June 14, 1865. *Bourn v. Goodyear*, 9 Wall., 811.

§ 6257. The patentee is not obliged to claim the whole term of fourteen years for which a patent may be granted. Under the eighth section of the act of 1836, he may waive his claim to part of the term in favor of the public by antedating the patent in the manner and under the conditions there specified; and if he knowingly acquiesces in the antedating, and takes the deed so, he is in like condition. Neither can he in such a case correct the date of the patent as a clerical error, where it appears from the proceedings in the case that the antedating of the patent was a deliberate act on the part of the commissioner, made in supposed accordance with the provisions of the law, upon the express request of the patentee who accepted and acquiesced in the patent so granted. *Cushman, In re*, 1 MacA. Pat. Cases, 577.

See *Antedating*, § 235.

§ 6258. Section 16 of the act of March 2, 1861, is amendatory of section 6 of the act of March 3, 1839, and not inconsistent therewith. *De Florez v. Raynolds*, 17 Blatch., 436.

§ 6259. The evident design of section 16 of the act of 1861 was that no patents thereafter granted should be extended, but that their original terms of duration should be seventeen years, instead of fourteen years with the privilege of an extension of seven years, as under the former law. *Ibid.*

§ 6260. The law did not provide that the patents granted under such section should by their terms and on their face be granted for seventeen years from the date of issue, but that they should "remain in force" for the term specified. *Ibid.*

§ 6261. The term or duration of a patent must be determined by the statute and all the facts of the case, and not merely by the terms of the grant in the patent. *Ibid.*

§ 6262. As long as separate patents for a machine, and the process and the product, are allowable, they represent distinct *inventions*, and each one may live, without interference or molestation, its whole life without regard to the death of the other. *McKay v. Dibert*, 5 Fed. Rep., 587.

§ 6263. Where letters patent were surrendered and canceled for error of the office in incorrectly limiting their term, and a new patent issued for seventeen years from its date of issue, *held*, that the term did not run from the date of the canceled patent, but from that of the new patent, the patentee having refused to accept the first patent, and having exercised no rights under it. *Railway Register Mfg. Co. v. North Hudson C. R. Co.*, 23 Fed. Rep., 593.

See *Bill*, § 583. *Burden of Proof*, § 664. *Disclaimer*, § 2065. *Reissue*, §§ 5739-5746.

Term of patent — Effect of foreign on domestic patent.

SUMMARY (BATE REFRIGERATING CO. v. GILLETT, §§ 6264–6267) — *Construction of section 4887, Revised Statutes, §§ 6264, 6265.* — *Date of Canadian patent, § 6266.* — *Prolongation of foreign patent, § 6267.*

(GRAMME ELECTRICAL CO. v. ARNOUX & HOCHHAUSEN ELECTRICAL CO., §§ 6268–6271) — *Construction of section 4887, Revised Statutes, §§ 6268–6271.* — *Austrian patent, § 6269.* — *Secret patent, § 6270.*

BATE REFRIGERATING COMPANY v. GILLETT.

(Circuit Court for New Jersey: 13 Federal Reporter, 553–558; 22 Official Gazette, 1205. 1882.)

STATEMENT OF FACTS.—Petition to dissolve injunction. An injunction had issued restraining the defendants from violating the patent of the complainant. The petition set forth that the letters patent, whose violation was enjoined, were numbered 197,134, and had been granted to one Bate for seventeen years from November 20, 1877; that prior thereto—namely, January 9, 1877—a patent for the same invention had been granted to the said Bate in the Dominion of Canada for the term of five years; that said patent expired January 9, 1882, and that therefore the patent granted by the United States expired on the same day, according to the Revised Statutes, section 4887; and that the letters patent No. 197,134, having been granted for seventeen years, were in violation of section 4887, and therefore null and void; and prayed a dissolution of the injunction. The affidavits showed that Bate had filed his application for letters patent at Washington on December 1, 1876, and before any action had been taken had filed a like application in Canada on December 19, 1876; that letters were granted in Canada and dated January 11, 1877; but the inventor not having furnished a working model of his invention, as required by section 15 of the Canadian patent act, the letters were withheld until June, 1878, when, a model having been furnished, they were mailed to the inventor's solicitor; that in the meantime the United States had issued their letters patent; that in 1881 Bate procured an extension of his Canadian patent.

§ 6264. *Under section 4887, Revised Statutes, the life of the domestic patent expires with the term of the prior outstanding foreign patent.*

Opinion by NIXON, J.

The case turns upon the question whether the invention was patented in Canada previous to the issuing of the patent in the United States in the sense in which the word "patented" is used in section 4887 of the Revised Statutes. The provisions of the section: "Every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one at the same time, with the one having the shortest term, and in no case shall it be in force more than seventeen years."

The phraseology here used materially differs from the previous legislation upon the subject. The power of the commissioner is defined and abridged. Where a foreign patent has been granted for the same subject-matter he is expressly required to limit the terms of the domestic patent to the period of time that the foreign one has to run; or, if there be more than one, then to make it expire at the same time with the one having the shortest term. We do not see how any language could have been employed that would more clearly express the legislative design that the life of the domestic patent should expire with the term of any outstanding foreign patent; but the counsel for the complainant contended that the present case did not fall within the limitation of

the statute because the application of the United States patent was filed antecedent to the application for or the grant of the Canadian patent.

§ 6265. — *although the date of filing of the domestic patent was prior to the grant of the foreign patent.*

We are at a loss to understand what the time of filing the application has to do with the matter. It is true the acts of 1836, section 8, and of 1839, section 6, made the date of filing the specifications and drawings in the one case, and the date of application for the home patent in the other, the point of time from which to reckon the six months intervening between the issue of the foreign and domestic patents. It is also true that by section 4886 and the first clause of section 4887 of the Revised Statutes, an inventor is required to file an application for his patent within two years after his invention or discovery has been in public use or on sale, from all of which the late commissioner was led to the opinion that the word "previously" in the last clause of section 4887 had reference to time prior to the filing of the application rather than to time prior to the granting of the patent (*Ex parte Mann*, 17 O. G., 330); but this seems to be wresting the language of the section from its plain and obvious meaning, and we are not able to follow the reasoning by which such an interpretation is reached.

§ 6266. *The grant of a Canadian patent is determined by its date or issue, not by its delivery.*

It is further insisted that the grant of the Canadian patent was to be determined, not by its date or issue, but the time of the delivery to the patentee, namely, June 26, 1878, a long time after the date of the American patent. Hence it was said "the invention had not been previously patented in a foreign country" when the patent was granted here; but this position will not stand the test of analysis or examination. It appears upon the face of the Canadian patent that it was dated on the 9th and issued on the 11th of January, 1877, and was to continue in force for five years from its date. By the eighteenth section of the Canadian patent act the invention is patented so as to be available to the patentee when signed, sealed and registered. Owing to the neglect of the inventor in not forwarding a model, it was not delivered until June, 1878; but it was no less a patent, securing to him the benefits of the invention and protecting him against infringement. This becomes manifest by referring to section 16 of the act. Again the proofs show that the patent was absolutely granted as early as January, 1877, although the delivery was withheld, owing to the laches of the grantee.

§ 6267. *The prolongation of the term of a prior foreign patent does not lengthen the term of the domestic patent beyond the original foreign term.*

It was further maintained that even if the American patent should terminate with the Canadian patent, the extension of the latter under the provisions of the act operated to lengthen the term of the domestic patent to the period of fifteen years from the date of the first issue of the foreign patent. By virtue of the provisions of section 17 of the Canadian laws, Bate procured extensions, first on December 12, 1881, for five years from January 9, 1882, and secondly on December 13, 1881, for another five years, to be computed from the expiration of the prior extension, to wit, January 9, 1887.

The question is an interesting one and has already received examination and answer in other circuits. It first came before Mr. Justice Clifford, in *Henry v. Tool Company*, decided in 1878 (14 O. G., 855). In that case the United States patented for the full term of seventeen years, although at the

time of the grant there was an English patent for the same invention which had been granted for fourteen years from the 15th of November, 1860. The defendants claimed that the United States patent expired by operation of law at the same time with the English patent. The complainant insisted that the language of the statute extended not only to the term of the foreign patent in force when the United States patent was obtained, but also to the term of any prolongation which the patentee might secure from the foreign government, and that, as he had obtained an extension of four years to the original term, the owners of the domestic patent were entitled to add those four years to its life. Mr. Justice Clifford refused to accede to such a construction of the law, but held: 1. That by the provision of the act of July 8, 1870, congress never intended to extend the term of the domestic patent beyond the legal term secured to the foreign patentee when the domestic patent was granted. 2. That the prolongation of the English patent for a further term, after the expiration of the original, did not save the domestic patent from lapsing under the statute. He was followed in this construction by Blatchford, J., in *Reissner v. Sharp*, 16 O. G., 356. There was an attempt made to distinguish the case from *Henry v. Tool Company*, *supra*: 1. Because the Canadian patent had not expired when the extension was granted; and 2. Because the extension, by the terms of the Canadian law, was not a matter of favor, as it was under the English act. But the judge could not perceive that these considerations were of sufficient force to cause any other conclusion as to the plain meaning of the statute than that arrived at by Mr. Justice Clifford. We are clearly of opinion that the prayer of the petition should be granted and the injunction dissolved.

Whether the complainant's United States patent is void *ab initio* because the term was not limited on its face to expire at the same time as the foreign patent is not properly before the court on this motion. It was a defense to the suits of which the defendants did not choose to avail themselves, and a formal interlocutory decree entered on the case cannot be impeached in and by any such collateral proceedings. Injunction dissolved.

GRAMME ELECTRICAL COMPANY *v.* ARNOUX & HOCHHAUSEN ELECTRICAL COMPANY.

(Circuit Court for New York: 17 Federal Reporter, 838-841; 25 Official Gazette, 193. 1883.)

Opinion by BLATCHFORD, J.

STATEMENT OF FACTS.—This is a suit in equity, brought for an infringement of letters patent No. 120,057, granted to Zenobe Theophile Gramme and Eardley Louis Charles D'Ivernois, October 17, 1871, for seventeen years from that day, for an improvement in magneto-electric machines. It is set up as a defense in the answer that the patentees obtained a patent in Austria, December 30, 1870, for the same invention as is covered by No. 120,057; that the Austrian patent has expired, and that, therefore, No. 120,057 has expired.

The Austrian patent and sundry documents pertaining to it, and the Austrian statute, are in evidence. The patentees took out a patent in France for the same invention for fifteen years on the 22d of November, 1869. On the 30th of May, 1870, they made oath in Paris, France, to their application for No. 120,057. The application and the oath recited the date and the term of the French patent. The application was filed in the United States patent office, August 17, 1870, with a specification, drawings and model, and the

proper fee was paid. On the 3d of October, 1870, they filed in Austria an application, dated September 30, 1870, for a patent for the same invention for the period of one year. On the 30th of December, 1870, "an exclusive patent" was issued to them in Austria "for the duration of one year" for the invention, "under all conditions and with all effects stated in the supreme patent law of August 15, 1852." An amended oath to the United States application was sworn to by the patentees at Paris, June 26, 1871, and filed in the patent office July 12, 1871. It referred to the French patent, and stated its date and term, but it did not mention the Austrian patent. The final fee for No. 120,057 was paid October 2, 1871. The Austrian patent was extended nine times, year to year, each extension being for one year, and till December 30 in each year, and it finally expired December 30, 1880.

The bill in this suit was filed in July, 1881. It is agreed that the Austrian patent applied for and granted was for the same invention that is claimed in No. 120,057.

The Austrian patent law of August 15, 1852, requires that the applicant for a patent shall state in his petition the number of years for which he demands a patent, which number cannot exceed fifteen, except by special grant of the crown. The tax must be paid in advance and is in proportion to the duration of the privilege. The exclusive privilege secures to the patentee the exclusive use of his invention "for the number of years mentioned in his privilege." A patentee whose privilege has been granted for a short period may claim its prolongation for one or more years during the fixed longest period, provided he demands such a prolongation before the privilege has become extinct and pays in advance the tax for the required term of prolongation.

§ 6268. *The meaning of section 4887, Revised Statutes (section 25 of the act of 1870), is that the United States patent shall expire at the same time with the foreign patent having the shortest term to run which was granted before the United States patent was granted, and not that it shall expire at the same time with the foreign patent having the shortest term to run which was granted before the time when the application for the United States patent was made.*

No. 120,057 was granted under the provisions of the act of July 8, 1870 (16 U. S. Stats. at Large, 198), and its validity and duration must be tested by those provisions. By section 22 of that act (p. 201) every patent is to be granted for the term of seventeen years. By section 25 (p. 201) it is provided as follows: "No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented, or caused to be patented, in a foreign country: *Provided*, the same shall not have been introduced into public use in the United States more than two years prior to the application, and that the patent shall expire at the same time with the foreign patent; or, if there be more than one, at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years."

It is contended for the defendant that under the foregoing provisions No. 120,057 expired either on December 30, 1871, or on December 30, 1880, the date of the expiration of the Austrian patent, accordingly as that patent is to be regarded as a patent for one year or for ten years. To this the plaintiff replies that the application for No. 120,057 was filed before the application for the Austrian patent was filed. But the date of the application for No. 120,057 cannot affect the question. Under the act of 1870 a patent takes effect from the time when it is granted, and cannot be antedated. The meaning of sec-

tion 25 of the act of 1870 is that the United States patent shall expire at the same time with the foreign patent having the shortest term to run which was granted before the United States patent was granted, and not that it shall expire at the same time with the foreign patent having the shortest term to run which was granted before the time when the application for the United States patent was made. *Bate Refrigerating Co. v. Gillett*, 13 Fed. Rep., 553 (§§ 6264-67, *supra*).

§ 6269. *An Austrian patent granted for one year may be prolonged to fifteen years; but a capacity of being prolonged so as to have a duration of fifteen years is not equivalent to having a term of fifteen years; and where the Austrian patent was prolonged so as to expire at the end of ten years, the United States patent expired with it.*

It is also contended by the plaintiff that the Austrian patent, though granted for the duration of one year on its face, was really a patent for fifteen years. It might have been prolonged year by year, or otherwise, for five years beyond December 30, 1880. But it was not prolonged beyond that date, and at most it cannot be regarded as a patent which, when granted, had a longer term to run than till December 30, 1880, even if it could be considered as a patent having, when granted, a longer term to run than one year. A capacity of being prolonged so as to have a duration of fifteen years is not equivalent to having a term of fifteen years, when the patent is granted for one year and then is prolonged so as to expire at the end of ten years. At latest the Austrian patent expired December 30, 1880, and it is not necessary to decide whether the term for which it was granted was not a term of only one year.

§ 6270. *Although the Austrian patent was a secret patent, it was nevertheless a patent within the meaning of section 4887, however far it might come short of being a prior public foreign patent sufficient to defeat a patent granted here to another inventor.*

It is also contended for the plaintiff that the Austrian patent was a secret patent, and therefore not a patent within the meaning of section 25 of the act of 1870. The Austrian statute provides that the petition for a patent must contain a statement whether the invention is to be kept secret or not; that special care is to be taken for the observation of the required secrecy, and due precautions are to be adopted against any possible violation of the secret; and that specifications as to which secrecy is demanded are not open to the public or for the taking of copies until the patent is extinct. In the present case the petition for the Austrian patent stated that it was desired that the description be kept secret. But the Austrian statute also provides that an exclusive privilege secures to the patentee the exclusive use of his invention, as laid down in his specification, for the number of years mentioned in his privilege. The Austrian patent in the present case states on its face that it is an exclusive patent, for the duration of one year, for the improvements in question, "in consonance with the description deposited" "under all conditions and with all effects stated in the" Austrian statute.

§ 6271. *It was also the manifest intention of section 4887 that the exclusive privilege under the patent here should expire with the exclusive privilege granted abroad to the same inventor having the shortest term.*

In view of these facts, however far the Austrian patent might have come short of being a prior public foreign patent sufficient to defeat a patent granted here to another inventor for an invention made after the granting of such

prior foreign patent, it is not perceived how the question of secrecy or publicity in the foreign patent granted prior to the granting of the patent here can affect, under section 25 of the act of 1870, the question of the duration of the patent here. The Austrian patent conferred on the patentees an exclusive privilege. It was the manifest intention of section 25 of the act of 1870 that the exclusive privilege under the patent here should expire with the exclusive privilege granted abroad to the same inventor having the shortest term. *De Florez v. Raynolds*, 17 Blatch., 436, 450.

As the Austrian patent expired at the latest on December 30, 1880, and before this suit was brought, and No. 120,057 continued to exist no longer, there was no ground for this suit in equity when it was brought, whatever ground there may have been for a suit at law against these defendants for infringement. *Root v. Railway Co.*, 105 U. S., 189. The novelty of the invention patented is attacked, and it is also contended that the patent is invalid because it was issued for the term of seventeen years and not for a shorter term. But the consideration of these questions is unnecessary, and the bill is dismissed, with costs.

Term of patent — Construction of statutes — Domestic patent term as affected by foreign patent, §§ 6272-6284.

§ 6272. By the terms of the acts of 1835 and 1836, inventions patented abroad more than six months before were limited to fourteen years from the date of publication of the foreign patent, while those patented abroad within six months before were not affected at all by the foreign patent. *American Diamond Rock-Boring Co. v. Sheldon*, 17 Blatch., 303.

§ 6273. Patents granted under the act of March 2, 1861, for inventions previously patented in a foreign country do not remain in force for seventeen years from their date, but are limited to the term of seventeen years from the date of publication of such foreign patents. *De Florez v. Raynolds*, 17 Blatch., 436.

§ 6274. The actual date of issuing a patent (section 8, act of 1836), or the time when a patent should "take date," was one thing, and the date from which its term began to run was another. The latter need not necessarily be a date expressed on the face of the patent, and under section 6 of the act of 1839, such date is "the date of publication" of the foreign patent. *Ibid.*

§ 6275. The provisions of the law limiting the duration of a United States patent for an invention previously patented abroad to the same inventor are intended to give to the patentee a specified term from the date at which his foreign patent had effect as a foreign patent in his favor. *Ibid.*

§ 6276. The language of the act of 1861, that "all patents hereafter granted shall remain in force for seventeen years from the date of issue," and "all acts and parts of acts heretofore passed which are inconsistent with this act are hereby repealed," considered in connection with former and existing legislation respecting inventions first patented abroad, was well calculated to create the doubt and embarrassment which followed. *Siemens v. Sellers*, 16 Fed. Rep., 856.

§ 6277. The provision of the patent act of 1870, that in the case of a prior foreign patent the United States patent "shall expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term," is not retroactive. It did not take away any portion of the term of an existing patent, nor any right to an extension (*a reissue?*) which was in force when such patent was granted. *Badische Anilin & Soda Fabrik v. Hamilton Manufacturing Co.*, 13 O. G., 273.

§ 6278. Hence, a patent granted originally in 1869, and reissued after the passage of the act of 1870, is not abridged in term by the expiration of a prior foreign patent for the same invention occurring subsequent to the reissue. *Ibid.*

§ 6279. By the provisions of the patent act of July 8, 1870, congress never intended to extend the term of the domestic patent beyond the legal term secured to the foreign patentee when the domestic patent was granted. *Henry v. Providence Tool Co.*, 14 O. G., 855.

§ 6280. The limitation is the same, even if the domestic application was filed before the application for, or the grant of, the foreign patent, the word "previously" in the last clause of section 4887 referring to time prior to the grant of the domestic patent rather than to time prior to the application therefor. (*Ex parte Mann*, 17 O. G., 330, disapproved.) *Bate Refrigerating Co. v. Gillett*, 22 O. G., 1205.

§ 6281. Section 4887 of the Revised Statutes expressly requires the commissioner of patents to limit the term of a domestic patent for an invention previously patented in a foreign country to the period of time which the foreign patent has to run, or, if there be more than one such foreign patent, to so limit the domestic patent that it will expire at the same time with the one having the shortest term. *Ibid.*

§ 6282. Statutes with regard to the effect of a foreign patent upon a United States patent recited. *Cornley v. Marckwald*, 17 Fed. Rep., 83.

§ 6283. The provision of the statutes (§ 4887, R. S.), that a United States patent for an invention previously patented abroad shall be so limited as to expire at the same time with the foreign patent, seems to mean that the term of the patent here shall be as long as the remainder of the term for which the patent was granted there, without reference to incidents occurring after the grant. It refers to fixing the term, not to keeping the foreign patent in force. *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.*, 21 Fed. Rep., 458.

§ 6284. Section 4887 is not to be construed as requiring the limitation of the term of the domestic patent to that of the prior foreign patent to be expressed in the patent, but merely as controlling the effect or duration of the grant. *Canan v. Pound Mfg. Co.*, 23 Fed. Rep., 185.

See *Errors*, § 2181. *Extension*, §§ 2515, 2516. *Foreign Patents*, §§ 2520-2532.

Term of patent—Domestic patent term as affected by foreign patents—In general, §§ 6285-6289. *Does not include extension of foreign patent*, §§ 6290-6293. *Particular cases*, §§ 6294-6303.

§ 6285. A patent not limited on its face to the term of a prior foreign patent is not void. *O'Reilly v. Morse*, 15 How., 62.

§ 6286. The date of publication of the foreign patent is to be the date from which to determine the life of an American patent. *Weston v. White*, 13 Blatch., 364.

§ 6287. An American patent will expire at the same time with the foreign patent granted to the same party or parties, but will not exceed the term of seventeen years. *Ibid.*

§ 6288. An inventor receiving a patent in the first instance in this country is entitled to seventeen years' protection of his invention; but if he has previously obtained letters patent in one or more foreign countries, then, while not deprived of his right to a patent here, the term to which the law in such case limits his protection is a period not extending beyond the date of the expiration of that one of the foreign patents first expiring. *United States ex rel. Koechlin v. Marble*, 22 O. G., 1365.

§ 6289. It is only a patent for an invention that has been previously actually patented in a foreign country that is limited by the foreign patent. The description of the invention in the foreign patent might affect the validity of the domestic one and might not, but would not limit it. *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.*, 22 Fed. Rep., 341.

§ 6290. The prolongation of the English patent for a further term after the expiration of the original does not save the domestic patent from lapsing under the statute on the expiration of the original foreign term. *Henry v. Providence Tool Co.*, 14 O. G., 855.

§ 6291. *Held*, that a United States patent is limited to the original term granted the prior foreign patent and does not include a prolongation or extension of the term of the foreign patent. *Reissner v. Sharp*, 16 Blatch., 381.

§ 6292. The statute limits the term of the United States patent to the legal term secured to the foreign patent at the time when the United States patent was granted, excluding all subsequent prolongations or extensions of the term of the foreign patent, whether made by the executive or legislative department of the foreign government, before or after the expiration of the original term of the foreign patent; and the reissue patent to C. Reissner & Co. expired May 15, 1878. *Ibid.*

§ 6293. The term of the domestic patent is limited to the term of the foreign patent in force when the domestic patent was granted, and is not prolonged by any subsequent extension of the foreign patent. *Bate Refrigerator Co. v. Gillett*, 22 O. G., 1205.

§ 6294. Where the patent application was filed and acted on in the United States, although not issued prior to the date of the French patent for the same invention, *held*, it was properly not limited to run from the date of the French patent. *Morse v. Bain*, 9 West. L. J., 106.

§ 6295. Where the date of the United States application did not appear apart from that of the patent, and the date of the filing of the full English specification was not six months prior thereto, *held*, that under act of 1836, it was not limited by the prior English patent, unless the date of the grant of the English patent—six months prior to the filing of the English specification—be taken as the date at which the invention was patented in England. *American Diamond Rock-Boring Co. v. Sheldon*, 17 Blatch., 303.

§ 6296. Where application for the English patent was filed subsequent to application in the United States, and the English patent was sealed and published five months subsequent to the

issue of the United States patent, but bore date prior thereto — the date of the provisional application — it was held not to limit the term of the United States patent. *Gold & Stock Telegraph Co. v. Commercial Telegraph Co.*, 23 Fed. Rep., 340.

§ 6297. Where the patent was issued for fourteen years, without being limited, in view of act 1837, section 6, to fourteen years from date of patentee's prior foreign patent, it was held illegally issued (*Morse's Patent*, No. 1647). *Smith v. Ely*, 5 McL., 76, overruled. *Smith v. Ely*, 15 How., 137.

§ 6298. A patent not so limited under section 4887, Revised Statutes, as to expire with the prior foreign patent for the same invention, *held*, invalid. *Paillard v. Gautschi*, 20 O. G., 1893.

§ 6299. A patent granted for seventeen years from the date of its issue, and not limited on its face to expire at the time of expiration of a foreign patent granted to the same party, *held*, to be valid for the term of such foreign patent. *Canan v. Pound Mfg. Co.*, 23 Fed. Rep., 185.

§ 6300. Where a prior Canadian patent, granted for a term of five years, was declared void *ab initio* by a Canadian court, *held*, that the subsequent United States patent ran for the full term of seventeen years, as if there had been no such prior Canadian patent. *Bate Refrigerator Co. v. Gillett*, 20 Fed. Rep., 192.

§ 6301. Where a patent issued, running fourteen years from its date, and a foreign patent had been issued before upon the same invention, the error was held to have been properly corrected on a reissue. *Buerk v. Valentine*, 9 Blatch., 479.

§ 6302. The patentee in such a case cannot recover for infringements previous to the reissue any more than on any other reissued patent. *Ibid.*

§ 6303. Although the original patent in that case was void, no notoriety nor use of the invention after the application for it was filed and before the reissued patent was obtained would affect the validity of the latter. *Ibid.*

See *Process*, § 5059.

361. TERRITORIAL ASSIGNMENT.

See ASSIGNMENT.

362. TERRITORIAL LICENSE.

See LICENSE.

363. TERRITORIAL LIMITATIONS IN CONTRACTS CONCERNING PATENTS.

See CONTRACTS, CONCERNING PATENTS, TERRITORIAL LIMITATION.

364. THING PATENTED.

§ 6304. "Thing patented" is to be understood generally throughout the patent law as referring to the patented machine, when taken in connection with the right to use, in contradistinction to the right to make and sell. *Wilson v. Rousseau*, 4 How., 646.

§ 6305. The patent law protects the thing patented, not the product. *Boyd v. Brown*, 3 McL., 295.

365. TITLE.

SUMMARY (*MOORE v. MARSH*, §§ 6306, 6307) — *Owner's right to recover*, § 6306. — *Act 1836, section 14, construed*, § 6307.

MOORE v. MARSH.

(7 Wallace, 515-523. 1868.)

ERROR to U. S. Circuit Court, Western District of Pennsylvania.

Opinion by MR. JUSTICE CLIFFORD.

STATEMENT OF FACTS.— Viewed in the light of the admitted facts, the only question in the case is whether the assignment by the plaintiff to a third person of an undivided half of the right, title and interest secured to him by his

letters patent, subsequent to the alleged infringement, but before the commencement of his suit, is a bar to his claim to recover damages for such infringement.

Letters patent were granted to the plaintiff on the 18th of April, 1848 [No. 5522], for a certain new and useful improvement in grain drills, in which it is alleged that he is the original and first inventor of the improvement. Original patent was for the term of fourteen years, but it was subsequently extended by the commissioner of patents for the term of seven years from and after the expiration of the original term. Alleged defects existed in the original specification, and in consequence thereof the plaintiff, on the 3d of February, 1863, surrendered the letters patent, and the same were reissued to him in three new patents for separate and distinct parts of the invention for the unexpired portion of the original and extended terms of the patent. [Reissues Nos. 1393, 1394, 1395.]

Damages are claimed of the defendants for infringing the reissued letters patent from the day of the reissue to the 24th of February, 1865, as more fully set forth in the declaration. Pleas to the declaration were subsequently filed by the defendants, and the record shows that they gave due notice of certain special defenses which they proposed to offer in evidence under the general issue, in pursuance of the act of congress in such case made and provided. Before the day for the trial came, however, the parties filed an agreement waiving a jury and submitting the cause to the court, stipulating that the decision of the court should have the same effect as the verdict of a jury. Leave to amend was subsequently granted by the court to both parties.

Purport of the amendment to the declaration was, that the plaintiff was the sole owner of the letters patent for the county of Union, in the state of Pennsylvania, from the date of the reissued letters patent to the 24th of February, 1865, and that the defendants had infringed the same throughout that period, by making and using the invention, and vending the same to others to be used, without his license or consent.

Defendants filed another special plea, in which they alleged that the plaintiff, when he commenced his suit, was not the owner of the exclusive right secured in the reissued letters patent within any part of the United States; that in certain states and districts he had parted with all his interest in the patent; and that, on the said 24th of February, he assigned and transferred an undivided half of all the residue of his right, title and interest in the same, and, therefore, that the plaintiff had no right to bring this action in his own name against the defendants. Plaintiff demurred to the plea, and the defendants joined in demurrer. Parties were heard, and the court rendered judgment for the defendants, and the plaintiff sued out this writ of error.

Conceded fact is, that the plaintiff was the exclusive owner of the patent in the territorial district where the alleged infringement was committed, throughout the entire period of the infringement, as alleged in the declaration. Express allegation of the declaration is to that effect, and, as the plea is in avoidance and contains no denial of the matters alleged in the declaration, they must be considered as admitted, unless the matters alleged in the special plea are a sufficient answer to the action. Briefly stated, the matter alleged in avoidance of the right of the plaintiff to maintain the suit is, that he, before he commenced the suit, but subsequent to the infringement, sold and assigned an undivided half of his patent for the territorial district where the infringement was committed to a third person.

Patentees have secured to them, by virtue of the letters patent granted to them, the full and exclusive right and liberty, for a prescribed term, "of making and using, and vending to others to be used," their respective inventions or discoveries; and, whenever their rights, as thus defined, are invaded by others, they are entitled to an action on the case to recover actual damages as compensation for the injury. 5 Stat. at Large, 123, § 14.

Such damages may be recovered by action on the case in any circuit court of competent jurisdiction, to be brought in the name or names of the person or persons interested, whether as patentees, assignees or as grantees of the exclusive right, as already defined within and throughout a specified part of the United States. *Id.* Assignees and grantees, as well as the patentee, may, under some circumstances, maintain an action on the case for an infringement, in their own name, as appears by the express words of the act of congress. An assignee is one who holds, by a valid assignment in writing, the whole interest of a patent, or any undivided part of such whole interest, throughout the United States. 5 Stat. at Large, 121, § 11.

Where the patentee has assigned his whole interest, either before or after the patent is issued, the action must be brought in the name of the assignee, because he alone was interested in the patent at the time the infringement took place; but where the assignment is of an undivided part of the patent, the action should be brought for every infringement committed subsequent to the assignment, in the joint names of the patentee and assignee, as representing the entire interest. *Herbert v. Adams*, 4 Mason, 15; *Curtis on Patents* (3d ed.), § 347; *Gayler v. Wilder*, 10 How., 477; *Whittemore v. Cutter*, 1 Gall., 430; *Woodworth v. Wilson*, 4 How., 712.

Settled view at one time was, that the grantee of a territorial right, for a particular district, could not bring an action on the patent in his own name; but the act of congress having made him a party interested in the patent, it is now equally well settled that he may sue in his own name for invasion of the patent in that territorial district, as no one else is injured by any such infringement. *Tyler v. Tuel*, 6 Cr., 324; *Gayler v. Wilder*, 10 How., 477 (§§ 385-396, *supra*); *Curtis on Patents*, § 346. Both assignees and grantees have an interest in the patent, but the terms are not synonymous, as used in the patent law. *Potter v. Holland*, *Law's Digest*, 157.

Grants, as well as assignments, must be in writing, and they must convey the exclusive right, under the patent, to make and use, and vend to others to be used, the thing patented, within and throughout some specified district or portion of the United States, and such right must be exclusive of the patentee, as well as of all others, except the grantee. Suits for infringement in such districts, if committed subsequent to the grant, can only be brought in the name of the grantee, as it is clear that no one can maintain such an action until his rights have been invaded, nor until he is interested in the damages to be recovered.

Alleged infringement in this case was committed in the county of Union, in the state of Pennsylvania, and the admitted fact is that the plaintiff, throughout the entire period of the infringement, was the sole owner of the exclusive right to make and use, and grant to others to make and use, the thing patented, in that territorial district, by virtue of his original title as patentee, having never assigned or granted any right, title or interest within that county. 5 Stat. at Large, 121, § 11.

§ 6306. *Under the patent act of 1836 the original owner of a patent may recover for an infringement during the time of his ownership.*

Grant that these views are correct, and it is clear that unless the plaintiff can maintain the action there can be no redress, as it is too plain for argument that a subsequent assignee or grantee can neither maintain an action in his own name, or be joined with the patentee in maintaining it, for any infringement of the exclusive right committed before he became interested in the patent. Undoubtedly the assignee *thereafter* stands in the place of the patentee, both as to right under the patent and future responsibility; but it is a great mistake to suppose that the assignment of a patent carries with it a transfer of the right to damages for an infringement committed before such assignment. Comment upon the cases cited, as supporting this proposition, is unnecessary, as it is clear to a demonstration that they give it no countenance whatever. Such a proposition finds no support in any decided case, nor in the act of congress upon the subject.

§ 6307. *The meaning of the word "interested," in section 14 of patent act, is that the right of action is given to the person owning the exclusive right at the time the infringement was committed.*

True meaning of the word interested, as employed in the last clause of the fourteenth section of the patent act, when properly understood and applied, is, that the right of action is given to the person or persons owning the exclusive right at the time the infringement is committed. Subsequent sale and transfer of the exclusive right are no bar to an action to recover damages for an infringement committed before such sale and transfer. The reason for the rule is, that the assignee or grantee is not interested in the damages for any infringement committed before the sale and transfer of the patent. Correct interpretation of the words person or persons interested is, that the words mean the person or persons interested in the patent at the time when the infringement was committed, which is the cause of action for which the damages may be recovered. *Dean v. Mason*, 20 How., 198.

Assignment was made in that case after suit was brought, but before the final decree. Proof of the fact was offered and a motion filed to dismiss the case, but the court overruled the motion because the assignees could have no interest in a suit for an infringement committed before their right accrued. *Kilborn v. Rewee*, 8 Gray, 415; 1 Hilliard on T., 521; *Eades v. Harris*, 1 Younge & Collier, 230.

Attempt is made to distinguish the case at bar from the rule established in those cases, but, in the view of this court, without success. Judgment reversed. New venire ordered.

Title — Generally — Recording, §§ 6308, 6309. *Mesne assignment*, § 6310. *Administrators*, §§ 6311, 6312. *Sale of firm property*, § 6313. *Attachment of stock*, §§ 6314, 6315. *Priv-ity*, § 6316. *Title in trust*, §§ 6317, 6318. *Reissue to assignee*, § 6319. *Conveyance in trust*, §§ 6320, 6321. *Patentee's right*, § 6322. *Non-payment of purchase money*, § 6323.

§ 6308. A written instrument executed by the owner of a patent and recorded in the patent office is necessary to the transfer of the title in it to a purchaser. *Ashcroft v. Walworth*, 1 Holmes, 152.

§ 6309. The titles to patents are required by law to be recorded, and a purchaser has a right to rely upon the apparent recorded title, so long as he acts in good faith. *Secombe v. Campbell*, 18 Blatch., 108.

§ 6310. The title to a patent granted an assignee having at the date of its grant no interest of record in the patent, vests, by operation of law, instantly in the ultimate assignee. *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 33 O. G., 1597.

§ 6311. In a suit for the infringement of a patent, the bill alleged and the proofs showed that the letters patent became the property of P., as administratrix of the patentee, as part of his estate, and that complainant was the sole devisee and legatee under the will of P. *Held*, that no property in the patent passed to complainant, and the bill must be dismissed. *Pelham v. Edelmeyer*, 15 Fed. Rep., 262.

§ 6312. From a comparison of the sections of the statutes relating to patents, it is made clear that a patent-right, like any other personal property, is understood by congress to vest in the executors and administrators of the patentee, if he has died without having assigned it. *Shaw Relief Valve Co. v. City of New Bedford*, 19 Fed. Rep., 753.

§ 6313. The title to a patent taken out in the name of one of the members of a firm and never assigned to the firm will not pass by sale of partnership property, although expenses incident to the issue of the patent were paid by the firm, and the patent was used for the benefit of the firm while the partnership lasted. *McWilliams Manufacturing Co. v. Blundell*, 11 Fed. Rep., 419.

§ 6314. The attachment of shares of a stockholder in a corporation does not affect its right to assign letters patent, of which he is the owner. *Gottfried v. Miller*, 14 Otto, 521.

§ 6315. The fact that a person holds stock in a company gives him no title to its property, and the attachment of such stock in the hands of a stockholder for a personal debt of the stockholder does not in any way incumber the property of the company. *Ibid*.

§ 6316. Where suit for infringement was brought against the licensee of a party who, at the time of granting it, had no title in the patent, but subsequently acquired such title in privity with plaintiff, and plaintiff had subsequently agreed to confirm all licenses of such party, *held*, that because of such privity the suit would not lie. *Gottfried v. Miller*, 10 Fed. Rep., 471.

§ 6317. S. and E., patentees, executed an agreement, sale and grant to B., of "the said invention and letters patent or extensions to be hereafter obtained on account of said invention," and containing certain covenants and agreements of quiet enjoyment of all rights under the patent so assigned, and not to make or sell, or cause to be made or sold, any other machine for the purposes to which such patented machine is applicable. *Emmons v. Sladdin*, 9 O. G., 352.

§ 6318. Subsequently S. and L. took out a patent and obtained a reissue thereof for inventions of the same character and purpose of that described in the sale or assignment to B., and brought suit against the plaintiffs herein, who are the purchasers and assignees of B.'s interest. *Held*, that the title of S. and L. must be held to be only in trust for B. and his assigns, so far as the letters patent of the United States embraced any inventions made by S. before the conveyance to B., and incorporated in the invention described in the agreement of sale and grant to B. by S. and E. *Ibid*.

§ 6319. The action of the patent office in reissuing a patent to assignees raises a presumption of title in the assignees named, and if the defendant wished to raise the question as to whether a reservation contained in an assignment included the territory in controversy, he should have raised it in his answer, or at least have put in proof tending to show such fact. *Washburn & Moen Manufacturing Co. v. Haish*, 10 Biss., 65.

§ 6320. The defense that the plaintiff's title fails because one of the parties through whom such title is derived did not own the patent when it was surrendered by and reissued to him was sought to be sustained by showing that a certain instrument of writing was forged by such party by placing it before and attaching it to the genuine execution of another and a different instrument. It appearing that the parties whose assignment such instrument purported to be had knowingly acted under the same. *Held*, that this ratified and confirmed the instrument as good from the beginning. *Campbell v. James*, 17 Blatch., 42.

§ 6321. It appearing that the conveyance was one expressly in trust, upon condition that the plaintiff should have the sole management of the trust until a fair, just and reasonable settlement should be had with the United States for the use of the invention in the postal service of the United States by the postoffice department, *held*, that as no such settlement had been made, the limitation in the conveyance had not expired, and the right to bring suit for infringement was in the plaintiff. *Ibid*.

§ 6322. The rights of a patentee or his assigns, under a new patent, are unaffected by the acquiescence or engagements of those whose title expired with the original patent. *Smith v. Mercer*, 4 West. L. J., 49.

§ 6323. Equity will enforce a lien for purchase money, but it does not vacate a transfer because the purchase money has not been paid. *Perkins v. U. S. Electric Light Co.*, 24 O. G., 204.

Title — *Equitable title*, §§ 6324, 6325. *Legal title*, §§ 6326-6328.

§ 6324. In a court of equity, an equitable title is sufficient, as against the patentee and those claiming under him with notice of the complainant's rights, to entitle the latter to sue. *Ruggles v. Eddy*, 10 Blatch., 52.

§ 6325. In a court of equity a party holding an equitable title cannot be ousted of his equitable rights by the holder of the legal title, who in such case stands as trustee for the party beneficially interested. *Whiting v. Graves*, 13 O. G., 455.

§ 6326. The legal title to the patent being in the plaintiff, it constitutes no defense to the action to make a showing of equitable interests in other parties. *Graham v. McCormick*, 10 Biss., 39.

§ 6327. Letters patent having been issued directly to the defendant as assignee, it acquired the legal title. *Perkins v. United States Electric Light Co.*, 24 O. G., 204.

§ 6328. Where complainant had acquired the legal title to the patent, *held*, that it must prevail over the equitable title of defendant, unless acquired with notice of the equities of defendant. *Davis Improved Wrought Iron Wagon Wheel Co. v. Davis Wrought Iron Wagon Co.*, 20 Fed. Rep., 699.

Title — *Severance of*, § 6329. *Warranty*, §§ 6330-6332. *Pleading*, § 6333.

§ 6329. On sale of a patented machine, the courts will permit a severance of ownership and right to use, if the patentee has chosen to dis sever them, and if his intent is not doubtful. *Porter Needle Co. v. National Needle Co.*, 17 Fed. Rep., 536.

§ 6330. Every seller of personal property impliedly warrants that he has title to and right to sell what he assumes to sell. His undertaking to sell includes an undertaking to that effect. *Faulks v. Kamp*, 17 Blatch., 432.

§ 6331. A warranty of title or right draws to it any after-acquired right or title of the warrantor, and carries it to the benefit of the person to whom the warranty runs. *Ibid.*

§ 6332. So where the defendants assigned the patent and afterward acquired a prior patent, whatever right, if any, they acquired to the invention by such patent inured directly to the benefit of the assignee. *Ibid.*

See *Commissioner*, § 1113.

§ 6333. A question of title raised by demurrer cannot be disposed of by amendment. *Shaw Relief Valve Co. v. City of New Bedford*, 19 Fed. Rep., 753.

366. TRIAL OUT OF EQUITY.

Trial out of equity — *Lies in the discretion of the court*, §§ 6334-6338. *When granted*, §§ 6339, 6340. *Findings are not conclusive*, §§ 6341-6343. *When verdict will be set aside*, § 6344. *Practice*, §§ 6345, 6346. *Particular cases*, §§ 6347-6349.

§ 6334. Allowance of a jury trial to settle the question of infringement out of equity is a matter of sound discretion with the court and not one of right. *Brooks v. Norcross*, 2 Fish., 661.

§ 6335. A jury trial out of equity lies in the discretion of the court. *Ely v. Monson & Brimfield Mfg. Co.*, 4 Fish., 64.

§ 6336. Where it is discretionary with a court of equity whether it will first send a case to be tried at law, and it exercises its discretion to decide the case upon its merits without the aid of a jury of any sort, such action is not a ground of appeal. *Cochrane v. Deener*, 4 Otto, 781.

§ 6337. But if the appellate court were convinced that the case was not properly decided, and could not be properly decided without such a reference, it might, in the exercise of its own discretion, remand it to the court below for that purpose. *Ibid.*

§ 6338. Upon a bill in equity for the infringement of a patent it is a matter of discretion, and not of jurisdiction, whether a case shall be first tried at law; and in this matter the courts of the United States, sitting as courts of equity in patent cases, are much less disposed than the English courts are to send parties to a jury before assuming to decide upon the merits. *Ibid.*

§ 6339. Feigned issue out of chancery is not granted as a matter of course; it will not be granted on an old patent, long in use and established by decisions. *Van Hook v. Pendleton*, 1 Blatch., 187.

§ 6340. If the conscience of the court is in such doubt as to need the verdict of a jury, it will obtain it; but it cannot be on account of a request by a party or on a question of infringement involving law as well as fact. *Brooks v. Norcross*, 2 Fish., 661.

§ 6341. A verdict upon an issue ordered by a court of equity is not final. *Allen v. Blunt*, 3 Story, 742.

§ 6342. The finding of a jury out of equity is not conclusive; it only aids the court. *Ely v. Monson & Brimfield Mfg. Co.*, 4 Fish., 64.

§ 6343. The verdict of a jury upon an issue out of chancery is only advisory, and never conclusive upon the court. It is intended to inform the conscience of the chancellor, and may be disregarded and a decree rendered contrary to it. *Watt v. Starke*, 17 O. G., 1092.

§ 6344. Verdict of a jury on an issue out of chancery will not be set aside, unless the preponderance of evidence against it is great. *Brooks v. Bicknell*, 4 McL., 70.

§ 6345. Rules as to issues directed out of chancery. *Ibid.*

§ 6346. On an issue out of chancery to try the validity of patent, the proper notices of persons and place where the patented article was before used must be set out. *Orr v. Merrill*, 1 W. & M., 376.

§ 6347. After a verdict for plaintiff, refusal of a new trial, on bill for perpetual injunction, answer and ratification, defendants were allowed to amend answer, and a feigned issue was granted to try novelty of plaintiff's invention in view of newly discovered evidence. *Foote v. Silsby*, 1 Blatch., 545.

§ 6348. Where the case has been set down for final hearing without motion or order for a trial at law, and the opinion of the court is so formed as not to be affected by the verdict, and a long delay would be involved, the court refused to exercise its discretion in ordering such trial before granting an injunction. *Goodyear v. Day*, 2 Wall. Jr., 283.

§ 6349. Where it appeared that a trial at law and a hearing in equity had already been had, and that both had resulted favorably to complainant's patent, a motion to bring an action at law to determine the several matters involved in the suit was overruled. *Howe v. Williams*, 2 Cliff., 245.

367. TRIAL AT LAW, INJUNCTION, PRIOR.

See INJUNCTION, PRIOR, TRIAL AT LAW.

368. TRIAL, NEW.

See NEW TRIAL.

369. TRIPLE DAMAGES.

See DAMAGES, TRIPLE.

370. TRUSTEE.

§ 6350. The conveyance of a patent to a trustee in trust vests the legal title in him. *Campbell v. James*, 17 Blatch., 42.

See *Attorney*, §§ 577, 578. *Assignee*, § 543. *Contracts*, § 1315. *Damages and Profits*, §§ 1558, 1702. *Employer and Employee*, § 2099. *Infringer*, §§ 2993, 2994. *Jurisdiction*, §§ 3913, 3956. *Title*, §§ 6317, 6318, 6320, 6321.

371. UNSUCCESSFUL EXPERIMENT.

See EXPERIMENT.

372. UNRESTRICTED SALE OF PATENTED ARTICLES.

See SALE, OF PATENTED ARTICLES, UNRESTRICTED.

373. USE.

See EXTENSION, USE UNDER. RECOVERY, FOR PRIOR USE.

Use — Analogous.

SUMMARY (PENNSYLVANIA R. CO. *v.* LOCOMOTIVE ENGINE SAFETY TRUCK CO., § 6351) — *Analogous use*, § 6351.PENNSYLVANIA RAILROAD COMPANY *v.* LOCOMOTIVE ENGINE SAFETY TRUCK COMPANY.

(110 U. S., 490-498; 27 Official Gazette, 207. 1884.)

APPEAL from U. S. Circuit Court, Eastern District of Pennsylvania.

Opinion by MR. JUSTICE GRAY.

STATEMENT OF FACTS.—This is an appeal by the defendant below, from a decree against it, upon a bill in equity for the infringement of letters patent [No. 34,377], granted on February 11, 1862, to Alba F. Smith for an improvement in trucks for locomotive-engines, the specification annexed to which, except the drawings and the letters referring to them, and the formal beginning and conclusion, was as follows:

“Several laterally-moving trucks have heretofore been made and applied to railroad cars. My invention does not relate broadly to such laterally-moving trucks, but my said invention consists in the employment, in a locomotive-engine, of a truck or pilot wheels provided with pendent links, to allow of a lateral movement, so that the driving-wheels of the locomotive-engine continue to move correctly on a curved track in consequence of the lateral movement allowed by said pendent links, the forward parts of the engine traveling as a tangent to the curve, while the axles of the drivers are parallel, or nearly so, to the radial line of the curve. In the drawing I have represented my improved truck itself. The mode of applying the same to any ordinary locomotive-engine will be apparent to any competent mechanic, as my truck can be fitted in the place of those already constructed, or the same may be altered to include my improvement.”

The specification then refers to the drawings, showing the wheels, the axles and the frame of any ordinary locomotive-truck, made in any usual manner, with the center cross-bearing plate or platform of two thicknesses of iron plate riveted together, strengthened by cross-bars beneath, and embracing at its ends the upper bars of the frame, a bolster made of a flanged bar, the king-bolt passing through the center of the bolster, and also through an elongated opening in the plate, so as to allow of lateral motion to the truck beneath the bolster, and at the same time becoming a connection to hold the truck to the engine, the bolster taking the weight of the engine in the middle, and itself suspended at the ends of bars attached to the moving ends of pendent links attached by bolts at their upper ends to brackets on the frame, and the distance between the bars, transversely of the truck, slightly more than between the bolts, so that the pendent links diverge slightly. The specification then proceeds:

“When running upon a straight road, the engine preserves great steadiness, because any change of position transversely of the track, in consequence of the engine moving over the truck or the truck beneath the engine, is checked by the weight of the engine hanging upon the links, and in consequence of

their divergence any side movement causes the links on the side toward which the movement occurs to assume a more inclined position, while the other links come vertical, or nearly so. Hence the weight of the engine acts with a leverage upon the most inclined links, to bring them into the same angle as the others, greatly promoting the steadiness of the engine in running on a straight line. As the pilot or truck wheels enter a curve, a sidewise movement is given to the truck, in consequence of the engine and drivers continuing to travel as a tangent to the curve of the track. This movement and the slight turn of the whole truck on the king-bolt not only causes the wheels to travel correctly on the track, with their axles parallel to the radial line of the curve of track, but also elevates the outer side of the engine, preventing any tendency to run off the track upon the outer side of the curve. Upon entering a straight track the truck again assumes the central position, and in case of irregularity in the track or any obstruction the truck moves laterally without disturbing the movement of the engine.

“I do not claim laterally-moving trucks, nor pendent links, separately considered, but what I claim and desire to secure by letters patent is the employment, in a locomotive-engine, of a truck or pilot-wheels fitted with the pendent links, to allow of lateral motion to the engine, as specified, whereby the drivers of said engine are allowed to remain correctly on the track, in consequence of the lateral motion of the truck allowed for by said pendent links when running on a curve, as set forth.”

The invention, then, as claimed, is for the combination, with a locomotive-engine, of a truck, of which the king-bolt, forming the connection to hold the truck to the engine, passes through a bolster and through an elongated opening in the plate or platform of the truck, so as to allow the truck to have a lateral motion beneath the bolster, and the bolster takes the weight of the engine in the middle, and is suspended from the frame of the truck by pendent and slightly-divergent links, so that any movement of the engine or truck sidewise, as in entering upon or passing over a curve of the track, causes the links on the side toward which the engine moves to assume a more inclined position, and the other links to become nearly vertical, and the weight of the engine hanging upon the links checks its own lateral movement and tends to bring both sets of links back to their original angle. In railroad cars the trucks were allowed to swivel around the king-bolt before 1841. The transverse slot and pendent links, allowing a lateral motion, were used by Davenport and Bridges in 1841. In 1859 Kipple and Bullock made the pendent links divergent, and at the time of Smith's invention the trucks of railroad cars had all the elements of the truck put by him under the front of a locomotive-engine. The question, therefore, is whether employing as the forward truck of a locomotive-engine with fixed driving-wheels a truck already in use on railroad-cars has the novelty requisite to sustain a patent.

After carefully considering the evidence and arguments in this case and the reasons assigned for sustaining Smith's patent, in the opinion of the court below, reported in 1 Ban. & Ard., 470, and in the opinion rendered by the circuit court in the second circuit in *Locomotive Engine Safety Truck Co. v. Erie Railway Co.*, reported in 6 Fish. Pat. Cas., 187, and in 10 Blatchford, 292, this court finds itself unable to escape from the conclusion that the application of the old truck to a locomotive-engine neither is a new use nor does it produce a new result.

In both engine and car the increased friction against the rails and the danger of being thrown off the track in entering upon or passing along a curve are due to the impulse of forward motion in a direction tangential to the curve and to the influence of centrifugal force. In the engine, as in the car, the object and the effect of the transverse slot allowing a slight lateral motion, and of the divergent pendent links by means of which the weight of the engine or car itself helps to keep it upon the track, are to secure steadiness and safety by lessening the friction against the rails and the danger of being thrown off the track. The only difference is that, by reason of the fixed position of the driving-wheels of the engine, the truck, which has before been applied at each end of a car can only be applied at the forward end of the engine, and therefore the accommodation of the movement of the engine to the curve of the track may be less complete than in the case of the car. The effect of the invention upon the engine as compared with its effect upon the car is the same in kind, though perhaps less in degree.

§ 6351. *The application of an old process or machine to a similar or analogous subject, with no change in the manner of applying it, and no result substantially distinct in its nature, will not sustain a patent, even if the new form of result has not before been contemplated.*

It is settled by many decisions of this court, which it is unnecessary to quote from or refer to in detail, that the application of an old process or machine to a similar or analogous subject, with no change in the manner of application, and no result substantially distinct in its nature, will not sustain a patent, even if the new form of result has not before been contemplated. *Hotchkiss v. Greenwood*, 11 How., 248; *Phillips v. Page*, 24 How., 164, 167; *Jones v. Morehead*, 1 Wall., 155, overruling S. C., nom.; *Livingston v. Jones*, 1 Fish. Pat. Cas., 521; *Hicks v. Kelsey*, 18 Wall., 670; *Smith v. Nichols*, 21 Wall., 112; *Brown v. Piper*, 91 U. S., 37 (§§ 6354-57, *infra*); *Roberts v. Ryer*, 91 U. S., 150; *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S., 274, 276 (§§ 807-10, *supra*); *Planing Machine Co. v. Keith*, 101 U. S., 479, 491; *Pearce v. Mulford*, 102 U. S., 112; *Heald v. Rice*, 104 U. S., 737, 754-756; *Atlantic Works v. Brady*, 107 U. S., 192.

In the well known case of *Crane v. Price*, in which the English court of common pleas upheld a patent for using anthracite instead of bituminous coal with the hot-blast in smelting iron ore, the evidence, as Chief Justice Tindal remarked, proved beyond doubt that in the result of the combination of the hot-air blast with the anthracite not only was the yield of the furnace more and the expense of making the iron less, but "the nature, properties and quality of the iron were better" than under the former process, by means of the combination of the hot-air blast with bituminous coal. 4 Man. & Gr., 580, 604; 5 Scott, N. R., 388, 389; 1 Webster, Pat. Cas., 393, 410. And the decision rests, as was pointed out by Chief Baron Pollock and Baron Parke, in *Dobbs v. Penn*, 3 Exch., 427, 432, 433, and by Mr. Justice Bradley in *Hicks v. Kelsey*, above cited, upon the ground that a new metal or composition of matter was produced. As observed by Mr. Justice Bradley: "In compositions of matter a different ingredient changes the nature of the compound; whereas, an iron bar in place of a wooden one, and subserving the same purpose, does not change the identity of a machine." 18 Wall., 674.

So in *Smith v. Goodyear Dental Vulcanite Co.*, in this court, as was observed by Mr. Justice Strong in delivering its judgment: "A new product was the

result, differing from all that had preceded it, not merely in degree of usefulness and excellence, but differing in kind, having new uses and properties. 93 U. S., 486, 494." See, also, *Goodyear Dental Vulcanite Co. v. Davis*, 102 U. S., 222.

Upon the principles which must govern this case, the decisions of this court and of the highest courts of England are in full accord, as will appear by referring to three cases, fully argued and considered, all of which were carried to the exchequer chamber, and two of which were finally decided in the house of lords. In *Bush v. Fox* a patent for constructing the interior of a caisson or cylinder with successive chambers to work in, "in such manner that the work-people may be supplied with compressed air, and be able to raise the material excavated, and to make or construct foundations and buildings," under water, when a similar apparatus had already been used for working underground on land, was held by Chief Baron Pollock, by the court of exchequer chamber, and by the house of lords, to be void for want of novelty, after able arguments in support of the patent by Sir Alexander Cockburn, then attorney-general, and by Mr. Webster, the accomplished patent counsel, at the successive stages of the case. *Macrory*, Pat. Cas., 152, 167, 179; 9 Exch., 651; 5 H. L. Cas., 707.

So the court of queen's bench held that the finishing of yarns of wool or hair by a process previously applied to yarns of cotton and linen, by subjecting them, while distended and kept separate, to the action of rotatory beaters or burnishers, by which they would be burnished or polished on all sides, was not the subject of a patent, because, as Lord Campbell said, in order to sustain a patent for the application of an old process to a new purpose, "there must be some invention in the manner in which the old process is applied." "Here there is no novelty in the mode of application," "but merely the application of a known process by a known means to another substance." *Brook v. Aston*, 27 Law Journal (N. S.), Q. B., 145; S. C., 4 Jurist (N. S.), 279; S. C., with the opinion less fully reported, 8 E. & B., 478. The judgment was unanimously affirmed in the exchequer chamber. Of the opinions there delivered it is sufficient to quote from that of Baron Martin, who, after expressing his concurrence in the statement of Mr. Justice Willes in *Patent Bottle Envelope Co. v. Seymer*, 28 Law Journal (N. S.), C. P., 22, 24; S. C., 5 C. B. (N. S.), 164, 173, that "the application of a well-known tool to work previously untried materials or to produce new forms is not the subject of a patent," added, "when a machine is well known, it becomes in fact a tool." 28 Law Journal (N. S.), Q. B., 175, 176; 5 Jurist (N. S.), 1025, 1027.

But perhaps the most important English case is that of *Harwood v. Great Northern R'y Co.*, 2 B. & S., 194, 222, and 11 H. L. Cas., 654. In that case a patent was obtained for "improvements in fishes and fish-joints for connecting the rails of railways." In the specification the patentee stated that in securing the joints of rails it had been found advantageous to attach to each side of the rails, by means of bolts and rivets, pieces of iron commonly called "fishes," and described his invention as consisting in making the fishes with a groove or recess in their outer surfaces, so as to receive the square heads of the bolts or rivets, and to prevent them from turning round while the nuts on the other side were being screwed on or off, and also to avoid the danger of the flanges of the wheels of the carriages striking against the heads; and he claimed "the constructing fishes for connecting the rails of railways with a

groove adapted for receiving the heads of the bolts or rivets employed for securing such fishes, and the application of such fishes for connecting the rails of railways."

In an action for the infringement of that patent it appeared that fishes for connecting the rails of railways had never before been made with a groove or recess in their outer surfaces, so as to receive the square heads of the bolts; but it was proved that in the construction of several railway bridges, beams of timber had been laid horizontally one above the other, and fastened or bolted together with bolts and nuts, horizontal bars or plates of iron placed beneath, parallel to and in contact with the beams, and fastened or bolted by the same bolts and nuts, and each of these bars or plates of iron constructed with a groove in its under surface, which received the square heads of the bolts, and which served the double purpose of strength and of preventing the heads of the bolts from turning round. In those bridges there were no joints to be fished by the bars or plates of iron, nor were there corresponding bars or plates of iron above the horizontal beams of timber. But it was also proved that a bridge, known as the "Hackney bridge," having too great a span to be conveniently crossed by a single beam, had been constructed with two horizontal longitudinal beams of timber on each side, the ends of which met and were joined together in the middle of the bridge by scarf-joints; that beneath those beams were transverse planks, constituting the flooring of the bridge; and beneath the planks were bars of grooved iron, like those used in the other bridges, carried under the scarf-joints and under the whole length of the horizontal beams; that above and immediately over each scarf-joint, extending eighteen inches beyond each end of the joint, and resting immediately upon the longitudinal beam, was a horizontal flat plate of iron thirteen feet in length, and that the bolts passed upward through the grooved iron bars, the transverse planking, and the longitudinal beams, and also, at the middle of the bridge, through the plates of iron over the scarf-joints. A verdict supporting the patent was obtained under the rulings of Lord Chief Justice Cockburn and affirmed by the court of queen's bench; but its judgment was unanimously reversed in the exchequer chamber in a considered judgment delivered by Mr. Justice Willes, and the judgment of reversal was affirmed by the house of lords in accordance with the opinions of Lord Chancellor Westbury, Lord Cranworth and Lord Wensleydale, and of a majority of the judges who attended, upon the ground, as stated by the lord chancellor, that the application of the channeled iron horizontally under the timbers of a bridge being well known, "the channeled iron was applied in a manner which was notorious, and the application of it to a vertical fish would be no more than the application of a well known contrivance to a purpose exactly analogous or corresponding to the purpose to which it had been previously applied." 11 H. L. Cas., 683. And all who gave opinions in the house of lords concurred with the court of exchequer chamber in the proposition of law that the mere application of an old contrivance in an old way to an analogous subject, without any novelty in the mode of applying such old contrivance to the new purpose, is not a valid subject-matter of a patent. 2 B. & S., 228; 11 H. L. Cas., 666, 672, 682, 684, 685.

In the case at bar the old contrivance of a railroad-truck, with the swiveling king-bolt, transverse slot, and pendent divergent links, already in use under railroad cars, is applied in the old way, without any novelty in the mode of

applying it, to the analogous purpose of forming the forward truck of a locomotive-engine. This application is not a new invention, and therefore not a valid subject of a patent.

The decree of the circuit court must therefore be reversed, and the case remanded, with directions to dismiss the bill.

§ 6352. Where the particular position of machinery claimed is not new, but has existed before in other somewhat different machines, where it was applied to analogous purposes, the objection is fatal. *Moody v. Fiske*, 2 Mason, 112.

§ 6353. A mere analogous use is not patentable; but when a new or improved manufacture is produced by new contrivances, combinations or arrangements, a new principle may be constituted, and the application or practice of old things will of course be new also. *In re Smith*, 1 MacA. Pat. Cases, 255.

See *Invention*, §§ 3519-3524, 3600-3605.

Use — Double.

SUMMARY (*BROWN v. PIPER*, §§ 6354-6357) — *Double use; patentability*, § 6354. — *State of the art; admissibility in evidence, without notice*, § 6355. — *Judicial notice*, §§ 6356, 6357.

BROWN v. PIPER.

(1 Otto, 37-44. 1875.)

APPEAL from U. S. Circuit Court, District of Massachusetts.

Opinion by Mr. JUSTICE SWAYNE.

STATEMENT OF FACTS.—The bill is founded upon two patents granted by the United States to the appellee,—one numbered 732 [now numbered 31,736], of the 19th of March, 1861; the other numbered 36,107, and dated August 5, 1862. The second and later patent was not relied upon in the argument here, and may, therefore, be laid out of view. Our attention will be confined to the prior one. It is declared in the specification to be “for a new and improved method of preserving fish and meats.” The invention is alleged to consist “in a method of preserving fish and other articles in a chamber, and cooling the latter by means of a freezing mixture, so applied that no communication shall exist between the interior of the preserving chamber and that of the vessels in which the freezing mixture is placed.” The specification continues: “I do not profess to have invented the means of artificial congelation, nor to have discovered the fact that no decay takes place in animal substances so long as they are kept a few degrees below the freezing point of water; but the practical application of them to the art of preserving fish and meats, as above described, is a new and very valuable improvement. The apparatus for freezing fish and keeping them in a frozen state may be constructed in various ways and of different shapes. The apparatus shown in the drawing, however, will suffice to illustrate the principle and mode of operation.”

The process and apparatus are then described as follows: A box of wood or other suitable material, surrounded by a packing of charcoal or other non-conducting substance, is to be provided, and the fish in small quantities laid in it on a rack. Metallic pans filled with a freezing mixture, such as salt and ice, are then to be set over them, and a cover shut over the pans. “In about twenty-four hours, the freezing mixture having been changed once in twelve hours, the fish will be frozen completely through.” After being frozen, the fish or meat may, if desired, be covered with a thin coating of ice; and this coating may be preserved by applying the substances named, which will exclude the air, and prevent the juices from escaping by evaporation. “The

fish are then *to be packed closely* in a large preserving box, which is inclosed in a still larger box; the space between the boxes being filled with charcoal or other non-conducting material, to exclude the heat." Other minor details are described, which it is not deemed material to repeat. The patentee then declares: "I do not desire to be understood as confining myself to the specific apparatus above described, nor to the use of either or both the preliminary processes of freezing and cooling; but I have described the mode of operation, which, by experience, I have found best for preserving the most delicate varieties of fish." The summation and claim are: "Having described my invention, what I claim as new, and desire to secure by letters patent, is, *preserving fish or other articles in a close chamber by means of a freezing mixture, having no contact with the atmosphere of the preserving chamber, substantially as set forth.*"

The patent is not for the principle long and well known to physicists, that a low degree of cold, like a high degree of heat, prevents the decay of animal matter; nor is it for the freezing of the articles to be preserved before or after they are placed in the preserving chamber; nor is it for applying, by means of an apparatus with any particular details of construction, cold to the articles to be preserved; nor is it for the frigorific effect of the freezing mixture upon the atmosphere of the inner chamber; but it is for the application to such articles of the degree of cold necessary to preserve them, by means of "a close chamber," in which they are to be placed, and "a freezing mixture, having no communication with the atmosphere of the preserving chamber."

If this result be reached by the means designated in any way substantially the same with that described, having the feature of the non-contact of the freezing mixture with the air of the preserving chamber, there is a clear invasion of the territory which the patentee has marked out and seeks to appropriate to himself.

It was earnestly maintained by the learned counsel for the appellee that the essence of the invention is the creation of "a freezing atmosphere" in the preserving chamber. To this there are several answers. There is nothing in the specification or claim to warrant the proposition. The direction is that "the fish are to be packed closely." This implies clearly that as many fish are to be put into the preserving chamber as it can be made to contain.

Atmospheric air is itself an agent of decay; and in all such cases it is important to preclude as far as possible its presence and contact. "If air be absolutely excluded, putrefaction ceases; and the result is the preservation of the substance in some circumstances, perhaps in all." 3 Ure's Dict. of Arts, 548. "On this principle is founded Appert's process, by which easily decomposable articles of food and drink, such as meat, fish, vegetables, milk, etc., are preserved for years; viz., by packing them in air-tight bottles or soldered tin cans, heating the vessels for several hours in boiling water, and keeping them carefully closed." 2 Watts' Dict. of Chem., 625. The patentee is to be presumed to have known this property of air.

The patent is for "a new and useful improvement" in the art to which it relates. It was issued under the act of July 4, 1836. The rights of the parties are to be considered in the light of that act. The defense relied upon in the answer is the want of novelty; and several instances of prior use and knowledge, with the requisite circumstances of time, place and persons, are alleged.

We deem it sufficient to consider one of them. On the 17th of August,

1842, a patent was issued to John Good "for a corpse preserver." The apparatus, as described, was an outer case with a close-fitting lid. The case was made double; there being a partition to within four or five inches, more or less, of the top of the outer one, leaving a space between the two of several inches, which was to be filled with ice. There was a false bottom with holes in it in the inner compartment. It rested upon ledges, which kept it four or five inches above the bottom. The intervening space was a receptacle for ice. The corpse was deposited upon the false bottom. A tray was placed over it, and under the lid. The tray was four or five inches deep, used to contain the freezing mixture, and had a flange to prevent the mixture from escaping. Proper outlets were provided for the passage of the water from the melting ice. There was no communication between the tray containing the freezing mixture and the inner compartment containing the body. Swartz, an intelligent and unimpeached witness, was examined on the 15th of October, 1869. He testified that he was an undertaker, and had used the apparatus for about twenty years, sometimes with ice under the false bottom, and sometimes without it. In either case he applied a sufficient degree of cold to prevent putrefaction before interment. He thought the bodies were sometimes frozen, but was not certain. The material point in his business was the prevention of decay for the time being; and that was always accomplished.

Here was the application of the requisite degree of cold exactly in the manner called for in the specification of the appellee. This is hardly denied; but it is insisted that the process was never applied by the witness to the preservation of fish and meats.

§ 6354. *The application of an old process to a new subject, without any exercise of the inventive faculty, or the development of any idea which can be deemed new or original in the sense of the patent law, is not patentable.*

The answer is, that this was simply the application by the patentee of an old process to a new subject, without any exercise of the inventive faculty, and without the development of any idea which can be deemed new or original in the sense of the patent law. The thing was within the circle of what was well known before, and belonged to the public. No one could lawfully appropriate it to himself, and exclude others from using it in any usual way for any purpose to which it may be desired to apply it. This is fatal to the patent. *Ames v. Howard*, 1 Sumn., 487; *Howe v. Abbot*, 2 Story, 194; *Bean v. Smalwood*, id., 411; *Winans v. B. & P. R. R.*, id., 412; *Hotchkiss v. Greenwood*, 11 How., 248.

§ 6355. *Evidence of the state of the art (which consists of proof of what was old and in general use at the time of the alleged invention) is admissible in actions at law under the general issue, without special notice, and in equity cases without any averment in the answer touching the subject.*

There is another view of the case that may properly be taken. Evidence of the state of the art is admissible in actions at law under the general issue without a special notice, and in equity cases without any averment in the answer touching the subject. It consists of proof of what was old and in general use at the time of the alleged invention. It is received for three purposes, and none other,—to show what was then old, to distinguish what was new, and to aid the court in the construction of the patent.

§ 6356. *Things of which the court will take judicial notice enumerated and defined.*

Of private and special facts, in trials in equity and at law, the court or jury,

as the case may be, is bound carefully to exclude the influence of all previous knowledge. But there are many things of which judicial cognizance may be taken. "To require proof of every fact, as that Calais is beyond the jurisdiction of the court, would be utterly and absolutely absurd." *Gresley's Ev. in Eq.*, 294. Facts of universal notoriety need not be proved. See *Taylor's Ev.*, sec. 4, note 2. Among the things of which judicial notice is taken are the law of nations; the general customs and usages of merchants; the notary's seal; things which must happen according to the laws of nature; the coincidences of the days of the week with those of the month; the meaning of words in the vernacular language; the customary abbreviations of christian names; the accession of the chief magistrate to office, and his leaving it. In this country, such notice is taken of the appointment of members of the cabinet, the election and resignations of senators, and of the appointment of marshals and sheriffs, but not of their deputies. The courts of the United States take judicial notice of the ports and waters of the United States where the tide ebbs and flows, of the boundaries of the several states and judicial districts, and of the laws and jurisprudence of the several states in which they exercise jurisdiction.

§ 6357. *Courts will take judicial notice of whatever is generally known and used within their jurisdiction.*

Courts will take notice of whatever is generally known within the limits of their jurisdiction; and, if the judge's memory is at fault, he may refresh it by resorting to any means for that purpose which he may deem safe and proper. This extends to such matters of science as are involved in the cases brought before him. See 1 *Greenleaf's Ev.*, 11; *Gresley's Ev.*, *supra*; and *Taylor's Ev.*, sec. 4 and *post*. In *The Ohio L. & T. Co. v. Debolt*, 16 How., 435, it was said to be "a matter of public history, which this court cannot refuse to notice, that almost every bill for the incorporation of companies" of the classes named is prepared and passed under the circumstances stated. In *Hoare v. Silverlock*, 12 Ad. & Ell., N. S., 624, it was held that where a libel charged that the friends of the plaintiff had "realized the fable of the frozen snake," the court would take notice that the knowledge of that fable existed generally in society. This power is to be exercised by courts with caution. Care must be taken that the requisite notoriety exists. Every reasonable doubt upon the subject should be resolved promptly in the negative.

The pleadings and proofs in the case under consideration are silent as to the ice-cream freezer. But it is a thing in the common knowledge and use of the people throughout the country. Notice and proof were, therefore, unnecessary. The statute requiring notice was not intended to apply in such cases. The court can take judicial notice of it, and give it the same effect as if it had been set up as a defense in the answer and the proof were plenary. See *M. & A. Glue Co. v. Upton*, 6 Patent Off. Gaz., 843, and *Needham v. Washburn*, 7 id., 651,—both decided by Mr. Justice Clifford upon the circuit. We can see no substantial diversity between that apparatus and the alleged invention of the appellee. In the former, as in the apparatus of the appellee, "the freezing mixture" has "no contact with the atmosphere" of the chamber where the work is to be done. If the freezer be full, and the preserving chamber be full, there would be room for but little air in either. If either were only partially full, the vacuum would be filled with that substance. The cold is generated by the same materials and applied under the same circumstances. If the cream were taken out of the freezer and fish put in, there would be, in all substantial respects, the same apparatus, process and result. If the preserving

chamber were as tight as the freezer, either might be convertibly used for the purpose of the other.

“The preservative effect of cold, and especially of dry cold, is well known and exemplified in the keeping of meat and fruit in ice-houses. Animals have been found undecomposed in the ice of Siberia which belong to extinct species, and which must have been embalmed in ice for ages.” Tit. “Antiseptic,” 1 Amer. Encyclo., 570.

Artificial freezing is usually applied to water and articles of food. “There are two general methods of effecting it, viz.: by liquefaction and by vaporization and expansion. The method by liquefaction is performed by freezing mixtures, which are formed by mixing together two or more bodies, one or all of which may be solid. They are used together in vessels having three or more concentric apartments,—an inner one, containing the article to be frozen; one eccentric to this, containing the freezing mixture, provided with some contrivance for agitation; one, again, outside of this, filled with a non-conductor of heat, as powdered charcoal, gypsum or cotton wood; and sometimes one between them for holding water.” Tit. “Freezing,” 7 Amer. Encyclo., 474.

Here the principle and substance of the appellee’s claim are set forth as belonging to the general domain of knowledge and science. It is known that Lord Bacon applied snow to poultry to preserve it. He said the process succeeded “excellently well.” The experiment was made in his old age, imprudently, and brought on his last illness. Examined by the light of these considerations, we think this patent was void on its face, and that the court might have stopped short at that instrument, and without looking beyond it into the answers and testimony, *sua sponte*, if the objection were not taken by counsel, well have adjudged in favor of the defendant. These views render it unnecessary to consider the exceptions to the master’s report.

The decree of the circuit court is reversed, and the cause will be remanded with directions to dismiss the bill. (a)

Use — Double — Defined, §§ 6358, 6359. *Is not patentable,* §§ 6360-6377. See *Patentability*, §§ 4551-4559.

§ 6358. What is and what is not double use. *Strong v. Noble*, 6 Blatch., 477.

§ 6359. An invention must involve a new principle. When the principle of the alleged invention has been discovered and applied before, the new application of it will be what is called a double use. In such cases, although there may be in the new application some degree of novelty — something may have been discovered or found out that was not known before — yet, unless the new occasion on which the principle is applied leads to some kind of new manufacture or to some new result, it will be but a double use. *In re Blandy*, 1 MacA. Pat. Cases, 552.

§ 6360. Mere application of an old device to a new use is not patentable. *Gallahue v. Butterfield*, 10 Blatch., 232; *Hawes v. Washburn*, 5 O. G., 491; *Ames v. Howard*, 1 Sumn., 482; *Teese v. Phelps*, 1 McAl., 48; *Roberts v. Ryer*, 1 Otto, 150; *Beane v. Smallwood*, 2 Story, 409.

§ 6361. The mere application of an existing machine or organization to a new use is not the subject-matter of a patent. *Conover v. Roach*, 4 Fish., 12; *Phillips v. Page*, 24 How., 164.

§ 6362. The application of an ordinary power to an ordinary purpose is not an invention within the meaning of the patent law. *Cochrane v. Waterman*, 1 MacA. Pat. Cases, 52.

§ 6363. Mere use of a mechanical structure for a different purpose is not of itself patentable. *Judson v. Moore*, 1 Bond, 285.

§ 6364. The application of an old machine to a new use, or to a new purpose, or the application of an old process to a new result, is not a patentable invention. *Bray v. Hartshorn*, 1 Cliff., 538.

(a) The above disposes, also, of *Piper v. Moon*, 1 Otto, 44.

§ 6365. The application of old devices to a new use, where it involves no new means and produces no new effects, is not patentable, although it may be useful to combine two results by uniting two instrumentalities. *Sawyer v. Bixby*, 9 Blatch., 361.

§ 6366. The application of an old fabric to a new use, requiring nothing new to adapt it, is not invention. *Smith v. Elliott*, 9 Blatch., 400.

§ 6367. If the effect of the old contrivance, when applied to the new object, is simply a better and therefore more useful accomplishment of the old effect, in an analogous object, by the use of precisely the same means, the application of the new use is not patentable. *In re Arkel*, 15 Blatch., 437.

§ 6368. A new use or application of a material or composition previously known is not invention. *Matthews v. Skates*, 1 Fish., 602.

§ 6369. A composition having been described in a prior patent, one who applies it to a new use cannot claim the composition as his invention. *United States & Foreign Salamander Felt-ing Co. v. Haven*, 3 Dill., 131.

§ 6370. A patent cannot be sustained where old and known methods and elements are used, and the novelty consists only in the use of a new material, although producing a better and cheaper article. *Hotchkiss v. Greenwood*, 11 How., 248.

§ 6371. The application of an old process to manufacture an article to which it has never before been applied is not patentable invention. *Howe v. Abbott*, 2 Story, 191.

§ 6372. The mere carrying forward, or new or more extended application, of the original thought, a change only in forms, proportions or degree, doing substantially the same thing in the same way, by substantially the same means, with better results, is not such an invention as will sustain a patent. *Roberts v. Ryer*, 1 Otto, 150.

§ 6373. The adoption for the fastening and laying of metallic shingles of the means which had always been employed for laying and fastening wooden shingles is an application of old instrumentalities to a new but cognate use, which did not involve original thought or inventive skill. *American Iron Co. v. Anglo-American Roofing Co.*, 16 Fed. Rep., 915.

§ 6374. Where the change consists merely in the employment of an obvious substitute, the discovery and application of which could not have involved the exercise of the inventive faculty in any considerable degree, the change will then be treated as merely an unsubstantial colorable variation, or a double use. *Stephens v. Salisbury*, 1 MacA. Pat. Cases, 379; *In re Everson*, 1 MacA. Pat. Cases, 406.

§ 6375. To defeat a patent on the ground of double use, it must be shown that the process described in the specification was known before, and had been applied in the same way to some analogous purpose. *Roberts v. Dickey*, 4 Brewster, 260.

§ 6376. It does not constitute patentable novelty to put an additional lock on a door, where one had been used before; it is mere double use. *Yale Lock Mfg. Co. v. Berkshire Nat. Bank*, 17 Fed. Rep., 531.

§ 6377. The application to a portable steam-engine of a hollow bed-plate fastened to the boiler, and supporting the operative parts of the engine out of contact with the boiler, whereby these parts will not be affected by the expansion and contraction of the boiler, *held*, not to be a patentable invention, in view of the fact that similar bed-plates had previously been used in various parts of the engine for a similar purpose. It is an obvious application, and a mere double use of an old device. *In re Blandy*, 1 MacA. Pat. Cases, 552.

See *Claims, Construction of*, § 791. *Invention*, §§ 3519-3524, 3600-3605.

Use — Experimental public.

SUMMARY (*ELIZABETH v. PAVEMENT CO.*, §§ 6378-6386).—*Foreign patent is a publication*, § 6378.—*Public experimental use*, § 6379.—*What is an abandonment*, § 6380.—*Public use that works an abandonment*, § 6381.—*Public knowledge and public use distinguished*, § 6382.—*General rules; profits recoverable in equity*, § 6383.—*Liability of contractor for infringement*, § 6384.—*Liability of infringer for profits*, § 6385.—*Royalty not a measure of damages in this case*, § 6386.

ELIZABETH v. PAVEMENT COMPANY.

(7 Otto, 126-144. 1877.)

APPEAL from U. S. Circuit Court, District of New Jersey.

Opinion by MR. JUSTICE BRADLEY.

STATEMENT OF FACTS.—This suit was brought by the American Nicholson Pavement Company against the city of Elizabeth, N. J., George W. Tubbs,

and the New Jersey Wood-paving Company, a corporation of New Jersey, upon a patent issued to Samuel Nicholson, dated August 20, 1867, for a new and improved wooden pavement, being a second reissue of a patent issued to said Nicholson August 8, 1854. The reissued patent was extended in 1868 for a further term of seven years. A copy of it is appended to the bill; and, in the specification, it is declared that the nature and object of the invention consists in providing a process or mode of constructing wooden block pavements upon a foundation along a street or roadway with facility, cheapness, and accuracy, and also in the creation and construction of such a wooden pavement as shall be comparatively permanent and durable, by so uniting and combining all its parts, both superstructure and foundation, as to provide against the slipping of the horses' feet, against noise, against unequal wear, and against rot and, consequent sinking away from below. Two plans of making this pavement are specified. Both require a proper foundation on which to lay the blocks, consisting of tarred-paper or hydraulic cement covering the surface of the road-bed to the depth of about two inches, or of a flooring of boards or plank, also covered with tar, or other preventive of moisture. On this foundation, one plan is to set square blocks on end arranged like a checker-board, the alternate rows being shorter than the others, so as to leave narrow grooves or channel-ways to be filled with small broken stone or gravel, and then pouring over the whole melted tar or pitch, whereby the cavities are all filled and cemented together. The other plan is to arrange the blocks in rows transversely across the street, separated a small space (of about an inch) by strips of board at the bottom, which serve to keep the blocks at a uniform distance apart, and then filling these spaces with the same material as before. The blocks forming the pavement are about eight inches high. The alternate rows of short blocks in the first plan and the strips of board in the second plan should not be higher than four inches. The patent has four claims, the first two of which, which are the only ones in question, are as follows:

"I claim as an improvement in the art of constructing pavements:

"1. Placing a continuous foundation or support, as above described, directly upon the roadway; then arranging thereon a series of blocks, having parallel sides, endwise in rows, so as to leave a continuous narrow groove or channel-way between each row, and then filling said grooves or channel-ways with broken stone, gravel, and tar, or other like materials.

"2. I claim the formation of a pavement by laying a foundation directly upon the roadway, substantially as described, and then employing two sets of blocks; one a principal set of blocks, that shall form the wooden surface of the pavement when completed, and an auxiliary set of blocks or strips of board, which shall form no part of the surface of the pavement, but determine the width of the groove between the principal blocks, and also the filling of said groove, when so formed between the principal blocks, with broken stone, gravel, and tar, or other like material."

The bill charges that the defendants infringed this patent by laying down wooden pavements in the city of Elizabeth, N. J., constructed in substantial conformity with the process patented, and prays an account of profits, and an injunction.

The defendants answered in due course, admitting that they had constructed, and were still constructing, wooden pavements in Elizabeth, but alleging that they were constructed in accordance with a patent granted to John W. Brocklebank and Charles Trainer, dated January 12, 1869, and denied that it

infringed upon the complainant. They also denied that there was any novelty in the alleged invention of Nicholson, and specified a number of English and other patents which exhibited, as they claimed, every substantial and material part thereof which was claimed as new.

They also averred that the alleged invention of Nicholson was in public use, with his consent and allowance, for six years before he applied for a patent, on a certain avenue in Boston called the Mill-dam; and contended that said public use worked an abandonment of the pretended invention. These several issues, together with the question of profits, and liability on the part of the several defendants to respond thereto, are the subjects in controversy before us.

§ 6378. *A foreign patent or publication is no defense to a suit for infringement of an American patent, unless published before the making of the discovery patented.*

We do not think that the defense of want of novelty has been successfully made out. Nicholson's invention dates back as early as 1847 or 1848. He filed a *caveat* in the patent office in August, 1847, in which the checker-board pavement is fully described; and he constructed a small patch of pavement of both kinds, by way of experiment, in June or July, 1848, in a street near Boston, which comprised all the peculiarities afterwards described in his patent; and the experiment was a successful one. Before that period, we do not discover in any of the forms of pavements adduced as anticipations of his, any one that sufficiently resembles it to deprive him of the claim to its invention. As claimed by him, it is a combination of different parts or elements, consisting, as the appellant's counsel, with sufficient accuracy for the purposes of this case, enumerates them, 1st, of the foundation prepared to exclude moisture from beneath; 2d, the parallel-sided blocks; 3d, the strips between these blocks, to keep them at a uniform distance, and to create a space to be filled with gravel and tar; and 4th, the filling. Though it may be true that every one of these elements had been employed before, in one kind of pavement or another, yet they had never been used in the same combination and put together in the same manner as Nicholson combined and arranged them, so as to make a pavement like his. The one which makes the nearest approach to it, and might, perhaps, be deemed sufficiently like to deprive Nicholson of the merit of invention, is that of John Hosking, which, in one form, consisted of alternate rows of short and long blocks, the latter partially resting on the former by their being mutually rabbeted so as to fit together. The spaces thus formed between the longer blocks, and on the top of the shorter ones, were filled with loose stone and cement or asphalt, substantially the same as in Nicholson's pavement. It would be very difficult to sustain Nicholson's patent if Hosking's stood in his way. But the only evidence of the invention of the latter is derived from an English patent, the specification of which was not enrolled until March, 1850, nearly two years after Nicholson had put his pavement down in its completed form, by way of experiment, in Boston. A foreign patent, or other foreign printed publication describing an invention, is no defense to a suit upon a patent of the United States, unless published anterior to the making of the invention or discovery secured by the latter, provided that the American patentee, at the time of making application for his patent, believed himself to be the first inventor or discoverer of the thing patented. He is obliged to make oath to such belief when he applies for his patent; and it will be presumed that such was his belief until the contrary is proven. That was the law as it stood when Nicholson obtained his original patent, and it is the law

still. Act of 1836, secs. 7, 15; act of 1870, secs. 24, 25, 61; R. S., secs. 4886, 4887, 4920; and see Curtis, Patents, secs. 375, 375*a*. Since nothing appears to show that Nicholson had any knowledge of Hosking's invention or patent prior to his application for a patent in March, 1854, and since the evidence is very full to the effect that he had made his invention as early as 1848, the patent of Hosking cannot avail the defense in this suit.

It is unnecessary to make an elaborate examination of the other patents which were referred to for the purpose of showing an anticipation of Nicholson's invention. They are mostly English patents, and we will only advert in a summary way to such of them as seem to be most nearly relevant to the question in controversy, premising that in England the enrollment of the specification is the first publication of the particulars of a patented invention.

Stead's patent, enrolled in November, 1838, shows a plan of pavement consisting of a series of hexagonal, triangular or square-sided blocks, standing close together on the surface of the roadway, in a layer of sand, and being a little smaller at the bottom than at the top, so as to admit a packing of sand, or pitch and sand, in the interstices between them, below the surface. Small recesses at the top, around the edges of the blocks, are suggested, apparently for giving a better hold to the horses' feet. It had no prepared foundation like Nicholson's, and no spaces filled with gravel, etc.

Parkins' patent, enrolled October, 1839, proposes a pavement to consist of blocks leaning upon each other, and connected together with a mixture of sand and bitumen, and connected by keys laid in grooves, and having grooves cut in the surface, either across the blocks or along their edges, to give the horses a better foothold. This plan exhibits no spaces to be filled with gravel or other filling.

Wood's patent, enrolled in April, 1841, shows a pavement made of adjoining blocks fitted together, but alternately larger and smaller at the top, like the frustum of a pyramid, and not parallel-sided; those larger at the top standing slightly higher than the others, so that when pounded down, or pressed by rollers or loaded vehicles, they would act as wedges, binding the whole pavement more tightly together. No filling is used on the surface, and no prepared foundation is suggested. In one form of his pavement he describes continuous grooves, the grooves being formed of blocks which are shorter than the others; and states that the groove is to be filled with concrete, coal-tar, etc., mixed with gravel or sand; but there is no foundation described for the pavement; and the description given for laying down the pavement, viz., by ramming down the taller blocks after considerable surface has been covered by the pavement, shows that the road-bed on which the blocks are to be laid is to be a yielding one, capable of conforming itself to the under surface of the blocks in the same way as sand does to the ordinary stone pavement when the stones are rammed.

Perring's patent, enrolled January, 1843, shows a pavement consisting, in one form, of blocks leaning one upon another in rows, with strips of board between the rows, coming to within an inch or so of the top of the pavement, and the same distance from the bottom, leaving gutters for the water underneath, and the adjoining rows being connected with pins passing through the strips of board. The rows are thus separated to enable the horses' feet to get a better hold. No filling is suggested, and, indeed, would not be admissible, as the boards have no support but the pins; and no prepared foundation is required.

Crannis & Kemp's patent, enrolled August 21, 1843, presents, amongst other things, first, a pavement consisting of rows of blocks adjoining each other, but each block having a small recess on one side, on the surface, to enable the horses to get a better foothold; secondly, a pavement of alternate blocks adjoining each other, but differing in width, and slightly differing in height, the top of one block being rounded off so as to make a groove next to the adjoining blocks, and the rounded blocks in one row alternating with the rectangular topped blocks in the next row—the object of rounding off the alternate blocks being to give a foothold to the horses. This pavement is to be built on a flooring of plank, either of one or two thicknesses, but without any preparation to exclude moisture, and it has no filling in the depressions or grooves formed by rounding the alternate blocks.

A French patent, granted to Hediard in 1842, shows a pavement constructed of rows of blocks laid on a board foundation, cemented together by a thin filling (four-tenths of an inch thick) of cement or mastic, from top to bottom; no provision being made to prevent the accession of moisture from the ground below, and no strips between the rows to keep them separate from each other.

None of these pavements combine all the elements of Nicholson's, much less a combination of those elements arranged and disposed according to his plan. We think they present no ground for invalidating his patent, and no defense to this suit.

The next question to be considered is, whether Nicholson's invention was in public use or on sale, with his consent and allowance, for more than two years prior to his application for a patent, within the meaning of the sixth, seventh and fifteenth sections of the act of 1836, as qualified by the seventh section of the act of 1839, which were the acts in force in 1854, when he obtained his patent. It is contended by the appellants that the pavement which Nicholson put down by way of experiment, on Mill-dam avenue in Boston, in 1848, was publicly used for the space of six years before his application for a patent, and that this was a public use within the meaning of the law.

§ 6379. *The public experimental use of an invention, to test its qualities or remedy its defects, does not invalidate the subsequently granted patent.*

To determine this question, it is necessary to examine the circumstances under which this pavement was put down, and the object and purpose that Nicholson had in view. It is perfectly clear from the evidence that he did not intend to abandon his right to a patent. He had filed a *caveat* in August, 1847, and he constructed the pavement in question by way of experiment, for the purpose of testing its qualities. The road in which it was put down, though a public road, belonged to the Boston and Roxbury Mill Corporation, which received toll for its use; and Nicholson was a stockholder and treasurer of the corporation. The pavement in question was about seventy-five feet in length, and was laid adjoining to the toll-gate and in front of the toll-house. It was constructed by Nicholson at his own expense, and was placed by him where it was, in order to see the effect upon it of heavily loaded wagons, and of varied and constant use; and also to ascertain its durability, and liability to decay. Joseph L. Lang, who was toll-collector for many years, commencing in 1849, familiar with the road before that time, and with this pavement from the time of its origin, testified as follows: "Mr. Nicholson was there almost daily, and when he came he would examine the pavement, would often walk over it, cane in hand, striking it with his cane, and making particular examination of its condition. He asked me very often how people liked it, and asked me a great

many questions about it. I have heard him say a number of times that this was his first experiment with this pavement, and he thought that it was wearing very well. The circumstances that made this locality desirable for the purpose of obtaining a satisfactory test of the durability and value of the pavement were: that there would be a better chance to lay it there; he would have more room and a better chance than in the city; and, besides, it was a place where most everybody went over it, rich and poor. It was a great thoroughfare out of Boston. It was frequently traveled by teams having a load of five or six tons, and some larger. As these teams usually stopped at the toll-house, and started again, the stopping and starting would make as severe a trial to the pavement as it could be put to."

This evidence is corroborated by that of several other witnesses in the cause; the result of the whole being that Nicholson merely intended this piece of pavement as an experiment, to test its usefulness and durability. Was this a public use, within the meaning of the law?

§ 6380. *What is an abandonment of an invention in the sense of the patent law.*

An abandonment of an invention to the public may be evinced by the conduct of the inventor at any time, even within the two years named in the law. The effect of the law is, that no such consequence will necessarily follow from the invention being in public use or on sale, with the inventor's consent and allowance, at any time within two years before his application; but that, if the invention is in public use or on sale prior to that time, it will be conclusive evidence of abandonment, and the patent will be void.

§ 6381. *What is a public use that will work an abandonment.*

But, in this case, it becomes important to inquire what is such a public use as will have the effect referred to. That the use of the pavement in question was public in one sense cannot be disputed. But can it be said that the invention was in public use? The use of an invention by the inventor himself, or of any other person under his direction, by way of experiment, and in order to bring the invention to perfection, has never been regarded as such a use. Curtis, Patents, sec. 381; Shaw v. Cooper, 7 Pet., 292.

Now, the nature of a street pavement is such that it cannot be experimented upon satisfactorily except on a highway, which is always public. When the subject of invention is a machine, it may be tested and tried in a building, either with or without closed doors. In either case, such use is not a public use, within the meaning of the statute, so long as the inventor is engaged, in good faith, in testing its operation. He may see cause to alter it and improve it or not. His experiments will reveal the fact whether any and what alterations may be necessary. If durability is one of the qualities to be attained, a long period, perhaps years, may be necessary to enable the inventor to discover whether his purpose is accomplished. And though, during all that period, he may not find that any changes are necessary, yet he may be justly said to be using his machine only by way of experiment; and no one would say that such a use, pursued with a *bona fide* intent of testing the qualities of the machine, would be a public use, within the meaning of the statute. So long as he does not voluntarily allow others to make it and use it, and so long as it is not on sale for general use, he keeps the invention under his own control, and does not lose his title to a patent.

It would not be necessary, in such a case, that the machine should be put up and used only in the inventor's own shop or premises. He may have it

put up and used in the premises of another, and the use may inure to the benefit of the owner of the establishment. Still, if used under the surveillance of the inventor, and for the purpose of enabling him to test the machine, and ascertain whether it will answer the purpose intended, and make such alterations and improvements as experience demonstrates to be necessary, it will still be a mere experimental use, and not a public use, within the meaning of the statute.

Whilst the supposed machine is in such experimental use, the public may be incidentally deriving a benefit from it. If it be a grist-mill, or a carding-machine, customers from the surrounding country may enjoy the use of it by having their grain made into flour, or their wool into rolls, and still it will not be in public use, within the meaning of the law. But if the inventor allows his machine to be used by other persons generally, either with or without compensation, or if it is, with his consent, put on sale for such use, then it will be in public use and on public sale, within the meaning of the law.

If, now, we apply the same principles to this case, the analogy will be seen at once. Nicholson wished to experiment on his pavement. He believed it to be a good thing, but he was not sure; and the only mode in which he could test it was to place a specimen of it in a public roadway. He did this at his own expense, and with the consent of the owners of the road. Durability was one of the qualities to be attained. He wanted to know whether his pavement would stand, and whether it would resist decay. Its character for durability could not be ascertained without its being subjected to use for a considerable time. He subjected it to such use, in good faith, for the simple purpose of ascertaining whether it was what he claimed it to be. Did he do anything more than the inventor of the supposed machine might do, in testing his invention? The public had the incidental use of the pavement, it is true; but was the invention in public use, within the meaning of the statute? We think not. The proprietors of the road alone used the invention, and used it at Nicholson's request, by way of experiment. The only way in which they could use it was by allowing the public to pass over the pavement.

§ 6382. *It is not public knowledge but public use of an invention that avoids a patent.*

Had the city of Boston, or other parties, used the invention, by laying down the pavement in other streets and places, with Nicholson's consent and allowance, then, indeed, the invention itself would have been in public use, within the meaning of the law; but this was not the case. Nicholson did not sell it, nor allow others to use it or sell it. He did not let it go beyond his control. He did nothing that indicated any intent to do so. He kept it under his own eyes, and never for a moment abandoned the intent to obtain a patent for it.

In this connection it is proper to make another remark. It is not a public knowledge of his invention that precludes the inventor from obtaining a patent for it, but a public use or sale of it. In England, formerly, as well as under our patent act of 1793, if an inventor did not keep his invention secret, if a knowledge of it became public before his application for a patent, he could not obtain one. To be patentable, an invention must not have been known or used before the application; but this has not been the law of this country since the passage of the act of 1836, and it has been very much qualified in England. *Lewis v. Marling*, 10 B. & C., 22. Therefore, if it were true that during the whole period in which the pavement was used, the public knew how it was constructed, it would make no difference in the result.

It is sometimes said that an inventor acquires an undue advantage over the public by delaying to take out a patent, inasmuch as he thereby preserves the monopoly to himself for a longer period than is allowed by the policy of the law; but this cannot be said with justice when the delay is occasioned by a *bona fide* effort to bring his invention to perfection, or to ascertain whether it will answer the purpose intended. His monopoly only continues for the allotted period, in any event; and it is the interest of the public, as well as himself, that the invention should be perfect and properly tested, before a patent is granted for it. Any attempt to use it for a profit, and not by way of experiment, for a longer period than two years before the application, would deprive the inventor of his right to a patent.

The next question for consideration is, whether the defendants have infringed the patent of Nicholson. On this question we entertain no doubt. The pavement put down by the defendants in the city of Elizabeth differs in nothing from that described by Nicholson in his patent, except in the form of the strips placed between the rows of blocks, and the nicks or grooves made in the blocks to fit them. In Nicholson's description, they are simply strips of board standing endwise on the foundation. The patent describes the strips as "so arranged as to form spaces of about one inch in thickness between the rows of principal blocks. The auxiliary strip may be about half the height of the principal block; but it must not be permitted to fill up the grooves permanently and entirely, when the pavement is completed, or to perform any part of the pavement." The strips used by the defendants are substantially the same as here described, and perform the same office. The only difference in their construction and application between the blocks is, that they are beveled, by being made wider at the top than at the bottom,—the extra width of the top part being let into a notch or groove in the blocks. If they perform the additional office, of partially sustaining the pressure of the blocks and locking them together, they do not any the less perform the office assigned to them in Nicholson's pavement. Their peculiar form and application may constitute an improvement on his pavement, but it includes his.

It is objected that the blocks of the Elizabeth pavement have not parallel sides, as prescribed in Nicholson's patent, by reason of the notch or groove in the side, into which the strips are fitted; but this notch or groove does not take from the blocks their general conformity to the requisition of the patent. They are parallel-sided blocks, with a groove made in the lower part to receive the edges of the strips. The parallel-sided blocks described in Nicholson's patent were probably intended to distinguish them from such blocks as those described in Stead's patent, which were hexagonal and triangular in form; or those in Wood's patent, which were of a pyramidal shape, the opposite sides being at an angle with each other. As contradistinguished from these, both the Nicholson blocks and those used by the appellants are properly denominated blocks with parallel sides.

§ 6383. *General rules as to profits. Recoverable in equity.*

The next subject for consideration is the form and principles of the decree rendered by the court below. The bill prayed a decree for damages and profits; but, as it was filed before the passage of the act of July 8, 1870, which first authorized courts of equity to allow damages in addition to profits, the court below correctly held that a decree for profits alone could be rendered. It is unnecessary here to enter into the general question of profits recoverable in equity by a patentee. The subject, as a whole, is surrounded

with many difficulties, which the courts have not yet succeeded in overcoming. But one thing may be affirmed with reasonable confidence, that, if an infringer of a patent has realized no profit from the use of the invention, he cannot be called upon to respond for profits; the patentee, in such case, is left to his remedy for damages. It is also clear that a patentee is entitled to recover the profits that have been actually realized from the use of his invention, although, from other causes, the general business of the defendant, in which the invention is employed, may not have resulted in profits,—as where it is shown that the use of his invention produced a definite saving in the process of a manufacture. *Mowry v. Whitney*, 14 Wall., 434; *Cawood Patent*, 94 U. S., 695. On the contrary, though the defendant's general business be ever so profitable, if the use of the invention has not contributed to the profits, none can be recovered. The same result would seem to follow where it is impossible to show the profitable effect of using the invention upon the business results of the party infringing. It may be added that, where no profits are shown to have accrued, a court of equity cannot give a decree for profits by way of damages or as a punishment for the infringement. *Livingston v. Woodworth*, 15 How., 559. But when the entire profit of a business or undertaking results from the use of the invention, the patentee will be entitled to recover the entire profits if he elects that remedy. And in such a case the defendant will not be allowed to diminish the show of profits by putting in unconscionable claims for personal services or other inequitable deductions. *Rubber Co. v. Goodyear*, 9 Wall., 788. These general propositions will hardly admit of dispute, and they will furnish us some guide in deciding the questions raised in this case.

Only the defendants have appealed, and the errors assigned by them on this branch of the case are the following:

1st. "The court erred in decreeing that the complainants do recover of the defendants, the city of Elizabeth and George W. Tubbs, the sums set forth in the decree, because the master did not find that said defendants had made any profits, which failure to find was not excepted to by complainants, and because no proof was offered by complainants of any profits whatever made by said defendants."

2d. "The court erred in finding that the profits received by the defendants were the fruits of the use of the devices described and claimed in the first and second claims of the Nicholson patent,—there being no proof of any advantage derived by the defendants from such use of the Nicholson devices,—or was incident to the use of the devices of the Brocklebank & Trainer patent. The failure to specifically show such profits makes the recovery nominal."

3d. "The court erred in decreeing the whole amount of profits made by the New Jersey Wood-paving Company in the construction of the pavements referred to in the master's report. Whereas, if any profits ought to have been decreed, they should have been confined to the amount of the license for a royalty which the complainants had been accustomed to receive, and were bound by the terms of their title to accept, from any party constructing such pavement in New Jersey."

§ 6384. *Where a contractor infringed a patent his employer is not liable for profits unless he paid the contractor less than the patentee's prices.*

We will consider these assignments in order. The first seems to be well taken. The party who made the profit by the construction of the pavement in question was the New Jersey Wood-paving Company. The city of Eliza-

both made no profit at all. It paid the same for putting down the pavement in question that it was paying to the defendant in error for putting down the Nicholson pavement proper, namely, \$4.50 per square yard. It made itself liable to damages, undoubtedly, for using the patented pavement of Nicholson; but damages are not sought, or, at least, are not recoverable, in this suit. Profits only, as such, can be recovered therein. The very first evidence which the appellees offered before the master was the contracts made between the city and the other defendants for the construction of the pavement; and these contracts show the fact that the city was to pay the price named, and that any benefit to be derived from the construction of the pavement was to be enjoyed by the contractors.

It is insisted that the defendants, by answering jointly, admitting that they were jointly co-operating in laying the pavement, precluded themselves from making this defense. We do not think so. That admission is not inconsistent with the actual facts of the case, to wit, that this co-operation consisted of a contract for having the pavement made, on one side, and a contract to make it, on the other; and is by no means conclusive as to which party realized profit from the transactions. The complainants themselves, by their own evidence, showed that the contractors, and not the city, realized it.

The appellant, Tubbs, is in the same predicament with the city. Several of the contracts were made in his name, it is true, but they were made in behalf of the New Jersey Wood-paving Company, for whose use and benefit the contracts were made and completed. Tubbs only received a salary for his superintendence.

§ 6385. *Where profits are made by an infringer, he is liable to the patentee for them unless he can show that a portion of them is the result of some other thing used by him.*

The next assignment of error, based on the hypothesis that the profits received by the defendants were not the fruits of the use of Nicholson's invention, appears to us destitute of foundation. This matter is so fully and ably presented in the opinion of the circuit court as to require but little discussion from us. The Nicholson pavement was a complete thing, consisting of a certain combination of elements. The defendants used it as such — the whole of it. If they superadded the addition made to it by Brocklebank & Trainer, they failed to show that such addition contributed to the profits realized. The burden of proof was on them to do this. The evidence, if it shows anything, tends to prove that the addition diminished the profits instead of increasing them; but it could not have had much influence either way, inasmuch as the evidence shows that the profit made on this pavement was about the same as that made on the pavement of Nicholson, without the improvement. The appellants, however, obtained an allowance of nearly \$14,000 for the royalty paid by them for the use of the Brocklebank & Trainer patent. This allowance went so far in diminution of the profits recovered.

Equally without foundation is the position taken by the appellants, that other pavements, approaching in resemblance to that of Nicholson, were open to the public, and that the specific difference between those pavements and Nicholson's was small, and that, therefore, the Nicholson patent was entitled to only a small portion of the profits realized. Nicholson's pavement, as before said, was a complete combination in itself, differing from every other pavement. The parts were so correlated to each other, from bottom to top, that it required them all, put together as he put them, to make the complete

whole, and to produce the desired result. The foundation impervious to moisture, the blocks arranged in rows, the narrow strips between them for the purposes designated, the filling over those strips, cemented together, as shown by the patent,—all were required. Thus combined and arranged, they made a new thing, like a new chemical compound. It was this thing, and not another, that the people wanted and required. It was this that the appellants used, and, by using, made their profit, and prevented the appellee from making it. It is not the case of a profit derived from the construction of an old pavement together with a superadded profit derived from adding thereto an improvement made by Nicholson, but of an entire profit derived from the construction of his pavement as an entirety. A separation of distinct profit derived from Brocklebank & Trainer's improvement, if any such profit was made, might have been shown; but, as before stated, the appellants failed to show that any such distinct profit was realized.

We have looked over the various items claimed by the appellants by way of reduction of profits, and disallowed by the master and by the court below, and we are satisfied with the result which they reached. The gross profits of the work over actual expenses for material and labor were conceded to be \$123,610.78. The total deductions claimed before the master amounted to \$139,875.63, which would have been considerably more than sufficient to absorb the whole profits. The master and the court allowed deductions to the amount of \$48,618.62, which reduced the profits to \$74,992.16, for which amount the decree was rendered. The deductions overruled and disallowed amounted to \$91,257.85. Of these \$31,111.92 was a profit of twenty per cent., which the appellants claimed they had a right to add to the actual cost of lumber and other materials and labor. It is only necessary to state the claim to show its preposterousness. Other items were one of \$7,000 for salaries, and another of \$3,000 for rent, for a period of time that occurred after the work was completed. Another item was one of \$2,675.09 for the cost of a dock which the parties built on their own land; and another of \$25,000, paid for an interest in the Brocklebank & Trainer patent. As the appellants still hold these properties, we cannot well conceive what the purchase of them has to do in this account. They also claim \$15,241.33 for that amount abated from the assessments of some of their stockholders who owned lands along the streets paved. As this was a gratuity which they made to themselves, they cannot claim a deduction for it here. The last item was \$6,572.75, claimed to have been profits made upon other work, which were allowed to be included in these contracts. As this is not explained in any satisfactory way, we think the master did right in rejecting it.

We are entirely satisfied with the disposition made of these various items, and with the correctness of the decree, so far as the statement of the account is concerned.

§ 6386. *The royalty paid by the assignee to the patentee is no element to be considered in a decree against an infringer.*

But the appellants assign a third error. They insist that the appellee, as assignor of the Nicholson patent for the state of New Jersey (which was the ground of its title), was entitled to recover only thirty-one cents per square yard in any event,—being limited to that charge for the use of the patent by the terms of the assignment; sixteen cents of which was to be paid to the proprietors and fifteen to be retained by the appellee.

This matter is quite satisfactorily disposed of, in the opinion of the court

below. The stipulation was between third parties, and the appellants have no concern in it. It only applied, by its terms, to cases where, by reason of the decisions of the courts or otherwise, it should be found impracticable for the appellees to obtain contracts for laying the pavement in any town or city, or where the work of constructing pavements should be required by law to be let under public lettings, open to general competition. The object was to secure as extensive a use of the pavement as possible, as thereby the emoluments of the proprietors would be increased. But the assignment gave to the appellee the exclusive right in the patent for the state of New Jersey. It did not prohibit the appellee from constructing the pavements itself, if it could obtain contracts for doing so, and making thereby any profit it could. There was no obstacle to its doing this in the city of Elizabeth. On the contrary, it did obtain from the city large contracts, and would have obtained more if the appellants had not interfered. There is nothing in this state of things which entitles the latter, after making large profits from the use of the invention, to refuse to respond therefor. It is not for them to say that the hands of the appellee are tied by its contract with its grantor. This would be to take advantage of their own wrong. Whatever bearing the stipulation in the assignment may have on the measure of damages in an action at law, it affords no defense to the appellants when called upon to account for the profits which they have wrongfully made by pirating the invention.

We think there is no error in the decree of the circuit court, except in making the city of Elizabeth and George W. Tubbs accountable for the profits. As to them a decree for injunction only to prevent them from constructing the pavement during the term of the patent should have been rendered; which, of course, cannot now be made. As to the New Jersey Wood-paving Company, the decree was in all respects correct. A decree for costs in the court below should be awarded against all the defendants.

The decree of the circuit court, therefore, must be reversed, with costs, and the cause remanded to said court with instructions to enter a decree in conformity with this opinion; and it is so ordered.

Use — Experimental public, and sale — *Will not defeat a patent, §§ 6387-6389; neither will an experimental public use, §§ 6390-6396.*

§ 6387. The law permits an inventor to make practical tests of his invention, and when an invention is used in public in the way of experiment or trial, or when a machine is sold on trial and warranted, it is not such a public use or sale as is contemplated by the statute. *Graham v. McCormick*, 10 Biss., 39.

§ 6388. An inventor can use for profit an imperfect machine for two years prior to applying for a patent on the perfected machine, without invalidating the patent, when during such use he was perfecting the machine. *Sprague v. Smith*, 12 Fed. Rep., 721.

§ 6389. In case of a sale and public use of a machine subsequently patented, such sale and use being more than two years before the date of the application, it being shown that such sale was for experimental purposes, then upon the question of the reasonableness of the use in point of duration every presumption should be made in favor of the inventor. *Innis v. Oil City Boiler Works*, 30 O. G., 998.

§ 6390. Putting an invention out on trial and for the purpose of experiment and improvement, *held* not such a public use as would be considered a dedication to the public. *Stanley v. Hewitt*, 17 Frank. Jr., 2d Series, 165.

§ 6391. An invention will not be held forfeited because it was used for experimental purposes, in good faith, for more than two years before applying for a patent. The objection is not one to be regarded with favor; but, if clearly established, it is fatal. *Birdsell v. McDonald*, 6 O. G., 682.

§ 6392. The use of an invention for the purposes of experiment, though made in public from

necessity, is not evidence of intent to abandon. *Locomotive-Engine Safety-Truck Co. v. Pennsylvania R. Co.*, 6 O. G., 927.

§ 6393. Neither does such use debar from a patent, although it takes place more than two years before the application. *Ibid.*

§ 6394. Public use, in good faith, for experimental purposes, while the inventor is perfecting his invention, and for a reasonable period even before the beginning of the two years of limitation, cannot affect the rights of the inventor. *Henry v. Francistown Soap-Stone Stove Co.*, 9 O. G., 408.

§ 6395. The use of an invention in public two years prior to the filing of the application will not invalidate the patent when the invention is of such a nature that its trial can only be conducted in public. *Campbell v. Mayor, etc., of New York*, 9 Fed. Rep., 500.

§ 6396. Where the prior public use of the invention was the only manner in which it could be conveniently used for the purpose of actual experiment, *held* not to vitiate the patent. *Railway Register Mfg. Co. v. Broadway and Seventh Ave. R. Co.*, 22 Fed. Rep., 655.

Use — Experimental — *Will defeat a patent (act 1793)*, § 6397. *Will not defeat a patent*, §§ 6398-6408. *For profit, will not defeat*, §§ 6409, 6410. *May constitute an infringement*, §§ 6411, 6412. *What is and what is not an experimental use*, §§ 6413, 6414.

§ 6397. Under act 1793, section 1, experimental use of a machine is such prior use as to invalidate a subsequent patent therefor. *Watson v. Bladen*, 4 Wash., 580.

§ 6398. Experimental use is not such public use as will defeat a patent. *Wyeth v. Stone*, 1 Story, 273.

§ 6399. Experimental use will not deprive an inventor of his right to a patent. *Ryan v. Goodwin*, 3 Sumn., 514.

§ 6400. Experimental use prior to application for patent raises no presumption of abandonment. *Jones v. Sewall*, 3 Cliff., 563.

§ 6401. The use of an invention by the author for the purposes of experiment, though continued for more than two years, will not prejudice his right to a patent. *Ibid.*

§ 6402. Neither will the sale or use of it by others without his consent. *Ibid.*

§ 6403. Mere experimental use, made in good faith, and not in such wise as to amount to a fraud upon the public, misleading them into a use, in the belief that it is free, does not destroy the exclusive right of an inventor. *Sisson v. Gilbert*, 9 Blatch., 185.

§ 6404. An experimental use for more than two years prior to application for patent will not invalidate the patent. *American Hide & Leather Splitting Co. v. Tool Co.*, 1 Holmes, 503.

§ 6405. Acts of an inventor, to determine the value, utility or success of his invention, are to be liberally construed, if the acts are not inconsistent with the clear intention to hold the exclusive privilege. *Jennings v. Pierce*, 15 Blatch., 42.

§ 6406. Experimental use occurring more than two years prior to the filing of the application is not fatal to a patent, even though the use was for the purpose of satisfying others as to its utility. *Sinclair v. Backus*, 4 Fed. Rep., 539.

§ 6407. The law permits an inventor to construct a machine which he is engaged in studying upon and developing, and place it in friendly hands for the purpose of testing it and ascertaining whether it will perform the functions claimed for it; and if these machines are strictly experiments, made solely with a view to perfect the device, the right of the inventor remains unimpaired; but when an inventor puts his incomplete or experimental device upon the market, and sells it as a manufacturer more than two years before he applies for his patent, he gives to the public the device in the condition or stage of development in which he sells it. In such case his patent cannot be allowed to relate back and cover forms which he gave to the public more than two years before he applied for a patent. *Lyman v. Maypole*, 19 Fed. Rep., 735.

§ 6408. A patent cannot be defeated by a single experimental machine when the recollection of the mechanism that constituted it has passed away from the mind of the witness, who deposes to its existence thirty-five years before, so that it cannot from such recollection be reconstructed, and there being no other record of it. *Taylor v. Wood*, 12 Blatch., 110.

§ 6409. Where for a certain number of years the inventor, experimenting on his machine, ran it himself, kept it secret, but sold the product, which, owing to the imperfection of the machine, had mostly to be reworked, *held*, that the use for profit was incidental and subordinate to the experimental use, and the entire use might, with propriety, be considered as experimental, and was not a public use. *Jennings v. Pierce*, 15 Blatch., 42.

§ 6410. Where a machine was experimented on for four years, being used in the condition in which it was from time to time for profit, its product being sold, but the machine itself neither being sold, used by others nor licensed to be so used, and kept from view as much as possible, returning ultimately to the original device, for which a caveat had been filed at the

outset, *held*, it was an experimental use and not such public use as to invalidate the patent. *Emery v. Cavanagh*, 17 Fed. Rep., 242.

§ 6411. Experimental making and using of a patented invention is a technical infringement that may be restrained. *Albright v. Celluloid Harness-Trimming Co.*, 12 O. G., 227.

§ 6412. An experimental use, where there has been no profit and no sale, will not render one liable for infringement; but where, as a matter of business, products of so-called experiments are thrown on the market for sale, it constitutes an infringement. *Poppenhusen v. New York Gutta-percha Comb Co.*, 2 Fish., 62.

§ 6413. A use for the mere purpose of competitive examination, experiment and test is not a public use. *United States Rifle & Cartridge Company v. Whitney Arms Co.*, 14 Blatch., 94.

§ 6414. Where, through a series of years, a machine and process were used without material change in either, such use held not to have been experimental. *Manning v. Cape Ann Isinglass & Glue Co.*, 23 O. G., 2413; 108 U. S., 462; 4 Ban. & Ard., 612.

Use — Prior foreign knowledge and — *Patent not defeated by a mere prior foreign discovery*, §§ 6415, 6416; *or knowledge*, §§ 6417, 6418; *or knowledge or use*, §§ 6419-6421.

§ 6415. When the patentee believes himself to be the first inventor, a previous discovery in a foreign country shall not render his patent void, unless such discovery, or some substantial part of it, had been before patented or described in a printed publication. *O'Reilly v. Morse*, 15 How., 62.

§ 6416. Prior discovery and use in a foreign country, in the absence of its being patented or described in a printed publication, is no bar to the grant of a patent here. *Toucey's Opinion*, 5 Op., 19.

§ 6417. Patentee must be the first and original inventor, but prior knowledge abroad, in the absence of publication, or of a patent in the United States, will not defeat his patent. *Parker v. Stiles*, 5 McL., 44.

§ 6418. Previous knowledge of an invention abroad is no defense against a patent, unless it was described in some printed publication so clearly as to enable others to put it in practice. *Jones v. Sewall*, 3 Cliff., 563.

§ 6419. Knowledge or use in a foreign country is no proof of want of originality or novelty of the invention of an American citizen, unless it appears that it was patented in such foreign country, or there described in some public work. *Judson v. Cope*, 1 Bond, 327.

§ 6420. Mere previous knowledge or use of the thing patented in a foreign country will not defeat a patent issued here to the original inventor, unless it appears that it had been patented there, or published prior to his discovery. *Jones v. Sewall*, 3 Cliff., 563.

§ 6421. Evidence of knowledge and use in a foreign country would not of itself defeat the patent or be material. *Coburn v. Schroeder*, 11 Fed. Rep., 425.

Use — Prior foreign — *Will not defeat a domestic patent*, §§ 6422-6432.

§ 6422. By act 1836, section 15, it appears clearly that a use in a foreign country was not meant to be included within the terms of section 6, "not known or used by others before his or their discovery or invention thereof." *Bartholomew v. Sawyer*, 4 Blatch., 347.

§ 6423. Prior use in a foreign country does not invalidate a subsequently patented United States patent, where the patentee at the time of application supposed himself the first inventor, unless the prior invention has been patented or described in some printed public work. *Hays v. Sulsor*, 1 Bond, 279.

§ 6424. A patent will be sustained, although the invention was in use in a foreign country before the patentee originated it, unless it appear that the patentee did not believe himself to be the prior inventor when he filed his application. *Roemer v. Simon*, 5 O. G., 555.

§ 6425. The courts have uniformly held that no prior use in a foreign country of an invention invalidated a patent granted here, unless the invention had been patented or described in some printed publication. *Illingworth v. Spaulding*, 9 Fed. Rep., 611.

§ 6426. Foreign prior public use not brought home to patentee before the date of his patent cannot invalidate it. *Adams v. Loft*, 4 B. & A., 495.

§ 6427. Mere use of complainant's device in a foreign country, without its being patented or described in any printed publication, is not sufficient to anticipate his patent. *Phillips v. City of Detroit*, 17 O. G., 191.

§ 6428. Proof of prior use in a foreign country will not supersede a patent granted here unless the alleged invention was patented in some foreign country. *Roemer v. Simon*, 5 Otto, 214.

§ 6429. Proof of such foreign manufacture and use, if known to the applicant for a patent, may be evidence tending to show that he is not the inventor of the alleged new improvement. *Ibid.*

§ 6430. Public use in a foreign country, which might defeat the patent there, would have no effect upon a patent granted here, and a foreign patent would have no effect but to limit the term. *Cornley v. Marckwald*, 17 Fed. Rep., 83.

§ 6431. Prior use in a foreign country is no bar to a patent in this country. *Schillinger v. Greenway Brewing Co.*, 17 Fed. Rep., 244.

§ 6432. A simple use of the invention abroad, if not patented or described in any printed publication, is not a bar to obtaining a valid patent in the United States. *Worswick Mfg. Co. v. Steiger*, 17 Fed. Rep., 250.

Use — Foreign — *Quære: Is knowledge by persons here of foreign use a defense*, § 6433. *It will not defeat a patent*, § 6434. *Act 1836; time of foreign use*, § 6435.

§ 6433. *Quære*, whether proof of a knowledge, by persons residing in this country, of prior foreign use is a defense admissible under act 1870. *Illingworth v. Spaulding*, 9 Fed. Rep., 611. See *Plea in Bar*, § 4766.

§ 6434. The use or knowledge of the use of an invention in a foreign country, by persons residing in this country, will not defeat a patent which has here been granted to a *bona fide* patentee, who at the time was ignorant of the invention or its use abroad. *Doyle v. Spaulding*, 19 Fed. Rep., 744.

§ 6435. The time referred to by the terms (act 1836, section 15), "having been before known or used in a foreign country," is the time when patentee's original invention or discovery was made, not the date of his application. *Bartholomew v. Sawyer*, 4 Blatch., 347.

Use — Infringement — *Use on foreign vessel in domestic port is not*, §§ 6436, 6437. *Capture of article under protection of foreign patent confers no right to use under domestic patent*, § 6438.

§ 6436. The use of an invention by a foreign vessel temporarily in a United States port is not an infringement of the patent for which a right of action will lie. *Brown v. Duchesne*, 19 How., 183.

§ 6437. Where the action was for the infringement of plaintiff's invention, consisting in its use on board a foreign vessel in a United States port in the course of lawful trade, the device complained of having been made abroad, *held*, that the patent laws did not apply to such vessels so as to affect the structure or equipment which they bring hither. *Brown v. Duchesne*, 2 Curt., 371.

§ 6438. Where patentee had a patent in this country on his invention, and a subsequent patent on the same invention in England, granted before its practical introduction into this country, and one of the articles patented in England was captured on an English vessel, *held*, that no right accrued to use such invention on American vessels. *Wirt's Opinion*, 5 Op., 726.

See *Infringement*, § 2942.

Use — Statutes, construction of; knowledge and use prior to application — *Act 1793*, §§ 6439-6442. *Act 1800*, § 6443. *Act 1836*, § 6444. *Act 1839*, § 6445. *Revised Statutes*, §§ 6446, 6447. See *Statutes*, § 6109.

§ 6439. Act 1793, section 1, knowledge and use prior to application, construed. *Morris v. Huntington*, 1 Paine, 348.

§ 6440. Act 1793, chapter 11, "abandonment, prior knowledge and use," reviewed and construed. *Pennock v. Dialogue*, 2 Pet., 1.

§ 6441. The words "not known or used," in the act 1793, signify not known or used by the public. *Ibid.*

§ 6442. Under act 1793 prior knowledge or use refers to public only; and when fraudulently obtained raises no presumption of abandonment. *Shaw v. Cooper*, 7 Pet., 292.

§ 6443. Prior knowledge and use, act 1800, to avoid a patent, must relate to the application. *Whitney v. Emmett*, 1 Bald., 303.

§ 6444. The "prior knowledge and use" contemplated in section 7, act 1836, was intended to be confined to a use, discovery or invention in this country made prior to applicant's discovery or invention, the proof of which prior use must be so limited, provided patentee at the time of his application believed himself to be the first inventor. *Bartholomew v. Sawyer*, 4 Blatch., 347.

See *Reduction to Practice*, §§ 5238-5240.

§ 6445. Act 1839, section 7, knowledge and use for two years prior to application, construed. *Sickles v. Mitchell*, 3 Blatch., 548.

§ 6446. Section 4886, Revised Statutes, providing that a patent may be granted if the invention was not known or used by others, and section 4920, Revised Statutes, providing that in his

notice of defenses the defendant shall state not only the names and residences of the persons alleged to have had prior knowledge of the invention, but "where and by whom it had been used," are to be construed together; and prior knowledge of an invention not accessible to the public did not defeat a patent. (*Gayler v. Wilder*, 10 How., 477.) *Searls v. Bouton*, 12 Fed. Rep., 140.

§ 6447. Section 4886, Revised Statutes, "not known or used by others in this country," construed. *Doyle v. Spaulding*, 19 Fed. Rep., 744.

Use—Statutory notice of prior knowledge and use—Requirements under act 1836, §§ 6448-6453; *under section 4220, Revised Statutes*, §§ 6454, 6455. *Generally*, §§ 6456-6465.

§ 6448. Under act 1836, section 15, notice of prior knowledge and use requires nothing more than the names and residences of the persons who possessed the prior knowledge of the thing patented, and the name of the place at which it had been used. *Wilton v. Railroads*, 1 Wall. Jr., 192.

§ 6449. Under act 1836, section 15, defendant must show notice to plaintiff, where he relies on defense of prior use of the invention. The object of such notice considered. *Phila. & Trenton R. Co. v. Stimpson*, 14 Pet., 448.

§ 6450. Notice of prior knowledge and use, referring merely to the county in which the thing was used, *held*, not sufficiently definite to meet the requirements of the act, and evidence thereunder was rejected. *Hays v. Sulsor*, 1 Bond, 259.

§ 6451. Under act 1836, section 15, notice of special matter requires the name of the person who had knowledge of the use, and the place where it was used, to be given. *Judson v. Cope*, 1 Bond, 327.

§ 6452. Under act 1836, section 15, notice of prior use must contain the name and residence of the person previously using, and the place where used; but the time of using is not material. *Phillips v. Page*, 24 How., 164.

§ 6453. Notice of prior knowledge and use under act 1836, section 15, is sufficiently certain and precise, if the adversary is thereby placed in a way that he may ascertain all that is necessary to his defense or answer; and where, in addition to the particular town in which such large objects as mill-stones are used, the name and residence of the witness by whom such use is to be proven is given, it is sufficient notice. *Wise v. Allis*, 9 Wall., 737.

§ 6454. Under section 4920, Revised Statutes, after notice of the name of the alleged prior inventor, and of the place of use, and of the name of some one who has used the invention, has been given or waived, all other witnesses may be examined without notice. *Woodbury Patent Planing Machine Co. v. Keith*, 4 B. & A., 100.

§ 6455. The statute, section 4920, Revised Statutes, does not require the names of witnesses to be given, but only the names of those who knew of the thing, and where they can be found, and by whom the thing was used. *Sutro v. Moll*, 19 Blatch., 89.

See *Abandonment*, § 12. *Answer*, §§ 218, 219. *Bill, of Review*, § 616.

§ 6456. Where, in a suit in chancery, the defense of prior knowledge or use of the thing patented is set up, defendant in his answer must give the names and places of residence of those who possessed such knowledge when the same had been used. *Agawam Co. v. Jordan*, 7 Wall., 583.

§ 6457. A notice given by the defendant in an action on a patent, which gives the names of the persons who knew of the prior use of the invention, and of the works in which it was used and their locality, is sufficient. *Smith v. Frazer*, 2 O. G., 175.

§ 6458. Where there is no question made that plaintiff's patentee was the original and first inventor, and the prior use relied on is that by inventor himself, or under his license, in the statutory notice names of persons using, and places where used, need not be given. *American Hide & Leather Splitting Co. v. Tool Co.*, 1 Holmes, 503.

§ 6459. The court will not invoke the privilege of the act requiring notice of prior knowledge and use for parties who have not availed themselves of it at the time of taking testimony. *Crouch v. Speer*, 6 O. G., 187.

§ 6460. In a suit at law on a patent, thirty days' notice in writing must be given of all matters relied upon by the defendant, to prove the patentee was not the original and first inventor of the improvement. In equity suits for infringement, such notice must be given in the answer of the respondent. *Pickering v. Phillips*, 4 Cliff., 383.

§ 6461. Parties defendants sued at law for infringement are not allowed to set up the defense of a prior invention, knowledge or use of the thing patented, unless written notice thereof is given thirty days before the trial. *Roemer v. Simon*, 5 Otto, 214.

§ 6462. Such notice must state the names of the patentees and the dates of their patents alleged to have been invented, and the names and residences of the persons alleged to have in-

vented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used. *Ibid.*

§ 6463. Testimony as to the prior knowledge and use of the invention by persons not named in the answer will be considered on the hearing, if no motion is then made to strike it out, although it was objected to when it was taken. *Elm City Co. v. Wooster*, 4 O. G., 83.

§ 6464. Where, on the question of novelty, the alleged prior patent and its patentee's knowledge and use of the plaintiff's invention was not set up or referred to in the answer, the testimony in regard to it was not considered. *Carstaedt v. U. S. Corset Co.*, 13 Blatch., 119.

§ 6465. The respondents having given due notice of the defense of prior invention and use, stating the names and residences of the persons having the prior knowledge, and where and by whom the alleged invention had been used, added further that it had been known to and used by others to them unknown, and prayed leave that when discovered they might be permitted to insert and set forth their names in the answer. *Held*, that on motion to insert, in accordance with the notice, and no objection made, the court was justified in entering the additional names and residences *nunc pro tunc*. *Roemer v. Simon*, 5 Otto, 214.

Use — Prior knowledge and, generally — *Is a question of fact*, § 6466. *Must be prior to discovery*, §§ 6467, 6468. *Secret knowledge immaterial*, § 6469. *Experiments do not amount to*, § 6470. *What is and what is not*, §§ 6471-6473.

§ 6466. Prior knowledge and use is a question of fact, which the jury may decide on the evidence of one witness; and the question is on the credibility, not the number, of witnesses, *Whitney v. Emmett*, 1 Bald., 303.

§ 6467. Prior knowledge and use, to defeat a patent, must be prior to the date of invention. *Judson v. Cope*, 1 Bond, 327.

§ 6468. The first inventor has a right to a patent, though the knowledge and use by others was prior to his application, but not prior to his discovery. *Mellus v. Silsbee*, 4 Mason, 108.

§ 6469. The fact that an invention has been known or used before the application is immaterial, without it was known or used by the public. *Reed v. Cutter*, 1 Story, 590.

§ 6470. Proof of prior experiments on the principle of the invention, if not carried on to completion, does not make out the fact of prior knowledge or use, within the meaning of the patent laws. *Wayne v. Holmes*, 1 Bond, 27.

§ 6471. The imparting of the knowledge of the construction of a completed and perfected invention, by its inventor, to three witnesses skilled in the art, who saw it and understood its arrangement, *held*, to be giving to the public such a knowledge of it as a complete invention as to deprive a subsequent inventor from being considered a first and original inventor. *Coffin v. Ogden*, 7 Blatch., 61.

§ 6472. As the law seeks to encourage inventors to make known their inventions and to discourage an extension of the monopoly beyond the statutory period, and because of the difficulty in determining the amount of knowledge derived from the exhibition, publication and use of an invention, it has always been held that where the public have had means of knowledge of an invention they have had knowledge of the same. *Perkins v. Nashua Card & Glazed Paper Co.*, 2 Fed. Rep., 451.

§ 6473. Where it was shown that the parties set up as having prior knowledge of the patented invention had brought together all the parts necessary to accomplish the result patentee accomplished, but did not know how to use them, *held*, that this was not the known use required to defeat a patent. *Campbell v. Mayor, etc., of New York*, 9 Fed. Rep., 500.

See *Art, Lost*, §§ 391, 395.

Use — Public — *Defined*, §§ 6474-6476. *How established*, §§ 6477-6481.

§ 6474. By public use is meant a use in public by and with consent of the inventor. *Rich v. Lippincott*, 2 Fish., 1.

§ 6475. A public use, as meant by the statute, is a use in public. The invention need not be generally adopted by the public. Public is not equivalent to general use, but is distinguished from secret use — used in a public manner. *Hunt v. Howe*, 1 MacA. Pat. Cases, 366.

§ 6476. Public use is opposed to private use; it need not to be a general use by the community, but it must be an open use, so that the structure and *modus operandi* are apparent. *Adams v. Edwards*, 1 Fish., 1.

§ 6477. The obvious purpose of incurring the expense and trouble of taking out letters-patent is to carry the invention into public operation, use and sale, and it is natural to suppose that this the patentee has done. *Ellithorp v. Robertson*, 1 MacA. Pat. Cases, 585.

§ 6478. Public use, in the sense of the patent law, is proved by a single use by any person,

not the inventor, or by the inventor in an open way, provided the use was not experimental. *Jones v. Barker*, 11 Fed. Rep., 597.

§ 6479. To establish the fact of public use, actual knowledge of the invention need not have been derived by any one interested to practice it, but it is enough that any one or more persons not under pledge of secrecy saw the invention, or even might have seen it if they had used their opportunities, provided it was in fact practiced in the ordinary way after being completed. *Perkins v. Nashua Card & Glazed Paper Co.*, 2 Fed. Rep., 451.

§ 6480. Where there has been no pledge to secrecy, the visitors and workmen at a factory must be held to be either part of the public or persons from whom the public may acquire the art without breach of trust. *Ibid.*

§ 6481. *Doubted*, whether a pledge of secrecy exacted of a number of workmen who had nothing to do with the machine in question and had an opportunity to examine it would make the use a secret one. *Ibid.*

See *Grant*, § 2642.

Use — Public — *While application is pending, will not invalidate patent*, §§ 6482-6484.

§ 6482. Where the continuity of the application is not destroyed, public use for more than two years prior to the final application will not invalidate a patent. *Howe v. Newton*, 2 Fish., 531.

§ 6483. Use of the invention during pendency of the application in the patent office, without the consent of the inventor, cannot defeat the operation of letters patent after they are duly granted. *Goodyear Dental Vulcanite Co. v. Wetherbee*, 3 Cliff., 555.

§ 6484. Public or common use subsequent to the date of the original application, if that has been a continuing one, and the two petitions are "parts of the same transaction," will not avoid the patent. *Weston v. White*, 13 Blatch., 448.

Use — Prior public.

SUMMARY (*EGBERT v. LIPPMANN*, §§ 6485-6489) — *What constitutes public use*, §§ 6485, 6487. — *Number of persons using immaterial*, § 6486. — *Public use by one person held sufficient*, § 6488. — *Public and private use distinguished*, § 6489.

EGBERT v. LIPPMANN.

(14 Otto, 333-339. 1881.)

APPEAL from U. S. Circuit Court, Southern District of New York.

Opinion by MR. JUSTICE WOODS.

STATEMENT OF FACTS.— This suit was brought for an alleged infringement of the complainant's reissued letters-patent, No. 5216, dated January 7, 1873, for an improvement in corset-springs. The original letters bear date July 17, 1866, and were issued to Samuel H. Barnes. The reissue was made to the complainant, under her then name, Frances Lee Barnes, executrix of the original patentee.

The specification for the reissue declares: "This invention consists in forming the springs of corsets of two or more metallic plates, placed one upon another, and so connected as to prevent them from sliding off each other laterally or edgewise, and at the same time admit of their playing or sliding upon each other, in the direction of their length or longitudinally, whereby their flexibility and elasticity are greatly increased, while at the same time much strength is obtained."

The second claim is as follows: "A pair of corset-springs, each member of the pair being composed of two or more metallic plates, placed one on another, and fastened together at their centers, and so connected at or near each end that they can move or play on each other in the direction of their length."

The bill alleges that Barnes was the original and first inventor of the improvement covered by the reissued letters-patent, and that it had not, at the

time of his application for the original letters, been for more than two years in public use or on sale, with his consent or allowance. The answer takes issue on this averment and also denies infringement. On a final hearing the court dismissed the bill, and the complainant appealed.

As to the second defense above mentioned, it is sufficient to say that the evidence establishes beyond controversy the infringement by the defendants of the second claim of the reissue. We have, therefore, to consider whether the defense that the patented invention had, with the consent of the inventor, been publicly used for more than two years prior to his application for the original letters, is sustained by the testimony in the record.

The sixth, seventh and fifteenth sections of the act of July 4, 1836, ch. 357 (5 Stat., 117), as qualified by the seventh section of the act of March 3, 1839, chapter 88 (*id.*, 353), were in force at the date of his application. Their effect is to render letters patent invalid if the invention which they cover was in public use, with the consent and allowance of the inventor, for more than two years prior to his application. Since the passage of the act of 1839 it has been strenuously contended that the public use of an invention for more than two years before such application, even without his consent and allowance, renders the letters patent therefor void. It is unnecessary in this case to decide this question, for the alleged use of the invention covered by the letters patent to Barnes is conceded to have been with his express consent.

The evidence on which the defendants rely to establish a prior public use of the invention consists mainly of the testimony of the complainant. She testifies that Barnes invented the improvement covered by his patent between January and May, 1855; that between the dates named the witness and her friend Miss Cugier were complaining of the breaking of their corset-steels. Barnes, who was present, and was an intimate friend of the witness, said he thought he could make her a pair that would not break. At their next interview he presented her with a pair of corset-steels which he himself had made. The witness wore these steels a long time. In 1858 Barnes made and presented to her another pair, which she also wore a long time. When the corsets in which these steels were used wore out, the witness ripped them open and took out the steels and put them in new corsets. This was done several times. It is admitted, and, in fact, is asserted, by complainant, that these steels embodied the invention afterwards patented by Barnes and covered by the reissued letters patent on which this suit is brought.

Joseph H. Sturgis, another witness for complainant, testifies that in 1863 Barnes spoke to him about two inventions made by himself, one of which was a corset-steel, and that he went to the house of Barnes to see them. Before this time, and after the transactions testified to by the complainant, Barnes and she had intermarried. Barnes said his wife had a pair of steels made according to his invention in the corsets which she was then wearing, and if she would take them off he would show them to witness. Mrs. Barnes went out, and returned with a pair of corsets and a pair of scissors, and ripped the corsets open and took out the steels. Barnes then explained to witness how they were made and used.

This is the evidence presented by the record on which the defendants rely to establish the public use of the invention by the patentee's consent and allowance. The question for our decision is, whether this testimony shows a public use within the meaning of the statute.

§ 6485. *To constitute the public use of a patent it is not necessary that more than one of the patented articles should be publicly used. The use of a great number may tend to strengthen the proof of public use, but one well-defined case of public use is just as effectual to annul the patent as many.*

We observe, in the first place, that to constitute the public use of an invention it is not necessary that more than one of the patented articles should be publicly used. The use of a great number may tend to strengthen the proof, but one well-defined case of such use is just as effectual to annul the patent as many. *McClurg v. Kingsland*, 1 How., 202; *Consolidated Fruit-Jar Co. v. Wright*, 94 U. S., 92; *Pitts v. Hall*, 2 Blatch., 229. For instance, if the inventor of a mower, a printing-press or a railway car makes and sells only one of the articles invented by him, and allows the vendee to use it for two years, without restriction or limitation, the use is just as public as if he had sold and allowed the use of a great number.

§ 6486. *Whether the use of an invention is public or private does not necessarily depend upon the number of persons to whom its use is known.*

We remark, secondly, that, whether the use of an invention is public or private does not necessarily depend upon the number of persons to whom its use is known. If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee, without limitation or restriction, or injunction of secrecy, and it is so used, such use is public, even though the use and knowledge of the use may be confined to one person.

§ 6487. *A use of an invention is a public use, within the meaning of the law, if the inventor sells a machine of which his invention forms a part, and allows it to be used without restriction of any kind, although, owing to the character of the invention, it can only be used when it cannot be seen or observed by the public eye.*

We say, thirdly, that some inventions are by their very character only capable of being used where they cannot be seen or observed by the public eye. An invention may consist of a lever or spring, hidden in the running gear of a watch, or of a ratchet, shaft or cog-wheel covered from view in the recesses of a machine for spinning or weaving. Nevertheless, if its inventor sells a machine of which his invention forms a part, and allows it to be used without restriction of any kind, the use is a public one. So, on the other hand, a use necessarily open to public view, if made in good faith solely to test the qualities of the invention and for the purpose of experiment, is not a public use within the meaning of the statute. *Elizabeth v. Pavement Co.*, 97 U. S., 126 (§§ 6378-86, *supra*); *Shaw v. Cooper*, 7 Pet., 292.

§ 6488. *Where the inventor made and gave to a person for use two pairs of corset-steels, imposing no obligation of secrecy or any condition or restriction whatever, and it appeared that the invention was at that time complete, and the donee used them for a series of years before the filing of the application for a patent in the manner and for the purpose designed by the inventor, held, that the patent was invalidated by virtue of the public use, with the consent and allowance of the inventor, for more than two years prior to the filing of the application.*

Tested by these principles, we think the evidence of the complainant herself shows that for more than two years before the application for the original letters there was, by the consent and allowance of Barnes, a public use of the invention covered by them. He made and gave to her two pairs of corset-steels constructed according to his device, one in 1855 and one in 1858. They were presented to her for use. He imposed no obligation of secrecy, nor any

condition or restriction whatever. They were not presented for the purpose of experiment, nor to test their qualities. No such claim is set up in her testimony. The invention was at the time complete, and there is no evidence that it was afterwards changed or improved. The donee of the steels used them for years for the purpose and in the manner designed by the inventor. They were not capable of any other use. She might have exhibited them to any person or made other steels of the same kind, and used or sold them, without violating any condition or restriction imposed on her by the inventor.

According to the testimony of the complainant the invention was completed and put to use in 1855. The inventor slept on his rights for eleven years. Letters patent were not applied for till March, 1866. In the meantime the invention had found its way into general and almost universal use. A great part of the record is taken up with the testimony of the manufacturers and venders of corset-steels, showing that before he applied for letters the principle of his device was almost universally used in the manufacture of corset-steels. It is fair to presume that, having learned from this general use that there was some value in his invention, he attempted to resume, by his application, what by his acts he had clearly dedicated to the public.

“An abandonment of an invention to the public may be evinced by the conduct of the inventor at any time, even within the two years named in the law. The effect of the law is that no such consequence will necessarily follow from the invention being in public use or on sale, with the inventor’s consent and allowance, at any time within two years before his application; but that, if the invention is in public use or on sale prior to that time, it will be conclusive evidence of abandonment, and the patent will be void.” *Elizabeth v. Pavement Company, supra.*

We are of opinion that the defense of two years’ public use, by the consent and allowance of the inventor, before he made application for letters patent, is satisfactorily established by the evidence.

Decree affirmed.

Dissenting opinion by MR. JUSTICE MILLER.

The sixth section of the act of July 4, 1836, chapter 357, makes it a condition of the grant of a patent that the invention for which it was asked should not, at the time of the application for a patent, “have been in public use or on sale with the consent or allowance” of the inventor or discoverer. Section 15 of the same act declares that it shall be a good defense to an action for infringement of the patent, that it had been in public use or on sale with the consent or allowance of the patentee before his application. This was afterwards modified by the seventh section of the act of March 3, 1839, chapter 88, which declares that no patent shall be void on that ground unless the prior use has been for more than two years before the application.

This is the law under which the patent of the complainant is held void by the opinion just delivered. The previous part of the same section requires that the invention must be one “not known or used by others” before the discovery or invention made by the applicant. In this limitation, though in the same sentence as the other, the word “public” is not used, so that the use by others, which would defeat the applicant, if without his consent, need not be public; but where the use of his invention is by his consent or allowance, it must be public or it will not have that effect.

The reason of this is, undoubtedly, that if without his consent others have

used the machine, composition or manufacture, it is strong proof that he was not the discoverer or first inventor. In that case he was not entitled to a patent. If the use was with his consent or allowance, the fact that such consent or allowance was first obtained is evidence that he was the inventor and claimed to be such. In such case he was not to lose his right to a patent, unless the use which he permitted was such as showed an intention of abandoning his invention to the public. It must, in the language of the act, be *in public use* or on sale. If on sale, of course the public who buy can use it; and if used in public with his consent, it may be copied by others. In either event there is an end of his exclusive right of use or sale.

§ 6489. *Private and public use distinguished.*

The word *public* is, therefore, an important member of the sentence. A private use with consent, which could lead to no copy or reproduction of the machine, which taught the nature of the invention to no one but the party to whom such consent was given, which left the public at large as ignorant of this as it was before the author's discovery, was no abandonment to the public, and did not defeat his claim for a patent. If the little steel spring inserted in a single pair of corsets, and used by only one woman, covered by her outer-clothing, and in a position always withheld from public observation, is a *public* use of that piece of steel, I am at a loss to know the line between a private and a public use.

The opinion argues that the use was public, because, with the consent of the inventor to its use, no limitation was imposed in regard to its use in public. It may be well imagined that a prohibition to the party so permitted against exposing her use of the steel spring to public observation would have been supposed to be a piece of irony. An objection quite the opposite of this suggested by the opinion is, that the invention was incapable of a public use. That is to say, that while the statute says the right to the patent can only be defeated by a use which is public, it is equally fatal to the claim, when it is permitted to be used at all, that the article can never be used in public.

I cannot on such reasoning as this eliminate from the statute the word *public*, and disregard its obvious importance in connection with the remainder of the act, for the purpose of defeating a patent otherwise meritorious.

Use — Statutes, construction of — *Prior public use, acts 1793, 1836, 1839, §§ 6490-6494. Prior public use or sale, acts 1836, 1839, 1870, R. S., §§ 6495-6511. See Abandonment, Under the Statute, §§ 55-65.*

§ 6490. Under act of 1793, prior use is no bar to a patent. *Goodyear v. Mathews*, 1 Paine, 300.

§ 6491. Act 1793, section 1, "prior public use," construed. *Mellus v. Silsbee*, 4 Mason, 108.

§ 6492. Under the laws of 1836 and 1839, use or sale of an invention to defeat a patent must be with the consent and allowance of the inventor. *Campbell v. Mayor, etc., of New York*, 9 Fed. Rep., 500.

§ 6493. By the provision of the act of 1836, section 15, it was only public use or sale, with the consent and allowance of a patentee, before the application for a patent, that would defeat the patent. The act of 1839, section 7, did not change the character of the public use or sale that would defeat a patent, but provided that no patent should be held invalid by reason of them, unless "such purchase, sale or prior use has been for more than two years prior to such application for patent." *Campbell v. James*, 17 Blatch., 42.

§ 6494. "Public and common use" (act 1839, section 6) of an invention previously patented in England must be more than the "public use" of section 6; it must have passed into general use in the community to invalidate a patent upon the ground of the prior English patent. *American Hide & Leather Splitting Co. v. Tool Co.*, 1 Holmes, 503.

§ 6495. Under the seventh section of the act of 1836, directing the commissioner to cause an examination to be made of the alleged new invention, and to issue a patent if it shall not appear

inter alia that the invention had been in public use or on sale, with the applicant's consent or allowance, prior to the application, the commissioner has authority to investigate and determine the question of public use arising in connection with an application for a patent. *Mowry v. Barber*, 1 MacA. Pat. Cases, 563.

§ 6496. The use and sale of an invention under a patent is a public use within the meaning of section 7 of act of 1836, although such use is limited by the grant or monopoly to the patentee and those deriving title under him. It is not meant by the statute that there must be a general knowledge of and right to use the invention. The words "public use" mean use in public, as distinguished from secret or private use; and such a use by a single person will defeat the patent. *Ellithorp v. Robertson*, 1 MacA. Pat. Cases, 585.

§ 6497. The negative prerequisites to a patent — that the invention has not been in public use or on sale, etc. — as mentioned in the sixth section of the act of 1836, are equally binding upon the commissioner with the others therein named, and are expressly submitted to his examination by the opening provisions of section 7 of the same act. *Hunt v. Howe*, 1 MacA. Pat. Cases, 366.

§ 6498. The terms of act 1836, section 7, "prior to the application" for a patent, refer only to the "public use or sale" (of the invention) "with the applicant's consent or allowance." *Bartholomew v. Sawyer*, 4 Blatch., 347.

§ 6499. Under act 1839, prior public use and sale to invalidate a patent must be for more than two years prior to application, with knowledge and consent of inventor, and not for experimental purposes only. The burden of proof is on defendant who sets it up. *American Hide & Leather Splitting Co. v. Tool Co.*, 1 Holmes, 503.

§ 6500. The meaning of section 7 of the act of 1839 is given by inverting the order of the parts of the section so as to read as follows: No patent shall be held to be invalid by reason of such purchase, sale, or use prior to the application aforesaid, except on proof that such purchase, sale, or prior use has been for more than two years prior to said application for a patent, or by abandonment of said invention to the public. *Wickersham v. Singer*, 1 MacA. Pat. Cases, 645.

§ 6501. As distinguished from the English law — that if the thing is in use before the issuing of the patent, the patent is void — our law (section 7, act of 1839) provides that the use of the thing, even by leave of the inventor, for two years before his application for a patent, shall not invalidate it; *a fortiori*, the use of it by a third person or subsequent inventor after the first inventor, and before the issuing of the patent to the first inventor, without his consent, will not be a bar to such patent. *Heath v. Hildreth*, 1 MacA. Pat. Cases, 12.

§ 6502. Under the seventh section of the act of 1839 an inventor cannot obtain a patent if his invention was in public use more than two years prior to filing his application. *Rugg v. Haines*, 1 MacA. Pat. Cases, 420.

§ 6503. Under the provisions of section 15 of the act of 1836, and the seventh section of the act of 1839, an application will be barred by proof that the invention has been in public use for more than two years prior to filing the application. *Arnold v. Bishop*, 1 MacA. Pat. Cases, 28.

§ 6504. Section 7 of the patent act of March 3, 1839, as amendatory of that of July 4, 1836, construed to imply that the purchase, sale or prior use of an invention, etc., in defeat of a patent shall have been with knowledge and consent of the inventor. *Draper v. Wattles*, 16 O. G., 629.

§ 6505. Section 7 of the act of 1839 relieved the inventor from the danger of forfeiting his invention in consequence of its having been in public use or on sale for less than two years, but had no other effect. *Russell & Erwin Manufacturing Co. v. Mallory*, 10 Blatch., 140.

§ 6506. Section 7 of the act of 1839 has no application to a case where an applicant is met with the objection that the invention has been in public use under the patent of another. That provision is intended to relate to the case of a use, sale or license to use given, made or claimed under the patentee who admits and claims the privilege. In the case in question the applicant, so far from claiming the exception, denies that he ever did use or sell the invention to any one, and the patentee sets up no such claim. *Ellithorp v. Robertson*, 1 MacA. Pat. Cases, 585.

§ 6507. It would seem that the commissioner has power to compel the attendance of witnesses for the purpose of investigating the questions of public use and abandonment under the clause of section 12, act of 1839, providing that the commissioner shall have power to make such regulations in respect of the taking of evidence to be used in contested cases before him as may be just and reasonable. *Hunt v. Howe*, 1 MacA. Pat. Cases, 366.

§ 6508. It is the policy of the patent laws to forbid the issue of a patent for an invention which has been in public use before the application therefor. The statute of 1836 (5 Stats., 117, sec. 6) did not allow the issue of a patent when the invention had been in public use or on sale for any period, however short, with the consent or allowance of the inventor; and the statute of 1870 (Rev. Stats., sec. 4886) does not allow the issue when the invention had been in public

use for more than two years prior to the application, either with or without the consent or allowance of the inventor. *Manning v. Cape Ann Isinglass & Glue Co.*, 108 U. S., 462.

§ 6509. Public use in this country of the invention of the foreign patentee more than two years prior to filing the application for domestic patent is a defeat of the patent by the terms of the existing law of 1870. The public use thus made essential is a use in public, not necessarily a use by the public generally. *Henry v. Providence Tool Co.*, 14 O. G., 855.

§ 6510. Under section 4886, Revised Statutes, as under act of 1839, a public use of an invention for two years prior to the application, with or without the consent of the inventor, is sufficient to invalidate the patent. *Andrews v. Hovey*, 16 Fed. Rep., 387.

§ 6511. Section 4899, Revised Statutes, must be construed in connection with section 4886; and it may be said generally that while section 4886 makes void every patent where it is shown that the invention was in public use or on sale for the period of two years before the application for patent, section 4899, although allowing letters patent to stand, excepts from liability to the inventor, all persons who have used for less than two years any patented machine or article that has been purchased or constructed with the knowledge and consent of the inventor prior to his application for patent. *Duffy v. Reynolds*, 33 O. G., 621.

See *Applications*, §§ 340, 341. *Commissioner*, § 1094.

Use — Prior public, with inventor's allowance — Will defeat a patent, §§ 6512-6518. When not presumed, §§ 6519, 6520. When presumed, §§ 6521, 6522.

§ 6512. Public use, to defeat a patent, must be either generally allowed or acquiesced in, or, at least, unlimited in time, extent or object. *Wyeth v. Stone*, 1 Story, 273.

§ 6513. No fraudulent or wrongful use of an invention, and no public use without the consent, or knowledge, or sanction of the inventor, would deprive him of his right to a patent. *Pierson v. Eagle Screw Co.*, 3 Story, 402.

§ 6514. Public use of an invention prior to the grant of a patent, if acquiesced in by the inventor, is an abandonment, whether fraudulently obtained from him or not. *Shaw v. Cooper*, 7 Pet., 292.

§ 6515. The omission by an inventor to apply for a patent within two years after he learns that another is publicly using the invention and claiming it as his own, and the failure to interpose any warning or objection whatever, makes out a clear case of disability to prosecute a claim for a patent within the seventh section of the act of 1839. *Justice v. Jones*, 1 MacA. Pat. Cases, 635.

§ 6516. Whatever may be the intention of the inventor, if he suffers his invention to go into public use through any means whatever, without an immediate assertion of his right, he is not entitled to a patent; nor will a patent obtained under such circumstances protect his right. (*Shaw v. Cooper*, 7 Pet., 292.) *Savary v. Lauter*, 1 MacA. Pat. Cases, 691.

§ 6517. A first inventor cannot acquire a good title to a patent if he suffer the thing invented to go into public use, or to be publicly sold for use, more than two years before the date of his application for patent. *Rich v. Lippincott*, 2 Fish., 1.

§ 6518. The statute has made contemporaneous public use, with the knowledge and allowance of the inventor, a bar when it exceeds two years; but in the absence of that, and of any other colorable circumstance, we know of no mere period of time which ought, *per se*, to deprive an inventor of his patent. *Andrews v. Carman*, 13 Blatch., 307.

See *Priority of Invention*, § 4994.

§ 6519. The law does not presume, from patentee's public use of his own invention prior to patenting, that he consents to such use by others. *McMillin v. Barclay*, 5 Fish., 189.

§ 6520. The acquiescence of an inventor in the public use of his invention can in no case be presumed when he has no knowledge of such use; but this knowledge may be presumed from the circumstances of the case. What is evidence of acquiescence. (*Shaw v. Cooper*, 7 Pet., 292.) *Wickersham v. Singer*, 1 MacA. Pat. Cases, 645.

See *Abandonment*, § 37.

§ 6521. The fact that a patent was taken out by another inventor, four years before the application in question was filed, raises a strong presumption that the invention has been in public use with the consent and allowance of the applicant; and in the absence of any proof that the patent was surreptitiously or unjustly obtained, casts the burden of proof on the applicant to show that the fact is otherwise. *Ellithorp v. Robertson*, 1 MacA. Pat. Cases, 585.

§ 6522. When the machine of a rival inventor has been publicly used for years, with the knowledge of the applicant, or of which he might have had knowledge, he will be presumed to have acquiesced in and consented to such public use of the invention. *Hunt v. Howe*, 1 MacA. Pat. Cases, 366.

See *Acquiescence*, §§ 140-142. *Defenses*, § 1825.

Use — Prior public, § 6523.

§ 6523. If others practice the invention in this country, whether with or without the knowledge or consent of the patentee, more than two years prior to the filing of his application, the patent is invalid under the existing law. *Kelleher v. Darling*, 4 Cliff., 424.

Use — Prior public, prior to application — *Presumptions*, § 6524. *Must be of a perfect machine*, §§ 6525, 6526. *Must be clearly proved*, §§ 6527-6534. *Cannot be avoided by assigning invention*, § 6535.

§ 6524. As to public use for more than two years prior to date of application, the presumption is in favor of the patent. *Brown v. Whittemore*, 2 O. G., 248.

See *Date of Invention*, §§ 1724-1727.

§ 6525. Public use for more than two years prior to application for patent must be of a "perfect" machine, *i. e.*, a practical and operative invention, in order to invalidate the subsequent patent. *American Hide & Leather Splitting Co. v. Tool Co.*, 1 Holmes, 503.

§ 6526. Prior public use to defeat a patent must be of the perfected machine and not experimental merely, in order to amount to a dedication to the public. *Winans v. New York & Harlem R. R.*, 4 Fish., 1.

§ 6527. Public use of a single machine, other than by way of experiment, more than two years prior to application, must be clearly proved to establish an abandonment. *Pitts v. Hall*, 2 Blatch., 229.

§ 6528. Defense of prior public use to defeat a patent should be made out by clear proof. *Campbell v. James*, 17 Blatch., 42.

§ 6529. In order to sustain the defense of prior use, it is necessary for the defendant to show not only that the process was in public use prior to the alleged discovery, but that it was so used by some one who perceived the fact of its utility, who knew what could be accomplished by it, and who communicated this information to the public. *Boyd v. Cherry*, 4 McC., 70.

§ 6530. To justify the court in sustaining the defense of prior public use, the proof should be clear and satisfactory; the right of the infringer to invalidate the patent for this cause should be undoubted. *Graham v. McCormick*, 10 Biss., 39.

§ 6531. An application for a patent cannot be rejected on the ground that the invention was in public use and on sale for more than two years before the time of filing the application, when the only proof before the commissioner consists of mere *ex parte* affidavits taken without notice and cross-examination. *Alteneck's Appeal*, 23 O. G., 269.

§ 6532. The defense of public use for more than two years prior to the filing of the application upon which the patent was granted must be clearly proven. A private use for testing the invention and informing the inventor as to its perfection and usefulness, with the design on his part all the while to procure a patent, will not sustain such defense. *Campbell v. James*, 17 Blatch., 42.

§ 6533. Evidence almost wholly made up of the recollections of witnesses, revived after the lapse of many years, and contradicted in most instances by explicit testimony of other equally credible witnesses, leaves so much doubt as to the actual existence of the device as to make it unsafe to defeat a patent on the ground of public use thus sought to be established. *Washburn & Moen Manufacturing Co. v. Haish*, 10 Biss., 65.

§ 6534. In order to invalidate a patent on the ground of prior use, it is necessary to adduce evidence of that high character which convinces the court beyond a reasonable doubt. *Everest v. Buffalo Lubricating Oil Co.*, 20 Fed. Rep., 848.

§ 6535. The inventor cannot relieve himself of the consequences of the prior public use of his patented invention by assigning an interest in his invention or patent to the person by whom the invention was thus used. *Worley v. Loker Tobacco Co.*, 14 Otto, 340.

Use — Prior public, prior to application; particular cases — *Held to be a public use*, §§ 6535-6546. *Not a public use*, §§ 6547-6549.

§ 6536. The use of the machines by the plaintiff with consent of patentee, for a period of more than two years prior to application, in the absence of any evidence that a single step was taken to secure a patent, or that either the inventor or the plaintiffs intended to secure one, is a public use, an abandonment under act 1839, section 7, and the patent is void. *Toppan v. National Bank Note Co.*, 4 Blatch., 509.

§ 6537. Where the use of patentee's invention for four years prior to application was obviously that of a complete invention, and with a view to derive such benefit from it as might be due to its greater efficiency and economy over other devices before in use, and it was used

also in the ordinary way of the public use of such mechanism, it was held such prior public use as to invalidate the patent. *McMillin v. Barclay*, 5 Fish., 189.

§ 6538. Where a single stove was sold two years prior to the application for patent, although the particulars and terms of the sale were not proved, it was held to invalidate the patent. *Henry v. Francistown Soap-stone Co.*, 2 Fed. Rep., 78.

§ 6539. When it appeared from the testimony submitted in an interference that the applicant in the case — the other party being a patentee — had permitted several persons to make, for their own personal use and wear, corsets embracing his invention, without restriction or reservation, for more than two years before his application was filed, *held*, that his application was barred under the law by reason of public use, and that it was unnecessary, under such circumstances, to determine the question of priority of invention. *Blackington v. Douglass*, 1 MacA. Pat. Cases, 622.

6540. B. invented and perfected and privately used the invention in 1853. In 1858 his neighbor S. independently invented and patented the same thing, and put it into public use with the full knowledge of B., who applied for a patent one year later. *Held*, that B. has shown gross and culpable negligence, and has forfeited his right to a patent. *Spear v. Belson*, 1 MacA. Pat. Cases, 699.

§ 6541. W. filed an application for the invention in 1850, which was at once returned to him as informal. In the same year he transmitted new drawings and specifications, omitting therefrom the invention in dispute. Upon further objection he withdrew the application in 1851, received the return fee, and took no further steps until he filed a new application, October 6, 1858. S. made application for a patent in 1850, obtained a patent in 1851, and put the invention into extensive public use from 1853 on; of all of which facts W. was fully informed as early as April, 1856. *Held*, W. had abandoned the invention by not using due diligence in applying for and prosecuting his application for a patent; that his application of 1858 did not relate back to the date of the original application, and that his right to the patent was barred by reason of the public use and sale of the invention, with his consent and allowance, more than two years prior to filing his second application. *Wickersham v. Singer*, 1 MacA. Pat. Cases, 645.

§ 6542. Where two samples of the invention were made by patentee and given to another person for use, and subsequently he showed them to a third party, it was held a public use, which, having occurred more than two years prior to his application, constituted an abandonment of his invention. *Egbert v. Lippman*, 15 Blatch., 295.

§ 6543. Where, eight years before applying for a patent, the inventor, voluntarily and for a consideration, made a device embodying the invention described in his patent, and sold the same without reserve to a third party, who bought it for use and did so publicly use it, the patent was held void for public use more than two years prior to date of application. *Schneider v. Thill*, 5 B. & A., 565.

§ 6544. Where skates containing an improvement on an earlier patent held by the same inventor were in use or were offered for sale by the same inventor, whether actually sold or not, more than two years before his application for his second or subordinate patent, the latter is void. *Plimpton v. Winslow*, 14 Fed. Rep., 919.

§ 6545. Where an inventor allowed to two persons the unrestricted use of his invention without injunction of secrecy or other condition, such use *held* to constitute a public use. *Manning v. Cape Ann Isinglass & Glue Co.*, 108 U. S., 462.

§ 6546. A device which was used for about two and one-half months only, and was then laid aside, *held* to be an anticipation of a patent when the use was not for the purpose of testing the device, but was a public and practical one, with as much success as was reasonable to expect at that early stage of a particular art. *Brush v. Condit*, 20 Fed. Rep., 826.

§ 6547. Where the inventor, before applying for a patent, allowed six years to elapse in a *bona fide* experiment to test the strength and durability of a wood pavement which was laid upon a frequented road, but without exposing to the public view the mode of its construction, *held*, that there was no such public use of the invention, or any such dedication or abandonment of it, as would avoid a patent for it. *American Nicholson Pavement Co. v. City of Elizabeth*, 3 O. G., 522.

§ 6548. If Nobel's English Patent No. 1345 be regarded as a patent for the invention found in No. 78,317, and as having been granted more than six months before Nobel's application for No. 78,317, still No. 78,317 was not invalid, because it does not appear that the invention covered by it was introduced into public and common use in the United States prior to the application for No. 78,317. *Atlantic Giant Powder Co. v. Rand*, 16 Blatch., 250.

§ 6549. Where more than two years prior to his application for patent the inventor gave to another a specimen of his invention, but not for sale, which was, however, sold without his consent or allowance, *held*, it was not a public use and sale to invalidate his patent under acts 1836 and 1839. *Davis v. Fredericks*, 19 Fed. Rep., 99.

Use—Prior public and sale, with inventor's consent— *Will defeat patent*, §§ 6550, 6551. *Evidence of*, §§ 6552, 6553. *How pleaded*, § 6554.

§ 6550. Public sale or use of the invention with inventor's consent prior to his application will, under act 1793, deprive inventor of his right to patent. *Pennock v. Dialogue*, 2 Pet., 1.

§ 6551. Public use or sale that will deprive an inventor of his right to a patent must be with his consent and prior to his application. *Ryan v. Goodwin*, 3 Sumn., 514.

§ 6552. An unconditional sale by the inventor himself of his invention, together with a machine embodying the invention, more than ten years before filing the application, and the public exhibition of the machine by the purchaser, is conclusive proof that the invention was in public use, with the consent and allowance of the inventor; and he cannot then resume his right to a patent by the repurchase of such invention and machine. *Hunt v. Howe*, 1 MacA. Pat. Cases, 366.

§ 6553. Consent and allowance of public use and sale for more than two years prior to application for patent may be inferred from inventor's acquiescence therein. *Sisson v. Gilbert*, 9 Blatch., 185.

§ 6554. Allegation of sale and public use of an invention with allowance and consent of inventor at the time of the application is not a good defense, unless alleged to have been for more than two years prior to such application. *Agawam Co. v. Jordan*, 7 Wall., 583.

Use—Prior public, and sale— *Will defeat a patent*, §§ 6555-6559. *Evidence of*, § 6560. *Does not apply to reissues*, § 6561.

§ 6555. An applicant must be rejected upon testimony taken in an interference proceeding showing a sale and use of the invention more than two years prior to filing the application. *Rugg v. Haines*, 1 MacA. Pat. Cases, 420.

§ 6556. A patent is void if, more than two years before the application for it was filed, the patentee had sold the patented articles for the double purpose of realizing the proceeds and of seeing if they would sell, and others had them in actual use. *Consolidated Fruit-Jar Co. v. Wright*, 12 Blatch., 149.

§ 6557. Sales in the usual course of business, whether absolute or conditional, if they are sales of the patented thing, work a forfeiture of the invention if occurring more than two years prior to the filing of an application. A single sale is as effectual for this purpose as a hundred sales. *Henry v. Francetown Soap-stone Co.*, 2 Fed. Rep., 78.

§ 6558. The thing sold, to defeat the patent, need not have been perfect in the mechanical sense; it is sufficient if it embodied the completed invention in a form which would be operative. *Ibid.*

§ 6559. The mere fact that some of the sales were conditional — *i. e.*, that the articles were to be returned if they were not satisfactory to the buyers — does not, without further explanation, prove that the articles were experimental. It may show that the purchaser had doubts, but does not prove that the seller had any. *Ibid.*

§ 6560. Evidence of continued manufacture and sale through several years, and the allowance of such use thence onward, for six years more, before the patent was applied for, *held*, to be such prior use and sale as to invalidate a patent. *Sisson v. Gilbert*, 9 Blatch., 185.

§ 6561. More than two years' public use and sale prior to application for a patent does not apply to application for a reissue. *Shaw v. Colwell Lead Co.*, 11 Fed. Rep., 711.

Use—Prior public, in general— *To invalidate patent, the use must be prior to the discovery*, § 6562. *The use must be public*, §§ 6563-6565. *Employer's prior public use, with consent of employee (inventor), defeats employee's patent*, § 6566. *Machine in use for two years cannot be patented with an improvement*, § 6567.

§ 6562. Use prior to the discovery, not the application, invalidates a patent. *Evans v. Weiss*, 2 Wash., 342; *Goodyear v. Mathews*, 1 Paine, 300; *Morris v. Huntington*, 1 Paine, 348; *Treadwell v. Bladen*, 4 Wash., 703.

§ 6563. A prior use to avoid a patent must be public and with the acquiescence of the inventor. *Whitney v. Emmett*, 1 Bald., 303.

§ 6564. The intervening use, in order to defeat a prior invention, must be public, and with the consent of the inventor, and continue two years. *Allen v. Blunt*, 2 W. & M., 121.

§ 6565. Prior use, in order to invalidate a patent to a subsequent inventor, must be public, and not a private use unknown to the inventor. *Haselden v. Ogden*, 3 Fish., 378.

§ 6566. If a person employed in the manufactory of another, while receiving wages, makes experiments at the expense and in the manufactory of the employer, has his wages increased in consequence of the useful results of his experiments, makes the article invented, and per-

mits his employer to use it, no compensation for its use being paid or demanded, and then obtains a patent for it, the patent is invalid and void. (*McClurg v. Kingsland*, 1 How., 202.) *Worley v. Loker Tobacco Co.*, 14 Otto, 340.

§ 6567. A patentee cannot be permitted to use for profit a machine which embodies a perfected invention, for a period of two years or more, and then obtain a valid patent for the old machine by means of the addition of some new improvements which were intended to benefit the patent rather than the machine. *Sprague v. Smith*, 12 Fed. Rep., 721.

Use — Prior knowledge and — *A perfected machine is necessary in order to defeat a patent on the ground of prior knowledge and use, §§ 6568-6571; prior use, § 6572.*

§ 6568. Adverse knowledge and use of the device claimed, prior to the patentee's invention thereof, on a machine which was never completed, the device itself not being patented or otherwise given or made accessible to the public until long after the issue of complainant's patent, will not invalidate the exclusive right of the patentees. *Bullock Printing Press Co. v. Jones*, 13 O. G., 124.

§ 6569. Since the decision of the case of *Coffin v. Ogden*, 18 Wall., 120, evidence is sufficient to support the defense of a prior knowledge and use when it proves that the invention was complete and capable of working, if it had been put in public use and was known to any considerable number of persons. *Judson v. Bradford*, 16 O. G., 171.

§ 6570. Although the circumstances of the inventor and the nature of the article may have required that it be tested by others, still, under the defense of adverse public use, it is somewhat difficult for a court to qualify, by a supposed intention not declared at the time, the act of an inventor who sells the patented article on two occasions, apparently in the ordinary course of trade. *Draper v. Wattles*, 16 O. G., 629.

§ 6571. But the sale, purchase or use must have been of the thing patented; hence, where it was a less perfect article, not merely a colorable variation, no dedication results, although such article may embody features in common with what was thereafter patented. *Ibid.*

§ 6572. A patent is not invalidated by proof that before the patentee's invention a device similar to the patentee's was temporarily in use, but proved a failure and was abandoned under circumstances indicating that it was no more than an unsuccessful and abortive experiment. To defeat a patent on the ground of prior use of the patented invention, it must appear that the anticipatory device was embodied in distinct form, and was so far perfected as to be capable of practical use. *Allis v. Buckstaff*, 22 O. G., 1705.

Use — Prior — Pleading and practice, §§ 6573-6579.

§ 6573. The defense that the patentee had allowed his invention to be in public use or on sale for two years before he applied for a patent is distinct from the defense that he had abandoned it to the public, and should not be blended with it in the same pleading. *Jones v. Sewall*, 3 Cliff., 563.

§ 6574. A plea in defense, that "the invention named was in public use and on sale more than two years prior to the supposed invention of the complainants," overruled as not within any one of those allowed by statute. *Kelleher v. Darling*, 4 Cliff., 424.

§ 6575. Inventors may, if they can, keep their invention secret, and if they do, no neglect to petition for a patent will forfeit their right to apply to the commissioner for that purpose. Mere delay is not a good defense, but the respondent, in a suit for infringement, if he gives the required notice, may allege and prove that the invention embodied in the patent in suit had been in public use or on sale more than two years prior to the complainant's application for a patent; and if he alleges and proves that defense he is entitled to prevail in the suit. Those requirements constitute conditions to the sufficiency of the defense, and the court held that the respondents had not complied with either to any effectual extent. *Bates v. Coe*, 8 Otto, 31 (§§ 1816-30).

§ 6576. Where the defense of prior use is relied upon it is necessary to set out in the answer the names of those who have invented or used the anticipatory machine or improvement, but not the names of the witnesses who are to testify touching such prior use. *Allis v. Buckstaff*, 22 O. G., 1705.

§ 6577. When the answer alleges knowledge by certain persons of a certain place, but not knowledge at that or any other place, proof cannot be received that such knowledge was at that place. Affirmative defenses, and especially this defense as provided and regulated by the statute, must be alleged as well as proved. *Searls v. Bouton*, 12 Fed. Rep., 140.

§ 6578. More than one patent may be included in one suit and more than one invention may be secured in the same patent, in which cases the several defenses of prior invention and pub-

lic use may be made to each patent in the suit and to each invention to which the charge of infringement relates. *Parks v. Booth*, 12 Otto, 96.

§ 6579. The patent act allows the infringer to plead and prove that the invention of the patentee had been in public use or on sale in this country for more than two years before the inventor applied for a patent; but no question of priority is open under that defense, nor will evidence sustain it that another had made or patented the invention two years before the application without the knowledge of the patentee whose invention is in question. *Ibid.*

Use — Prior use or sale — Burden of proof on defendant, §§ 6580-6584.

§ 6580. The burden of proof is on the party who sets up the objection of "prior use" against the patent. *Corn-Planter Patent*, 23 Wall., 181.

§ 6581. The burden of sustaining their answer by proof of prior use is on the defendants; and if the testimony is so conflicting as to leave the question in doubt, it will be decided against them. *Roemer v. Simon*, 5 O. G., 555.

§ 6582. Upon the issue of prior use, the burden of proof rests upon defendant. *Putnam v. Yerrington*, 9 O. G., 689.

§ 6583. The rule of evidence is that if a defendant alleges the prior use of a patented device, the burden of proof is upon him. *Parker v. Reinhoff*, 17 Blatch., 206.

See *Invention, Prior*, § 3714.

§ 6584. The burden is on defendant to prove a sale of plaintiff's invention for more than two years prior to his application. *Hovey v. Henry*, 3 West. L. J., 153.

See *Burden of Proof*, § 662.

Use — Prior public, single — Will defeat a patent, §§ 6585-6591.

§ 6585. A patent may be defeated by showing that the thing patented had been discovered and put in actual use prior to patentee's discovery, however limited that use may have been. *Bedford v. Hunt*, 1 Mason, 302.

§ 6586. A patent may be defeated by showing that the thing secured by the patent had been discovered or put into actual use prior to the discovery of patentee, however limited such prior use or knowledge may have been. *Rich v. Lippincott*, 2 Fish., 1.

§ 6587. A single public use of a prior invention, where both work and product were seen by several, is sufficient prior knowledge to defeat a subsequent patent for a similar invention. *Aiken v. Dolan*, 3 Fish., 197.

§ 6588. Prior public use of one machine will invalidate a patent therefor. *American Hide & Leather Splitting Co. v. Tool Co.*, 1 Holmes, 503.

§ 6589. A patent may be defeated by showing that the thing secured by the patent had been invented and put into actual public use prior to the discovery of the patentee, however limited such use (other than experimental) or knowledge of the prior discovery may have been. *Boston Elastic Fabric Co. v. East Hampton Rubber Thread Co.*, 9 O. G., 745.

§ 6590. One instance of public use more than two years prior to application is sufficient to defeat the patent. *Clark Pomace Holder Co. v. Ferguson*, 17 Fed. Rep., 79.

§ 6591. A single instance of the public use of his invention by a patentee for more than two years before the date of his application will be fatal to the validity of the letters patent. *Worley v. Tobacco Co.*, 14 Otto, 340.

See *Reduction to Practice*, §§ 5238-5240.

Use — Prior — Evidence, §§ 6592-6594.

§ 6592. Testimony that parties introduced by defendant to prove prior use of the invention had paid plaintiff for the privilege of the use is admissible. *Evans v. Eaton*, 3 Wheat., 454.

§ 6593. The testimony of a witness as to prior use by him of the invention patented is rendered unreliable and incompetent by the circumstance that his employers, after having the benefit of his skill, sought the right to use the patented process as soon as they heard of it, and the further fact that the specimens produced were very different from those made under the patent. *St. Louis Stamping Co. v. Quinby*, 16 O. G., 135.

§ 6594. Where, under a general denial of patentee's priority of invention, evidence of prior knowledge and use was taken without objection, or exception in the answer, it was held competent on the question of the validity of the patent, in view of decision in *Loom Co. v. Higgins*, 105 U. S., 595. *Zane v. Soffe*, 110 U. S., 200.

Use — Right to use — *Right to make distinguished from right to use*, § 6595. *During term of patent*, §§ 6596, 6597. *On expiration of term*, §§ 6598-6600. *Effect of recovery of damages on*, §§ 6601, 6602. *After reissue*, §§ 6603, 6604. *Right to use device constructed with inventor's permission, and paid for*, §§ 6605, 6606.

§ 6595. The right to make a machine is distinct from that of using it. *Bicknell v. Todd*, 5 McL., 236.

§ 6596. Right to use a machine under a license during the original term is a property right, which, on expiration of the original term, is attached to the particular machine then in use; and both the right and the machine may pass by sale, devise, or levy of execution, or assignment of insolvent's effects. *Woodworth v. Curtis*, 2 W. & M., 524.

§ 6597. Whether a patentee, who has lost his rights in consequence of proof that his alleged invention was anticipated by another to whom a patent has issued, will be allowed to continue the use of such invention by showing that neither was the first inventor, must depend upon whether he has acted in good faith in the matter. *Greenwood v. Bracher*, 1 Fed. Rep., 856.

§ 6598. The right to use a machine after the expiration of the term of the patent is an incident to the primal right to use it during the original term; if that falls on account of fraud, the incident falls with it. *Union Paper Bag Machine Co. v. Nixon*, 1 Flip., 491.

§ 6599. Whatever was patented to the inventor and enjoyed by him and those operating under him during the term of the patent belongs to the public and is free to all at the expiration of the term. *Willcox & Gibbs Sewing Machine Co. v. Frame*, 24 O. G., 1272.

§ 6600. Where the public has acquired in any way the right to use a machine or device for a particular purpose, it has the right to use it for all the like purposes to which it can be applied, and no one can take out a patent to cover the application of the device to a similar purpose. *Blake v. City and County of San Francisco*, 113 U. S., 679.

§ 6601. Where the patent fee is adopted as the measure of damages, the right to the use of the invention throughout the term passes. *Sickles v. Borden*, 3 Blatch., 535.

§ 6602. One who pays damages for selling a machine in infringement of a patent does not acquire for himself or his vendee any right to use that machine except when actual damages have been paid. *Birdsell v. Shaliol*, 112 U. S., 485.

§ 6603. The fact that defendants were not liable for use of the invention under the defective patent conveys no right to continue its use subsequent to reissue. *Stimpson v. Railroad Co.*, 4 How., 380.

§ 6604. Acquiescence by the patentee in the use by the defendant of the original defective patent does not authorize the use of the invention after the issuing of the reissued patent. *McWilliams Manufacturing Co. v. Blundell*, 11 Fed. Rep., 419.

§ 6605. R., the agent of the patentee, authorized the firm of H., C. & N., for a valuable consideration, to construct for use, at their place of business, the device (a furnace) involved in the patent. The defendants, who had acquired all the rights of the firm of H., C. & N., were sued for infringement because of the use of the device. *Held*, first, that after the transaction with H., C. & N., the patentee had no right or interest with respect to the particular device and its use during the time of his original patent, and acquired none by the extension of his patent afterward; second, that those who *constructed* the device under the authority of the patentee, and the defendants who acquired it of them, have had, and still have, the right to use it at the particular place, clear of any claim of infringement by the patentee or his representatives. *Black v. Hubbard*, 12 O. G., 842.

§ 6606. Although the right to use may not have been acquired by lawful conveyance (according to the statutes) of that right as a subject of conveyance by itself, it was acquired by constructing the device for use, with the consent of the patentee obtained and paid for. *Ibid*.

See *Combination*, § 1018. *Contracts*, § 1290. *Decree*, §§ 1806, 1809. *Extension*, §§ 2490-2503. *Improvement*, §§ 2745-2764. *Improver*, §§ 2797-2809. *Infringement*, §§ 2911-2940. *Sale*, §§ 5912-5944.

374. UTILITY.

See NOVELTY, UTILITY AS EVIDENCE OF.

Utility — Defined, §§ 6607-6619. *In what want of utility consists*, §§ 6620, 6621.

§ 6607. Act 1793, "useful," construed. *Lowell v. Lewis*, 1 Mason, 182.

§ 6608. "Useful," act 1793, means not frivolous, or injurious to the well being, good policy or sound morals of society. *Lowell v. Lewis*, 1 Mason, 182; *Bedford v. Hunt*, 1 Mason, 302; *Kneass v. Schuylkill Bank*, 4 Wash., 9.

§ 6609. "Useful," act 1793, is used in contradistinction to frivolous or injurious. Want of

utility may be a good reason for not issuing a patent, but is no cause for avoiding it. *Whitney v. Emmett*, 1 Bald., 305.

§ 6610. "Utility" defined. *Earle v. Sawyer*, 4 Mason, 1.

§ 6611. An invention must be useful as contradistinguished from that which is frivolous, or wholly worthless. If not frivolous or entirely useless, the requirements of the law in this particular are complied with. *Stanley v. Hewitt*, 17 Frank. Jr. (2d Series), 165.

§ 6612. "Useful," in the patent law, is in contradistinction to "mischievous." The invention should be of some benefit. *Cox v. Griggs*, 1 Biss., 362.

§ 6613. "Useful," in the statute, is in contradistinction to what is frivolous or mischievous to the public. *Wintermute v. Redington*, 1 Fish., 239; *Page v. Ferry*, 1 Fish., 298.

§ 6614. What constitutes utility to sustain a patent. *Cook v. Ernst*, 2 O. G., 89.

§ 6615. In what "utility" consists. *McComb v. Ernest*, 1 Woods, 195.

§ 6616. Whether an invention is useful in the sense of the patent law is not whether it is not mischievous, or hurtful, or frivolous, or insignificant, but whether it is capable of use for a purpose from which some advantage can be derived. If it be useful in this sense, the degree or extent of its usefulness is altogether unimportant. *Crouch v. Speer*, 6 O. G., 187.

§ 6617. To constitute utility it is not important that it should be more valuable than other modes of accomplishing the same result; but it must be a practical method of doing the thing designed, in which its utility will more or less consist. *Roberts v. Ward*, 4 McL., 565.

§ 6618. It is not necessary to maintain a patent that the invention should be the very best for the use to which it is applied; if it is at all valuable, if its use for the purpose for which it is constructed is practicable, that is sufficient to sustain it as a useful invention. *Many v. Jagger*, 1 Blatch., 372.

§ 6619. The question whether the invention is sufficiently useful and important does not refer to its degree of utility as compared with other inventions of the same kind, but rather to its purpose; as whether, being capable of use, it is destined for some beneficial purpose, or is merely frivolous, insignificant or mischievous to society. *In re Seely*, 1 MacA. Pat. Cases, 248.

§ 6620. There is no utility in a patent which practices a deception on the public. *Langdon v. De Groot*, 1 Paine, 203.

§ 6621. Neither an invention which will not enable the operator to accomplish the described result, nor one which constantly exposes him to loss of his life, or great bodily harm, can be regarded as useful within the meaning of the patent law. *Mitchell v. Tilghman*, 19 Wall., 287.

See § 3638.

Utility — Degree of — Not essential, §§ 6622-6637.

§ 6622. To sustain a patent it must be to some extent useful. *Parker v. Stiles*, 5 McL., 44.

§ 6623. If the invention be useful to a certain degree and original with patentee, it is patentable, whether it does less or more work. *Wilbur v. Beecher*, 2 Blatch., 132.

§ 6624. Want of utility in a patented invention is a valid objection to the patent; but it is well settled that courts will not inquire astutely into the degree or measure of its utility, and unless it appears that the invention is wholly worthless or frivolous, the patent will be sustained. *Whitney v. Mowry*, 2 Bond, 45.

§ 6625. The law requires an invention to have some degree of utility, and that is all. *Many v. Sizer*, 1 Fish., 17.

§ 6626. The law does not require the patentees to prove their discovery to be useful to any eminent degree; it is sufficient if it produces an improved article at less cost or with more expedition than other known methods. *Carr v. Rice*, 1 Fish., 198.

§ 6627. If the invention be useful in any degree, and not absolutely worthless, the patent will be sustained. *Vance v. Campbell*, 1 Fish., 483.

§ 6628. A small degree of utility is sufficient to support a patent. *Clark Patent Steam & Fire Regulator Co. v. Copeland*, 2 Fish., 221.

§ 6629. All that the law requires is that an invention shall not be frivolous or dangerous. It does not require any degree of utility; if it is useful at all, that suffices. *Hoffheims v. Brandt*, 3 Fish., 218.

§ 6630. The degree of usefulness or importance to be exhibited by the alleged invention is not defined by the statute (act of 1836), nor is the degree material if the invention does not interfere with any prior right or claim, and is in itself innocent. If good may be the result of granting a patent, and evil cannot be, the patent should be allowed, especially as it is doubtful whether a rejected applicant has any means of having his right to a patent brought before a court of law to be tried by a jury. *In re Aiken*, 1 MacA. Pat. Cases, 130.

§ 6631. It is not necessary that the utility should be great; it is sufficient if the invention is an improvement at all. If it is of a different construction from former articles of the same kind, and of any use, that is sufficient. It need not come into general use. *Chandler v. Ladd*, 1 MacA. Pat. Cases, 493.

§ 6632. All the law requires as to utility is that the invention should not be frivolous or dangerous. It does not require any given degree of utility. If the invention is useful at all, that suffices. *Converse v. Cannon*, 2 Woods, 7.

§ 6633. Any degree of utility appreciable to a jury is sufficient, upon the question of utility, to sustain a patent. *Conover v. Roach*, 4 Fish., 12.

§ 6634. The patent is not void for want of utility if the invention possesses it in any measure, however slight. *Westlake v. Carter*, 4 O. G., 636.

§ 6635. In order to render a device patentable it need not possess greater utility or be better than others of the kind; it is sufficient if, being new, it serves a useful purpose. *Crouch v. Speer*, 6 O. G., 187.

§ 6636. Degree of utility is not a question. The law only requires that it shall be capable of some use, and that the use is not prohibited by sound morals or public policy. *Adams v. Loft*, 4 B. & A., 495.

§ 6637. If an invention is useful in any degree, no matter how infinitesimal, the court would not be justified in declaring the patent void. *Gibbs v. Hoefner*, 19 Fed. Rep., 323.

Utility — Evidence of, what constitutes — *The patent is*, §§ 6638, 6639. *General use*, §§ 6640-6643. *Defendant's use*, §§ 6644-6647. *Good sales*, §§ 6648-6650.

§ 6638. The patent is *prima facie* evidence of utility. *Vance v. Campbell*, 1 Fish., 483.

§ 6639. The patent is evidence of some utility, but this may be rebutted by evidence that it is frivolous and of no practical value. *Wayne v. Holmes*, 1 Bond, 27.

See *Novelty*, §§ 4324-4328.

§ 6640. General use of an invention is evidence of its utility. *Heinrich v. Luther*, 6 McL., 345.

§ 6641. Extensive use of an invention is evidence of utility. *Adams v. Edwards*, 1 Fish., 1.

§ 6642. It is essential that the improvement (in case of a machine), as described in the specification, shall, as a matter of fact, be capable of operating in the manner described; and it will be sufficient evidence of this fact if it shall appear, in the course of testimony taken in an interference proceeding, that the invention has been successful in the hands of others, although the applicant himself, having a mistaken idea of the capacity of the machine, has failed to obtain successful results. *Burrows v. Witherill*, 1 MacA. Pat. Cases, 315.

§ 6643. Utility is suggestive of originality, and the fact of the acceptance of a device or combination by the public and putting it into extensive use is accepted as evidence that it was the product of invention. *Washburn & Moen Mfg. Co. v. Haish*, 10 Biss., 65.

§ 6644. The fact that defendant prefers to use the mechanism patented to complainant is evidence that there is sufficient utility in the invention to support a patent. *Smith v. Glendale Elastic Fabrics Co.*, 1 Holmes, 340.

§ 6645. Utility of an invention held proven by defendant's imitation of it, and its favorable reception by the public. *Stanley v. Hewitt*, 17 Frank. Jr., 2d Series, 165.

§ 6646. A former contract between plaintiff and defendants for the use of plaintiff's machine admitted as evidence of utility. *Lee v. Blandy*, 1 Bond, 361.

§ 6647. The fact that the defendant is using in his machine the various combinations claimed in the patent, and testifies that the machine exhibits a high degree of utility, is ample evidence of the utility of the patented invention. *Foye v. Nichols*, 22 O. G., 2243.

§ 6648. Superior beauty of an ornament and good sales are evidence of utility. *Magic Ruffle Co. v. Douglass*, 2 Fish., 330.

§ 6649. The utility of an invention may be presumed from its having met with extensive sales. *Stuart v. Shantz*, 2 O. G., 524.

§ 6650. The utility of the article shown from its extensive sale, and the unanimity with which rivals engaged in its manufacture. *Eppinger v. Richey*, 14 Blatch., 307.

Utility — Evidence of — *Price paid*, § 6651. *Saving in labor*, § 6652. *What will not disprove*, §§ 6653, 6654.

§ 6651. Utility. Price paid for use, evidence of. *Park v. Little*, 3 Wash., 196.

§ 6652. In considering the question of utility, any saving in labor or expense is a proper subject for the consideration of the jury. *Hays v. Sulsor*, 1 Bond, 279.

§ 6653. The fact that the difference of construction is only brought into play on rare occasions is no sufficient reason to deny the utility of the invention. *Chandler v. Ladd*, 1 MacA. Pat. Cases, 493.

§ 6654. The fact that other devices, superior to patentee's original device, taken as a whole, have been invented, and have driven it out of use, does not prove or tend to prove that his invention lacks utility, as the law uses that term. *McComb v. Ernest*, 1 Woods, 195.

Utility — *Is essential to patentability*, §§ 6655-6658; *but not conclusive evidence of*, §§ 6659-6662.

§ 6655. Under the seventh section of the act of 1836, one of the conditions necessary to the granting of the patent is that, upon the examination thereby directed, "the commissioner shall deem it [the invention] to be sufficiently useful and important." *In re Cushman*, 1 MacA. Pat. Cases, 569.

§ 6656. The utility of an invention is an essential requisite to the validity of the patent. *Page v. Ferry*, 1 Fish., 298.

§ 6657. Every invention or discovery must be useful, to entitle the party to a patent. *Allen v. Hunter*, 6 McL., 303.

§ 6658. To warrant a patent the invention must be useful, that is, capable of some beneficial use, in contradistinction to what is pernicious, or frivolous or worthless. *Crompton v. Belknap Mills*, 3 Fish., 536.

See *Patentability*, §§ 4600-4604.

§ 6659. Utility is not an infallible test of originality. *Stanley Works v. Sargent & Co.*, 8 Blatch., 344.

§ 6660. Evidence of utility which may go to prove patentability. *Lindsay v. Stein*, 10 Fed. Rep., 907.

§ 6661. The demonstrated great utility of a device, while not conclusive as to its patentability, is a fair matter of consideration in determining it in questions of doubt. *Washburn & Moen Mfg. Co. v. Grinnell Wire Co.*, 24 Fed. Rep., 23.

§ 6662. While the fact that a device is useful and has superseded others previously employed for analogous purposes is proper to be considered, and in some cases is decisive, it does not of itself establish the fact of patentability. *Phillips v. City of Detroit*, 17 O. G., 191.

Utility — Infringer may not deny, §§ 6663-6668.

§ 6663. An infringer is estopped from denying utility. *Gray v. James*, Pet. C. C., 394; *Lowell v. Lewis*, 1 Mason, 182; *Kneass v. Schuylkill Bank*, 4 Wash., 9.

§ 6664. Infringers cannot set up want of utility in defense of the patent. *Phillips, Nimick & Co. v. Carroll & Co.*, 23 Fed. Rep., 249; *Hays v. Sulsor*, 1 Bond, 279; *Lee v. Blandy*, 1 Bond, 361; *Rice v. Heald*, 13 Pac. L. R., 33.

§ 6665. Where defendants have used the patented improvement, they are estopped from denying its utility. *Vance v. Campbell*, 1 Fish., 483.

§ 6666. Where defendant used the patented process before the filing of the bill, and continued its use under bond to account for profits, he was held estopped from insisting on its want of utility. *Whitney v. Mowry*, 4 Fish., 207.

§ 6667. Where defendants had made and sold large numbers of plaintiff's patented invention, they were estopped from setting up the defense of want of utility. *Robertson v. Garrett*, 10 Blatch., 490.

§ 6668. Where a manufacturer marked his articles with a patent which he did not own, *held*, that he could not be allowed to use that to which the complainant had at least the conclusive *prima facie* right and then defend himself by denying the validity of the patent. *Washburn & Moen Mfg. Co. v. Haish*, 9 Biss., 141.

Utility — Presumption of, arises on face of patent, §§ 6669-6674.

§ 6669. There is a presumption of some degree of utility arising from the patent itself, but it is not conclusive, and the other party may show that the invention is useless. *Lee v. Blandy*, 1 Bond, 361.

§ 6670. The patent raises the presumption of utility, which defendants must overcome; though if it is in any degree useful, the patent will be sustained. *Bell v. Daniels*, 1 Bond, 212.

§ 6671. An invention must be of some utility — a patent cannot be granted for a thing altogether frivolous; but the presumption on the face of the patent is that it is of some utility. *Hays v. Sulsor*, 1 Bond, 279.

§ 6672. Utility is presumed on the grant of a patent, and can only be repelled by clear proof that it is utterly worthless. The degree of utility is not pertinent, except in estimating damages. *Tilghman v. Werk*, 1 Bond, 511.

§ 6673. The presumption of utility arising upon the grant and extension of a patent, and the long and successful use of the patented process, requires clear and explicit proof of its utility to justify a judgment declaring the patent void. *Whitney v. Mowry*, 2 Bond, 45.

§ 6674. A machine cannot be pronounced useless or impracticable because it is susceptible of improvement which will obviate or prevent embarrassments to its more perfect operation. *Wheeler v. Clipper Mower & Reaper Co.*, 10 Blatch., 181.

See *Patents*, §§ 4629, 4633.

VAGUE SPECIFICATIONS—VALIDITY OF THE PATENT. §§ 6675-6690.

Utility—Burden is on defendant to show want of, §§ 6675, 6676.

§ 6675. Upon the question of want of utility the burden of proof is on defendant. *Parker v. Stiles*, 5 McL., 44.

§ 6676. The patent throws the burden of proof on defendant to show that the invention described therein is not a practical machine. *Fifield v. Whittemore*, 17 Fed. Rep., 513.

Utility—In general—*When a question for court, or jury, § 6677. In action for infringement, value shown, § 6678. Court will not reverse office decision as to, § 6679. Competent testimony as to, § 6680. Additional evidence in support of, § 6681. Filing affidavits as to, § 6682. Sufficient utility to sustain a patent, § 6683.*

§ 6677. When the question of “utility” is for the court, and when for the jury, considered. *Langdon v. De Groot*, 1 Paine, 203; *Parker v. Stiles*, 5 McL., 44.

§ 6678. In an action for infringement it is not necessary to show the comparative value of the thing invented, so far as the exclusive right is concerned, beyond the fact that it is useful, or of some value. *Hotchkiss v. Greenwood*, 4 McL., 456.

§ 6679. Where a suit upon a patent is defended on the ground that the alleged invention is not patentable, it is not usual for the court to revise the decision of the office as to its utility. *Doherty v. Haynes*, 4 Cliff., 291.

§ 6680. The testimony of witnesses is admissible to show the practical effect or utility of an invention. *In re Fultz*, 1 MacA. Pat. Cases, 178.

§ 6681. Where an applicant has complied with all the formal requirements of the law by duly filing his application, and it is not found upon examination that the invention is subject to any of the objections mentioned in the law as fatal to the grant of a patent, it is not competent for the commissioner to require additional evidence as to the practical result of the invention. *In re Seely*, 1 MacA. Pat. Cases, 248.

§ 6682. Pending the decision of an appeal from the commissioner, an applicant will be permitted, on motion, to procure and file affidavits of competent persons touching the practical utility and advantages of his invention. *In re Fultz*, 1 MacA. Pat. Cases, 178.

§ 6683. A patent held not to be void for want of utility in the invention upon its appearing that it possessed certain advantages over others. *Smith v. O'Connor*, 2 Saw., 461.

See *Defenses*, § 1844. *Identity*, §§ 2671-2710. *Novelty*, §§ 4331-4339. *Patentability*, § 4553.

375. VAGUE SPECIFICATIONS.

See SPECIFICATIONS, VAGUE.

376. VALIDITY OF THE PATENT.

Validity—*Pro tanto validity, §§ 6684, 6685. Prerequisites to valid grant, § 6686. A question for the court, § 6687. Presumption, §§ 6688, 6689. Not affected by foreign patents, § 6690. Cannot be collaterally attacked, § 6691. Use by others does not necessarily invalidate, § 6692.*

§ 6684. Act 1793, section 9, “*pro tanto* validity of patent,” considered. *Wyeth v. Stone*, 1 Story, 273.

§ 6685. Under act 1837, section 9, *held*, that in case of an “inadvertency and mistake of law, as well as of fact,” the patent will be valid, *pro tanto*, in the absence of unreasonable delay in filing disclaimer. *Ibid*.

§ 6686. It is enough that the inventor has perfected his invention, and is able to furnish to the patent office such specifications and model as the law requires. Having done this, the patent in so far as prerequisites to its validity, either by way of experiment or use, are material is valid. *Wheeler v. Clipper Mower & Reaper Co.*, 10 Blatch., 181.

§ 6687. The validity of the patent upon its face is a matter of construction for the court. *Parker v. Hatfield*, 4 McL., 61.

§ 6688. The presumption of validity arising on the grant of a patent is strengthened by its extension. *Whitney v. Mowry*, 2 Bond, 45.

§ 6689. The fact that persons in authority in certain cities had, during the last four years, employed plaintiff, at his own price, to lay his patented pavement, *held*, wholly insufficient to raise a presumption in favor of the validity of the patent. *Guidet v. Palmer*, 10 Blatch., 217.

§ 6690. The validity of a patent granted in this country does not at all depend upon the

validity of the patent granted in a foreign country, although its duration may. *Cornley v. Marckwald*, 17 Fed. Rep., 83.

§ 6691. In a suit for infringement the granting and validity of the patent cannot be collaterally attacked. *Crompton v. Belknap Mills*, 3 Fish., 536.

§ 6692. It does not detract from the validity of a patent, that the inventions of others are made use of in carrying out the patented invention. One invention may include within it many others, and patents for each and all be valid at the same time, but in such case each inventor would be precluded from using the inventions made and patented prior to his own, except by license from the owners thereof. *Cochrane v. Deener*, 4 Otto, 781.

See *Patentability*, § 4552. *Reissues*, §§ 5786-5788. *Verdict*, § 6705.

Validity — Evidence of — *Patent is*, § 6693. *Extensive sale is*, § 6694. *Evidence of invalidity*, §§ 6695-6697.

§ 6693. The patent is *prima facie* evidence that the several grants contained in it are valid, that the several things, methods and devices granted were new, that they are useful, that they require invention, and that they were patentee's invention. *Potter v. Hollender*, 4 Blatch., 238.

§ 6694. In all doubtful cases involving the validity of a patent, the fact that the article made by the use of the process described in the patent has been extensively sold is a consideration of great weight with the court, but it is not enough *per se* to sustain the patent. *Wilson Packing Co. v. Chicago Packing & Provision Co.*, 10 Biss., 559.

§ 6695. Under section 6, act 1793, defendant under general issue can give in evidence contesting the validity of the patent, provided he has given notice of his intention. *Evans v. Eaton*, 3 Wheat., 454.

§ 6696. Circumstances in which the long and unexplained acquiescence of patentee in the infringement of his patent may be evidence of its invalidity. *Doubleday v. Beatty*, 11 Fed. Rep., 729.

§ 6697. Where infringement is denied and a right alleged to make the patented article, which puts the plaintiff to the proof of his patent, as alleged in the bill, such proof may be met by any proof on the part of defendant tending to show the invalidity of the patent. *Eagleton Mfg. Co. v. West, Bradley & Cary Mfg. Co.*, 18 Blatch., 218.

Validity — Burden of proof — *On plaintiff to establish*, § 6698. *On defendant to disprove*, §§ 6699-6702.

§ 6698. The plaintiff must establish the validity of his patent. *Carr v. Rice*, 1 Fish., 198.

§ 6699. Burden of proof is on defendant in attacking the validity of the patent. *Adams v. Edwards*, 1 Fish., 1.

§ 6700. The burden of proof is on the party denying the validity of the patent. *Hoffheims v. Brandt*, 3 Fish., 218.

§ 6701. The patent is evidence of its own validity, and hence the burden of proof to invalidate it rests upon the defendants. Every reasonable doubt ought to be resolved against them. *Miller v. Foree*, 9 Fed. Rep., 603.

§ 6702. If the defendant claims that the patent is void for uncertainty, it rests with him to establish the charge. *Westlake v. Carter*, 4 O. G., 636.

377. VERDICT.

See TRIAL OUT OF EQUITY, §§ 6334-6349.

§ 6703. Where a verdict awarded actual damages the court refused to interfere with it, as defendant had it in his power to prove amount and neglected to do so. *Stephens v. Felt*, 2 Blatch., 37.

§ 6704. Where the evidence sustains the verdict, the court cannot say that the jury should have given greater weight to other parts of the testimony which would have limited the damages to a less sum. *Stanley v. Whipple*, 2 McL., 35.

§ 6705. The same weight is not given by courts to the verdict of a jury upon the validity of a patent which is justly given to the opinion of a jury upon other questions of fact. *Roberts v. Schuyler*, 12 Blatch., 444.

§ 6706. Where the suit is at law, the verdict of the jury must be for the damages sustained by the plaintiff, subject to the right of the court to enter judgment thereon for any sum above the verdict not exceeding three times that amount, together with the costs. *Judson v. Bradford*, 16 O. G., 171.

See *Disclaimer*, § 2064.

378. VIOLATION OF INJUNCTION.

See INJUNCTION, VIOLATION OF. INJUNCTION, PRELIMINARY, VIOLATION OF.

379. VOID PATENT.

Void patent—*When broader than invention*, §§ 6707-6711. *Ambiguous*, §§ 6712-6715. *Insufficiently described*, §§ 6716, 6717. *For fraudulent concealment*, § 6718.

§ 6707. Patentee must not patent more than his invention, or all is invalid. *Delano v. Scott*, Gilp., 489.

§ 6708. A patent broader than the invention is wholly void. *Whitney v. Emmett*, 1 Bald., 303.

§ 6709. A patentee who includes in his invention things before known cannot recover, as his patent is broader than his invention. *Evans v. Eaton*, 7 Wheat., 356.

§ 6710. Where an inventor claims to have invented more than he actually has invented his patent is void. *Tyler v. Devil*, 1 Am. L. J., 248.

§ 6711. When the claim expresses a combination of several elements without particularly pointing out the special construction of one embodying the actual novelty and invention, and the general combination is old, the patent is broader than the actual invention, and invalid. *Terry Clock Co. v. New Haven Clock Co.*, 17 O. G., 908.

§ 6712. A patent which describes an invention with such ambiguity that the court, without conjecture, cannot gather what it is, is void. *Ames v. Howard*, 1 Sumn., 482.

§ 6713. Whether the patent is void for uncertainty and ambiguity in the description is a matter of fact, to be decided upon the evidence of experts. *Washburn v. Gould*, 3 Story, 122.

§ 6714. If the meaning of the patent cannot be ascertained satisfactorily upon the face of the specification, the law declares it insufficient for ambiguity and uncertainty. *Emerson v. Hogg*, 2 Blatch., 1.

§ 6715. A patent is void for ambiguity if its terms be so obscure and doubtful that the court cannot determine what is the particular improvement claimed. *Barrett v. Hall*, 1 Mason, 447.

§ 6716. Unless the thing claimed to be invented is so described as to be known, in the language of the statute, from every other thing, the patent is void. And this must be determined by the court. *Brooks v. Jenkins*, 3 McL., 432.

§ 6717. A patent which fails to describe the invention so that it can be understood, or that fails to produce the precise result described, is void. *O'Reilly v. Morse*, 15 How., 62.

See *Improvement*, §§ 2785-2789.

§ 6718. If, with a fraudulent purpose of concealing the invention, or any material part of it, patentee omits or erroneously describes any essential element, the patent is absolutely void. *Whitney v. Mowry*, 2 Bond, 45.

See *Contracts*, § 1297. *Decree*, § 1812.

Void patent—*What will avoid a patent*, §§ 6719-6730.

§ 6719. A patent is void if the invention patented was not originally discovered by patentee or if previously described in some publication. *Evans v. Eaton*, 3 Wheat., 454.

§ 6720. A party can take nothing by a void patent. *Evans v. Eaton*, 7 Wheat., 356.

§ 6721. A patent embracing the invention of another is void. *Watson v. Bladen*, 4 Wash., 580.

§ 6722. If a patent covers material not patentable, the whole patent is void. *Blake v. Sperry*, 2 N. Y. Leg. Obs., 251.

§ 6723. *Held*, that the patent issued to an alien upon a false affidavit of citizenship was not voidable, but void; and that the commissioner had no power to grant a new original patent on its surrender after eight years' public use. *Mini's Assignee v. Adams*, 3 Wall. Jr., 20.

§ 6724. If it appears from the papers and records of the patent office in evidence that the statutory requirements have not been complied with, it is within the power of a court, and its plain duty, to hold the patent void. (R. I.) *Whitely v. Swayne*, 4 Fish., 117.

§ 6725. A patent is invalid if the result which is predicted cannot be obtained by the means described. *Mitchell v. Tilghman*, 19 Wall., 287.

§ 6726. Or, if the process cannot be performed without danger to the operator. *Ibid.*

§ 6727. A valid patent must be signed by the commissioner of patents and the secretary of the interior. If signed by the commissioner and not by the secretary, the patent is a nullity, though the omission be accidental. *Marsh v. Nichols*, 15 Fed. Rep., 914.

§ 6728. In such case the patent cannot be sustained by the production of the record of the patent office showing a complete patent, since a perfect record of an imperfect patent cannot prove the grant. *Ibid.*

§ 6729. A patent accidentally issued without the signature of the secretary of the interior cannot be amended in that particular by his successor in office. Nor does it make any difference that the same person was "acting" secretary of the interior under both administrations and signed the patent in that capacity. *Ibid.*

§ 6730. Upon a surrender of a patent for reissue, an interference declared thereon, a decision against the patentee and subsequent refusal of a reissue, the patent becomes destitute of validity and absolutely void. *Peck v. Collins*, 13 Otto, 660.

See *Inventor, Joint*, §§ 3790, 3793, 3794.

380. WAIVER.

See PRACTICE, WAIVER.

381. WARRANTY OF TITLE.

See TITLE, WARRANTY OF.

382. WITNESSES.

Witnesses — Competency of, §§ 6731-6741.

§ 6731. Competency of witness having an interest, sustained in view of ruling in *Evans v. Eaton*, 7 Wheat., 356. *Evans v. Hettich*, 7 Wheat., 453.

§ 6732. Where defendant justified under a prior patent assigned to him, and offered its patentee as witness to prove priority of invention, his competency as witness sustained. *Treadwell v. Bladen*, 4 Wash., 703.

§ 6733. Where witness executed and delivered a quitclaim of his interest in the patent to the administrator, some time before the latter transferred the interest now claimed by plaintiffs, *held*, that as he could not be affected by the verdict in the case, he was competent. *Brooks v. Jenkins*, 3 McL., 432.

§ 6734. Where, in an infringement suit in Albany, brought by plaintiff holding a right to that county, his witness testified to owning rights under the same patent in other counties, but none in Albany or in the suit, although he had employed counsel in another suit between the same parties, he was held competent. The reason given. *Buck v. Hermance*, 1 Blatch., 322.

§ 6735. The interest of a witness in the matter in controversy not objectionable when his relations to the parties are such that his interest will remain unaffected by any issue of the suit. *Arnold v. Bishop*, 1 MacA. Pat. Cases, 28.

§ 6736. It is not competent for witness to give evidence referring to plaintiff's acts among strangers. *Evans v. Hettich*, 7 Wheat., 453.

§ 6737. Exhibiting to witnesses the opinion in the former case is calculated to lead their minds to the further proof necessary in the case; and in its fairest aspect this proceeding would be as objectionable, if not more objectionable, than leading questions would be, answers to which are inadmissible in evidence. *Carter v. Carter*, 1 MacA. Pat. Cases, 388.

§ 6738. Under the provisions of United States statutes which regulate the subject of oral testimony at common law in the federal courts, the examination of an adverse party as witness before trial, as can be done under New York statute, cannot be had. There is nothing in section 914, Revised Statutes, which supersedes them. *Beardsley v. Littell*, 14 Blatch., 102.

§ 6739. Insanity of a witness is no objection to his competency or credibility, if he is sane when testifying. *Evans v. Hettich*, 7 Wheat., 453.

§ 6740. The wife of an applicant for a patent is an incompetent witness for him in an interference proceeding. *Nichols v. Harris*, 1 MacA. Pat. Cases, 302.

§ 6741. A wife is not a competent witness in cases where her husband is interested; a wife's testimony in a case of interfering patents suppressed. *Wooster v. Hill*, 22 Fed. Rep., 830.

Witnesses — Credibility, §§ 6742-6756.

§ 6742. A mistake by a witness in an immaterial fact ought not to discredit him. The maxim *falsus in uno, falsus in omnibus*, only applies where there is a wilful, corrupt falsehood in one particular, amounting to perjury. *Marshall v. Mee*, 1 MacA. Pat. Cases, 229.

§ 6743. The jury are judges of the credibility of witnesses; and if they believe that a witness has wilfully sworn falsely to any material matter, they may disregard the whole of his testimony. *Spaulding v. Tucker*, Deady, 649.

§ 6744. Where a witness falsifies a material fact in respect to which he cannot be presumed to be liable to mistake, courts are bound, upon principles of law, morality and justice to apply the maxim *falsus in uno, falsus in omnibus*. *American Bell Telephone Co. v. People's Telephone Co.*, 22 Fed. Rep., 309.

§ 6745. A witness who gives false testimony as to one particular cannot be credited as to any, according to the legal maxim *falsus in uno, falsus in omnibus*. And if there be reason to suppose that his perjury or prevarication is the result of subornation, it affords a reasonable ground in a doubtful case for suspecting the testimony of other witnesses adduced by the same party. *Wellman v. Blood*, 1 MacA. Pat. Cases, 432.

§ 6746. When there are deliberate inconsistencies and discrepancies in a witness' testimony in material matters, proceeding from design, no credit can be given to the same, in accordance with the rule *falsus in uno, falsus in omnibus*. When such inconsistencies arise from ignorance or a careless inadvertence, all confidence in the truth of his testimony must still be lost. *Carter v. Carter*, 1 MacA. Pat. Cases, 388.

§ 6747. If a party shows an unwillingness to let the truth out, and keeps back facts and the means of getting at facts in his power, then the jury is warranted in drawing the strongest possible inferences against him which may be drawn from the evidence actually given in favor of the other party; but if he comes forward with his books, furnishes all the evidence in his power, and is fairly candid in the matter, no inferences should be drawn against him, except such as are fairly drawn from the evidence adduced. *National Car-Brake Shoe Co. v. Terre Haute Car & Mfg. Co.*, 19 Fed. Rep., 514.

§ 6748. The testimony of a witness may be compared with his deposition in a former interference relating to the same matter; and gross contradictions thereby appearing, not accounted for by any satisfactory explanations, will discredit his testimony. *Wellman v. Blood*, 1 MacA. Pat. Cases, 432.

§ 6749. When witnesses have been once examined upon the facts in the case, and then upon a new trial endeavor to supplement the deficiency of their former testimony, as pointed out in the decision, their testimony should be received with great caution, and particularly where the occurrences to which they testify were twenty years old, and involved a nice point of invention. *Carter v. Carter*, 1 MacA. Pat. Cases, 388.

§ 6750. Under any circumstances, a great lapse of time, which has taken place before the witnesses are called upon to state the facts relating to a case where a nice point of invention is to be established, must in the nature of things make it very difficult to get at the real facts in the case, unless they were reduced to writing at the time. *Ibid.*

§ 6751. The presumption is that a witness under oath testifies honestly until the contrary is shown. Contradictions and inconsistencies upon immaterial points, not proceeding from corrupt motives, do not entirely destroy his testimony. *Screw Co. v. Sloan*, 1 MacA. Pat. Cases, 210.

§ 6752. While the natural interest which an inventor may be supposed to retain in his invention, after he has parted with all pecuniary interest in the same, will not render him an incompetent witness for his assignee in an interference with a rival inventor, the circumstance should be allowed due weight in considering the credit to be given to his testimony. *Ibid.*

§ 6753. The rule of law is, that where a witness stands wholly unimpeached by extrinsic circumstances, credit ought to be given to his testimony, unless it is so grossly improbable as to show that he is not to be trusted. *Ibid.*

§ 6754. Evidence of license from patentee will not discredit witness testifying to a prior existing machine. *Evans v. Eaton*, Pet. C. C., 322.

§ 6755. The testimony of witnesses as to the practicability of alleged prior devices incredible, where a test of reproductions of those devices showed them to be practically inoperative. *American Bell Telephone Co. v. People's Telephone Co.*, 25 Fed. Rep., 725.

§ 6756. A successful assault upon the general character of a witness does not necessarily exclude his testimony from consideration. The law recognizes the possibility of a witness of general bad character telling the truth, and thereupon permits such witnesses to testify, their evidence to be received for whatever, under the circumstances of the particular case, the tribunal charged with the duty of passing on and deciding the facts may deem it worth. *Miller v. Foree*, 9 Fed. Rep., 603.

Witnesses — Cross-examination, §§ 6757-6762.

§ 6757. A party has no right to cross-examine a witness except as to facts, etc., brought out in the direct examination. *Phila. & Trenton R. Co. v. Stimpson*, 14 Pet., 448.

§ 6758. When a party to the case, otherwise an incompetent witness, is produced to prove the loss of original drawings and sketches, and is cross-examined at large, his answers are thereby made evidence for himself. *Perry v. Cornell*, 1 MacA. Pat. Cases, 68.

§ 6759. Where a witness on direct examination has voluntarily referred to his own affairs in connection with the history of the invention, he cannot on cross-examination refuse to divulge the full particulars of the same on the ground that it will expose his private business. *Nichols v. Harris*, 1 MacA. Pat. Cases, 302.

§ 6760. Nor was it necessary for counsel to state that the purpose of the examination was to affect the credit of the witness, as that would defeat its very object. Much greater latitude is allowed on cross-examination than in direct. *Ibid.*

§ 6761. Where a witness had fixed the date of the invention by reference to a device of his own invention, it is competent for the other side, on cross-examination, to call out a full description of the device, and when made, with a view of showing that the witness was mistaken in his dates. *Ibid.*

§ 6762. A witness, on cross-examination, is bound to answer all material and proper questions; and his refusal to do so, or the giving of an evasive answer, shows a want of fairness on his part that must be considered as affecting the credit to be given to his testimony. *Cornell v. Hyatt*, 1 MacA. Pat. Cases, 423.

383. WRIT OF ERROR.

See PRACTICE, WRIT OF ERROR.

TABLE 1.

A TABLE OF PARTICULAR PATENTS UPON WHICH SUIT HAS BEEN BROUGHT, ARRANGED CHRONOLOGICALLY,

*And giving under each patent the suits in which it was involved; the construction, etc.,
of the patent in such suits; the reissues of such patent; the suits in which the reissue
or reissues were involved, as also the construction given them in such suits.*

NOTE.—For patents not found in this list, look in the Topical list, No. 3, and if not there, then in list of Pat-
entees, No. 4. The consecutive numbering of letters patent begins July, 1836.

1776.

Reutgen, C. Nov. 17, 1776. Forging Bolts and Round Iron.
Reutgen v. Kanowrs, 1 Wash., 168.

1779.

Whittemore, A. June 5, 1779. Machine for making Cotton and Wool Cards.
Whittemore v. Cutter, 1 Gall., 429; 1 Gall., 478.

1790.

Evans, O. Dec. 18, 1790. Hopper-boy.
Reviewed; construed; improvement not sufficiently distinguished from original inven-
tion, Evans v. Hettick, 3 Wash., 408. Reviewed, construed, and not infringed, Evans
v. Eaton, 3 Wash., 443. Construed to be for entire machine and void for not specifying
improvement, *Ibid.*, 7 Wheat., 356. Held novel, useful and patentable, Evans v. Robin-
son, 1 Car., L. R. (N. C.), 209. See, also, Evans v. Eaton, 3 Wheat., 455; 1 Pet. C. C.,
322; v. Chambers, 2 Wash., 125; v. Jordan, 1 Brock., 248; v. Weiss, 2 Wash., 342; v. Jor-
dan, 9 Cranch, 199; v. Kremer, 1 Pet. C. C., 215; v. Hettich, 7 Wheat., 453.

1798.

Tryon, I. Feb. 22, 1798. Cutting and Pointing Comb Teeth.
Tryon v. White, 1 Pet. C. C., 96.

1799.

Perkins, J. Feb. 14, 1799. Cutting and Heading Nails.
Construed to be for an art and not an abstract principle, Gray v. James, Pet. C. C., 400;
Ibid., Pet. C. C., 476.

1800.

Tyler, B. Feb. 20, 1800. Grist-mill.
Tyler v. Tuel, 6 Cranch, 324.

1806.

Bedford, J. July 16, 1806. Making Boots and Shoes.
Bedford v. Hunt, 1 Mason, 302.
Dawson, J. Nov. 6, 1806. Suspenders.
Dawson v. Follen, 2 Wash., 311.

1807.

Reed, J. Feb. 22, 1807. Cutting and Heading Nails.
Patent vacated, Odiorne v. Winkley, 2 Gall., 51. See, also, Odiorne v. Amesbury Nail
Factory, 2 Mason, 28.

1808.

Parke, J. P. Dec. 19, 1808. Fire Engine Alarm Bell.
Parke v. Little, 3 Wash., 196.

1809.

- Fulton, R. Feb. 11, 1809. Steamboat.
Cutting *v.* Myers, 4 Wash., 220.
Woodcock, J. May 8, 1809. Splitting Leather.
Woodcock *v.* Parker, 1 Gall., 438.
Barrett, W. June 27, 1809. Reel for Dyeing all Kinds of Silk Goods.
Stearns *v.* Barrett, 1 Mason, 153.

1811.

- Sawin & Skinner. Feb. 8, 1811. Cutting Nails or Brads.
Sawin *v.* Guild, 1 Gall., 484.

1812.

- Robinson, G. W. May 14, 1812. Mold for Casting Metal Buttons.
Goodyear *v.* Mathews, 1 Paine, 300.

1813.

- Perkins, J. March 23, 1813. Pump.
Lowell *v.* Lewis, 1 Mason, 182.

1814.

- Pettibone, D. Feb. 12, 1814. Auger for Boring Guns.
Construed, Pettibone *v.* Derringer, 4 Wash., 215.

1815.

- Kneass, J. Apr. 28, 1815. Printing on Bank Notes, etc.
Construed to be for an art, not for an effect, Kneass *v.* Schuylkill Bank, 4 Wash., 9.

1816.

- Sullivan, J. L. Dec. 4, 1816. Steam Tow-boat.
Validity doubted on the ground of insufficient specification, Sullivan *v.* Redfield, 1 Paine, 441.

1818.

- Ogle. 1818. Plow.
Ogle *v.* Ege, 4 Wash., 584.
Pennock & Sellers. July 6, 1818. Leather Tubes or Hose.
Pennock *v.* Dialogue, 4 Wash., 538; 2 Pet., 1.
Stearns & Barrett. Sept. 9, 1818. Dyeing and Finishing Silk Woven Goods.
Construed, Barrett *v.* Hall, 1 Mason, 447.

1819.

- Moody, P. Apr. 3, 1819. Double Speeder for Cotton.
Boston Mfg. Co. *v.* Fiske, 2 Mason, 119. Void for double use, Moody *v.* Fiske, 2 Mason, 112.
Dixon, P. July 16, 1819. Saddles without Saddle-trees.
Void for imperfectly distinguishing the invention from that which is old, Dixon *v.* Moyer, 4 Wash., 68.
Blanchard, T. Sept. 6, 1819. Turning Irregular Forms.
Construed not to include the power for working the combination; the claims sustained, Blanchard Gun-stock Turning Co. *v.* Warner, 1 Blatch., 278. Reviewed, Blanchard *v.* Beers, 2 Blatch., 413. Construed, and renewal by congress void for error as to description and date in act of congress, Blanchard *v.* Sprague, 3 Sumn., 279. Construed; held not unconstitutional; infringed, Blanchard *v.* Sprague, 3 Sumn., 535. See, also, Blanchard *v.* Whitney, 3 Blatch., 307; *v.* Sprague, 2 Story, 164; *v.* Eldridge, 1 Wall. Jr., 337; Blanchard Gun-stock Turning Co. *v.* Jacobs, 2 Blatch., 69.
Isaacs, M. Nov. 17, 1819. Inclined Circular Plane.
Isaacs *v.* Cooper, 4 Wash., 259.

1820.

- Treadwell, E. Jan. 10, 1820. Bread Finisher.
Wanting in novelty, Watson *v.* Bladen, 4 Wash., 580.
Blanchard, T. Jan. 20, 1820. Turning Irregular Forms.
Construed and held infringed, Blanchard *v.* Reeves, 1 Fish., 103. See, also, Blanchard *v.* Sprague, 3 Sumn., 535; 3 Sumn., 279; 2 Story, 164; *v.* Eldridge, 1 Wall. Jr., 337; *v.* Sprague, 1 Cliff., 288; *v.* Haynes, 6 West. L. J., 82; *v.* Beers, 2 Blatch., 413; Blanchard Gun-stock Turning Co. *v.* Jacobs, 2 Blatch., 69; Blanchard Gun-stock Turning Co. *v.* Warner, 1 Blatch., 278.
Eastman & Jaquith. March 16, 1820. Circular Saw.
Eastman *v.* Bodfish, 1 Story, 528.

Keplinger, S. May 4, 1820. Watch Chain Machine.

Keplinger *v.* De Young, 10 Wheat., 358.

Wood & Brundage. Nov. 9, 1820. Plow.

Wood & Brundage, *Ex parte*, 9 Wheat., 603.

1821.

Langdon, R. June 20, 1821. Preparing and Packing Thread.

Void for insufficiency of description in distinguishing the new from the old, Langdon *v.*

De Groot, 1 Paine, 203.

Grant, J. Aug. 11, 1821. Hat Bodies.

Grant *v.* Raymond, 6 Pet., 218.

1822.

Morris, J. May 15, 1822. Stop-cock.

Void in view of prior unrepealed patent, Morris *v.* Huntington, 1 Paine, 348.

Shaw, J. June 19, 1822. Reissue, May 7, 1829. Percussion Gun.

Held abandoned, Shaw *v.* Cooper, 7 Pet., 292.

Mellus, W. Aug. 3, 1822. Securing Ships from Decay.

Abandoned in view of use prior to patenting, Mellus *v.* Silsbee, 4 Mason, 108.

Earle, W. Dec. 28, 1822. Shingle Machine.

Substitution of a new element in an old combination, Earle *v.* Sawyer, 4 Mason, 1.

1824.

Herbert, O. R. July 14, 1824. Bedstead.

Herbert *v.* Adams, 4 Mason, 15.

1825.

Davis, G. Oct. 1, 1825. Plows.

Construed with view to patentee's change of form, Davis *v.* Palmer, 2 Brock., 298.

1826.

Treadwell, E. May 18, 1826. Biscuit and Sugar Bread Manufacture.

Treadwell *v.* Bladen, 4 Wash., 703.

Whitney & Robinson. Nov. 4, 1826. Making Glass Door Knobs.

Whitney *v.* Emmett, 1 Bald., 303.

Thomas, J. Nov. 6, 1826. Bilge Lever for Ships.

Doubted that patentee was first and original inventor, Thomas *v.* Weeks, 2 Paine, 92.

Gale, Wm. Dec. 7, 1826. Silver Spoon Manufacture.

Gilpin's Opinion, 3 Op., 595.

Goulding, J. Dec. 15, 1826. Wool Manufacture. Reissue, July 29, 1836.

Held infringed, Jordan *v.* Wallace, 5 Fish., 185. Extended reissue sustained as novel and valid, Jordan *v.* Dobson, 2 Abb., 398. Sustained, patentee being first and original inventor, Agawam Co. *v.* Jordan, 7 Wall., 583.

1828.

Woodworth, W. Dec. 27, 1828. Planing-mill. Reissue, 1871.

Infringed by use of analogous device and a colorable imitation, Gibson *v.* Van Dressar, 1 Blatch., 532. Construed to be for a combination and not infringed by a combination of some of its elements with a substantially different element, Brooks *v.* Fiske, 15 How., 214. Held infringed by substitution of equivalent, Pitts *v.* Edmonds, 1 Biss., 168. Infringed by a machine varied by an interchange of form and direction between two elements of its combination, while object and effect remain unchanged, Wilson *v.* Barnum, 2 Fish., 635.

Sustained, Motte *v.* Bennett, 2 Fish., 642. Construed, held valid and infringed, Olcott *v.* Hawkins, 2 Am. L. J. (9 Penna. L. J.), 317. Construed, Brooks *v.* Bicknell, 3 McL., 250; *v.* Jenkins, 3 McL., 432. Construed to be for an improved machine, Washburn *v.* Gould, 3 Story, 122. Sustained, Wilson *v.* Rousseau, 4 How., 646. Patentee held first inventor; sufficiency of description sustained, Woodworth *v.* Wilson, 4 How., 712.

Sustained, Woodworth *v.* Hall, 1 W. & M., 248. Infringed, Gibson *v.* Betts, 1 Blatch., 163. Sustained and held infringed in view of prior decisions, Van Hook *v.* Pendleton, 1 Blatch., 187.

Reissue No. 71, July 8, 1845.

Its signature by the acting commissioner, Woodworth *v.* Hall, 1 W. & M., 389. Held to be for same invention as original; sustained and infringed, Smith *v.* Mercer, 4 West. L. J., 49.

Sustained as valid, infringed by change of form, Gibson *v.* Harris, 1 Blatch., 167.

Sustained, Woodworth *v.* Edwards, 3 W. & M., 120. Infringed, Sloat *v.* Patton, 1 Fish., 154. See, also, Barnard *v.* Gibson, 7 How., 560; Bicknell *v.* Todd, 5 McLean, 236; Bloomer

v. McQuewan, 14 How., 539; *v. Millinger*, 1 Wall., 340; *v. Gilpin*, 4 Fish., 50; *v. Stolley*, 5 McLean, 158; *Brooks v. Norcross*, 2 Fish., 661; *v. Bicknell*, 4 McLean, 64; 4 McLean, 70; *v. Stolley*, 3 McLean, 523; *Brown v. Shannon*, 20 How., 55; *Dean v. Mason*, 20 How., 198; *Foss v. Herbert*, 1 Biss., 121; *Gibson v. Cook*, 2 Blatch., 144; *v. Barnard*, 1 Blatch., 388; *v. Gifford*, 1 Blatch., 529; *Jenkins v. Greenwald*, 1 Bond, 126; *Livingston v. Woodworth*, 15 How., 546; *Lippincott v. Kelly*, 1 West. L. J., 513; *Ritter v. Serrell*, 2 Blatch., 379; *Simpson v. Wilson*, 4 How., 709; *Van Hook v. Pendleton*, 2 Blatch., 85; *Wilson v. Sherman*, 1 Blatch., 536; *v. Simpson*, 9 How., 109 (repairs); *v. Barnum*, 8 How., 258; *v. Stolly*, 4 McLean, 273; *v. Turner*, Taney's Dec., 278; *v. Rousseau*, 1 Blatch., 3; *v. Stolly*, 4 McLean, 275; 5 McLean, 1; *Woodworth v. Cook*, 2 Blatch., 151; *v. Sherman*, 3 Story, 171; *v. Stone*, 3 Story, 749; *v. Weed*, 1 Blatch., 165; *v. Curtis*, 2 W. & M., 521.

1829.

Wyeth, N. J. March 18, 1829. Ice-cutting Apparatus.

Claim construed to be for a principle and void, *Wyeth v. Stone*, 1 Story, 273.

Knight, I. March 18, 1829. Railroad Car.

Reissue, July 10, 1834, and Apr. 28, 1836.

Knight v. Balt. & Ohio R. R., 3 Fish., 2.

Stone, A. Apr. 30, 1829. Loom.

Claim construed and limited, *Stone v. Sprague*, 1 Story, 270.

Burnap, C. P. May 1, 1829. Mode of Cutting Veneer by Machinery.

Burr v. Gregory, 2 Paine, 426.

Arnold, J. July 15, 1829. Loom.

Union Mfg. Co. v. Lounsbury, 2 Fish., 389.

Parker, Z. & A. Oct. 19, 1829. Water-wheel.

Sustained, *Parker v. Hatfield*, 4 McLean, 61. Construed to be for the combination and some of the improved elements, *Parker v. Haworth*, 4 McLean, 474.

Construed, *Parker v. Stiles*, 5 McLean, 44. Anticipated by a single prior existing machine never put to actual use, *Parker v. Ferguson*, 1 Blatch., 407.

Construed, *Wintermute v. Redington*, 1 Fish., 248. Construed, is patentable and found novel, *Parker v. Hulme*, 7 West. L. J., 417. See, also, *Parker v. Sears*, 1 Fish., 98; *v. Corbin*, 4 McLean, 462; *v. Banker*, 6 McLean, 631; *v. Hawks*, 2 Fish., 58; *v. Hallock*, 2 Fish., 543; *v. Bigler*, 1 Fish., 285; *v. Lewis*, 1 Bond, 172; *v. Brant*, 1 Fish., 58; *Case v. Redfield*, 4 McLean, 526; *Phelps v. Comstock*, 4 McLean, 353; 4 McLean, 525.

1830.

Smith, J. C. Jan. 29, 1830. Grinding Mill-stones.

See 397, Sept. 25, 1837, which is the same patent.

Aiken, H. May 24, 1830. Saw Set.

Construed and limited to material specified in description, *Aiken v. Bemis*, 3 W. & M., 348.

Scott, J. Nov. 12, 1830. Iron Chest or Safe.

Void and repealed, *Delano v. Scott*, 1 Gilp., 489.

1831.

Reed, J. Aug. 5, 1831. Pump.

Reed v. Cutter, 1 Story, 590.

Winans, R. July 20, 1831. Axle-tree for Carriages, Railway Cars.

Construed, and novelty and validity doubted, *Winans v. Boston & Prov. R. Co.*, 2 Story, 415.

Stimpson, J. Aug. 23, 1831. Rails for Railroad Carriages.

Claim construed to be for a combination of old elements, and not infringed by a combination of some of them with an element substantially different in form. *Stimpson v. Balt. & Sus. R. Co.*, 10 How., 344. See, also, *Stimpson v. Westchester R. Co.*, 4 How., 380; *v. The Railroads*, 1 Wall. Jr., 162.

1832.

Cooper, I. Oct. 25, 1832. Railway Carriages.

Cooper v. Mattheys, 8 Law Rep., 413.

Stanley, H. Dec. 17, 1832. Stove.

Reissue, Nov. 28, 1836.

Construed to be for a combination of old elements; held useful, infringed, and not abandoned by public experimental use. Claim construed to be for the individual elements, and not for the combination, and held invalid as covering more than patentee's invention. *Stanley v. Hewitt*, 17 Frank. Jr., 2d Series, 165. *Stanley v. Whipple*, 2 McLean, 35.

1833.

- Smith, J. C. March 3, 1833. Preparing Palm-leaf.
 Reissue No. 31, March 18, 1841.
 Double use, *How v. Abbott*, 2 Story, 191.
 Reed, J. & J. Nov. 19, 1833. Pump.
 Reed *v. Cutter*, 1 Story, 590.

1834.

- Emerson, J. B. March 8, 1834. Steam-engine.
 Sustained, *Emerson v. Hogg*, 2 Blatch., 1. Sustained for proper joinder of invention,
Hogg v. Emerson, 11 How., 587. See, also, *Hogg v. Emerson*, 6 How., 437.
 McCormick, C. H. June 21, 1834. Harvester.
 McCormick *v. Manny*, 6 McLean, 543.
 Winans, R. Oct. 1, 1834. Eight-wheeled Cars.
 Construed, and description held sufficient, *Winans v. Schenectady & Troy R. Co.*, 2
 Blatch., 279. Construed, novelty doubted, *Winans v. Eaton*, 1 Fish., 181. Construed,
Winans v. New York & Erie R. Co., 1 Fish., 213. Construed, *Winans v. New York &*
Harlem R. Co., 4 Fish., 1. Construction affirmed, *Ibid.*, 21 How., 88. See, also, *York &*
Maryland Line Road v. Winans, 17 How., 30.
 Wilson, C. Oct. 10, 1834. Cooking Stove.
 Claim construed, invention doubted, *Wilson v. Janes*, 3 Blatch., 227.
 Burden, H. Dec. 2, 1834. Hook or Brad-headed Spikes.
 Patentee held original and first inventor, *Troy Iron and Nail Factory v. Corning*, 1
 Blatch., 467.

1835.

- Harley, J. March 3, 1835. Casting Chilled Rollers.
 McClurg *v. Kingsland*, 1 How., 202.
 Crosby, N. & P. March 27, 1835. Saw-mill.
 Construed to be for a patentable combination, *Crosby v. Lapouraille*, Taney's Dec., 374.
 Smith, J. C. Apr. 3, 1835. Preparing Palm-leaf.
 See *Ibid.*, March 3, 1833.
 Stimpson, J. Sept. 26, 1835. Curves for Railways.
 Stimpson *v. The Railroads*, 1 Wall. Jr., 164; *Phila. & Trenton R. Co. v. Stimpson*, 14
 Pet., 448.

1836.

- Orr, J. Jan. 20, 1836. Air-tight Stove.
 Reissue No. 48, Nov. 12, 1842.
 Orr *v. Merrill*, 1 W. & M. 376; *v. Badger*, 7 Law Rep., 465; *v. Littlefield*, 1 W. & M. 30.,
 Colt, S. Feb. 25, 1836. Revolving Fire-arms.
 Reissue No. 124, Oct. 24, 1848.
 Fifth reissue claim, construed to be for five distinct combinations, is infringed. *Colt v.*
Massachusetts Arms Co., 1 Fish., 108. See, also, *Colt v. Young*, 2 Blatch., 471.
 Nevins, Wm. R. March 2, 1836. Machine for Rolling Dough and Cutting Crackers.
 Nevins *v. Johnson*, 3 Blatch., 80.
 Prouty & Mears. March 4, 1836. Plow.
 Not infringed by a combination of a less number of elements than those claimed, *Prouty*
v. Draper, 1 Story, 568. Construed to be for a combination of three elements and not in-
 fringed by use of two of them, *Prouty v. Ruggles*, 16 Pet., 336.
 Guyon, H. G. July 2, 1836. Compound Lever.
 Guyon *v. Serrell*, 1 Blatch., 245.
 16. Chaffee, E. M. Aug. 31, 1836. India Rubber.
 Construed to be for both process and means, *Day v. Union India Rubber Co.*, 3 Blatch., 490.
 See, also, *Day v. New England Car Spring Co.*, 3 Blatch., 154; 3 Blatch., 179; *v. Candee*,
 3 Fish., 9; *v. Union India Rubber Co.*, 20 How., 216; *v. Boston Belting Co.*, 16 Law Rep.,
 329; *v. Hartshorn*, 3 Fish., 32; *Hartshorn v. Day*, 19 How., 211; *Chaffee v. Boston Belting*
Co., 20 How., 216.
 68. Phillips, A. D. Oct. 24, 1836. Friction Matches.
 Construed and limited; method not infringed by a use of a part of it only, *Byam v.*
Farr, 1 Curt., 260. Construed to be for a new combination of old elements before used
 for same purpose, and not infringed by a different combination of the same elements,
Byam v. Eddy, 2 Blatch., 521.
 See, also, *Ryan v. Goodwin*, 3 Sumn., 514; *Brooks v. Byam*, 2 Story, 525; *Byam v. Bul-*
lard, 1 Curt., 100.

79. Crum, H. Nov. 14, 1836. Screw-cutting Machine.
Pierson v. Eagle Screw Co., 3 Story, 402.
97. Wood, J. Dec. 2, 1836. Making Brick or Tiles.
Proportions of materials in the composition held sufficiently stated, Wood v. Underhill, 5 How., 46.

1837.

144. Peirce, D. March 11, 1837. Scythe Snathes.
Alden v. Dewey, 1 Story, 336.
389. Imlay, R. Sept. 21, 1837. Railroad Cars and Carriages.
Construed to be for a combination and infringed, Imlay v. Norwich & Worcester R. Co., 4 Blatch., 227.
397. Smith, J. C. Sept. 25, 1837. Grinding Mill-stones.
Same patent as that of Jan. 29 1830. Infringed, Smith v. Pearce, 2 McLean, 176.
441. Stephens, H. Oct. 28, 1837. Coloring Matter.
Reissue No. 3, April 21, 1838, Stephens v. Felt, 2 Blatch., 37.
461. Allen, E. Nov. 11, 1837. Gun Locks.
Reissue No. 60, Jan. 15, 1844. Reissue held to be for same invention as original, Allen v. Sprague, 1 Blatch., 567. See, also, Allen v. Sprague, 1 Blatch., 480; v. Blunt, 2 W. & M., 121; 3 Story, 742; 1 Blatch., 480.
491. Crompton, W. Nov. 24, 1837. Power Loom.
Forbush v. Bradford, 1 Fish., 317.
Reissue 247. Sept. 13, 1853.
Forbush v. Cook, 2 Fish., 668.
505. Hathaway, J. G. Dec. 7, 1837. Applying Heat to Cooking Stoves.
Hathaway v. Roach, 2 W. & M., 63.
542. Pitts, H. & J. Dec. 29, 1837. Grain Thresher and Cleaner.
Construed and held not anticipated by a machine but slightly different in construction, but applied to an entirely different purpose, Pitts v. Wemple, 1 Biss., 87. Construed to be for the entire machine and the individual improvements, Pitts v. Whitman, 2 Story, 618. Construed to be for a combination and held infringed, Pitts v. Wemple, 6 McLean, 558. See, also, Pitts v. Hull, 3 Blatch., 201.

1838.

640. Truscott, Wolf & Dougherty. March 17, 1838. Cast-iron Wheels.
Construed to be for a new manufacture, Many v. Jagger, 1 Blatch., 372. Construed and limited in view of state of art, Many v. Sizer, 1 Fish., 31. Claim construed, Many v. Sizer, 1 Fish., 17.
777. Carver, E. June 12, 1838. Ribs of Cotton Gin.
Reissue No. 17, Nov. 16, 1839.
Construed, Carver v. Hyde, 16 Pet., 517. See, also, Carver v. Braintree Mfg. Co., 2 Story, 445.
797. Lindlay, J. June 20, 1838. Bedstead.
Boyd v. Brown, 3 McLean, 295; v. McAlpin, 3 McLean, 427.
821. Blake & Philos. June 30, 1838. Casters for Bedsteads.
Construed, held novel, and invention apparent with reasonable certainty on face of patent, Blake v. Sperry, 2 N. Y. Leg. Obs., 251.

1839.

1090. Haywood, N. Feb. 24, 1839. Preparing Caoutchouc.
Suydam v. Day, 2 Blatch., 20.
1092. Heinrich, R. Feb. 27, 1839. Tailor's Shears.
Construed in view of drawings, though not so claimed in specification, Heinrich v. Luther, 6 McLean, 346.
1157. Buck, D. May 20, 1839. Cooking Stove.
Claim construed, sustained and held infringed, Buck v. Gill, 4 McLean, 176. Construed to be for a combination, Buck v. Hermance, 1 Blatch., 398. Held novel, specification sufficient, and infringed, Buck v. Cobb, 9 Law Rep., 545. See, also, Buck v. Hermance, 1 Blatch., 322.
1243. Nock, J. July 16, 1839. Padlock.
Nock's Case, 2 Ct. of Claims, 451.
1252. Babbitt, J. July 17, 1839. Making Axle Boxes.
Construed, Roberts v. Ward, 4 McLean, 565.
1336. Knight, K. & A. Sept. 25, 1839. Paper Manufacture.
Knight v. Gravit, Mir. Pat. Off., 131.

1396. Roth, J. A. Oct. 31, 1839. Ore Furnace.

Collins v. Peebles, 2 Fish., 541.

1411. Crum, H. Nov. 14, 1839. Cutting Threads on Wood and Screws.

Pierson v. Eagle Screw Co., 3 Story, 402.

1840.

1503. Gorham, C. March 3, 1840. Palm Leaf Hat Pressing Machine.

Construed to be for a combination, Gorham v. Mixter, 1 Am. L. J., 539.

1517. Hildreth, G. W. March 19, 1840.

Held, on interference, subsequent to applicant who had made a model prior to patentee, Heath v. Hildreth, 1 MacA. Pat. Cases, 12.

1531. Bean, S. March 30, 1840. Rocking Chair.

Wanting in patentable novelty, Bean v. Smallwood, 2 Story, 408.

1630. Bell, M. June 10, 1840. Applying Waste Heat to Boilers.

Construed to be for the means of applying a principle and not for a principle; held novel and patentable, Bell v. Daniels, 1 Bond, 212. See, also, Bell v. McCullough, 1 Bond, 197.

1647. Morse, S. F. B. June 20, 1840. Electric Telegraph.

Held issued in violation of the law (act 1836, sec. 6), not being limited to fourteen years from date of his prior foreign patent, Smith v. Ely, 5 McLean, 79. Construed; patentee held first and original inventor; eighth claim void, being for a principle, O'Reilly v. Morse, 15 How., 62.

Reissue No. 117, June 13, 1848.

Reissue held legal; is for same invention as original, and not limited by term of French patent issued prior to grant, but subsequent to date of application of the original, Morse v. Bain, 9 West. L. J., 106. Construed and limited as to eighth claim in view of original, and reissue No. 79, Jan. 25, 1846, in order to be sustained; is not for a principle and is not infringed, Smith v. Downing, 1 Fish., 72. Held properly reissued a second time; is for same invention as original; construed to be for an art and sustained, French v. Rogers, 1 Fish., 133.

See, also, Smith v. Cummings, 1 Fish., 152; v. Ely, 15 How., 137; v. Selden, 1 Blatch., 475; Clum v. Brewer, 2 Curt., 506; Western Telegraph Co. v. Magnetic Telegraph Co., 21 How., 456; v. Penniman, 21 How., 460.

1658. Parker & McKelvey. June 27, 1840. Reaction Water-wheel.

Phelps v. Comstock, 4 McLean, 353; Case v. Redfield, 4 McLean, 526.

1714. Montgomery & Harris. Aug. 12, 1840. Bark Grinding Mill.

Construed, Wilbur v. Beecher, 2 Blatch., 132.

1757. Burden, H. Sept. 2, 1840. Spike Making Machine.

Particular machine held to have been made prior to date of patentee's application, Troy Iron & Nail Co. v. Odiorne, 17 How., 72. See, also, Troy Iron & Nail Co. v. Corning, 1 Blatch., 467; 6 Blatch., 328; 14 How., 218; v. Winslow, 11 Blatch., 513.

1839. Whipple, M. D. Oct. 28, 1840. Ginning Machine.

Reissue 140, July 31, 1849.

Second reissue claim construed, Whipple v. Baldwin Mfg. Co., 4 Fish., 29. Construed, Eli v. Monson, etc., Mfg. Co., 4 Fish., 64. Construed, held novel, patentable, and second claim infringed, Whipple v. Middlesex Co., 4 Fish., 41.

1868. Winans, R. Nov. 26, 1840. Locomotive Engines — Regulating Steam for.

Winans v. Danforth, M. S., N. Y., 1860.

1890. Burden, H. Dec. 10, 1840. Rolling Puddle Balls.

Process considered, Corning v. Burden, 15 How., 265.

1841.

1980. Ransom & Wenman. Feb. 13, 1841. Fire Engines.

Construed, Ransom v. Mayor, etc., of New York, 1 Fish., 261.

2021. Hanson, J. & H. March 29, 1841. Lead Pipe Machine.

Reissue No. 82, March 14, 1846.

Claim construed to be for a combination involving double use and not for a process, Le Roy v. Tatham, 14 How., 177.

Construed to be for a new combination applying a newly discovered principle to produce a new and useful result; sustained, Le Roy v. Tatham, 22 How., 132. Held invalid for failure of alien patentee to practice the invention within the United States within eighteen months (act 1836, § 9), Tatham v. Loring, 5 N. Y. Leg. Obs., 207. See, also, Tatham v. Lowber, 2 Blatch., 49; v. Le Roy, 2 Blatch., 474; 2 Blatch., 51; v. Lowber, 4 Blatch., 86.

2174. Page, G. July 16, 1841. Circular Saw-mill.

Construed to be for an old combination of old parts, Phillips v. Page, 24 How., 167. Construed, Page v. Ferry, 1 Fish., 303.

2197. Hotchkiss, J. E. July 29, 1841. Knobs for Doors.
Void for substitution of material amounting to double use only, *Hotchkiss v. Greenwood*, 11 How., 248. See, also, *Hotchkiss v. Greenwood*, 4 McLean, 456.
2275. Slocum, S. Sept. 30, 1841.
Not infringed, *American Pin Co. v. Oakville Co.*, 3 Blatch., 190.

1842.

2435. Armstrong, M. N. Jan. 24, 1842. Cleaning and Polishing Cutlery.
Armstrong v. Halenbeck, 3 N. Y. Leg. Obs., 43.
2488. Reed, J. March 12, 1842. Harvester.
Reed v. Miller, 2 Biss., 12.
2558. Du Faur, F. April 16, 1842. Generating and Applying Heat.
Reissue No. 67, Jan. 23, 1845.
Reissue construed and limited to formal arrangement and held not infringed, *Detmold v. Reeves*, 1 Fish., 127.
2631. Sickles, F. E. May 20, 1842. Lifting Valves, etc.
Construed and held not infringed, *Sickles v. Young*, 3 Blatch., 301. Held novel; patentee first and original inventor; first and second claims construed and not infringed, *Sickles v. Gloucester Mfg. Co.*, 1 Fish., 225. See, also, *Blank v. Mfg. Co.*, 3 Wall. Jr., 196; *Packet Co. v. Sickles*, 19 Wall., 611.
2636. Foote, E. May 26, 1842. Cooking Stove.
Claim construed to be for the patentable application of a new principle by means of mechanical contrivances, and not for a principle, *Foote v. Silsby*, 1 Blatch., 445. Claims construed, *Foote v. Silsby*, 2 Blatch., 260. See, also, *Foote v. Silsby*, 1 Blatch., 542; 1 Blatch., 545; 3 Blatch., 507; *Silsby v. Foote*, 14 How., 218; 20 How., 285.
2708. Rich, R. July 8, 1842. Water-wheel.
Construed, limited to combination claimed and not infringed, *Rich v. Close*, 8 Blatch., 41.
2725. Baldwin, S. K. July 16, 1842. Peg-cutting Machine.
Reissue No. 409, November 18, 1856.
Baldwin v. Sibley, 1 Cliff., 150.
2768. Hall, A. Sept. 3, 1842. Brick-press.
Combination claim construed, *Hall v. Wiles*, 2 Blatch., 197.
2872. Connison, A. Dec. 5, 1842. Steam-engine.
In interference, *Pomeroy v. Connison*, 1 MacA. Pat. Cases, 40.
2886. Sherwood, J. P. Dec. 14, 1842. Door-lock.
Invalid for want of novelty, *Jones v. Moorehead*, 1 Wall., 155.
Reissue No. 401, Oct. 7, 1856.
Held novel, *Livingston v. Jones*, 1 Fish., 521. See, also, *Livingston v. Jones*, 3 Wall. Jr., 330; *Moorehead v. Jones*, 3 Wall. Jr., 306.

1843.

2970. Howe, J. J. Feb. 24, 1843.
Not infringed, *American Pin Co. v. Oakville Co.*, 3 Blatch., 190.
3089. Davoll, W. C. May 19, 1843. Cotton Speeder.
Construed, *Davoll v. Brown*, 1 W. & M., 55.
3106. Waterman, H. May 26, 1843. Method of Connecting Tillers with the Rudder Heads of Vessels.
Held, on interference, surreptitiously granted, because caveat of contestant for priority was overlooked, *Cochrane v. Waterman*, 1 MacA. Pat. Cases, 52.
3117. Fitzgerald, D. June 1, 1843. Safe.
Construed to be for a patentable invention, *Gayler v. Wilder*, 10 How., 477. Construed, *Rich v. Lippincott*, 2 Fish., 1. See, also, *Wilder v. McCormick*, 2 Blatch., 31; *v. Gayler*, 1 Blatch., 511; 1 Blatch., 597; *v. Adams*, 2 W. & M., 329; *Gayler v. Wilder*, 10 How., 509; *Adams v. Edwards*, 1 Fish., 1.
3120. Calvert, F. A. June 3, 1843. Picking and Cleaning Wool and Cotton.
Nesmith v. Calvert, 1 W. & M., 34.
3292. Battin, J. Oct. 6, 1843. Coal Breaker.
Reissue No. 142, Sept. 4, 1849.
Battin v. Silliman, 3 Wall. Jr., 124; *v. Taggart*, 2 Wall. Jr., 101; 17 How., 74.

1844.

3431. Hovey, W. Feb. 12, 1844. Straw Cutter.
Construed to be for a combination, *Hovey v. Henry*, 3 West. L. J., 153.
3461. Goodyear, C. March 9, 1844. India Rubber Shirred Goods.
Awarded priority of invention on interference, *Warner v. Goodyear*, 1 MacA. Pat. Cases, 60. See, also, *Robinson, Ex parte*, 2 Biss. 309; *Gardner v. Goodyear Dental Vulcanite*

Co., 3 O. G., 295; Day v. Carey, 4 Blatch., 278; v. Stellman, 1 Fish., 501; Goodyear v. Day, 1 Blatch., 565.

3633. Goodyear, C. June 15, 1844. Indian Rubber, Soft Rubber.

Construed to be for new process and product, and is infringed by use of an equivalent, Goodyear v. Railroads, 2 Wall. Jr., 356.

Reissue No. 1085, Nov. 20, 1860. Process.

Claim held to be for different invention from original and void, Goodyear v. Providence Rubber Co., 2 Cliff., 351. See, also, Goodyear v. Congress Rubber Co., 3 Blatch., 449; v. Hills, 3 Fish., 134; v. Phelps, 3 Blatch., 91; v. N. J. Central R. R., 1 Fish., 626; v. McBurney, 2 Blatch., 32; v. Day, 2 Wall. Jr., 283; v. Bourn, 3 Blatch., 266; v. Bishop, 4 Blatch., 438; 2 Fish., 154; v. Mullee, 3 Fish., 420; v. Hullihen, 2 Hughes, 251; v. Chaffee, 3 Blatch., 268; v. Dunbar, 3 Wall. Jr., 310; v. N. Y. Gutta Percha Co., 2 Fish., 312; v. Beverly Rubber Co., 1 Cliff., 348; Rubber Co. v. Goodyear, 9 Wall., 788; 9 Wall., 807; Suydam v. Day, 2 Blatch., 20; Metropolitan Washing Machine Co. v. Earle, 3 Wall. Jr., 320; Day v. Newark India Rubber Mfg. Co., 1 Blatch., 628; Goodyear v. Day, 1 Blatch., 565; Day v. Cary, 4 Blatch., 271; Gardner v. Goodyear Dental Vulcanite Co., 3 O. G., 295; Robinson, *Ex parte*, 2 Biss., 309.

3802. Sickles, F. E. Oct. 19, 1844. Valves for Steam-engines.

Reissues 1112 and 1113, Jan. 1, 1861.

Construed and not infringed, Sickles v. Evans, 2 Cliff., 203.

3824. Mini, J. G. Nov. 13, 1844. Lampblack.

Void for false suggestion, Child v. Adams, 1 Fish., 189.

3857. Richards, R. Dec. 16, 1844. Machine for Cutting Leather in Soles.

Claim construed to be for an operative part of a machine, infringed by substituted equivalent which may amount to a patentable improvement, Foster v. Moore, 1 Curt., 279.

1845.

3876. Henry, S. Jan. 4, 1845. Stove.

Reconstrued, Ruggles v. Eddy, 12 O. G., 716; Ruggles v. Eddy, 10 Blatch., 52; 11 Blatch., 524.

3885. Tyler, P. B. Jan. 16, 1845. Cotton Press.

Reissue 92. May 1, 1847.

Tyler v. Hyde, 2 Blatch., 308.

3889. Cushman, W. M. C. Jan. 16, 1845. Railroad Rails.

Application for reissue, Cushman, *In re*, 1 MacA. Pat. Cases, 577.

3895. McCormick, C. H. Jan. 31, 1845. Harvester.

Claims construed, McCormick v. Seymour, 2 Blatch., 240. Claims construed and infringed, *Ibid.*, 3 Blatch., 209. Construed to be for a combination, sustained and not infringed, McCormick v. Manny, 6 McLean, 539. Construed and not infringed, McCormick v. Talcott, 20 How., 402. See, also, Seymour v. McCormick, 19 How., 96.

3987. Bigelow, E. B. Apr. 10, 1845. Power Loom.

Lowell Mfg. Co. v. Hartford Carpet Co., 2 Fish., 472.

4023. Parkhurst, S. R. May 1, 1845. Wool Carding Machine.

Patentee held first and original inventor, Parkhurst v. Kinsman, 1 Blatch., 488. In interference, Cundell v. Parkhurst, 1 MacA. Pat. Cases, 63. See, also, Parkhurst v. Kinsman, 2 Blatch., 72; 2 Blatch., 76; 2 Blatch., 78; Kinsman v. Parkhurst, 18 How., 289.

Reissue No. 1137, Feb. 12, 1861.

Morris v. Lowell Mfg. Co., 3 Fish., 67.

4120. Hale & Goodman, July 22, 1845. Machine for Cutting Irregular Forms.

Reissue No. 1400, Feb. 10, 1863.

Construed to be for a combination of old elements; limited to actual invention and not infringed, Hale v. Stimpson, 2 Fish., 565.

4199. Sickles, F. E. Sept. 19, 1845. Steam-engine.

Held valid, Sickles v. Mitchell, 3 Blatch., 548. Construed, Sickles v. Borden, 3 Blatch., 538.

Reissue 910, Feb. 21, 1860.

Reissue claim construed to be for a non-patentable result; abandoned by delay of fourteen years in reissuing; anticipated by prior patent to same patentee, and wanting in novelty, Sickles v. Falls, 4 Blatch., 509. Construed to be for a different invention from original and invalid, Sickles v. Evans, 2 Cliff., 203.

Reissue No. 1113, Jan. 1, 1861; No. 1260, Jan. 21, 1862.

Construed and not infringed, Sickles v. Evans, 2 Cliff., 203. See, also, Sickles v. Borden, 4 Blatch., 14; v. Tileston, 4 Blatch., 109; Steam Packet Co. v. Sickles, 10 How., 419.

- 4204.** Hovey, W. Sept. 23, 1845. Grinding Tools.
 Construed; novelty and originality doubted, *Hovey v. Stevens*, 1 W. & M., 290.
 Reissue No. 96, June 19, 1847.
 Claim construed and held insufficient in not distinguishing what is claimed as new,
Ibid., 3 W. & M., 17.
- 4213.** Stimpson, T. D. Sept. 30, 1845. Removing Truck Wheels.
Stimpson v. Mad River R. Co., 6 McLean, 603.
- 4266.** Hyatt, T. Nov. 12, 1845. Vault Cover.
 Reissue 303, April 3, 1855.
Lake v. Fitzgerald, 6 Fish., 420. Held not to interfere with 14,281, *Cornell v. Hyatt*, 1 MacA. Pat. Cases, 423.

1846.

- 4453.** Morse, S. F. B. Apr. 11, 1846. Electric Telegraph. (Morse Register.)
 Reissue, 118, June 13, 1848.
 Construed to be for the combination of the principle with the machinery invented; sustained and infringed, *Smith v. Clark*, 3 Am. L. J., 155. Reissue sustained and held infringed, *Morse v. Bain*, 9 West. L. J., 106. See, also, *Smith v. Downing*, 1 Fish., 72; *v. Selden*, 1 Blatch., 475; *v. Eli*, 5 McLean, 76; 15 How., 137; *O'Reilley v. Morse*, 15 How., 109.
- 4459.** Ide, N. Apr. 18, 1846. Cultivator.
 Held infringed, *Tracey v. Torrey*, 2 Blatch., 277, and *Chamberlin v. Ganson*, 2 Blatch., 279.
- 4472.** Wells, H. A. Apr. 25, 1846. Hat Body, Machine for making.
 Reissue 396. Sept. 30, 1856.
 Sustained and not infringed, *Burr v. Cowperthwaite*, 4 Blatch., 165.
 Reissue 2942, May 19, 1868.
 Fifth claim construed and not infringed when limited as in prior decisions. Sixth claim infringed, *Brett v. Quintard*, 10 Fed. Rep., 741. Not infringed in view of prior decisions, *Wells v. Jaques*, 5 Fish., 136. Reissue of an original combination for one of fewer elements considered, *Gill v. Wells*, 22 Wall., 1.
 Reissues 1086 and 1087, Dec. 4, 1860.
 If construed so as to be infringed, is too broad in view of state of art and original, and is void, *Burr v. Duryee*, 1 Wall., 531. Held not infringed if limited, otherwise too broad, *Burr v. Duryee*, 2 Fish., 275.
 2942 declared to be for same invention as original, and infringed by formal difference only, *Wells v. Gill*, 6 Fish., 574. Construed to be for a combination of old and well known devices to produce a new and useful result; valid in view of original; claims 1, 2, 4 and 6 infringed, *Wells v. Jaques*, 5 O. G., 364. Sixth claim construed to be for a combination; held valid and infringed, *Brett v. Quintard*, 17 Fed. Rep., 529. Sustained in view of original model and drawings; construed and infringed by a colorable variation, *Wells v. Haganman*, 29 Leg. Int., 405. See, also, *Wells v. Yates*, 6 Fish., 89.
- 4595.** Carey, D. June 27, 1846. Horse Power.
Pitts v. Hall, 2 Blatch., 230.
- 4726.** Howe, W. Aug. 28, 1846. Truss Bridge.
Railroad Co. v. Trimble, 10 Wall., 367.
- 4750.** Howe, E., Jr. Sept. 10, 1846. Sewing Machine.
 Held valid and not anticipated by an abandoned experiment, *Howe v. Underwood*, 1 Fish., 160. Construed in view of state of art, and claim literally to a result construed and sustained for the means; held infringed, *Howe v. Macon*, 1 Fish., 586.
 Reissue No. 1154, March 19, 1861.
 First claim construed, not anticipated by prior publication; sustained and infringed; patentee is first and original inventor, *Howe v. Williams*, 2 Cliff., 245.
- 4816.** Jackson & Judson. Oct. 17, 1846. Bell Telegraph.
United States Annunciator Co. v. Sanderson, 3 Blatch., 184.
- 4848.** Jackson & Morton. Nov. 12, 1846. Surgical Operation (Anæsthetic).
 Construed to be for a naked discovery; a more perfect effect produced by old agents in an old way on old subjects, not patentable and void, *Morton v. New York Eye Infirmary*, 5 Blatch., 116; *Cushing's Opinion*, 8 Op., 270.
- 4860.** Denniston, J. T. Nov. 20, 1846. Harness Saddles.
North v. Kershaw, 4 Blatch., 70.
- 4912.** Cahart, J. Dec. 28, 1846. Bellows for Musical Instrument.
 Reissue 484, Aug. 25, 1857.
 Void for new matter, *Cahart v. Austin*, 2 Cliff., 528.

1847.

5006. Jenkins, H. March 6, 1847. Wire Grating Manufacture.
Reissue No. 747, June 28, 1859.
Chase v. Walker, 3 Fish., 120.
5112. Atwood, A. May 15, 1847. Cast-iron Car Wheels.
Reissue No. 468, June 9, 1857.
Construed, novelty sustained and held infringed, Atwood v. Portland Co., 10 Fed. Rep., 283.
5175. Winans, R. June 26, 1847. Cars for Coal.
Construed, Winans v. Denmead, 15 How., 344.
5227. Hussey, O. Aug. 7, 1847. Reaper.
Reissue No. 449, April 14, 1857.
Novelty sustained, Hussey v. Whitely, 1 Bond, 407. Not void for laches in reissuing; is valid and infringed, Hussey v. Bradley, 5 Blatch., 134.
Reissue 742, June 21, 1859.
Not void for laches in reissuing; is valid, novel and infringed, *Ibid.* See, also, Hussey v. McCormick, 1 Biss., 300.
5253. Cornell, S. G. Aug. 21, 1847. Lead Pipe Machinery.
Tatham v. Le Roy, 2 Blatch., 484. Awarded priority on interference, Perry v. Cornell, 1 MacA. Pat. Cases, 68.
5254. Clark, T. Aug. 21, 1847. Safety Apparatus for Steam Boilers.
Construed, Clark Patent Steam Co. v. Copeland, 2 Fish., 221.
5335. McCormick, C. H. Oct. 23, 1847. Harvester.
Claim construed in view of specification to determine the invention, McCormick v. Seymour, 2 Blatch., 240.
Reissue No. 239, May 24, 1853.
Construed and held infringed, McCormick v. Talcott, 20 How., 402. See, also, McCormick v. Manny, 6 McLean, 543; v. Seymour, 3 Blatch., 223; Seymour v. McCormick, 16 How., 480.
5352. Boardman, Wm., Jr. Nov. 6, 1847. Portable Steam Pumps.
Awarded priority on interference, Atkinson v. Boardman, 1 MacA. Pat. Cases, 80.

1848.

5476. Gazley, A. H. March 14, 1848. Saddles.
North v. Kershaw, 4 Blatch., 10.
5522. Moore, L. Apr. 18, 1848. Seed Drill.
Reissues 1393, 1394 and 1395, Feb. 4, 1863.
Moore v. Marsh, 7 Wall., 515.
5531. Whitney, A. Apr. 25, 1848. Cast-iron Car Wheels.
Held novel, useful, not void for concealment; process claim construed, sustained, infringed by improvement, Whitney v. Mowry, 2 Bond, 45. Construed, *Ibid.*, 4 Fish., 141. Construed to be for a process obtaining a novel result, and not for a combination; not void for want of utility or for insufficient description, and is infringed, Mowry v. Whitney, 14 Wall., 620. Is for a process as an entirety, Whitney v. Mowry, 4 Fish., 207. See, also, Mowry v. Whitney, 14 Wall., 434.
5575. Serrell, A. T. May 16, 1848. Making Mouldings.
Reissue No. 187, Jan. 7, 1851; No. 243, June 21, 1853.
Construed, Serrell v. Collins, 4 Blatch., 62.
5876. How, J. Oct. 24, 1848. Boot Tree.
Eames v. Cook, 2 Fish., 146.

1849.

5993. Larabee, E. Jan. 2, 1849. Shower Bath.
Construed to be for a combination of old elements, and not infringed by a combination of less than the entire number of elements. Larabee v. Cortlan, 3 Fish., 5.
6025. Hibbert, J. Jan. 9, 1849. Knitting Needles.
Construed and limited to actual improvement in view of state of art, and held infringed, Aiken v. Dolan, 3 Fish., 197.
6086. Vance, E. Feb. 6, 1849. Cooking Stove.
Construed, Vance v. Campbell, 1 Fish., 483; 1 Black, 427.
6099. Morey & Johnson. Feb. 6, 1849. Sewing Machine.
Reissue No. 518, Jan. 12, 1858.
Construed and held infringed, Singer v. Walmsley, 1 Fish., 558.

- 6106.** Jenkins, H. Feb. 13, 1849. Wire Fence.
Construed and limited, and not infringed as limited, *New York Wire Rail Co. v. Walker*, 2 Fish., 179.
- 6135.** Dyson, J. Feb. 20, 1849. Carding Engine.
Held not infringed, *Dyson v. Danforth*, 4 Fish., 133.
- 6148.** Frost & Monroe. Feb. 27, 1849. Middlings Purifier.
Reissue No. 302, March 13, 1855.
Claim held bad for uncertainty, *Carr v. Rice*, 4 Blatch., 200.
Reissue 1280, Feb. 25, 1862.
• Construed to be for patentable matter; claim is for a combination, sustained, and not void for uncertainty in the specification, *Swift v. Whisen*, 2 Bond, 115; *Carr v. Rice*, 1 Fish., 198.
- 6162.** Corliss, G. H. March 10, 1849. Cut-off for Steam-engines.
Reissues Nos. 759 and 763, July 12, 1859.
Held novel, patentable and infringed, *Corliss v. Wheeler & Wilson Mfg. Co.*, 2 Fish., 199.
- 6245.** Haines, J. March 27, 1849. Harvester.
Reissue No. 331, Nov. 6, 1855.
Awarded priority on interference, *Haines v. Rugg*, 1 MacA. Pat. Cases, 420.
- 6328.** Bain, A. Apr. 17, 1849. Electric Telegraph.
Held not to interfere with Morse's patent No. 6420, *Bain v. Morse*, 6 West. L. J., 372;
Same Case, 1 MacA. Pat. Cases, 90.
- 6420.** Morse, S. F. B. May 1, 1849.
Sustained and held infringed, *O'Reilley v. Morse*, 15 How., 62. Held not to interfere with 6328, *Bain v. Morse*, 1 MacA. Pat. Cases, 90. Sustained, *Morse v. Bain*, 9 West. L. J., 106.
- 6439.** Bachelder, J. May 8, 1849. Sewing Machine.
Reissue No. 2125, Dec. 12, 1865.
Held novel, sustained and infringed, *Bachelder v. Moulton*, 11 Blatch., 304. Held valid, novel and infringed, *Potter v. Stewart*, 18 Blatch., 561. Construed to be for a combination; extension valid; is infringed, *Potter v. Braunsdorf*, 7 Blatch., 97.
- 6545.** Sanders, B. D. June 19, 1849. Winnowing Machine.
Reissue No. 306, Apr. 10, 1855.
Sanders v. Logan, 2 Fish., 167.
- 6757.** Cox, G. S. Oct. 2, 1849. Metallic Packing for Steam-engines.
Matthews v. Skates, 1 Fish., 602.
- 6762.** Hodge, N. Oct. 2, 1849. Operating Car Brake.
Reissue No. 231, March 1, 1853.
Hodge v. N. Missouri & Iron Mt. R. Co., 4 Fish., 161; *v. Hudson R. R. Co.*, 6 Blatch., 165;
v. Hudson R. & Harlem R. Co., 6 Blatch., 85; *Wood v. Mich. S. R. R.*, 2 Biss., 62.
- 6806.** Bigelow, E. B. Oct. 23, 1849. Jacquard Loom.
Lowell Mfg. Co. v. Hartford Carpet Co., 2 Fish., 472.
- 6835.** Rice, O. Oct. 30, 1849. Wash-board.
Description held sufficient, *Wayne v. Holmes*, 1 Bond, 27. See, also, *Wayne v. Winter*, 6 McLean, 344.
- 6939.** Marshall, M. Dec. 11, 1849. Loom.
Reissue No. 947, Apr. 24, 1860.
Held to be for same invention as original; is useful; original not void for want of oath, *Crompton v. Belknap Mills*, 3 Fish., 536.
- 6951.** Blanchard, T. Dec. 18, 1849. Wood-bending Machine
Reissue No. 853, Nov. 15, 1859.
Construed to be for a combination of old parts to produce a new and useful result, *Blanchard v. Puttman*, 2 Bond, 84. See, also, *Ibid.*, 8 Wall., 420.

1850.

- 7027.** Norcross, N. G. Jan. 15, 1850. Circular Saw-mill.
Construed to be for a combination, *Lee v. Blandy*, 1 Bond, 361.
- 7263.** Ladd, W. G., Jr. Apr. 9, 1850. Fluid Level.
In interference, *Chandler v. Ladd*, 1 MacA. Pat. Cases, 493.
- 7446.** Smith, A. June 18, 1850. Dyeing Parti-colored Yarn.
Reissue No. 217, May 11, 1852.
Construed, *Smith v. Higgins*, 1 Fish., 537. Construed to be for a combination and held not infringed, *Ibid.*, 2 Fish., 97.

- 7531.** O'Neil, J. July 30, 1850. Churns.
Additional patent No. 97, 1851.
Awarded priority on interference, *Burlew v. O'Neil*, 1 MacA. Pat. Cases, 168.
- 7686.** Matthews, M. M. Oct. 1, 1850. Printer's Ink.
Awarded priority on interference, *Matthews v. Wade*, 1 MacA. Pat. Cases, 144; *Johnson's Opinion*, *Ibid.*, 145.
- 7676.** Aiken, H. Oct. 1, 1850. Wrought-iron Car Wheels.
Held useful and important, the degree being immaterial, and is entitled to a patent, *Aiken, In re*, 1 MacA. Pat. Cases, 130.
- 7755.** Judson, J. & A. Nov. 5, 1850. Valves for Governors.
Construed to be for a patentable invention, *Judson v. Moore*, 1 Bond, 285. Sustained as for patentable subject-matter, *Judson v. Cope*, 1 Bond, 327.
Reissue No. 255, Jan. 10, 1854.
- 7776.** Wilson, A. B. Nov. 12, 1850. Sewing Machine.
Sustained, *Potter v. Whitney*, 3 Fish., 77.
Reissue No. 346, Jan. 22, 1856.
Held novel, not anticipated by incomplete experiment; claims construed and infringed, *Potter v. Wilson*, 2 Fish., 102. Held novel, *Potter v. Muller*, 2 Fish., 465. Infringed by formal variation, *Potter v. Schenck*, 1 Biss., 515. Infringed by use of equivalent, *Potter v. Davis Sewing Machine*, 3 Fish., 472. Held valid and infringed, *Potter v. Empire Sewing Machine Co.*, 3 Fish., 474. Sustained, *Grover & Baker Sewing Machine v. Sloat*, 2 Fish., 112.
Reissue No. 414, Dec. 9, 1856.
Construed to be for the substitution in an old combination of old elements, of a new and independent element constituting a new and patentable combination by its difference from the old element replaced, *Potter v. Holland*, 4 Blatch., 241. Held novel, not anticipated by incomplete experiments; claims construed and held infringed, *Potter v. Wilson*, 2 Fish., 102. Sustained as novel, *Potter v. Muller*, 2 Fish., 465. Sustained, *Grover & Baker Sewing Machine v. Sloat*, 2 Fish., 112. See, also, *Potter v. Fuller*, 2 Fish., 251; *v. Holland*, 4 Blatch., 206; *v. Muller*, 1 Bond, 601; *v. Stevens*, 2 Fish., 163; *v. Mack*, 3 Fish., 428; *v. Crowell*, 1 Abb., 89; *Burdell v. Denig*, 2 Fish., 538; 15 Fed. Rep., 397; 2 Otto, 716; *v. Comstock*, 15 Fed. Rep., 395; *Florence Sewing Machine Co. v. Singer Sewing Machine Co.*, 8 Blatch., 113; 8 Blatch., 117; *Wilson v. Barnum*, 1 Wall. Jr., 347.
- 7813.** Sabin, H. W. Dec. 3, 1850. Horse Rake.
Reissue Nos. 1914 and 1915. March 28, 1865.
Not abandoned; are for same invention as original, and valid, *Hoffheins v. Brandt*, 3 Fish., 219.
- 7854.** England, L. C. Dec. 24, 1850. Vats for Tanning Hides.
England v. Thompson, 3 Cliff., 271.

1851.

- 7931.** Grover & Baker. Feb. 11, 1851. Sewing Machine.
Reissue No. 568. June 15, 1858.
Grover & Baker Sewing Machine Co. v. Williams, 2 Fish., 133.
- 8047.** Littlefield, D. G. April 15, 1851. Cooking Stove.
Littlefield v. Perry, 21 Wall., 205; *Perry v. Littlefield*, 17 O. G., 51; *v. Corning*, 7 Blatch., 195.
- 8075.** Goodyear, N. May 6, 1851. India Rubber.
Reissue No. 556, May 18, 1858; 557, May 18, 1858.
Construed broadly as not limited to percentage composition provided same result is obtained, *Goodyear v. Mullee*, 5 Blatch., 429.
Sustained and infringed by a combination embodying the invention, *Goodyear v. Evans*, 6 Blatch., 121. Construed, limited, sustained and infringed. *Goodyear v. Berry*, 2 Bond, 189.
Not abandoned by laches, *Goodyear v. Hills*, 3 Fish., 134. Infringed, *Goodyear v. Rust*, 6 Blatch., 229. No. 556 sustained, not abandoned, sufficiently described, *Goodyear v. Wait*, 5 Blatch., 468. No. 557 construed, held novel and infringed, *Goodyear v. New York Gutta Percha Co.*, 2 Fish., 312. Sustained, *Goodyear v. Mullee*, 3 Fish., 420. See, also, *Goodyear v. Mullee*, 3 Fish., 259; *v. Allyn*, 6 Blatch., 33; *v. Honsinger*, 2 Biss., 1; *v. Hullihen*, 2 Hughes, 492.
- 8119.** Hoyt, Wm. H. May 27, 1851. Omnibus Steps.
Awarded priority on interference, *Stephenson v. Hoyt*, 1 MacA. Pat. Cases, 292.

- 8154.** Sangster, H. & J. June 10, 1851. Lantern.
Reissue No. 325, Aug. 21, 1855.
Wanting in novelty; claim construed to be for a result, *Sangster v. Miller*, 5 Blatch., 243.
- 8192.** Palmer & Williams. July 1, 1851. Harvester.
Reissue No. 305, Apr. 10, 1855.
Construed, limited and not infringed, *Seymour v. Osborne*, 3 Fish., 555.
Reissue No. 1110. Jan. 1, 1861.
Construed to be for a combination, and is infringed, *Ibid.*, 11 Wall., 516.
Reissue No. 1682, May 31, 1864.
Construed to be for a combination; sustained and infringed, *Ibid.* Held novel and infringed, *Seymour v. Marsh*, 2 O. G., 675. Considered, held novel, useful, and first claim infringed, *Marsh v. Seymour*, 97 U. S., 349.
- 8212.** Seymour, W. H. July 8, 1851. Harvester.
Reissue No. 1003, July 10, 1860.
Construed, limited and not infringed, *Seymour v. Osborne*, 3 Fish., 555.
Reissue No. 1177 (also No. 72), May 7, 1861.
Construed, held valid and infringed, *Seymour v. Marsh*, 2 O. G., 675; *Marsh v. Seymour*, 97 U. S., 349. Construed and held infringed, *Seymour v. Osborn*, 11 Wall., 516. Construed, limited and not infringed, *Seymour v. Osborn*, 3 Fish., 555.
Reissue 1683, May 31, 1864.
Held novel and useful; second claim infringed, *Marsh v. Seymour*, 97 U. S., 349. Construed to be for a combination; held valid and infringed, *Seymour v. Osborn*, 11 Wall., 516. Held novel and infringed, *Seymour v. Marsh*, 2 O. G., 675.
- 8253.** Corliss, G. H. July 29, 1851. Cut-off Gear.
Reissue No. 780, July 26, 1859.
Held novel, patentable and infringed, *Corliss v. Wheeler & Wilson Mfg. Co.*, 2 Fish., 199.
- 8282.** Akins & Felthousen. Aug. 5, 1851. Sewing Machine.
Reissue No. 1388, Jan. 27, 1863.
Potter v. Dixon, 5 Blatch., 160.
- 8294.** Singer, I. M. Aug. 12, 1851. Sewing Machine.
Reissue No. 278, Oct. 3, 1854.
Construed, *Singer v. Walmsley*, 1 Fish., 579. Sustained, *Wickersham v. Singer*, 1 MacA. Pat. Cases, 645.
- 8322.** Carter & Rees. Aug. 26, 1851. Nut and Washer Machine.
Reissue No. 313, June 19, 1855.
Construed, held novel, and not invalid for delay in reissuing, *Wood v. Cleveland Rolling Mill*, 4 Fish., 550. Held, on interference, entitled to patent for improvements made thereon, *Carter v. Carter*, 1 MacA. Pat. Cases, 388.
- 8368.** Jillson, A. Sept. 16, 1851. Weaver's Temples.
Awarded priority on interference, *Jillson v. Winsor*, 1 MacA. Pat. Cases, 136.
- 8427.** Kenyon, W. Oct. 14, 1851. Nuts.
Reissue No. 666, Feb. 15, 1859.
Construed, held novel, and not invalid for delay in reissuing, *Wood v. Cleveland Rolling Mill*, 4 Fish., 550. Held, on interference, subsequent to No. 13,118, *Carter v. Carter*, 1 MacA. Pat. Cases, 388.
- 8552.** Stevans, F. A. Nov. 25, 1851. Car Brake.
Construed to be for a patentable and novel combination of old elements, and sustained, *Emigh v. Chicago, Burlington & Quincy R. Co.*, 1 Biss., 400. See, also, *Same v. Baltimore & Ohio R. Co.*, 4 Hughes, 271; *Emigh v. Chamberlain*, 1 Biss., 367.
- 8589.** Hayden, H. W. Dec. 16, 1851. Machine for Making Brass Kettles.
Construed, and held to involve invention, *Waterbury Brass Co. v. New York & Brooklyn Brass Co.*, 3 Fish., 43.
Reissues Nos. 3995 and 3996, May 24, 1870.
Construed, held novel, valid and infringed, *Waterbury Brass Co. v. Miller*, 9 Blatch., 77.
- 8621.** Allen, J. Dec. 23, 1851. Setting Mineral Teeth.
Construed, held useful, *Allen v. Hunter*, 6 McLean, 303.

1852.

- 8641.** Rapp, A. W. Jan. 6, 1852. Gold Pen.
Construed, limited and not infringed. *Rapp v. Bard*, 1 Fish., 196.

- 8720.** Densmore, B. Feb. 10, 1852. Harvester.
Reissue No. 1262, Jan. 28, 1862.
Construed, invalid in part for new matter; not infringed, if limited, *Kirby v. Dodge & Stephenson Mfg. Co.*, 10 Blatch., 307. Construed, sustained, held novel and infringed, *Whiteley v. Kirby*, 11 Wall., 678.
- 8724.** Ketchum, W. F. Feb. 10, 1852. Harvester Attachments.
Reissues Nos. 4672 and 4673, Dec. 12, 1871.
Construed in view of state of art; are for same invention as original; valid and infringed, *Ketchum Harvesting Machine Co. v. Johnston Harvester Co.*, 13 O. G., 178. Infringed by manufacture here for sale abroad, *Ibid.*, 19 Blatch., 367.
- 8756.** Jones, S. T. Feb. 24, 1852. Zinc White Manufacture.
Held anticipated in part by English patent; invention not sufficiently distinguished from the invention in said patent, *Jones v. Osgood*, 6 Blatch., 435.
- 8861.** Shaw, D. Apr. 6, 1852. Smut Mill.
Reissue No. 3794, Jan. 11, 1870.
Third claim construed to be for a combination, and limited; novelty and validity doubted; not infringed by omission of one element and substitution of a new device; fifth claim invalid for want of invention, *Knox v. Murtha*, 9 Blatch., 205.
- 8876.** Singer, I. M. Apr. 13, 1852. Sewing Machine.
Singer v. Walmsley, 1 Fish., 558.
- 9005.** Rugg, G. H. June 8, 1852. Harvester.
Held, on interference, abandoned by public use and sale for more than two years prior to application, *Rugg v. Haines*, 1 MacA. Pat. Cases, 420.
- 9109.** Thompson & Bachelder. July 6, 1852. Car Brake.
Sustained, *Sayles v. Chicago & Northwestern R'y Co.*, 1 Biss., 468. Sustained; infringed by use of the inventive principle of the combination, *Ibid.*, 3 Biss., 52. Construed and limited to original application prior to amendment as against intervening rights of third parties; sustained and not infringed, *Railway Co. v. Sayles*, 97 U. S., 554. Novelty of patent, as construed by plaintiffs, doubted, *Mowry v. Grand St. & Newtown R. Co.*, 10 Blatch., 89. See, also, *Sayles v. Louisville City R. Co.*, 9 Fed. Rep., 512; *v. Oregon Central R'y Co.*, 6 Sawyer, 31; *v. Richmond, F. & P. R. Co.*, 3 Hughes, 172; *v. Dubuque & Sioux City R. Co.*, 5 Dill., 561; *Root v. Lake Shore & Mich. S. R. Co.*, 105 U. S., 189; *Hendrie v. Sayles*, 98 U. S., 546.
- 9432.** Moffitt, J. R. Nov. 30, 1852. Grain Separator.
Reissue No. 540, March 23, 1858.
Moffitt v. Garr, 1 Bond, 315; 1 Black, 273.
- 9435.** Tainter, D. Nov. 30, 1852. Rotary Knitting Machine.
First and second claims construed to be duplicate claims to same invention; patent not void in consequence, but sustained, *Tompkins v. Gage*, 5 Blatch., 268.
- 9484.** Hopkins, E. L. Dec. 21, 1852. Hat Body Manufacture.
Held not infringed, *Burr v. Duryee*, 2 Fish., 275.

1853.

- 9653.** Smith, Wm. Apr. 5, 1853. Corded Elastic Fabric.
Reissue Nos. 2843 and 2844, Jan. 14, 1868.
Not anticipated by abandoned experiment; sustained and infringed, *Smith v. Glendale Elastic Fabric Co.*, 1 Holmes, 340; *Elastic Fabric Co. v. Smith*, 100 U. S., 110.
Reissue No. 3014, June 30, 1868. Division B.
Double use, wanting in patentable invention, *Smith v. Elliott*, 9 Blatch., 400; *Smith v. Nichols*, 1 Holmes, 172.
Is for change in degree only, not involving invention, *Smith v. Nichols*, 21 Wall., 112. Not anticipated by abandoned experiment; sustained and infringed, *Smith v. Glendale Elastic Fabric Co.*, 1 Holmes, 340.
- 9688.** Sloan, T. J. Apr. 26, 1853. "Screw Machine."
Awarded priority on interference, *Screw Co. v. Sloan*, 1 MacA. Pat. Cas., 210.
- 9700.** Taylor, J. S. May 3, 1853. "Hat Body Machine."
Hawley v. Mitchell, 1 Holmes, 42; *Mitchell v. Hawley*, 16 Wall., 544.
- 9703.** O'Reilly, P. May 3, 1853. "Rails for Railroads."
Held that interference was improperly declared, the inventions not being similar, *O'Reilly v. Smith*, 1 MacA. Pat. Cas., 218.
- 9718.** Mee, J. May 10, 1853. Knitting Loom.
Awarded priority on interference over interfering applicant, who merely suggested improvements involving mechanical skill, *Marshall v. Mee*, 1 MacA. Pat. Cas., 229.

- 9719.** Mee, J. May 10, 1853. Knitting Loom.
Same as in 9718, *Ibid.*, 229.
- 9721.** Young, J. May 10, 1853. Printing Press.
Awarded priority on interference, Ruggles *v.* Young, 1 MacA. Pat. Cas., 160.
- 9736.** Seely, S. May 17, 1853. Lime Kiln.
Held to be for a patentable use of an old thing in an old way to produce known but better effects, Seely, *In re*, 1 MacA. Pat. Cas., 248.
- 9737.** Ketchum, Wm. F. May 17, 1853. Mowing Machine.
Awarded priority on interference, McCormick *v.* Howard, 1 MacA. Pat. Cas., 238.
- 9765.** Kittle, S. P. June 7, 1853. Door Fastening.
Erroneous description rejected; construed, and sustained in view of remainder of specification, Kittle *v.* Merriam, 2 Curt., 475.
- 9776.** Smith, H. L. June 7, 1853. Letter Files.
Held novel and to involve more than an analogous use; is patentable, Smith, *In re*, 1 MacA. Pat. Cas., 255.
- 9789.** Brookfield & White. June 14, 1853. Glass Manufacture.
On interference held to be product of joint inventors, Yearsley *v.* Brookfield, 1 MacA. Pat. Cas., 193.
- 9807.** Tuttle, J. H. June 21, 1853. Saw.
Reissue No. 4096, Aug. 9, 1870.
Construed and held not infringed, Wheeler *v.* Simpson, 6 O. G., 435.
- 9810.** Tyson W. F. June 12, 1853. Propellers.
Interference with No. 10 124 dissolved; there being no substantial identity between the two, Tyson *v.* Rankin, 1 MacA. Pat. Cas., 262.
- 9893.** Brown, G. W. Aug. 2, 1853. Seed Planter.
Reissue No. 1036, Sept. 11, 1860.
Construed, validity questioned, not infringed, Brown *v.* Selby, 2 Biss., 457. Construed, sustained, held valid and infringed, Corn-Planter Patent, 23 Wall., 181.
Reissue No. 1037, Sept. 11, 1860.
Construed, limited and wanting in novelty, Brown *v.* Selby, 2 Biss., 457; Corn-Planter Patent, 23 Wall., 181.
Reissue No. 1038, September 11, 1860.
Construed, limited and not infringed, Brown *v.* Selby, 2 Biss., 457. Construed, held valid and infringed, Corn-Planter Patent, 23 Wall., 181.
Reissue No. 1039, Sept. 11, 1860.
Construed, limited, sustained and not infringed, Brown *v.* Selby, 2 Biss., 457. Construed, held valid and infringed, Corn-Planter Patent, 23 Wall., 181.
- 9947.** Gallahue, A. C. Aug. 16, 1853. Machine for Pegging Shoes. Antedated Feb. 18, 1853.
Reissue No. 3533, July 6, 1869.
Fourth claim construed to be for a double use, Gallahue *v.* Butterfield, 10 Blatch., 232.
- 10038.** Sylla & Adams. Sept. 20, 1853. Harvester.
Reissues Nos. 723 and 724, March 17, 1859.
Construed; are for same invention as original; valid, sustained and infringed, Aultman *v.* Holley, 11 Blatch., 317.
Reissue No. 2608, May 14, 1867.
Construed; is for same invention as original; not invalid for new matter in description; is infringed, *Ibid.*, 11 Blatch., 317.
- 10078.** Pratt, E. L. Oct. 4, 1853. Apple-paring Machine.
Held not anticipated by defendant's patent, and is infringed by formal change only, Sargent *v.* Carter, 1 Fish., 277. See, also, Sargent *v.* Larned, 2 Curt., 349.
- 10124.** Beard, E. Oct. 18, 1853. Propeller.
Interference with No. 9810 dissolved, there being no substantial identity between the two. Tyson *v.* Rankin, 1 MacA. Pat. Cases, 262.
- 10204.** Gear, N. Nov. 8, 1853. Molding Machine.
Gear *v.* Holmes, 6 Fish., 595; *v.* Fitch, 16 O. G., 1231; *v.* Grosvenor, 1 Holmes, 215.
- 10289.** Bussell, E. T. Nov. 29, 1853. India Rubber and Steel Spring.
Reissue No. 4202, Dec. 13, 1870.
Novelty of invention, and validity of reissue to assignee (acts 1836 and 1837), sustained, National Car Spring Co. *v.* Union Car Spring Co., 12 Blatch., 80.
- 10339.** Meyer, L. O. P. Dec. 20, 1853. Vulcanizing Caoutchouc.
Construed, sustained and held infringed, Poppenhusen *v.* Falke, 5 Blatch., 46; 4 Blatch., 493. Not infringed, Poppenhusen *v.* New York Gutta-percha Co., 4 Blatch., 253. See, also, Poppenhusen *v.* New York Gutta-percha Co., 4 Blatch., 184; 2 Fish., 62.

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- 10422.** Smith, H. B. Jan. 10, 1854. Mortising Machine.
Construed, in view of state of art, to be for a combination, and not for a principle; held novel, and sustained, *Smith v. Fay & Co.*, 6 Fish., 446.
- 10448.** Littlefield, D. G. Jan. 24, 1854. Coal Burner.
Reissue No. 1823, Nov. 22, 1864.
Construed to be for an improvement on a prior patented invention, *Perry v. Littlefield*, 17 Blatch., 272.
- 10459.** Palmer & Williams. Jan. 24, 1854. Harvester.
Construed, sustained and held infringed, *Seymour v. Osborne*, 11 Wall., 516. Held not infringed, *Ibid.*, 3 Fish., 555.
- 10467.** Boughton, E. Jan. 31, 1854. Cultivator.
Held to be a patentable combination of old elements, *Boughton, In re*, 1 MacA. Pat. Cases, 278.
- 10477.** Lull & Porter. Jan. 31, 1854. Shutter Hinge.
Construed in view of state of art; single claim held to be in effect two claims, one of which is infringed, *Lull v. Clark*, 22 O. G., 1535. See, also, *Lull v. Clark*, 20 Fed. Rep., 454.
- 10597.** Johnson, W. H. March 7, 1854. Sewing Machine.
Reissue No. 355, Feb. 26, 1856.
Construed, *Johnson v. Root*, 1 Fish., 351. Third claim construed, *Ibid.*, 2 Cliff., 108.
- 10741.** Meyer, L. O. P. April 4, 1854. Vulcanizing Caoutchouc.
Reissue No. 797, Aug. 16, 1859.
Identity of reissue and original doubted; held infringed, *Poppenhusen v. Falke*, 4 Blatch., 493. Construed to cover more than original; sustained and infringed, *Ibid.*, 5 Blatch., 47. Construed and infringed, *Poppenhusen v. New York Gutta-percha Co.*, 2 Fish., 62. Not infringed, *Ibid.*, 4 Blatch., 253. See, also, *Ibid.*, 4 Blatch., 184.
- 10903.** Baker, W. May 16, 1854. Clapboard Joint.
Reissue No. 3268, Jan. 19, 1869.
Construed; invalid for want of invention and unpatentable subject-matter as to novelty and utility, *Everett v. Thatcher*, 2 Flip., 234.
- 10965.** Meyers & Eunson. May 23, 1854. Sewing Machine.
Construed and held novel; first claim wanting in novelty; first, second and third claims infringed by mechanical change, *Myers v. Frame*, 8 Blatch., 446. Void for duplication of part not involving invention, *Dunbar v. Myers*, 94 U. S., 187. Second claim infringed by device different in form and construction, but having same function and mode of operation, *Myers v. Duker*, 1 B. & A., 535. See, also, *Myers v. Dunbar*, 8 O. G., 321; *Eunson v. Dodge*, 18 Wall., 414; *Peck v. Frame*, 9 Blatch., 194; 5 Fish., 211; *Emerson v. Simm*, 6 Fish., 218.
- 10967.** Steadman, T. S. May 23, 1854. Harvester.
Reissue Nos. 985 and 986, June 19, 1860.
Abandoned and not infringed, *Whitely v. Swayne*, 7 Wall., 685. Not for same invention as original; invalid for want of proper oath, *Ibid.*, 4 Fish., 117.
- 10974.** Singer, I. M. May 30, 1854. Sewing Machine.
Construed and infringed, *Singer v. Walmsley*, 1 Fish., 580.
- 10975.** Singer, I. M. May 30, 1854. Sewing Machine.
Construed and infringed, *Singer v. Walmsley*, 1 Fish., 580.
- 11113.** Bartholomew, F. H. June 20, 1854. Valve-governor for Water-closets.
Bartholomew v. Sawyer, 4 Blatch., 347.
- 11125.** Howes, F. June 20, 1854. Extra Yard for Topsails.
Held novel, valid, with sufficient specification and description, *Howes v. Nute*, 4 Cliff., 173.
- 11343.** Watt & Burgess. July 18, 1854. Paper Pulp Manufacture.
Reissue No. 1448, April 7, 1863. Product.
Void for want of novelty, *American Wood-paper Co. v. Fibre Disintegrating Co.*, 6 Blatch., 27; *v. Heft*, 3 Fish., 316; *Wood-paper Patent*, 23 Wall., 566.
Reissue No. 1449, Apr. 7, 1863. Process.
Void for want of identity with original, *American Wood-paper Co. v. Fibre Disintegrating Co.*, 6 Blatch., 27. *Wood-paper Patent*, 23 Wall., 566. Illegal, void and wanting in novelty, *American Wood-paper Co. v. Heft*, 3 Fish., 316. See, also, *American Wood-paper Co. v. Glens Falls Co.*, 8 Blatch., 513; *v. Heft*, 4 Wall., 333.
- 11376.** Hunt, W. July 25, 1854. Shirt Collar.
Reissue No. 1828, Nov. 29, 1864.
Sustained and infringed, *Union Paper Collar Co. v. Van Deusen*, 10 Blatch., 109. See, also, *Union Paper Collar Co. v. White*, 7 O. G., 698, 877; 34 Leg. Int., 143.

11491. Nicolson, S. Aug. 8, 1854. Wooden Pavement.

Reissue No. 1583, Dec. 1, 1863.

Construed to be for a combination and not infringed, *Nicolson Pavement Co. v. Hatch*, 4 Sawyer, 692.

Reissue No. 2748, Aug. 20, 1867.

Construed, held novel; not abandoned by prior public experimental use; valid and infringed, *American Nicolson Pavement Co. v. City of Elizabeth*, 6 Fish., 424. Construed and held novel, *City of Elizabeth v. Pavement Co.*, 97 U. S., 126. See, also, *American Nicholson Pavement Co. v. City of Elizabeth*, 4 Fish., 189; 6 O. G., 764; *v. Jenkins*, 14 Wall., 452; *Jenkins v. Pavement Co.*, 1 Abb., 567; *Bigelow v. City of Louisville*, 3 Fish., 602.**11608.** Hayward, D. Aug. 29, 1854. India Rubber Manufacture.

Reissue No. 3531, July 6, 1869.

Construed to be for same invention as original; limited and held valid; reissued by proper person (assignee), *Carew v. Boston Elastic Fabric Co.*, 3 Cliff., 356; *Ibid.*, 1 Holmes, 45.**11638.** Bray, B. Sept. 5, 1854. Spring Roller.Construed to be for a novel combination and sufficiently described, *Bray v. Hartshorn*, 1 Cliff., 538.**11766.** Tilghman, R. A. Oct. 3, 1854. Purifying Fat Bodies.Held novel; valid in view of prior decision to that effect and in view of extension; infringed, *Tilghman v. Mitchell*, 9 Blatch., 18. Construed and infringed by use of lower temperature and more time in process, *Ibid.*, 9 Blatch., 1. Construed to be for a process embodying a new principle, and not for a principle; held novel; valid and infringed by adopting the principle to an available and practical extent, *Tilghman v. Werk*, 1 Bond, 511.Held sufficiently described; patentee first and original inventor and process infringed, *Tilghman v. Mitchell*, 2 Fish., 518. Construed strictly, and limited in view of specification; utility doubted, and held not infringed, *Mitchell v. Tilghman*, 19 Wall., 289. Construed broadly in view of patentee being first in the art; sustained as for a process and infringed, *Tilghman v. Proctor*, 102 U. S., 707.**11805.** Barnum, D. Oct. 17, 1854. Machinery for Forming Hat Bodies.In interference, *Hopkins v. Barnum*, 1 MacA. Pat. Cases, 334.**11820.** Richardson, J. Oct. 17, 1854. Pencil Case.Awarded priority on interference, *Richardson v. Hicks*, 1 MacA. Pat. Cases, 335.**11838.** Renton, J. Oct. 24, 1854. Making Wrought Iron Direct from the Ore.In interference, *Whipple v. Renton*, 1 MacA. Pat. Cases, 332.**11858.** Evarts, H. H. Oct. 31, 1854. Shingle Machine.Construed; third claim; literally for a result; sustained as for the mechanism by which the result is obtained, and not infringed by different intermediate mechanism of inventor leading up experimentally to the patented machine, *Evarts v. Ford*, 6 Fish., 587.**11928.** Bell, Wm. Nov. 14, 1854. Lamp Cap.Held operative and awarded priority on interference, *Bell v. Hill*, 1 MacA. Pat. Cases, 351.**11971.** Parham, C. Nov. 21, 1854. Sewing Machine.

Reissue No. 1562, Nov. 3, 1863.

Construed and sustained; first claim held patentable, novel and not anticipated by abandoned experiments; first and second claims infringed, *Parham v. American Button-hole, etc., Co.*, 4 Fish., 468.**12015.** Robertson, J. W. Nov. 28, 1854. Sewing Machine.Ellithorpe *v. Robertson*, 4 Blatch., 307. Patent denied for laches, on interference, *Same v. Same*, 1 MacA. Pat. Cases, 585. Above affirmed, *Same v. Same*, id., 634.**12017.** Allen, A. H. Dec. 5, 1854. Seats for Public Halls.

Reissue No. 1126, Jan. 15, 1861.

Is for same invention as original; valid and infringed; *Allen v. City of New York*, 17 Blatch., 350. See, also, *Allen v. Mayor, etc.*, 18 Blatch., 239; *v. City of Brooklyn*, 8 Blatch., 535; *Hayward v. Andrews*, 12 Fed. Rep., 786; 106 U. S., 672; *v. City of St. Louis*, 3 McCrary, 614.**12044.** Wheeler, C., Jr. Dec. 5, 1854. Harvester.

Reissues Nos. 875, 877, 878, 879, Jan. 3, 1860.

Construed, held novel and infringed, *Wheeler v. Clipper Mower & Reaper Co.*, 10 Blatch., 181; *v. McCormick*, 11 Blatch., 334.

Reissue No. 2610, May 14, 1867.

Construed and held infringed, *Ibid.*; *Ibid.*; *Wheeler v. McCormick*, 8 Blatch., 267.**12116.** Wilson, A. B. Dec. 19, 1854. Sewing Machine.*Grover & Baker Sewing Machine Co. v. Sloat*, 2 Fish., 114; *Potter v. Muller*, 1 Bond, 601.

1855.

- 12175.** Winsor, J. S. Jan. 2, 1855. Weaver's Harness.
Reissue No. 5282, Feb. 11, 1873.
Fourth claim held infringed by similar device in an English patent, *Kendrick v. Emmons*, 1 Holmes, 234; third, fourth and eighth claims infringed, *Ibid.*, 9 O. G., 201; *Kendrick v. Emmons*, 15 O. G., 936.
- 12227.** Camp, L. E. Jan. 12, 1855. Brass Kettle Manufacture.
Phelps v. Brown, 4 Blatch., 362.
- 12231.** Case, J. Jan. 17, 1855. Seed Planter.
Reissue No. 623, Nov. 16, 1858.
Claim construed to be for a combination, *Case v. Brown*, 1 Biss., 381. See, also, *Case v. Brown*, 2 Wall., 320.
- 12367.** Wheeler, C., Jr. Feb. 6, 1855. Harvester.
Reissue No. 2632, May 28, 1867.
Construed, sustained and infringed, *Wheeler v. Clipper Mower & Reaper Co.*, 10 Blatch., 181. Sustained; sixth and eighth claims infringed, *Wheeler v. McCormick*, 11 Blatch., 334.
- 12492.** Stainthorp, J. March 6, 1855. Candle Machine.
Construed, held novel, patentable, and infringed by use with an improvement, *Stainthorp v. Humiston*, 4 Fish., 107. Infringed, *Ibid.*, 2 Fish., 311. Construed, not anticipated by abandoned experiment; sustained, *Stainthorp v. Elkinton*, 1 Fish., 349. Construed, held novel, first claim infringed, *Stainthorp v. Humiston*, 1 Fish., 475. Construed, held novel, and infringed by colorable alteration, *Thayer v. Wales*, 9 Blatch., 170. See, also, *Thayer v. Wales*, 5 Fish., 448.
- 12530.** Schooley, J. C. March 13, 1855. Process for Curing Meats.
Construed in view of application papers admitted as evidence of intent, *Pike v. Potter*, 3 Fish., 55.
- 12535.** Cunningham, E. March 13, 1855. Vapor Apparatus.
Held to be for a novel and patentable invention; fourth claim construed, sustained and infringed, *Munson v. Gilbert & Barker Mfg. Co.*, 18 O. G., 194. In interference, *Drake v. Cunningham*, 1 MacA. Pat. Cases, 378.
- 12550.** Harris, E. March 20, 1855. Lamp.
Held identical with interfering invention and awarded priority, *Nichols v. Harris*, 1 MacA. Pat. Cases, 362; *Nichols v. Harris*, 1 MacA. Pat. Cases, 302.
- 12648.** White, R. Apr. 3, 1855. Repeating Fire-arms.
Sustained as novel; patentee first and original inventor, *White v. Allen*, 2 Cliff., 224.
- 12649.** White, R. Apr. 3, 1855. Repeating Fire-arms.
Construed, held novel and infringed by use of an equivalent, *White v. Boker*, 3 Fish., 66.
- 12678.** Thompson, M. Apr. 10, 1855. Furnace for Wet Fuel.
Reissue No. 446, March 31, 1857.
Held to be for same invention as original and both claims valid, *Black v. Thorne*, 10 Blatch., 66. See, also, *Black v. Thorne*, 12 Blatch., 20; *v. Munson*, 14 Blatch., 265; *v. Hubbard*, 12 O. G., 842; *v. Thorne*, 111 U. S., 122.
- 12682.** Latta, A. B. Apr. 10, 1855. Steam Generator.
Construed, *Latta v. Shawk*, 1 Bond, 259.
- 12700.** Southworth, A. S. Apr. 10, 1855. Plate Holder for Camera.
Reissue No. 1049, Sept. 25, 1860.
Sustained in conformity with prior decisions and held not infringed, *Ormsbee v. Wood*, 3 Fish., 372. Patentee not first and original inventor, *Wing v. Schoonmaker*, 3 Fish., 607. Construed to be for a result, not a principle; patentee is first and original inventor; not abandoned; is for same invention as original, and infringed, *Wing v. Richardson*, 2 Cliff., 449. Void, claims being for different invention from original, *Wing v. Anthony*, 106 U. S., 142. See, also, *Wing v. Warren*, 5 Fish., 548.
- 12811.** Brown, G. W. May 8, 1855. Seed Planter.
Reissue No. 1091, Dec. 11, 1860.
First claim construed, limited and sustained; second claim incorrect; not infringed, *Brown v. Selby*, 2 Biss., 457. First claim void and anticipated; second claim for a double use, *Corn-Planter Patent*, 23 Wall., 181.
Reissue No. 1092, Dec. 11, 1860.
Claim held incorrect and not infringed, *Brown v. Selby*, 2 Biss., 457. Is not for patentable invention, *Corn-Planter Patent*, 23 Wall., 181.
Reissue No. 1093, Dec. 11, 1860.
Construed, and not infringed, *Brown v. Selby*, 2 Biss., 457. Not sustained, *Corn-Planter Patent*, 23 Wall., 181.

- Reissue No. 1094, Dec. 11, 1860.
Not infringed, *Brown v. Selby*, 2 Biss., 457. Construed to be for frivolous matter and not sustained, *Corn-Planter Patent*, 23 Wall., 181.
Reissue No. 1095, Dec. 11, 1860.
Construed, limited and not infringed, *Brown v. Selby*, 2 Biss., 457. Sustained and infringed, *Corn-Planter Patent*, 23 Wall., 181.
- 12857.** Conover, J. A. May 15, 1855. Wood-splitting Machine.
Construed to be for a combination of old elements, *Conover v. Roach*, 4 Fish., 12. Construed, *Conover v. Rapp*, 4 Fish., 57. Construed and held infringed; extension valid, *Johnson v. McCullough*, 4 Fish., 170. Held not anticipated by prior machine having a different arrangement and combination of the same elements, *Conover v. Mers*, 3 Fish., 386. Construed, and infringed by colorable change, *Conover v. Dohrman*, 6 Blatch., 60. Construed and infringed, *Johnson v. Onion*, 3 Hughes, 290. See, also, *Conover v. Mers*, 11 Blatch., 197; *Mers v. Conover*, 11 O. G., 1111.
- 12956.** La Baw, G. W. May 29, 1855. Miter Machine.
Reissue No. 3445, May 18, 1869.
Held to be for same invention as original; novel, and second claim infringed by substitution of well known equivalent, *La Baw v. Hawkins*, 6 O. G., 724. See, also, *La Baw v. Hawkins*, 2 B. & A., 561.
- 13118.** Steer, I. H. June 19, 1855. Making Nuts.
Wood v. Cleveland Rolling Mill, 4 Fish., 550. Awarded priority on interference, *Carter v. Carter*, 1 MacA. Pat. Cases, 388.
- 13145.** Tuck, J. H. June 25, 1855. Stuffing Box Packing.
Claim construed to be a double claim to a new article of manufacture; sustained in part and infringed, *Tuck v. Bramhill*, 6 Blatch., 95.
- 13258.** Gamble, J. K. & W. P. July 17, 1855. Railroad Draw.
Interference held properly declared; awarded priority, *Spain v. Gamble*, 1 MacA. Pat. Cases, 358.
- 13286.** Waters, C. July 17, 1855. Lantern.
Wanting in novelty, *Dennis v. Cross*, 3 Biss., 389.
- 13364.** Salisbury, E. July 31, 1855. Railway Cars — Excluding Dust from.
Awarded priority on interference, *Stephens v. Salisbury*, 1 MacA. Pat. Cases, 379.
- 13416.** Burrows, J. E. Aug. 15, 1855. White Oxide of Zinc Manufacture.
Limited in view of unsuccessful prior experiments to date of application, and held anticipated by patent founded on caveat filed and successful experiments prior to such date, *Burrows v. Lehigh Zinc Co.*, 1 B. & A., 529. Awarded priority on interference, *Burrows v. Wetherill*, 1 MacA. Pat. Cases, 315.
- 13499.** Ross, F. A. & Marshall. Aug. 28, 1855. Sewing Machine.
Reissue No. 1145, Feb. 26, 1861.
First and second claims construed in view of state of art to be for mere aggregation, wanting in invention, *Ross v. Wolfinger*, 5 O. G., 117.
- 13523.** Haines, J. Sept. 4, 1855. Harvester.
Reissue No. 545, April 13, 1858.
Commissioner of Patents v. Whiteley, 4 Wall., 523.
- 13563.** Bisbee, A. Sept. 18, 1855. Steam Gauge Cock.
Reissue No. 4027, June 11, 1870.
Sustained as a patentable substitution of material involving invention, and infringed by similar device of same material mixed with other matter, *Dalton v. Nelson*, 13 Blatch., 357.
- 13586.** Tompkins & Johnson. Sept. 18, 1855. Rotary Knitting Machine.
Reissue No. 963, May 15, 1860.
Construed and sustained, *Tompkins v. Gage*, 5 Blatch., 268.
- 13606.** Wickoff & Morrison. Sept. 25, 1855. Boring Machine.
Reissue No. 404, Oct. 14, 1856.
Farrington v. Board of Water Commissioners, 4 Fish., 216; *v. Gregory*, 4 Fish., 221.
- 13676.** Cook, J. M. Oct. 16, 1855. Dust Deflector.
Construed, sustained, and infringed by formal difference only, *Cook v. Howard*, 4 Fish., 269.
- 13802.** Sanford, D. W. C. Nov. 13, 1855. Refrigerator.
Reissue No. 455, April 21, 1857.
Construed, held wanting in novelty, *Roberts v. Buck*, 1 Holmes, 224. Construction approved, *Roberts v. Harnden*, 2 Cliff., 500. Claim construed to be for a combination, *Ibid.*, 2 Cliff., 500. Void for want of novelty, *Roberts v. Ryer*, 11 Blatch., 11. Held useful; construed to be for a double use, consisting in a more extended application; wanting in nov-

- elty, *Roberts v. Dyer* (or *Ryer*), 91 U. S., 150. Wanting in novelty, *Roberts v. Blake*, 3 O. G., 268.
- 13806.** Wetherill, S. Nov. 13, 1855. White Oxide of Zinc Manufacture.
Infringed, *Wetherill v. New Jersey Zinc Co.*, 5 O. G., 460; *Wetherill v. New Jersey Zinc Co.*, 1 B. & A., 485; *v. Passaic Zinc Co.*, 6 Fish., 50. Awarded priority on interference, *Jones v. Wetherill*, 1 MacA. Pat. Cases, 409.
- 13927.** Treadwell, D. Dec. 11, 1855. Cannon Manufacture.
Reissue No. 1272, Feb. 4, 1862.
Construed and wanting in novelty, *Treadwell v. Parrott*, 5 Blatch., 369.
- 1856.
- 14119.** Strong, Ross & Howe. Jan. 15, 1856. Weighing Scales.
Prime *v. Brandon Mfg. Co.*, 16 Blatch., 453; 3 B. & A., 191.
- 14133.** Hubbell, Wm. W. Jan. 22, 1856. Eccentric Explosive Shells.
Reissue No. 521, Jan. 19, 1858.
Patentee not first and original inventor; invention as described not operative, *Hubbell's Case*, 5 Ct. of Claims, 1.
- 14281.** Cornell, J. B. Feb. 10, 1856. Illuminating Vault Covers.
Held not to interfere with reissue No. 303 (original patent No. 4266), *Cornell v. Hyatt*, 1 MacA. Pat. Cases, 423.
- 14287.** Marquiss & Emerson. Feb. 19, 1856. Mole of Draining Plow.
Construed, *Hays v. Sulsor*, 1 Bond, 279.
- 14350.** Dorsey, O. March 4, 1856. Harvester Rake.
Reissue No. 2982, June 9, 1868.
Is for same invention as original; novel, sufficiently described, and infringed by formal difference only, *Dorsey Harvester Rake Co. v. Marsh*, 6 Fish., 387. See, also, *Dorsey Harvester Rake Co. v. Bradley Mfg. Co.*, 12 Blatch., 202.
- 14405.** Morris, J. C. March 11, 1856. Wood-bending Machine.
Reissue No. 1312, May 27, 1862.
Construed, held identical with original, novel and infringed, *Morris v. Royer*, 2 Bond, 66.
- 14447.** Dodge, C. March 18, 1856. Fire-place.
Construed to be for a combination; infringement doubted, *Dodge v. Card*, 1 Bond, 393.
- 14481.** Wellman, G. March 18, 1856. Carding Machine.
In interference, *Wellman v. Blood*, 1 MacA. Pat. Cases, 432.
- 14510.** Lyman, A. S. March 25, 1856. Cooling and Ventilating Rooms.
Reissue No. 5786, March 10, 1874.
Not anticipated by rejected and withdrawn application; first claim construed, held novel and infringed, *Lyman Ventilating, etc., Co. v. Lalor*, 12 Blatch., 303. Construed in accordance with prior decision and as to part claimed to be infringed; held wanting in novelty, *Lyman Ventilating, etc., Co. v. Chamberlain*, 10 O. G., 588.
- 14585.** Harrington, J. R. Apr. 1, 1856. Carpet Lining Machine.
Reissue No. 2415, Dec. 11, 1866. Product.
Validity doubted in view of withdrawal of application for product and taking of original patent on machine alone, *American Carpet Lining Co. v. Manhattan Carpet Lining Co.*, 20 O. G., 372.
- 14624.** Young, E. Apr. 6, 1856. Slate Frame.
In interference, *Justice v. Jones*, 1 MacA. Pat. Cases, 635.
- 14722.** Hosford, E. N. Apr. 22, 1856. Pulvulent Acid.
Reissue No. 2979, June 9, 1868.
First and second claims held wanting in novelty, *Rumford Chemical Works v. Lauer*, 10 Blatch., 122. First, second and third claims held invalid in view of prior decision; fourth claim infringed by sale of compound with intent to be combined so as to infringe, *Rumford Chemical Works v. Hecker*, 10 O. G., 289. See, also, *Rumford Chemical Works v. Hecker*, 11 O. G., 330; 11 Blatch., 552; *v. Vice*, 14 Blatch., 179; *Oliver, Finnie & Co. v. Rumford Chemical Works*, 25 O. G., 784; *Attorney-General ex rel. Hecker v. Rumford Chemical Works*, 9 O. G., 1062.
- 14740.** Sibley, H. H. Apr. 22, 1856. Tent.
Burns' Case, 4 Ct. of Claims, 113; *United States v. Burns*, 12 Wall., 246.
- 14818.** King, J. T. May 6, 1856. Washing Machine.
Held prior inventor, *King v. Gedney*, 1 MacA. Pat. Cases, 443.
- 14845.** Taylor, J. S. May 3, 1856. Machine for Sizing and Felting Hats.
Hawley v. Mitchell, 1 Holmes, 42; *Mitchell v. Hawley*, 3 O. G., 241.
- 14951.** Eames, C. T. May 27, 1856. Boot Trees.
Construed, *Eames v. Cook*, 2 Fish., 146.

- 15044.** Mann, H. F. June 3, 1856. Harvester.
Reissue No. 4281, Feb. 28, 1871.
Fourth claim construed, limited, and held not infringed, *Mann v. Bayliss*, 10 O. G., 113; Same Case, *Ibid.*, 789.
- 15273.** Barber, H. B. July 8, 1856. Method of Drawing Water from Wells.
Mowry v. Barber, 1 MacA. Pat. Cases, 563.
- 15292.** Halsey, J. E. July 8, 1856. Fire-arms.
Construed to be for a novel combination, *Halsey, In re*, 1 MacA. Pat. Cases, 459.
- 15474.** Carr, Wm. S. Aug. 5, 1856. Water-closet.
Reissue No. 978, June 12, 1860.
Held novel, valid, and infringed by colorable change only, *Blake v. McNab & Harlan Mfg. Co.*, 19 Blatch., 73. Third claim held, in view of state of art, not to involve patentable invention; not infringed if sustained, *Thompson v. Boisselier*, 31 O. G., 377; 114 U. S., 1.
- 15570.** Osborn, W. Aug. 19, 1856. Bonnet Pressing Machine.
Reissue No. 933, March 27, 1860.
Construed and held not infringed, *Doubleday v. Bracheo*, 2 Fish., 560.
Reissue No. 2257, May 29, 1866.
Construed and held infringed, *Doubleday v. Sherman*, 3 Fish., 369. See, also, *Doubleday v. Sherman*, 6 Blatch., 513; 8 Blatch., 45.
- 15687.** Cawood, J. D. Sept. 9, 1856. Anvil.
Construed; limited in view of state of art; validity sustained, *Cawood Patent*, 94 U. S., 695. Construed and limited in view of specification to specific device, *Turrill v. Railroad Co.*, 1 Wall., 491. Construed to be a patentable and novel modification of an old combination to produce a new result, *Turrill v. Illinois Central R. R.*, 3 Biss., 66. Construed, limited, and infringed by use of its essential parts, *Ibid.*, 3 Biss., 72. See, also, *Turrill v. Illinois Central R. R.*, 5 Biss., 344; *Illinois Central R. Co. v. Turrill*, 26 O. G. 917; *Turrill v. Illinois Central R. Co.*, 20 Fed. Rep., 912.
- 15693.** Gray, A. W. Sept. 9, 1856. Horse-power.
Reissue No. 1322, July 1, 1862.
Not infringed, *Gray v. Hulshizer*, 13 O. G., X, Jan. 15.
- 15753.** Ball, H. Sept. 23, 1856. Oven.
Reissue No. 4026. June 14, 1870.
Is for different invention from original and void, *Ball v. Langles*, 102 U. S., 128. Void for new matter, *Garneau v. Dozier*, 102 U. S., 230. Construed; third claim void, being for different invention from original, *Ball v. Withington*, 6 O. G., 933.
- 15957.** Thompson, G. Oct. 21, 1856. Caustic Alkali.
Reissues Nos. 2569, 2570 and 2571, Apr. 16, 1867.
Construed; held a patentable improvement in the art and infringed, *Penna. Salt Co. v. Gugenheim*, 3 Fish., 423. Process and product are for same invention as original, and involve invention, *Penna. Salt Mfg. Co. v. Thompson*, 5 Fish., 148. See, also, *Thompson v. Barry*, 2 Weekly Notes, 100; *v. Mendelsohn*, 5 Fish., 187; *Penna. Salt Co. v. Myers*, 1 Weekly Notes, 377.
- 16030.** Singer, I. M. Nov. 4, 1856. Sewing Machine.
Construed and infringed, *Singer v. Walmsley*, 1 Fish., 580. Held novel and valid; third claim is for patentable subject-matter; not abandoned and is infringed, *Singer v. Braunsdorf*, 7 Blatch., 521. Sustained, *Wickersham v. Singer*, 1 MacA. Pat. Cases, 645.
- 16094.** Louis, L. Nov. 18, 1856. Melodeon.
Hammond v. Mason & Hamlin Organ Co., 1 Holmes, 296; 92 U. S., 724.
- 16263.** Babcock, G. H. Dec. 23, 1856. Printing Press.
Held, on interference, subsequent to No. 22,611, *Babcock v. Degner*, 1 MacA. Pat. Cases, 607.

1857.

- 16364.** Cramer, J. P. Jan. 6, 1857. Cultivator Teeth.
Awarded priority on interference, *Clarke v. Cramer*, 1 MacA. Pat. Cases, 473.
- 16648.** Huson, E. Feb. 17, 1857. Wagon Gearing.
Reissue No. 6660, Sept. 28, 1875.
Construed and sustained, *Halsey v. Garlick*, 12 O. G., 1026.
- 16676.** Adams, C. Feb. 24, 1857. Keeper for Door Locks.
Construed; held novel; not prejudiced by delay during pendency of application arising out of error of office; is infringed, *Adams v. Jones*, 1 Fish., 527.
- 16700.** Woodward, D. A. Feb. 24, 1857. Solar Camera.
Reissue No. 2311, July 10, 1866.
Construed to be for a patentable arrangement and substitution of the elements of a combination; held novel and valid, *Woodward v. Dinsmore*, 4 Fish., 163.

- 16797.** Hicks, W. C. March 10, 1857. Fire-arms.
Reissue No. 3798, Jan. 18, 1870.
Claim construed to be for a combination and not a result; held valid and infringed, *Renwick v. Pond*, 10 Blatch., 39. Held valid; not anticipated by caveat, *Renwick v. Cooper*, 10 Blatch., 201.
- 16833.** Hayden, I. March 17, 1857. Cotton Cleaner.
Hayden v. Suffolk Mfg. Co., 4 Fish., 86.
- 16933.** Sloan, W. D. March 31, 1857. Lathe.
Infringed, *Whitney v. Rollstone Machine Co.*, 8 O. G., 908.
- 16956.** Davidson, C. H. & H. E. March 31, 1857. Syringe.
Reissue No. 1940, Apr. 25, 1865.
Sustained as novel; infringed by change of form, *Morey v. Lockwood*, 8 Wall., 230.
- 16961.** Barker, S. Apr. 7, 1857. Treating Moss for Mattresses.
Muscan Hair Mfg. Co. v. American Hair Mfg. Co., 4 Blatch., 174.
- 17023.** Chandler, T. A. Apr. 14, 1857. Pendulum Levels.
Held patentable, *Chandler v. Ladd*, 1 MacA. Pat. Cases, 493.
- 17082.** Douglass, A. Apr. 21, 1857. Bustles.
Awarded priority on interference, *Blackington v. Douglass*, 1 MacA. Pat. Cases, 622.
- 17184.** Rice, B. F. Apr. 28, 1857. Paper Bag Machine.
Reissue No. 920, March 6, 1860.
Second and fourth claims construed and held infringed, *Union Paper Bag Co. v. Nixon*, 1 Flip., 491. Sufficiently described; not void for new matter; claims construed to be for combinations to accomplish result, not for a principle, *Ibid.*, 6 Fish., 402. See, also, *Newell v. West*, 13 Blatch., 114; *Paper Bag Cases*, 105 U. S., 766.
- 17264.** Corbin & Martlett. May 12, 1857. Artificial Honey.
Construed to be for a new, useful and patentable composition of matter, *Corbin & Martlett, In re*, 1 MacA. Pat. Cases, 521.
- 17331.** Johnson, A. May 19, 1857. Fastening Metallic Coverings.
Reissue No. 4870, April 16, 1872.
Void for new matter, laches in reissuing; for want of novelty, *Johnson v. Flushing & North Side R. Co.*, 105 U. S. 539. Held, as construed by plaintiffs, to be for a different invention from original, *Ibid.*, 15 Blatch., 192.
- 17387.** Mellier, M. A. C. May 26, 1857. Paper Pulp.
Infringed by variation in degree of heat compensated for by prolonging the process; patent valid, extension invalid, *American Wood-paper Co. v. Glens Falls Paper Co.*, 8 Blatch., 513.
Claim construed as not limited to single substance mentioned; process held novel, and infringed by a process of several steps with one of which it is identical, *American Wood-paper Co. v. Fiber Disintegrating Co.*, 6 Blatch., 27. Held infringed by process employing heat and pressure below the minimum given, *Cadwalader, J.*; not infringed, *Grier, J.* *American Wood Paper Co. v. Heft*, 3 Fish., 316. See, also, *Buchanan v. Howland*, 5 Blatch., 151; *Anthony v. Carroll*, 9 O. G., 199.
- 17520.** Sarven, J. D. June 9, 1857. Carriage Wheel. Reissue No. 4116, Sept. 6, 1870. Second claim infringed, *Sarven v. Hall*, 11 Blatch., 295. Is for same invention as original; second claim is for a combination and infringed, *Ibid.*, 9 Blatch., 524.
- 17530.** Walsh, J. C. June 9, 1857. Gas Burner.
Held to involve patentable invention, *Walsh, In re*, 1 MacA. Pat. Cases, 530.
- 17602.** See ¶ 5, p. 752.
- 17665.** Burden, H. June 30, 1857. Horse Shoe Machine.
Second claim construed, and limited, in view of state of art, to mechanism, and held not to cover result of mechanism; is sufficiently described as limited, and not infringed. Sixth claim is infringed, *Burden v. Corning*, 2 Fish., 477.
- 17855.** Gale, Wm. S. July 21, 1857. Steam Packing.
Construed to be for an art; held novel and valid, *Poillon v. Schmidt*, 6 Blatch., 299.
- 17899.** Slawson, J. B. July 28, 1857. Fare Box.
Reissue No. 4240, Jan. 24, 1871.
Construed in view of disclaimer to be for addition to old fare box of a second window, and held void for non-invention and aggregation, *Slawson v. Grand St., etc., R. Co.*, 17 Blatch., 512. Construed to be for duplication not involving invention, *Ibid.*, 107 U. S., 649.
- 17916.** Carpenter, D. H. Aug. 4, 1857. Vapor Burner.
Hamilton v. Simons & Sample, 5 Biss., 77.
- 17990.** Whitaker & Reed. Aug. 11, 1857. Reaper.
Read v. Bowman, 2 Wall., 591.

- 17999.** Wagner, I. Z. Aug. 11, 1857. Brick Machine.
Construed to be for a patentable combination, Wagner, *In re*, 1 MacA. Pat. Cases, 510.
- 18083.** Cahoon, C. W. Sept. 1, 1857. Seeding Machine.
Reissue No. 554, May 17, 1858.
Claims construed, sustained and infringed, Cahoon *v.* Ring, 1 Cliff., 592.
- 18124.** Gambrill & Burgee. Sept. 1, 1857. Carding Machine.
Awarded priority on interference, Carroll *v.* Gambrill, 1 MacA. Pat. Cases, 581.
- 18249.** Robertson, T. J. Sept. 22, 1857. Hand Stamp.
Reissue No. 4675, Dec. 12, 1871.
Novelty sustained, Robertson *v.* Secomb Mfg. Co., 10 Blatch., 481. Sustained as practically useful, Robertson *v.* Hill, 6 Fish., 465. Held valid, Robertson *v.* Garrett, 10 Blatch., 490.
- 17602.** Woodward, E. F. June 16, 1857. Hoop Skirt.
Reissue No. 501, Sept. 29, 1857.
Construed, limited and not infringed, West *v.* Silver Wire & Skirt Mfg. Co., 5 Blatch., 477.
- 18526.** Allen, E. G. Oct. 27, 1857. Steam Gauge.
Awarded priority on interference, Farley *v.* National Steam Gauge Co., 1 MacA. Pat. Cases, 618.
- 18546.** Hebbard, A. Nov. 3, 1857. Ice Pitcher.
Is for a patentable and novel new combination applied to an old purpose, Hebbard, *In re*, 1 MacA. Pat. Cases, 543.
- 18635.** Griscomb & Denn. Nov. 17, 1857. Lime Kiln.
Additional Improvement, 192. Feb. 23, 1858.
Construed and infringed, Shelly *v.* Brannan, 2 Biss., 315.
- 18742.** Hayden, I. Dec. 1, 1857. Long Trunk for Cleaning Cotton.
Held valid, and not to have abandoned matter shown but not claimed, Suffolk Co. *v.* Hayden, 3 Wall., 315. See, also, Hayden *v.* Suffolk Mfg. Co., 4 Fish. 86; *v.* Great Falls Mfg. Co., 3 Fed. Rep., 519; *v.* Oriental Mills, 22 Fed. Rep. 103.
- 18770.** Rowe, S. Dec. 1, 1857. Machine for Making Brooms.
Pitcher's Case, 1 Ct. of Claims, 7.
- 18874.** Thompson, M. Dec. 15, 1857. Bagasse Furnace.
Held novel, Black *v.* Thorne, 10 Blatch., 66. See, also, Black *v.* Thorne, 7 O. G., 176; *v.* Hubbard, 12 O. G., 842; Black *v.* Thorne, 111 U. S., 122.
- 18975.** Jackson, S. E. & M. P. Dec. 29, 1857. Mowing Machine.
Reissue No. 3460, May 25, 1869.
Decreed good and valid; second and fourth claims infringed, Jackson *v.* Breck, 11 O. G., 112.

1858.

- 19074.** Collender, H. W. Jan. 12, 1858. Billiard Table Cushion.
Reissue No. 2511, March 19, 1867.
Held novel, useful; sustained and infringed, Collender *v.* Came, 4 Cliff., 393. Claim construed to be for the art, Collender *v.* Bailey, 13 O. G., 277.
- 19206.** Race & Matthews. Jan. 26, 1858. Hydrant Casing.
Reissue No. 4887, April 30, 1872.
Void for laches in reissuing, and for being for different invention from original by claiming individually the elements of the original combination, Matthews *v.* Boston Machine Co., 105 U. S., 54.
- 19283.** Kelsea, H. Feb. 2, 1858. Manufacture of Sewing Silk.
Awarded priority on interference, Hill *v.* Dunklee, 1 MacA. Pat. Cases, 475.
- 19347.** Chaffee, E. W. Feb. 16, 1858. Flexible Gum Mat.
Construed and held not infringed, Brown *v.* Rubber Step Mfg. Co., 13 O. G., 369.
- 19377.** Nishwitz, F. Feb. 16, 1858. Harvester.
Reissue No. 3372, Apr. 13, 1869.
First and second claims held valid and infringed, Sprague *v.* Adriance, 14 O. G., 308.
- 19412.** Dennis, P. Feb. 23, 1858. Cultivator.
Reissue No. 1515, Aug. 4, 1863.
First claim held wanting in novelty; second claim is for a combination, and not infringed by omission of one of its essential elements, Dennis *v.* Eddy, 4 Fish., 423. Construed and limited to the peculiar form, and infringed by substantial copy; second claim held not infringed, Eddy *v.* Dennis, 95 U. S., 560.
- 19490.** Cook, F. March 2, 1858. Bale Tie.
Third claim construed; held patentable subject-matter and infringed, McComb *v.* Brodie, 1 Woods, 153. Novelty sustained, and held, in view of state of art, to involve invention,

- McComb *v.* Beard, 10 Blatch., 350. Third claim held useful, novel, valid and infringed, Cook *v.* Ernst, 5 Fish., 396. Construed, McComb *v.* Ernst, 1 Woods, 195. Construed; infringed by sale of part with intent to be used for infringement, American Cotton Tie Co. *v.* Simmons, 106 U. S., 89.
- 19508.** Lewis, R. L. March 2, 1858. Boot Tree.
Construed to be for a combination of mechanical powers to effect a useful result, Eames *v.* Godfrey, 1 Wall., 78; Howe *v.* Newton, 2 Fish., 531; Godfrey *v.* Eames, 1 Wall., 317.
- 19637.** Howes & Throop. March 16, 1858. Grain Separator.
Reissue No. 4793, March 5, 1872.
First claim construed to be for a combination infringed by use of formal difference; second claim construed, and infringed; held to be for same invention as original and not abandoned, Howes *v.* McNeal, 15 Blatch., 103; *Ibid.*, 17 O. G., 799.
- 19747.** Boardman, B. March 30, 1858. Wire Staple.
Reissue No. 2183, March 6, 1866.
Construed to be for article of manufacture made by a particular process, and not anticipated by similar article not made by same process; compared with original, held novel and sustained, Rogers *v.* Sargent, 7 Blatch., 507.
- 19783.** Lippman, H. L. March 30, 1858. Lead Pencil and Eraser.
Construed, in view of state of art, and limited; validity, as involving patentable invention, doubted; is not infringed, Reckendorfer *v.* Faber, 12 Blatch., 68. Held to be for aggregation not involving invention, *Ibid.*, 92 U. S., 347.
- 19786.** Mason, J. L. March 30, 1858. Lathe Chuck.
Consolidated Fruit Jar Co. *v.* Whitney, 2 B. & A., 375.
- 19824.** Bigelow, E. Apr. 6, 1858. Syrup Caster.
Reissue No. 2406, Dec. 4, 1866.
First claim is for duplication of parts, not involving invention, Bigelow *v.* Matthews, 7 Blatch., 77.
- 19932.** Kidd, W. E. Apr. 13, 1858. Bonnet Frames.
Construed, Kidd *v.* Spence, 4 Fish., 37.
- 19956.** Spear, J. Apr. 13, 1858. Cooking Stoves.
In interference, Spear *v.* Belson, 1 MacA. Pat. Cases, 699.
- 19984.** Deuchfield, J. Apr. 20, 1858. Cooling and Drying Meal.
Reissue No. 4712, Jan. 17, 1872.
Construed to be for a novel and valid combination, and not an aggregation; identical with original and infringed, Herring *v.* Nelson, 14 Blatch., 292. Compared with original; valid where identical, invalid as to new matter, which consists in subdividing old combination claims into combination claims of a less number of elements, Gage *v.* Herring, 107 U. S., 640.
Not void for clerical office error; held novel, valid, and first claim infringed, Bignall *v.* Harvey, 18 Blatch., 353. See, also, Herring *v.* Gage, 15 Blatch., 124.
- 20159.** Jones, E. F. May 4, 1858. Lamp.
Reissue 648, Jan. 11, 1859.
Infringed by mere substitution, Jones *v.* Vankirk, 2 Fish., 586.
- 20249.** Birdsell, J. C. May 18, 1858. Clover Huller.
Reissue No. 1299, April 8, 1862.
Construed, held not too broad; is for a novel and patentable combination; valid and infringed, Birdsell *v.* McDonald, 1 Ban. & Ard., 165. Construed to be for a combination, Birdsell *v.* Hagerstown Agricultural Implement Co., 1 Hughes, 59. See, also, Birdsell *v.* Hagerstown Agricultural Implement Co., 1 Hughes, 64; 1 Ban. & Ard., 426; *v.* Shaliol, 112 U. S., 485; *v.* Perego, 5 Blatch., 251; Perrigo *v.* Spaulding, 12 O. G., 352.
- 20324.** Carpenter, D. H. May 25, 1858. Vapor Burner.
Hamilton *v.* Simons, 5 Biss., 77.
- 20519.** Storrs, L. B. June 8, 1858. Tailor's Pressing Machine.
Construed and infringed by formal variation, consisting in use of an equivalent. Storrs *v.* Howe, 4 Cliff., 388.
- 20542.** Blake, E. W. June 15, 1858. Stone Crusher.
Reissue No. 2145, Jan. 9, 1866.
Construed and infringed by employment of a mechanical equivalent, Blake *v.* Robertson, 11 Blatch., 237. Sustained as novel and for same invention as original, Blake *v.* Stafford, 6 Blatch., 195. Held novel and not anticipated by single prior machine seen twenty years before by a single witness; first and second claims infringed, Blake *v.* Eagle Works Mfg. Co., 3 Biss., 77.
Novelty of invention sustained, Blake *v.* Rawson, 1 Holmes, 200; *v.* Robertson, 94 U. S. 728. Sustained; held novel and valid, and infringed by improvement embodying it;

- Blake *v.* Robertson, 6 Fish., 509. See, also, Blake *v.* Greenwood Cemetery, 14 Blatch., 242; 16 Fed. Rep., 676; *v.* Boisselier, 16 O. G., 854.
- 20616.** Bantz, G. June 22, 1858. Furnace for Burning Wet Fuel.
Reissue No. 4731, Feb. 6, 1872.
Held valid; patentee prior inventor; construed and held infringed, Bantz *v.* Ellas, 6 O. G., 117. Void for being broader than original, and for unreasonable delay in reissuing, Bantz *v.* Frantz, 105 U. S., 160.
- 20681.** Mann, R. J. June 22, 1858. Hoop Skirts.
Construed, held novel and infringed, Doughty *v.* Day, 9 Blatch., 262.
- 20719.** Ketchum, W. F. June 29, 1858. Mowing Machine.
Reissue No. 4484, July 25, 1871.
Construed, in view of state of art, to be valid and for same invention as original, and is infringed, Ketchum Harvesting Machine Co. *v.* Johnston Harvester Co., 13 O. G., 178. Infringement by sale abroad of article made here, *Ibid.*, 19 Blatch., 367.
- 20775.** Blake, L. R. July 6, 1858. Sewing Machine.
McKay *v.* Dibert, 19 O. G., 1351; *v.* Mace, 23 Fed. Rep., 76.
- 21026.** Sampson, B. E. July 27, 1858. Horse Car Coupling.
Reissue No. 906, Feb. 21, 1860.
Second claim held valid and novel, Proctor *v.* Brill, 4 Fed. Rep., 415; Proctor *v.* Brill, 16 Fed. Rep., 791.
- 21029.** Sargeant, I. A. July 27, 1858. Clothes Wringer.
Reissue No. 2829, Dec. 31, 1867.
Construed to be for same invention as original; limited in view of state of art, and not infringed, Washing Machine Co. *v.* Tool Co., 1 Holmes, 161; 20 Wall., 242.
- 21059.** Blandy, H. & F. L. J. Aug. 3, 1858. Steam-engines.
Construed; patentee held inventor and not his workman; held novel and infringed, Blandy *v.* Griffith, 3 Fish., 609. Claim construed to be for a double use, Blandy, *In re*, 1 MacA. Pat. Cases, 552. See, also, Blandy *v.* Griffith, 6 Fish., 434.
- 21161.** Voelter, H. Aug. 10, 1858. Reducing Wood to Paper Pulp.
Reissue No. 4418, June 6, 1871.
Held novel and infringed, Miller *v.* Androscoggin Pulp Co., 1 Holmes, 142.
- 21172.** North, J. Aug. 10, 1858. Machine for Folding Paper.
Appleton *v.* Bacon, 2 Black, 699.
- 21286.** Waterman, H. Aug. 24, 1858. Tempering Wire and Steel.
Construed to be for a process, Waterman *v.* Thomson, 2 Fish., 461.
Reissue 1874, Feb. 14, 1865.
Waterman *v.* Wallace, 13 Blatch., 128.
- 21551.** Cole, R. H. Sept. 21, 1858. Nut Machine.
Construed to be for a patentable combination, Cole, *In re*, 1 MacA. Pat. Cases, 539.
- 21576.** Reichman, C. Sept. 21, 1858. Lamp.
Reissue No. 3082, Aug. 11, 1868.
Construed in view of state of art at date of original; limited and held not infringed; fourth claim wanting in novelty and void, Carlton *v.* Bokee, 17 Wall., 463.
- 21659.** Douglas, A. Oct. 5, 1858. Sewing Machine.
Reissue No. 5180, Dec. 10, 1872.
Wooster *v.* Taylor, 12 Blatch., 384; *v.* Seidenberger, 13 Blatch., 88; Thomson *v.* Wooster, 31 O. G., 913; 114 U. S., 104.
- 21712.** Whitcomb, G. Oct. 5, 1858. Hay Rake.
Reissue No. 2994, June 16, 1868.
Construed to be for a new and useful combination not in public use for more than two years prior to application; is valid and infringed, Brown *v.* Whittemore, 5 Fish., 524. Construed, sustained; fourth and fifth claims infringed, Edgerton *v.* Breck, 5 B. & A., 42. Void for public use more than two years prior to application, Edgerton *v.* Furst & Bradley Mfg. Co., 10 Biss., 402.
- 21717.** Stimpson, J. H. Oct. 5, 1858. Ice Pitcher.
Stimpson *v.* Rogers, 4 Blatch., 337.
- 21734.** Bartholomew, F. H. Oct. 12, 1858. Water-closet.
Held novel and infringed by a colorable change only, Blake *v.* McNab & Harlan Mfg. Co., 19 Blatch., 73. Claim 1 construed, and limited in view of state of art, and held not infringed, Thompson *v.* Boisselier, 31 O. G., 377; 114 U. S., 1.
- 21829.** Gordon, E. Oct. 19, 1858. Photographic Shield.
Construed, its novelty considered, Gordon *v.* Anthony, 16 Blatch., 234.
- 21856.** Steele, W. Oct. 19, 1858. Stave-cutting Machine.
Brammer *v.* Jones, 2 Bond, 100.

- 21879.** Henshaw, J. R. Oct. 26, 1858. Self-mousing Hook.
Reissue No. 2166, Feb. 6, 1866.
Is for same invention as original; construed, held novel, useful; patentee first and original inventor, and is infringed, *Middleton Tool Co. v. Judd*, 3 Fish., 141.
- 22018.** Davidson, C. H. Nov. 9, 1858. Lacteal Instrument.
Awarded priority on interference, *Davidson v. Lewis*, 1 MacA. Pat. Cases, 599.
- 22094.** Symmes, J. Nov. 16, 1858. Breech Loader.
Reissue No. 3946, May 3, 1870.
Construed to be for a combination of three elements and held wanting in novelty, *Roberts v. Schuyler*, 12 Blatch., 444.
- 22129.** Mason, J. L. Nov. 23, 1858. Moulds for Making Bottles.
Consolidated Fruit Jar Co. *v. Whitney*, 2 B. & A., 30; 2 B. & A., 375.
- 22157.** Brown, J. R. Nov. 30, 1858. Pipe Tongs.
Ashcroft v. Walworth, 1 Holmes, 152.
- 22186.** Mason, J. L. Nov. 30, 1858. Screw Neck Bottles.
Consolidated Fruit Jar Co. *v. Whitney*, 2 B. & A., 30; 2 B. & A. 375.
- 22356.** Fairclough, J. Dec. 21, 1858. Balancing Millstones.
Reissue No. 786, Aug. 2, 1859.
Wise v. Allis, 9 Wall., 737.
- 22439.** Matthew, D. Dec. 28, 1858. Locomotive Axle Bearing.
Matthew v. Penna. R. Co., 8 Fed. Rep., 45.

1859.

- 22532.** Lamoureaux, D. Jan. 4, 1859. Corsets and Bustles Manufacture.
Held valid on stipulation filed by both parties, *Foy v. Hunter*, 9 O. G., 542.
- 22539.** Allender, J. Jan. 11, 1859. Clothes Wringer.
Reissue No. 1934, Apr. 18, 1865.
First and fourth claims infringed, *Bailey Washing and Wringing Machine Co. v. Adams*, 3 B. & A., 96. Sustained; fifth and sixth claims novel and infringed, *Bailey Washing and Wringing Machine Co. v. Lincoln*, 4 Fish., 379. See, also, *Eureka Co. v. Bailey Co.*, 11 Wall., 488.
- 22611.** Degener, C. H. Jan. 11, 1859. Printing Press.
Awarded priority on interference with No. 16,263, *Babcock v. Degener*, 1 MacA. Pat. Cases, 607.
- 22697.** Bigelow, E. Jan. 25, 1859. Soda Water Apparatus.
Reissue No. 2711, Aug. 6, 1867.
Construed; first claim void for want of novelty; second and third claims sustained and infringed, *Bigelow v. Matthews*, 7 Blatch., 77.
- 22723.** Gersten, C. Jan. 25, 1859. Lamp.
Reissue No. 2765, Sept. 17, 1867.
Held not to involve patentable invention, *Dane v. Chicago Mfg. Co.*, 3 Biss., 380.
- 22787.** Dodge, P. Feb. 1, 1859. Stove.
Void for public use and sale of a single stove more than two years prior to application, *Henry v. Frankestown Soapstone Stove Co.*, 2 Fed. Rep., 78. Not abandoned by public use more than two years prior to application, *Ibid.*, 9 O. G., 408.
- 22859.** Dundas, J. Feb. 8, 1859. Cultivator.
Marsh v. Sayles, 2 O. G., 340.
Reissue No. 2380, Oct. 16, 1860, held anticipated by invention prior in date of conception and reduction to practice, *Sayles v. Hapgood*, 2 Biss., 189.
- 22990.** Taylor, L. Feb. 15, 1859. Mop Head.
Reissue No. 3682, Oct. 19, 1869.
Invention held novel; sufficient description; claims construed, and limited in view of state of art and of fraudulent intent in expanding them, and held not infringed, *Taylor v. Garretson*, 9 Blatch., 156.
- 23001.** Porter, L. P. Feb. 15, 1859. Elastic Toy.
Held infringed, *New York Rubber Co. v. Cahaskel*, 9 O. G., 923.
- 23033.** Lawton & Bliss. Feb. 22, 1859. Hose Coupling.
Construed and held not infringed, *Bliss v. Haight*, 7 Blatch., 7.
Reissue No. 3768, Dec. 21, 1869.
Construed in view of original, and sustained as valid, novel, and infringed, *Bliss v. Gaylord Mfg. Co.*, 7 Blatch., 279. Construed not for same invention as original and void, *Bliss v. City of Brooklyn*, 10 Blatch., 54. See, also, *Bliss v. City of Brooklyn*, 8 Blatch., 533.

- 26114.** Kirby, W. A. Nov. 15, 1859. Harvester.
Reissue No. 1211, July 9, 1861.
Construed, change in position of raker's seat held wanting in patentable invention and not novel. Kirby *v.* Beardsley, 5 Blatch., 438.
- 23263.** Putnam, H. W. March 15, 1859. Bottle Stopper.
Reissue No. 1606, Jan. 19, 1864.
Novelty of invention and validity of patent sustained, Putnam *v.* Hickey, 3 Biss., 157. Sustained for invention involving more than substitution of material; first claim construed and infringed, Putnam *v.* Weatherbee, 1 Holmes, 497. Construed; second, third and fourth claims held wanting in novelty; first claim construed to be for substitution or equivalent accomplishing a better result; held novel and infringed, Putnam *v.* Yerrington, 9 O. G., 689. Marking patented articles, Putnam *v.* Sudhoff, 1 B. & A., 198; Putnam *v.* Lomax, 10 Biss., 546.
- 23291.** Brodie, G. March 22, 1859. Bale Tie.
Reissue No. 5333, March 25, 1873.
Infringed by repairing article sold to be used but once, American Cotton Tie Supply Co. *v.* Bullard, 17 Blatch., 160. Construed, infringed by sale of part with intent to be used in infringing, American Cotton Tie Supply Co. *v.* Simmons, 106 U. S., 89. See, also, American Cotton Tie Supply Co. *v.* Simmons, 13 O. G., 967; *v.* McCready, 17 Blatch., 291.
- 23361.** Gallahue, A. C. March 29, 1859. Machine for Pegging Shoes.
Reissue No. 3517, June 22, 1869.
Second claim construed, sustained and infringed, Gallahue *v.* Butterfield, 10 Blatch., 232.
- 23694.** Monroe, E. P. Apr. 19, 1859. Egg-beater.
Reissue No. 1062, Oct. 16, 1860.
Second claim construed and held not infringed, Monroe *v.* Dover Stamping Co., 1 Holmes, 413.
- 23771.** Lockwood, W. E. Apr. 26, 1859. Cuffs and Collars.
Reissue No. 1980, June 6, 1865, and 1981, June 6, 1865.
Held invalid for want of patentable invention, Union Paper Collar Co. *v.* Van Deusen, 10 Blatch., 109.
Reissue No. 5259, Jan. 28, 1873.
Construed in view of state of art, and held wanting in patentable novelty, Union Paper Collar Co. *v.* Leland, 1 Holmes, 427.
- 23950.** Root, S. E. May 10, 1859. Clock Dial.
Reissue No. 6580, Aug. 3, 1875.
Construed in view of disclaimer to be for a mechanical contrivance merely, wanting in invention, Root *v.* Welch Mfg. Co., 17 Blatch., 478.
- 23957.** Spring, A. & C. May 10, 1859. Lathe.
Construed to be for application of an old machine to an analogous use not involving invention, and void for want of novelty, Howe Machine Co. *v.* National Needle Co., 21 Fed. Rep., 630. Sustained, not anticipated by prior abandoned experiment; held infringed, Spring *v.* Domestic Sewing Machine Co., 9 Fed. Rep., 505. Held wanting in novelty, Spring *v.* Packard, 8 O. G., 341; Spring *v.* Domestic Sewing Machine Co., 16 O. G., 721; 22 O. G., 1445.
- 24104.** Davis, Wm. May 24, 1859. Hominy Machine.
Combination claim held too broad and indefinite, Davis, *In re*, 1 MacA. Pat. Cases, 628.
- 24162.** Strong, Ross & Howe. May 24, 1859. Weighing Scales.
Prime *v.* Brandon Mfg. Co., 16 Blatch., 453; 3 B. & A., 191.
- 24307.** Jacobs, E. June 7, 1859. Construction of Prisons.
Held wanting in novelty, Jacobs *v.* Baker, 7 Wall., 295.
- 24720.** Chambers, M. July 12, 1859. Skirt Supporter.
Chambers, *In re*, 1 MacA. Pat. Cases, 641.
- 24734.** Goodale, W. July 12, 1859. Paper Bag Machine.
Subject-matter held to involve invention and not mere mechanical skill; is infringed, Union Paper Bag Machine Co. *v.* Pultz & Walkley, 15 Blatch., 160. Construed, *Ibid.*, 16 Blatch., 76. Construed and held infringed by a substantial equivalent, Union Paper Bag Machine Co. *v.* Murphy, 97 U. S., 120.
- 24748.** Masury, J. M. July 12, 1859. Paint Can.
Held novel, Masury *v.* Tiemann, 8 Blatch., 426. Construed, held novel and infringed, Masury *v.* Anderson, 11 Blatch., 162.
- 25061.** Tufts, O. Aug. 9, 1859. Elevator.
Construed and limited in view of state of art, and held not infringed, Tufts *v.* Boston Machine Co., 1 Holmes, 459.

25098. Cox, T. S. Aug. 16, 1859. Mole or Drain Plows.
Construed, *Cox v. Griggs*, 1 Biss., 362.
25148. Strong, Ross & Howe. Aug. 16, 1859. Weighing Scales.
Prime *v. Brandon Mfg. Co.*, 16 Blatch., 453; 3 B. & A., 191.
25235. Lauth, B. Aug. 23, 1859. Iron Manufacture.
Awarded priority on interference, *Savary v. Lauth*, 1 MacA. Pat. Cases, 691.
25418. Keen, M. L. Sept. 13, 1859. Paper Pulp Boiler.
Held not infringed, *American Wood-paper Co. v. Heft*, 3 Fish., 316; *v. Fiber Disintegrating Co.*, 6 Blatch., 27.
25484. Booth, J. L. Sept. 20, 1859. Grain Separator.
Reissue No. 1826, Nov. 29, 1864.
Held a patentable combination of old elements: sustained and infringed, *Booth v. Parks*, 1 Flip., 381. Held sufficiently described; novel; not abandoned, and infringed, *Parks v. Booth*, 102 U. S., 96. See, also, *Booth v. Seevers*, 19 O. G., 1140.
25534. Stearns, C. Sept. 20, 1859. Lightning Rod Machine.
Awarded priority on interference, *Stearns v. Davis*, 1 MacA. Pat. Cases, 696.
25701. Draper, J. Oct. 4, 1859. Hoop Skirt.
Reissue No. 870, Dec. 27, 1859.
Construed; limited and held infringed, *Doughty v. West*, 2 Fish., 553. Construed; sustained and infringed by an improvement, *Ibid.*, 6 Blatch., 429.
Reissue No. 2046, Aug. 1, 1865.
Doughty v. West, 4 Fish., 318.
25843. McQuinston, T. Oct. 18, 1859. Plow.
Reissue No. 4383, May 16, 1871.
Turnbull v. Weir Plow Co., 6 Biss., 225; 9 Biss., 334.
26013. Chase, L. C. Nov. 8, 1859. Buckles.
Reissue No. 1483, May 26, 1863.
Held wanting in novelty, *Chase v. Sabin*, 1 Holmes, 395.
26108. Jacobs, E. Nov. 15, 1859. Fastening for Jail Doors.
Held wanting in novelty, *Jacobs v. Baker*, 7 Wall., 295.
26114. See ¶ 1, p. 756.
26205. Robertson, T. J. W. Nov. 23, 1859. Sewing Machine.
First and second claims sustained as novel and second claim is infringed, *Dibble v. Augur*, 7 Blatch., 86. Claims construed, limited and not infringed, *Dibble v. Sibley*, 7 Blatch., 209.
26248. Brown, P. Nov. 29, 1859. Paint Can. *Brown v. Hall*, 6 Blatch., 401.
26329. Silverthorn, N. Nov. 29, 1859. Boot and Shoe Tip.
Reissue No. 3070, Aug. 4, 1868.
Sustained and held infringed, *American Shoe Tip Co. v. National Shoe Toe Protector Co.*, 11 O. G., 470.
26410. Blessing, Wm. Dec. 13, 1859. Seed Planter.
Construed and limited in accordance with patentee's intent as evidenced by application record, *Trader v. Messmore*, 7 O. G., 385.
26415. Conant, H. Dec. 13, 1859. Spool-winding Machine.
Construed and limited in order to be sustained; held novel, and first and third claims infringed, *Willimantic Linen Co. v. Clark Thread Co.*, 4 B. & A., 133. See, also, *Same v. Same*, 32 O. G., 1356.
26500. Jacobs, E. Dec. 20, 1859. Iron Plate Jails.
Jacobs v. Commissioners of Hamilton County, 1 Bond, 500.

1860.

26891. Cummings, G. N. Jan. 24, 1860. Spectacle Case Catch.
Construed; held not anticipated; sustained and is infringed, *Parker v. Remhof*, 17 Blatch., 206.
26901. Gold, W. L. Jan. 24, 1860. Steam-engine.
Claims construed to be for combinations of old elements, *Gould v. Rees*, 15 Wall., 187.
26904. Hubbell, Wm. W. Jan. 24, 1860. Projectiles for Fire-arms.
Patentee held first and original inventor as to part of device, *Hubbell's Case*, 5 Ct. of Claims, 1.
27094. Allen, E. Feb. 14, 1860. Cartridge Case Machine.
Reissue 1948, May 9, 1865.
Construed and held infringed, *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 11 O. G., 1113. Construed and limited in view of disclaimer, *Ibid.*, 112 U. S., 624.

See, also, *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 7 Fed. Rep., 344; 8 Fed. Rep., 446.

27222. Jacobs, E. Feb. 21, 1860. Prisons (joining plates of metal).

Held wanting in novelty, *Jacobs v. Baker*, 7 Wall., 295.

27898. Frink, I. P. Apr. 17, 1860. Reflector.

Reissues Nos. 3826 and 3827, Feb. 8, 1870.

Construed; sustained as novel and valid; 3827 held infringed, *Frink v. Petry*, 11 Blatch., 422.

27899. Fowler, F. F. Apr. 17, 1860. Hay Elevator.

Reissues Nos. 1869 and 1871, Feb. 14, 1865.

Sustained as properly reissued in divisional reissues, *Bennet v. Fowler*, 8 Wall., 445.

28016. Smith, I. R. Apr. 24, 1860. Cultivator.

Reissue No. 3932, Apr. 26, 1870.

Sufficiently described; valid and infringed, *Calkins v. Bertrand*, 6 Biss., 494. See, also, *Calkins v. Bertrand*, 8 Fed. Rep., 755.

28130. McKenzie, D. May 1, 1860. Baker's Oven.

Reissue No. 6397, April 20, 1875.

Construed and limited in view of state of art, and held not infringed, *Garneau v. Dozier*, 102 U. S., 230.

28139. Arnold, G. B. May 8, 1860. Sewing Machine.

Reviewed, *Magic Ruffle Co. v. Douglas*, 2 Fish., 330.

28181. Ingalls, E. T. May 8, 1860. Boot Burnishing Machine.

Construed and sustained, *Dodge v. Feary*, 8 Fed. Rep., 329. Held not infringed, *Sweetser v. Helms*, 10 O. G., 4.

28196. Richardson, F. B. & B. L. May 8, 1860. Syringe.

Held, in conformity with *Morey v. Lockwood*, 8 Wall., 230, not an infringement of Davidson's reissue, *Richardson v. Lockwood*, 4 Cliff., 128.

28244. Arnold, G. B. May 8, 1860. Ruffles.

Reviewed, *Magic Ruffle Co. v. Douglas*, 2 Fish., 330. See, also, *Magic Ruffle Co. v. Elm City Co.*, 13 Blatch., 151; 14 Blatch., 109.

28314. Swain, A. M. May 15, 1860. Turbine Wheel.

Reissue No. 5154, Nov. 19, 1872.

Construed and limited, in order to be sustained, to invention in original; not infringed as limited, *Swain Turbine Co. v. Ladd*, 102 U. S., 408. Construed and limited in view of original, in order to be sustained; fifth claim, literally functional, construed to include the means for effecting the result; not infringed as limited, *Ibid.*, 11 O. G., 153.

28482. Henderson, J. C. May 29, 1860. Coal Stove.

Reissue No. 3523, June 29, 1869.

Seventh claim, literally for a result, construed to be for the means whereby it is obtained; fifth, sixth and seventh claims held novel and infringed, *Henderson v. Cleveland Co-operative Stove Co.*, 12 O. G., 4.

28495. Lovatt, J. May 29, 1860. Skate.

Reissue No. 6369, April 6, 1875.

Construed, and limited to means specified and their equivalents; valid, and held infringed, *Turrell v. Spaeth*, 14 O. G., 377. See, also, *Turrell v. Spaeth*, 9 O. G., 1163; 8 O. G., 986; *v. Bradford*, 23 O. G., 1623.

28633. Fuller, H. W. June 5, 1860. Marking Cloth for Sewing Machine.

Construed, limited and sustained, *Fuller v. Yentzer*, 6 Biss., 203. Construed to be for a new and useful combination of old elements; sustained and not infringed, *Fuller v. Yentzer*, 94 U. S., 288; 94 U. S., 299.

28762. Merrill, R. S. June 19, 1860. Lamp.

Wanting in novelty; reissue refused, *Merrill, In re*, 1 MacArthur, 301.

28951. Allen, E. July 3, 1860. Revolver.

Reissue No. 1268, Feb. 4, 1862.

Held, on interference, subsequent in invention to No. 30,990, *Smith v. Allen*, 2 Fish., 572.

29221. Van Kirk, J. T. July 17, 1860. Lamp.

Jones v. Van Kirk, 2 Fish., 586.

29236. Bernot, E. July 24, 1860. File-cutting Machine.

Extended by special act beyond term of foreign patent to full domestic term, and again extended by patent office, sustained, *New American File Co. v. Nicholson File Co.*, 8 Fed. Rep., 816.

29282. Jacobs, E. July 24, 1860. Prisons.

Wanting in novelty, *Jacobs v. Barker*, 7 Wall., 295.

- 29534.** Whitney, B. D. Aug. 7, 1860. Lathe.
Whitney v. Rollstone Machine Works, 2 Ban. & Ard., 170.
- 29561.** Blake, L. R. Aug. 14, 1860. Boot and Shoe Manufacture. Process.
Reissue No. 9043, Jan. 13, 1880.
Invalid for want of patentability, McKay v. Jackman, 12 Fed. Rep., 615. See, also, McKay v. Dibert, 5 Fed. Rep., 587; v. McKnight, 5 Fed. Rep., 593; v. Mace, 23 Fed. Rep., 76; v. Scott Sole & Machine Co., 20 O. G., 372.
- 29562.** Blake, L. R. Aug. 14, 1860. Boots and Shoes. Product.
Infringed by manufacture of the product on a machine carrying out the expired patented process, MacKay v. Dibert, 5 Fed. Rep., 587. See, also, McKay v. Jackman, 12 Fed. Rep., 615; v. McKnight, 5 Fed. Rep., 593; v. Mace, 23 Fed. Rep., 76; v. Scott Sole & Machine Co., 20 O. G., 372.
- 29576.** Dunbar, H. D. Aug. 14, 1860. Pistons and Piston Packings.
Larabee v. Peoria, Pekin & Jacksonville R. Co., 3 Ban. & Ard., 180.
- 29649.** Flanders & Allen. Aug. 14, 1860. Leather Splitting Machine.
Found to have been abandoned, American Hide, etc., Machine Co., v. American Tool & Machine Co., 1 Holmes, 503.
- 29785.** Haskell, D. Aug. 28, 1860. Sewing Machine.
Held useful, patentable and infringed, Haskell v. Shoe Machinery Mfg. Co., 3 Ban. & Ard., 553.
- 29971.** Hayden, I. Sept. 11, 1860. Cotton Cleaner.
Held to be for a different invention from that in his prior patent; held valid and not abandoned, Suffolk Co. v. Hayden, 3 Wall., 315. See, also, Hayden v. Suffolk Mfg. Co., 4 Fish., 86.
- 30112.** Arnold, G. B. & A. Sept. 25, 1860. Sewing Machine.
Reviewed, Magic Ruffle Co. v. Douglas, 2 Fish., 330.
- 30140.** Hall, J. L. Sept. 25, 1860. Locks.
Hall v. Macneale, 107 U. S., 90.
- 30191.** Armstrong, H. G. Oct. 2, 1860. Paper-Bag Machine.
Infringed, Union Paper-Bag Machine Co. v. Binney, 5 Fish., 166.
- 30357.** Slemmon, M. G. Oct. 9, 1860. Plow.
Reissue No. 6131, Nov. 10, 1874.
Invalid for allowance of claims formally abandoned by disclaimer prior thereto, Leggett v. Avery, 11 Otto, 256.
- 30379.** Sibley, F. S. Oct. 9, 1860. Curling Hat Brims.
Doubleday v. Sherman, 8 Blatch., 45. Construed and held infringed, *Ibid.*, 3 Fish., 371.
- 30381.** Ambrose, J. E. Oct. 16, 1860. Lamps.
Reissue No. 6844, Jan. 11, 1876.
Is for a different invention from original, Miller & Co. v. Bridgeport Brass Co., 14 Blatch., 282. Void, being for a different invention from original and for delay in reissuing, *Ibid.*, 104 U. S., 350.
- 30441.** Graham, E. H. Oct. 16, 1860. Picker Staff Motion for Looms.
Reissue No. 2626, May 28, 1867.
Construed to be for a novel combination; sustained and infringed, Graham v. Mason, 4 Cliff., 88; Mason v. Graham, 23 Wall., 261. See, also, Graham v. Mason, 1 Holmes, 88.
- 30577.** Jones, J. L. Nov. 6, 1860. Truss Bridges.
First, third and sixth claims construed; infringement not found, Westlake v. Cartter, 6 Fish., 519.
- 30651.** Tyler, S. W. C. Nov. 13, 1860. Harvester.
Reissue No. 6609, Aug. 24, 1875.
Held novel and not infringed, Tyler v. Crane, 7 Fed. Rep., 775.
- 30685.** Moore, H. Nov. 20, 1860. Seed Drill.
Second and third claims construed and held not infringed, Moore v. Thomas, 3 Ban. & Ard., 113. See, also, Westcott v. Wayne Agricultural Works, 11 Fed. Rep., 298.
- 30990.** Smith & Wesson. Dec. 18, 1860. Revolver.
Held, on interference with No. 28,951, to be prior inventors, Smith v. Allen, 2 Fish., 572.

1861.

- 31133.** Stafford, D. S. Jan. 15, 1861. Corn Cultivator.
Conklin & Stafford, 1 MacArthur, 375.
- 31147.** Bell, A. J. Jan. 22, 1861. Steamboat Staging.
Infringed by use of improvement, Converse v. Cannon, 2 Woods, 7.
- 31187.** Neill, A. Jan. 22, 1861. Moulds for India Rubber Pencil Heads.
Patentee sustained as sole and not joint inventor, Ashcroft v. Cutter, 6 Blatch., 511.

- 31252.** McComb, J. J. Jan. 29, 1861. Bale Tie.

Construed; infringed by sale of part, with intent to be used in infringing, American Cotton Tie Supply Co. v. Simmons, 106 U. S., 89. Infringed by repair of article sold to be used once only, American Cotton Tie Supply Co. v. Bullard, 17 Blatch., 160. See, also, American Cotton Tie Supply Co. v. McCready, 17 Blatch., 291; v. Simons, 13 O. G., 967.

- 31626.** Richardson, F. B. March 5, 1861. Syringe.

Reissue No. 2005, June 20, 1865.

Held anticipated, Richardson v. Lockwood, 6 Fish., 454.

- 31734.** Nyce, B. M. March 19, 1861. Preserving Fruit.

Reissue No. 3252, Jan. 5, 1869.

Sustained, in view of identity with original, and is infringed, Chicago Fruit Co. v. Busch, 2 Biss., 472.

- 31736.** Piper, E. March 19, 1861. Preserving Fish.

Claim construed to be for an "art" or method; held novel and infringed, Piper v. Brown, 1 Holmes, 20. Broad claim construed, and held void for want of novelty, Piper v. Moon, 10 Blatch., 264. Construed to be for application of old process to new subject, not involving invention, Piper v. Moon, 91 U. S., 44; Brown v. Piper, 91 U. S., 37. See, also, Piper v. Brown, 1 Holmes, 196.

- 31819.** Moore, H. March 26, 1861. Seed Drill.

Sixth claim construed to be for multiplication of a device in a prior patent and not patentable, Moore v. Thomas, 3 Ban. & Ard., 13. See, also, Wescott v. Wayne Agricultural Works, 11 Fed. Rep., 298.

- 32180.** Chase, L. C. Apr. 30, 1861. Halter Ring.

Reissue No. 1514, July 28, 1863.

Construed, limited and held novel, Chase v. Wesson, 1 Holmes, 274.

- 32257.** Treadwell & Hailes. May 7, 1861. Stove.

Reissue No. 1397, Feb. 4, 1863.

Construed to be for a combination, and not infringed by an aggregation of some of the old elements claimed, Hailes v. Van Wormer, 7 Blatch., 443. Second claim held wanting in novelty; third and fourth claims not infringed; fifth claim for a combination, not infringed, *Ibid.*, 20 Wall., 353.

- 32331.** Yale, L., Jr. May 14, 1861. Locks.

Reissue No. 1470, Apr. 28, 1863.

Construed; first claim held wanting in novelty; second claim infringed, Yale & Greenleaf Mfg. Co. v. North, 5 Blatch., 455.

- 32370.** Howard, G. C. May 21, 1861. Paper Perforator.

Tappan v. National Bank Note Co., 4 Blatch., 509.

- 32441.** Tufts, O. May 28, 1861. Elevator.

First and second claims construed and held wanting in novelty, Tufts v. Boston Machine Co., 1 Holmes, 459.

- 32521.** Kirkham, W. S. June 11, 1861. Door Lock.

Reissue No. 1390, Jan. 27, 1863.

Patentee held not prior inventor, Coffin v. Ogden, 18 Wall., 120. Construed in order to be sustained as not for a function; held wanting in novelty, *Ibid.*, 7 Blatch., 61.

- 32845.** Turrell, G. B. July 16, 1861. Beer Cooler.

Turrell v. Cammerrer, 3 Fish., 462.

- 32904.** Stover, H. D. July 23, 1861. Planing Machine.

Claim 3, although inaccurate, construed in order to be sustained; held novel and infringed, Stover v. Halsted, 13 Blatch., 95.

- 32933.** Dahlgreen, J. A. Aug. 6, 1861. Cast-iron Ordnance.

Dahlgreen's Case, 16 Court of Claims, 30.

- 32984.** Dahlgreen, J. A. Aug. 6, 1861. Cast-iron Ordnance.

Dahlgreen's Case, 16 Court of Claims, 30.

- 32985.** Dahlgreen, J. A. Aug. 6, 1861. Cast-iron Ordnance.

Dahlgreen's Case, 16 Court of Claims, 30.

- 32986.** Dahlgreen, J. A. Aug. 6, 1861. Projectile.

Dahlgreen's Case, 16 Court of Claims, 30.

- 33270.** Spaulding, N. W. Sept. 10, 1861. Setting Teeth in Saws.

Reissue No. 1456, Apr. 21, 1863.

Spaulding v. Tucker, 4 Fish., 633; Tucker v. Spaulding, 13 Wall., 453; Spaulding v. Duff, 1 Sawyer, 702. Subject-matter held patentable, Spaulding v. Tucker, Deady, 649.

- 33370.** Sisson, W. Sept. 24, 1861. Stave Machine.

Held to have been in public use and on sale for more than two years prior to application, Sisson v. Gilbert, 9 Blatch., 185. See, also, May v. Chaffee, 2 Dill., 385.

- 33384.** King & Freese. Oct. 1, 1861. Bridge.
Reissue No. 2707, July 30, 1867.
Held novel and infringed, *King v. Hammond*, 4 Fish., 488.
- 33685.** Rouillion, A. A. Nov. 5, 1861. Bed Bottom.
Held wanting in novelty in view of similar prior device used for analogous purpose and of prior foreign publication. *Woven Wire Mattress Co. v. Whittlesey*, 8 Biss., 23.
- 33808.** Williams, I. F. Nov. 26, 1861. Flocking Machine for Rubber.
Reissue No. 4937, June 4, 1872.
Construed and limited in order to be sustained, and not infringed as limited, *Williams v. Barker*, 2 Fed. Rep., 649.
- 33978.** Blake, S. A. Dec. 24, 1861. Bonnets.
Construed, limited; held patentable and infringed, *Baldwin v. Bernard*, 9 Blatch., 509; *v. Shultz*, 9 Blatch., 494; 9 Blatch., 505.
- 34026.** Mann, B. A. Dec. 24, 1861. Skirt Machine.
Reissue No. 1518, Aug. 4, 1863.
Claims construed, limited; held novel and infringed, *Wilcox v. Komp*, 7 Blatch., 126.
- 34043.** Adams, T. W. Dec. 24, 1861. Hats.
Held novel and infringed by use of equivalent, *Mallory v. White*, 8 Blatch., 552.

1862.

- 34059.** Hubbell, Wm. W. Jan. 7, 1862. Explosive Shell.
Patentee held first and original inventor, and patent infringed, *Hubbell's Case*, 5 Court of Claims, 1.
- 34183.** Linville & Piper. January 14, 1862. Iron Truss for Bridges.
Construed and limited in view of claim and specification and held not infringed, *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S., 274; 5 Fish., 468.
- 34252.** Grosjean, F. Jan. 28, 1862. Spoons and Forks.
Reissue No. 2682, July 16, 1867.
Second claim held to involve invention; is not for a double use, and is novel, *Grosjean v. Peck, Stow & Wilcox Co.*, 11 Blatch., 54.
- 34377.** Smith, A. F. Feb. 11, 1862. Truck for Locomotives.
Construed and held novel, *Locomotive Engine Safety Truck Co. v. Erie R'y Co.*, 10 Blatch., 292. Construed in view of state of art to be for a combination, and not an aggregation or double use; held patentable, novel, not abandoned, valid and infringed, *Locomotive Engine Safety Truck Co. v. Pennsylvania R. Co.*, 1 Ban. & Ard., 470. Construed to be for an old contrivance applied in an old way to an analogous purpose; held wanting in invention and void, *Pennsylvania R. Co. v. Locomotive Safety Truck Co.*, 110 U. S., 490.
- 34476.** Bliss, W. H. Feb. 25, 1862. Hose Coupling.
Construed and held not infringed, *Bliss v. Haight*, 7 Blatch., 7.
- 34928.** Winslow, I. April 8, 1862. Canning Green Corn.
Held, in view of state of art, not to be for a patentable invention, *Jones v. Hodges*, 1 Holmes, 37. Held fully anticipated by English patent, *Jones v. Sewall*, 91 U. S., 171. Sustained; not abandoned by sale more than two years prior to application; held novel, *Jones v. Sewall*, 3 Cliff., 565. Construed in view of state of art, and held not infringed by omission of one step in process and the substitution of an entirely different step, *Jones v. Merrill*, 8 O. G., 401. See 35,274.
Reissue No. 7067, Apr. 18, 1876.
Jones v. McMurry, 13 O. G., 6.
- 34992.** Sykes, J. W. Apr. 15, 1862. Grain Elevator and Dryer.
Sykes v. Manhattan Elevator and Grain Drying Co., 6 Blatch., 496.
- 35030.** Lyon, J. W. Apr. 22, 1862. Padlock.
Second claim construed and limited to peculiar mechanism, in view of state of art, and not infringed, *Miller v. Smith*, 4 Ban. & Ard., 314.
- 35122.** Williams, I. A. Apr. 29, 1862. Locomotive Lamp.
Reissue No. 2133, Dec. 19, 1865.
Held novel, patentable and useful; claims construed to be for combinations and are infringed, *Williams v. Rome, Watertown, etc., R. Co.*, 15 Blatch., 200. Construed to be for construction and arrangement of old parts; fifth claim not novel, *Williams v. Boston & Albany R. Co.*, 17 Blatch., 21. See, also, *Williams v. Rome, Watertown & O. R. Co.*, 18 Blatch., 181.
- 35209.** Birdsell, J. C. May 13, 1862. Clover Huller.
Birdsell v. Hagerstown Agricultural Implement Mfg. Co., 6 O. G., 604; *v. McDonald*, 1 Ban. & Ard., 165; *Perrigo v. Spaulding*, 13 Blatch., 389.

35274. Winslow, I. May 13, 1862. Preserving Corn.

Novelty sustained; not abandoned by public use more than two years prior to application, *Jones v. Sewall*, 3 Cliff., 565. Construed in view of state of art, and held not infringed by omission of one step in process and substitution of an entirely different step, *Jones v. Merrill*, 8 O. G., 401. Held, in view of state of art, wanting in patentable invention, *Jones v. Hodges*, 1 Holmes, 37. Held fully anticipated by English patent, *Jones v. Sewall*, 91 U. S., 171. See 34,928.

Reissue No. 7061, Apr. 18, 1876.

Void, being for different invention from original, *Jones v. McMurry*, 2 Hughes, 527.

35315. Hoffheins, R. May 20, 1862. Harvester.

Reissue No. 2224, Apr. 10, 1866.

Construed, and claims 1, 8, 9, 11, 12, 14, 16 and 19 held not warranted by original, *Hoffheins v. Russell*, 107 U. S., 132.

35346. Winslow, I. May 20, 1862. Preserving Corn.

Novelty sustained; not abandoned by sale more than two years prior to application, *Jones v. Sewall*, 3 Cliff., 565. Held, in view of state of art, wanting in patentable invention, *Jones v. Hodges*, 1 Holmes, 37.

35348. Strong, Ross & Howe. May 20, 1862. Weighing Scales.

Prime *v. Brandon Mfg Co.*, 16 Blatch., 453; 3 Ban. & Ard., 191.

35390. Richards, J. May 25, 1862. Scroll-saw Guide.

Reissue No. 1527, Aug. 25, 1863.

Claim construed and held not infringed, *Fay & Co. v. Cordesman Bros.*, 25 O. G., 1277.

35582. Reeves, S. June 17, 1862. Construction of Columns, etc.

Not anticipated by incomplete invention embodied in drawings only, nor by a prior publication, *Reeves v. Keystone Bridge Co.*, 5 Fish., 456. See, also, *Reeves v. Keystone Bridge Co.*, 2 Ban. & Ard., 256.

35598. Fish, W. L. June 17, 1862. Lamp-chimney.

Reissue No. 7069, April 18, 1876.

Compared with original and held to be for same invention; is for a novel combination and not an aggregation; claims 1, 2 and 3 infringed, *Kerosene Lamp-heater Co. v. Littell*, 3 Ban. & Ard., 312. See, also, *Kerosene Lamp-heater Co. v. Fisher*, 5 Ban. & Ard., 78.

35842. Shaw, J. July 8, 1862. Apparatus for Saving Silver from Waste Solution.

Reissue No. 1651, April 5, 1864.

Claim construed to be for a result; held too vague and general, and invalid, *Shaw & Wilcox Co. v. Lovejoy*, 7 Blatch., 232.

35856. Horton, J. M. July 8, 1862. Augur Handle.

Reissue No. 4187, Nov. 29, 1870.

Construed; held novel and infringed, *Miller's Falls Co. v. Ives & Co.*, 14 Blatch., 169.

36065. Battey, W. P. Aug. 5, 1862. Gas Retort.

Prima facie case of infringement, *Wren v. Spencer Optical Mfg. Co.*, 5 Ban. & Ard., 61.

36107. Piper, E. Aug. 5, 1862. Preserving Animal Substances.

Piper v. Brown, 1 Holmes, 20; *v. Moon*, 91 U. S., 44; *Brown v. Piper*, 91 U. S., 37.

36163. McKay & Mathies. Aug. 12, 1862. Sewing Machine.

McKay v. Mace, 23 Fed. Rep., 76.

36266. Albertson, A. Aug. 26, 1862. Bottle Stopper.

Reissue No. 2386, Oct. 30, 1866.

Construed; limited to specific device and not infringed as limited, *Matthews v. Schoneberger*, 18 Blatch., 357. Construed and limited in view of state of art, in order to be sustained, *Matthews v. Chambers*, 6 Fed. Rep., 874.

36292. Gallahue, A. C. Aug. 26, 1862. Shoe-pegging Machine.

Construed; patentee held first and original inventor; is infringed, *Gallahue v. Butterfield*, 10 Blatch., 232.

36326. Winslow, I. Aug. 26, 1862. Preserving Corn.

Sustained, and held not abandoned by public use and sale more than two years prior to application, *Jones v. Sewall*, 3 Cliff., 565. Held wanting in patentable invention in view of state of art, *Jones v. Hodges*, 1 Holmes, 37. See 34,928; 35,274.

36495. Jones, N. Sept. 16, 1862. Shoe Lasts.

Claim construed to be for a "peculiar form." Held sufficiently described, novel and infringed, *Mabie v. Haskell*, 2 Cliff., 507.

36512. Du Bois, J. September 23, 1862. Pier for Bridge.

Claim 1 construed to be for device, not process. Claim 2 construed, *Du Bois v. Railroad Co.*, 12 Wall., 47. See, also, *Du Bois v. Philadelphia, Wilmington & B. R. Co.*, 5 Fish., 208.

- 36603.** Clissold, Wm. Oct. 7, 1862. Wool Lubricating Machine.
Reissue No. 2213, March 27, 1866.
Construed; claims 3 and 5 infringed by use of substantial equivalent, *Harwood v. Mill River Wool Mfg. Co.*, 3 Fish., 526.
- 36854.** Reckendorfer, J. Nov. 4, 1862. Pencil.
Reissue No. 3863, March 1, 1870.
Construed, limited; validity as for a patentable invention doubted; not infringed. *Reckendorfer v. Faber*, 12 Blatch., 68. Construed, held to be for aggregation not involving invention, *Ibid.*, 92 U. S., 347.
- 37033.** Crosby & Kellogg. Dec. 2, 1862. Crimping Machine.
Claim 2 infringed by use of substantial equivalent. Claim 4 infringed, *Tuttle v. Clafin*, 19 Fed. Rep., 599. See, also, *Elm City Co. v. Wooster*, 6 Fish., 452.
- 37037.** Firth & Ingham. Dec. 2, 1862. Flasks for Casting Iron Pipes.
Claim 1 construed to be for a novel combination of old parts; held not infringed by discarding one of the essential elements of the combination, *Smith v. Marshall*, 10 O. G., 375.
- 37052.** Palmer, C. H. Dec. 9, 1862. Repeating Gun.
Claim 1 construed, and limited to a combination consisting of three subcombinations. Held not infringed, *Palmer v. Gattling Gun Co.*, 19 Blatch., 392.
- 37124.** Baird, J. H. Dec. 9, 1862. Skirt Machine.
Examined, construed, held novel and claim 3 infringed, *Wilcox v. Komp*, 7 Blatch., 126.
- 37175.** Norton, M. P. Dec. 16, 1862. Hand Stamp.
Campbell v. Ward, 12 Fed. Rep., 150.

1863.

- 37317.** Cochrane, Wm. F. Jan. 13, 1863. Bolting Flour.
Reissue No. 5841, April 21, 1874.
Sustained and held infringed, *Cochrane v. Deener*, 94 U. S., 78. Held void for new matter, *American Middlings Purifier Co. v. Atlantic Milling Co.*, 5 Dill., 127. Sustained as novel and valid; infringement not shown, *Ibid.*, 4 Dill., 100. See, also, *Cochrane v. Deener*, 95 U. S., 355; *American Middlings Purifier Co. v. Christian*, 4 Dill., 448; *v. Vail*, 15 Blatch., 315.
- 37318.** Cochrane, Wm. F. Jan. 13, 1863. Bolting Flour.
Reissue No. 6030, Aug. 25, 1874.
Sustained and held infringed, *Cochrane v. Deener*, 94 U. S., 781. Held novel and valid; infringement not established, *American Middlings Purifier Co. v. Milling Co.*, 4 Dill., 100. See, also, *Cochrane v. Deener*, 95 U. S., 355; *American Middlings Purifier Co. v. Christian*, 4 Dill., 448; *v. Vail*, 15 Blatch., 315.
- 37319.** Cochrane, Wm. F. Jan. 13, 1863. Bolting Flour.
Held not infringed, *Cochrane v. Deener*, 94 U. S., 781. See, also, *Cochrane v. Deener*, 95 U. S., 355.
- 37320.** Cochrane, Wm. F. Jan. 13, 1863. Bolting Flour.
Held not infringed, *Cochrane v. Deener*, 94 U. S., 781. See, also, *Cochrane v. Deener*, 95 U. S., 355.
- 37321.** Cochrane, Wm. F. Jan. 13, 1863. Bolting Flour.
Reissues Nos. 6594 and 6595, Aug. 17, 1875.
Sustained and held infringed, *Cochrane v. Deener*, 94 U. S., 781. Validity and novelty sustained; infringement not shown, *American Middlings Purifier Co. v. Milling Co.*, 4 Dill., 100. See, also, *Cochrane v. Deener*, 95 U. S., 355; *American Middlings Purifier Co. v. Christian*, 4 Dill., 448.
- 37433.** Coe, C. W. Jan. 20, 1863. Drilling and Screw-cutting Machine.
Reissue No. 2487, Feb. 19, 1867.
Construed; is for a combination; is sufficiently described; held not anticipated; is valid and infringed; patentee held first and original inventor, *Bates v. Coe*, 98 U. S., 31.
- 37446.** Hull, L. Jan. 20, 1863. Machine for Cutting Caoutchouc.
Construed to be for the operation of an old machine in a different manner to produce a new result; held to be for the machine, not the art; is novel and not infringed, *Boston Elastic Fabric Co. v. East Hampton Rubber Co.*, 1 Holmes, 372.
Reissue No. 5903, June 2, 1874.
Held to have been in public use prior to discovery by patentee, *Ibid.*, 2 Ban. & Ard., 268.
- 37548.** Jasper, G. A. Jan. 27, 1863. Purifying and Cleansing Sugar.
Construed, *Union Sugar Refinery v. Matthiessen*, 3 Cliff., 639. See, also, *Union Sugar Refinery v. Matthiessen*, 3 Cliff., 146.

- 37550.** Pipo, J. A. Jan. 27, 1863. Ruffler.
Reissue No. 6565, July 27, 1875.
Held novel; claims 5, 7, 8 and 10 sustained and held infringed, *Wooster v. Blake*, 8 Fed. Rep., 429. Claims 1, 7 and 8 held invalid for twelve years' delay in reissuing, *Wooster v. Handy*, 21 Fed. Rep., 51. Claims 1, 7, 8 and 10 invalid, *Wooster v. Howe Machine Co.*, 21 Fed. Rep., 67. Claims 2, 4 and 5 infringed, *Wooster v. Clark*, 21 O. G., 264. See, also, *Wooster v. Howe Machine Co.*, 4 Ban. & Ard., 319.
- 37630.** Marsh, J. S. Feb. 10, 1863. Reaping Machine.
Reissue No. 2354, Sept. 11, 1866.
Result claim construed, and limited, in view of disclaimer and state of art, to be for specific combinations or for change of location with changes to adapt device thereto, and not infringed as limited, *Marsh v. Dodge & S. Mfg. Co.*, 6 Fish., 562.
- 37726.** Morgan, C. H. Feb. 17, 1863. Paper Bag Machine.
Union Paper Bag Machine Co. v. Nixon, 9 O. G., 691; 21 O. G., 1275.
- 37835.** Tuttle, W. G. March 3, 1863. Saw.
Held not infringed, *Hoe v. Simpson*, 1 Ban. & Ard., 420.
- 37941.** Welling, W. M. March 17, 1863. Martingale Ring.
Construed; held wanting in novelty and invention, *Rubber Coated Harness Co. v. Welling*, 97 U. S., 7. Liberally construed in view of state of art; is for a combination, and infringed by substitution of a known equivalent for one of its elements, *Welling v. Rubber Coated Harness Co.*, 1 Ban. & Ard., 282. Held to cover product; doubted whether it also covers process, *Ibid.*, 2 Ban. & Ard., 1.
- 38002.** Burrall, T. D. March 24, 1863. Corn Sheller.
Held insufficiently described, and wanting in novelty, *Burrall v. Rumsey*, 13 O. G., 123.
- 38015.** Tyler, C. N. March 24, 1863. Burning Fluid.
Tyler v. Boston, 7 Wall., 327.
- 38153.** Cowing, G. Apr. 14, 1863. Cylinder Polisher.
Cowing v. Rumsey, 8 Blatch., 36.
- 38175.** Norton, M. P. Apr. 14, 1863. Letter Stamp.
Reissue No. 4143, Oct. 4, 1870.
Construed in view of original and state of art. Claims 3 and 4 void for new matter or redundancy. Claims 1 and 2 limited and not infringed, *James v. Campbell*, 104 U. S., 356. Held to involve invention; to be novel, original, valid and infringed, *Campbell v. James*, 17 Blatch., 42. See, also, *Campbell v. James*, 18 Blatch., 92; 18 Blatch., 196; *v. Ward*, 12 Fed. Rep., 150; *v. James*, 5 Ban. & Ard., 630; *Secomb v. Campbell*, 5 Ban. & Ard., 632; 18 Blatch., 108; *Shavor's Case*, 4 Court of Claims, 440.
- 38200.** Bullock, Adams & Selden. Apr. 14, 1863. Printing Press.
Not invalidated by prior private knowledge and use of an incomplete machine; is novel, patentable and infringed, *Bullock Printing Press Co. v. Jones*, 3 Ban. & Ard., 195.
- 38206.** Heaton, C. W. S. Apr. 14, 1863. Defensive Ship Armor.
Limited to application of a particular device in a certain way, and not infringed by making the device for such use, but not applying it, *Heaton v. Quintard*, 7 Blatch., 73. Anticipated by prior publication, *Webb v. Quintard*, 9 Blatch., 352.
- 38389.** House, M. W. May 5, 1863. Electric Baths.
Held not infringed by defendant who justifies under a valid reissue of a prior patent, *House v. Young*, 3 Fish., 335.
- 38452.** Pettie, S. E. May 5, 1863. Paper Bag Machine.
Claims 8 and 9 wanting in novelty. Claim 3 is valid and not an alternative claim. Claims 1, 2 and 4 are infringed, *Union Paper Bag Co. v. Nixon*, 6 Fish., 402. Infringed by variation not involving invention, *Union Paper Bag Co. v. Binney*, 5 Fish., 166.
- 38519.** Waterman, N. May 12, 1863. Tray.
Held useful and sustained, *Doherty v. Haynes*, 4 Cliff., 291.
- 38664.** Evans, A. May 26, 1863. Paper Collar.
Reissue No. 2309, July 10, 1866.
Held void, *Union Paper Collar Co. v. Van Deusen*, 10 Blatch., 109. Is for different invention from the original and wanting in novelty, *Ibid.*, 23 Wall., 530.
- 38670.** Gilmore, J. T. May 26, 1863. Millstone Dressing.
Sustained over interfering patent No. 73,524, *Gilmore v. Golay*, 3 Fish., 522.
- 38694.** Murdock, J. G. May 26, 1863. Hydrant.
Reissue No. 3434, May 11, 1869.
Meyer v. Bailey, 2 Ban. & Ard., 73.
- 38713.** Merrill & Horner. May 26, 1863. Coffin Lids.
Adams v. Burks, 1 Holmes, 40; 17 Wall., 453.

- 38807.** Bosworth, C. F. June 9, 1863. Sewing Machine.
Reissue No. 7985, Dec. 11, 1877.
Construed in view of original and state of art; held novel as to claims 1, 2 and 3, and infringed, *Straw Sewing Machine Co. v. Eames*, 18 Blatch., 520.
- 38901.** Keen, M. L. June 16, 1863. Boiler for Making Paper Pulp.
Held not infringed, *American Wood-paper Co. v. Heft*, 3 Fish., 316, and *American Wood-paper Co. v. Fiber Disintegrating Co.*, 6 Blatch., 27.
- 38924.** Wicke, G. June 16, 1863. Box Nailing Machine.
Construed to be for a new combination of old devices, limited to specific mechanism, and held not infringed, *Wicke v. Ortrum*, 103 U. S., 461. See, also, *Wicke v. Kleinknecht*, 1 Ban. & Ard., 608.
- 38961.** Gray, S. S. June 23, 1863. Shirt Collars.
Reissue No. 1646, March 29, 1864.
Construed and held wanting in novelty, *Union Paper Collar Co. v. Van Deusen*, 10 Blatch., 109, and 23 Wall., 530.
- 38974.** Miller, H. June 23, 1863. Sheet Metal Can.
Reissue No. 7682, May 15, 1877.
Claim 1 construed to be for an aggregation of old elements and void. Claim 2 held to be included in claim 1 as an indispensable incident of the device there claimed and is void, *Combined Patents Can Co. v. Lloyd*, 11 Fed. Rep., 152.
- 38987.** Sands, T. June 23, 1863. Machine for Making Knitting Needles.
Reissue No. 1821, Nov. 15, 1864.
Sustained and held not infringed, *Sands v. Wardwell*, 3 Cliff., 277.
- 39027.** Atterbury, J. S. & T. B. June 30, 1863. Jelly Glass.
Atterbury v. Gill, 3 Ban. & Ard., 174.
- 39134.** Earle, T. July 7, 1863. Egg Beater.
Reissue No. 6542, July 13, 1875.
Broad claim held invalid, *Turner & Seymour Mfg. Co. v. Dover Stamping Co.*, 111 U. S., 319.
- 39210.** Black, A. S. July 14, 1863. Tempering Umbrella-ribs.
Claim 1 construed; held novel and infringed, *American Mfg. Co. v. Lane*, 14 Blatch., 438.
- 39235.** Leschot, R. July 14, 1863. Rock-drill.
Reissue No. 3690, Oct. 26, 1869.
Construed, *American Diamond Rock Boring Co. v. Sullivan Machine Co.*, 14 Blatch., 119. Is for same invention as original and infringed, *American Diamond Rock Boring Co. v. Sheldon*, 17 Blatch., 208. Claim 1 held enlarged and void for delay in reissuing; remaining claims are for more than the original invention and cover nothing that is infringed, *Ibid.*, 33 O. G., 1598. Held there was not inadvertence or mistake in original to justify the reissue in view of accuracy of the original specification and claims, *American Diamond Drill Co. v. Sullivan Machine Co.*, 21 Fed. Rep., 74. Held to be for a term of seventeen years, unlimited by prior foreign patent, *American Diamond Rock Boring Co. v. Sheldon*, 17 Blatch., 303. See, also, *American Diamond Rock Boring Co. v. Sheldon*, 18 Blatch., 50; *Steam Stone Cutter Co. v. Sheldon*, 15 Fed. Rep., 608.
- 39280.** Elwell, H. H. July 21, 1863. Knob-latch.
Reissue No. 3909, Apr. 5, 1870.
Declared valid, *Norwalk Lock Co. v. Berger*, 13 O. G., 47.
- 39535.** Treadwell & Hailes. Aug. 11, 1863. Base Burning Stove.
Claim 1 held to be for an aggregation wanting in invention, *Hailes v. Van Wormer*, 20 Wall., 353. Construed to be for a combination, and not infringed by an aggregation of some only of its elements, *Hailes v. Van Wormer*, 7 Blatch., 443.
- 39546.** Budding, B. O. Aug. 18, 1863. Heel-polishing Machine.
Construed and sustained, *Dodge v. Feary*, 8 Fed. Rep., 329. Held not infringed, *Sweetser v. Helms*, 2 Ban. & Ard., 263.
- 39702.** Reay, G. H. Aug. 25, 1863. Envelope Machine.
Reissue No. 2529, March 26, 1867.
Not infringed by sale of machine after expiration of patent, which was built during term according to understanding with patentee, *Reay v. Rau*, 15 Fed. Rep., 749. Claim 2 held valid and infringed, *Reay v. Berlin & Jones Envelope Co.*, 19 Fed. Rep., 311. Claim 2 construed, and held not infringed by change in the arrangement of parts, *Ibid.*, 20 Fed. Rep., 506. Claim 4 is for different invention from original and is too broad and void; invalid for three years' delay in reissuing. Claim 5 is for a function, and not patentable apart from the machinery. Claims 1, 2 and 10 are valid and infringed, *Reay v. Raynor*, 19 Fed. Rep., 308.

- 39889.** Crossman, C. P. Sept. 15, 1863. Caster.
Held infringed by improvement, *Star Salt Caster Co. v. Crossman*, 4 Cliff., 568. See, also, *Star Salt Caster Co. v. Crossman*, 3 Ban. & Ard., 281.
- 39910.** Foy, L. H. Sept. 15, 1863. Corset Skirt Supporter.
Reissue No. 2654, June 18, 1867.
Held valid on stipulation filed by both parties, *Foy v. Hunter*, 9 O. G., 542, and 9 O. G., 543.
- 40084.** Rose, I. M. Sept. 22, 1863. Marking Clothes in Sewing Machines.
Reissue No. 3218, Dec. 1, 1868.
Construed, limited and not infringed, *Fuller v. Yentzer*, 6 Biss., 203. Held not anticipated and not infringed, *Ibid.*, 94 U. S., 299.
- 40156.** Bing, J. Oct. 6, 1863. Shoe for Car-brakes.
Sustained, claims construed and held infringed, *National Car-brake Shoe Co. v. Lake Shore & Mich. S. R'y Co.*, 9 Biss., 503. Held not infringed by accidental resemblance in device intended for a different purpose, in the absence of evidence of intent, *National Car-Brake Shoe Co. v. D. L. & N. R. Co.*, 4 Fed. Rep., 224. Claim 2 construed as commensurate with real invention to be "substantially as specified in regard to the combination" claimed; is infringed and novel, *Lake Shore & Mich. S. R'y Co. v. National Car-brake Shoe Co.*, 110 U. S., 229. See, also, *National Car-brake Shoe Co. v. Terre Haute Car & Mfg. Co.*, 19 Fed. Rep., 514.
- 40221.** Chambers, Jr., C. Oct. 6, 1863. Brick Machine.
Chambers v. Smith, 5 Fish., 12.
- 40481.** Hoffheins, R. Nov. 3, 1863. Harvester.
Reissue No. 2490, Feb. 19, 1867.
Construed in view of original, and held that claims 1, 2, 6 and 7 are not warranted thereby; limited and held not infringed, *Hoffheins v. Russell*, 107 U. S., 132.
- 40507.** Sperry, J. Nov. 3, 1863. Manufacturing Boxes.
Sperry v. Logan, 3 Ban. & Ard., 260.
- 40515.** Tarr & Wonson. Nov. 3, 1863. Paint for Ship's Bottom.
Reissue No. 4598, Oct. 17, 1871.
Held wanting in novelty, *Tarr v. Webb*, 10 Blatch., 96. Limited in view of prior decision, and held not infringed, *Wonson v. Gilman*, 2 Ban. & Ard., 590.
Reissue No. 4599, Oct. 17, 1871.
Infringed by substitution of an equivalent, *Tarr v. Folsom*, 1 Holmes, 313. Held valid and novel, *Wonson v. Peterson*, 3 Ban. & Ard., 249.
- 40584.** Wardwell, J. G. Nov. 10, 1863. Stone Channeling Machine.
Reissues Nos. 2087 and 2088, Oct. 10, 1865.
Steam Cutter Co. v. Sheldon, 10 Blatch., 1; *Steam Stone Cutter Co. v. Shortsleeves*, 10 Blatch., 381; *v. Windsor Mfg. Co.*, 17 Blatch., 24; 18 Blatch., 47.
- 40590.** Taft, G. C. Nov. 10, 1863. Wrench.
Reissue No. 3483, June 1, 1869.
Construed, in view of state of art, to be for the mechanism described to effect the result stated, and not infringed by different means; not mechanical equivalents, although having a common object, *Coes v. Collins Co.*, 9 Fed. Rep., 905.
- 40777.** Teel, A. C. Dec. 1, 1863. Gate.
Reissue No. 2667, July 2, 1867.
Patentee held not to be first and original inventor, *Wright v. McMillan*, 13 O. G., 47.
- 40789.** Bergen, G. I. Dec. 1, 1863. Corn Planter.
Reissue No. 1935, April 18, 1865.
Claim 1 construed and not infringed, if limited in view of state of art; doubted if not void for want of utility. Claim 2 wanting in novelty, *McFarland v. Deere & Mansur Mfg. Co.*, 22 Fed. Rep., 781. Held not infringed in conformity with above decision, *McFarland v. Brown*, 22 Fed. Rep., 787.
- 40811.** Blaisdell, J. H. Dec. 8, 1863. Soda Water Apparatus.
Construed and limited in view of state of art, in order to be sustained, *Blaisdell v. Tufts*, 3 Ban. & Ard., 521. Claim 4 infringed, *Blaisdell v. Dows*, 4 Ban. & Ard., 499; *v. Puffer*, 4 Ban. & Ard., 500.
- 40874.** Wheeler, Z. Dec. 8, 1863. Amalgamator.
Birdsall v. Coolidge, 93 U. S., 64.
- 40964.** Tucker, H. Dec. 15, 1863. Bronzing or Coloring Iron.
Reissue No. 2355, Sept. 11, 1866. Process.
Construed to be for same invention as original; is novel, valid and infringed, *Tucker v. Tucker Mfg. Co.*, 4 Cliff., 397. Construed, and held not infringed by a similar process in which not sufficient oxide is used to obtain the same result, *Tucker v. Burditt*, 5 Ban. &

Ard., 220. Held not infringed by similar process in which the heat was not carried to the point of producing oxidation, *Tucker v. Corbin*, 5 Fed. Rep., 810.

Reissue No. 2356, Sept. 11, 1866. Product.

Held valid and infringed, *Tucker v. Dana*, 7 Fed. Rep., 213. Sustained as for a new article of manufacture, *Tucker v. Burditt*, 4 Ban. & Ard., 569. Both reissues sustained and held infringed, *Tucker v. Sargent & Co.*, 19 Blatch., 538.

1864.

41097. Sawyer, H. Jan. 5, 1864. Putting up, etc., Powders.

Reissue No. 2769, Oct. 1, 1867.

Held to be for a double use wanting in patentable invention, *Sawyer v. Bixby*, 9 Blatch., 361.

41214. Fuzzard, W. Jan. 12, 1864. Surface-sizing Fibrous Matter.

Reissue No. 1649, April 5, 1864.

Construed to be for a combination; limited and not infringed, *Fuzzard Wadding Mfg. Co. v. Dickinson*, 6 Blatch., 80.

41232. Ogborn & Free. Jan. 12, 1864. Grain Separator.

Schwarzel v. Holensshade, 2 Bond, 29.

41395. Reay, G. H. Jan. 26, 1864. Envelope Machine.

Held not infringed, *Reay v. Rau*, 15 Fed. Rep., 749.

41471. Bailey, T. H. Feb. 9, 1864. Valves.

Reissue No. 7886, Sept. 18, 1877.

Claim 2, if broadly construed, is wanting in novelty; not infringed, if limited, in view of state of art, *Blake v. City, etc., of San Francisco*, 113 U. S., 679.

41782. Pingree, S. W. March 1, 1864. Extracting Tan Bark.

Reissue No. 1922, March 28, 1865.

Construed to be for same invention as original; invalid for want of novelty, *Bridge v. Brown*, 1 Holmes, 53.

41788. Siemens, C. W. & F. March 1, 1864. Regenerator Furnace.

Reissue No. 3265, Jan. 12, 1869.

Patent term held expired, being limited to that of prior foreign patent, *Siemens v. Sellers*, 16 Fed. Rep., 856.

41887. Francis, L. March 8, 1864. Ink.

Reissue No. 3576, Aug. 3, 1869.

Construed, limited and sustained; no infringement proved, *Francis v. Mellor*, 5 Fish., 153.

41897. Hagan, W. E. March 8, 1864. Stove.

Reissue No. 1988, June 6, 1865.

Claim 1 held identical with original, and sustained as prior in invention to No. 45,803 on interference, *Gold & Silver Separating Co. v. United States Disintegrating Co.*, 6 Blatch., 307.

42126. Suggett, J. March 29, 1864. Pumps.

Construed to be for a combination of old principles, to effect a new and useful purpose. Found for defendant, *Haselden v. Ogden*, 3 Fish., 378.

42136. Woodman, C. T. March 29, 1864. Leather Ornamenting Machine.

Construed as to patentable invention and mechanical skill, in substitution of old elements, *Stimpson v. Woodman*, 10 Wall., 117. Construed and held not infringed, in view of above decision, *Woodman Pebbling Machine Co. v. Guild*, 4 Cliff., 185. Construed to be for a combination, and limited to the means described, *Woodman v. Stimpson*, 3 Fish., 98.

42153. Atwood & Holland. April 5, 1864. Sewing Silk Manufacture.

Belding v. Turner, 8 Blatch., 321; *Myers v. Dunbar*, 8 Blatch., 446.

42292. Johnson, A. F. April 12, 1864. Sewing Machine.

Reissue No. 6550, July 20, 1875.

Held novel, valid and infringed, *Thomas v. Shoe Machine Mfg. Co.*, 3 Ban. & Ard., 138.

42403. Robjohn, T. April 19, 1864. Band Ruffles.

Construed to be for an improvement in degree and held wanting in novelty, *Wooster v. Cahoun*, 11 Blatch., 215. See, also, *Wooster v. Blake*, 20 O. G., 158.

42520. Westlake, W. April 26, 1864. Lantern.

Reissue No. 3747, Nov. 23, 1869.

Held to be for a change in the relative position of parts, wanting in patentable invention, *Dane v. Chicago Mfg. Co.*, 3 Biss., 374. Construed to be for a combination, wanting in novelty, *Ibid.*, 7 O. G., 924.

42555. Budding, B. O. May 3, 1864. Heel-polishing Machine.

Held not infringed, *Sweetser v. Helms*, 2 Ban. & Ard., 263. See, also, *Dodge v. Feary*, 8 Fed. Rep., 329.

- 42572.** Fullam, A. I. May 3, 1864. Shearing Sheep.

Reissue No. 5701, Dec. 23, 1873.

Construed and held infringed, *Earle v. Harlow*, 2 Ban. & Ard., 264.

- 42580.** Holbeck & Gottfried. May 3, 1864. Pitching Barrels.

Construed to be for application of old contrivances to a new process, not involving patentable invention, *Gottfried v. Crescent Brewing Co.*, 9 Fed. Rep., 762. Declared invalid, *Ibid.*, 22 O. G., 1447. Sustained in accordance with above decision, *Gottfried v. Stahlmann*, 22 O. G., 1788. Held not infringed by repairing a licensed machine whose identity was maintained, *Gottfried v. Seipp Brewing Co.*, 10 Biss., 368.

Patentees held joint inventors; is novel, and not anticipated by abandoned experiment; construed to be for a patentable combination; is sufficiently described, and infringed, *Gottfried v. Phillip Best Brewing Co.*, 5 Ban. & Ard., 4. Held not anticipated by prior device producing same result by a different process; sustained and infringed by apparatus producing same result, but portable and differing in minor details, *Gottfried v. Bartholomae*, 8 Biss., 219. See, also, *Gottfried v. Miller*, 104 U. S., 521; 10 Fed. Rep., 471.

- 42591.** Moody, S. A. May 3, 1864. Corset.

Reissue No. 2165, Jan. 30, 1866.

Held useful and novel, *Moody v. Taber*, 1 Holmes, 325.

- 42842.** Day, S. F. May 24, 1864. Electro-magnetic Telegraph.

Reissue No. 3335, March 23, 1869.

Claim 2 construed, and held wanting in novelty, the principle of operation being the same, although constructed to produce a louder sound, *Day v. Bankers' & Brokers' Telegraph Co.*, 9 Blatch., 345.

- 42920.** Knibbs, J. May 24, 1864. Fire-engine Pump.

Held novel, and not abandoned by prior public experimental use; is valid and infringed, *Campbell v. Mayor of New York*, 9 Fed. Rep., 500. See, also, *City of Concord v. Norton*, 16 Fed. Rep., 477.

- 43009.** Cummings, J. A. June 7, 1864. Artificial Gums.

Validity doubted, in view of public use during eight years interval between application and grant, *Goodyear v. Hills*, 3 Fish., 134.

Reissue No. 1904, March 21, 1865.

Construed; sustained; held novel and infringed; not abandoned during pendency of application, *Goodyear Dental Vulcanite Co. v. Weatherbee*, 3 Cliff., 555. Construed to be for the described article produced by the described process, and held valid, *Goodyear Dental Vulcanite Co. v. Smith*, 1 Holmes, 354. Is for a patentable substitution of material involving invention, *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S., 486.

Construed to be infringed by use of substantial equivalents and by repairs which practiced the entire invention, *Goodyear Dental Vulcanite Co. v. Preterre*, 15 Blatch., 274. Construed to be for product made in the manner defined and not separate from process, and not infringed by celluloid plate, *Goodyear Dental Vulcanite Co. v. Davis*, 3 Ban. & Ard., 115, and 102 U. S., 222.

Construed; sustained, and held not infringed, *Goodyear Dental Vulcanite Co. v. Root*, 1 Ban. & Ard., 384. Sustained in conformity with prior adjudications, *Goodyear Dental Vulcanite Co. v. Willis*, 1 Flip., 388. Infringement not shown, *Goodyear Dental Vulcanite Co. v. Flagg*, 9 O. G., 153.

Construed; claim 1 is for patentable subject-matter, and is infringed by change, if any, of form, and not of substance. Patentee is first and original inventor, *Goodyear Dental Vulcanite Co. v. Gardiner*, 3 Cliff., 408. Sustained in conformity with supreme court decision, and held not infringed by use of celluloid, *Goodyear Dental Vulcanite Co. v. Brightwell, MacArthur & MacKay*, 74. See, also, *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 2 Ban. & Ard., 252; *v. Osgood*, 2 Ban. & Ard., 529; *Gardner v. Goodyear Dental Vulcanite Co.*, 6 Fish., 329.

- 43192.** Francis & Lemate. June 21, 1864. Compound for Inking Rollers.

Reissue No. 2805, Nov. 26, 1867.

Construed as limited by disclaimer, and no infringement proved, *Francis v. Mellor*, 5 Fish., 153. See, also, *Francis v. Mahn*, 1 O. G., 51.

- 43371.** Prince, G. W. June 28, 1864. Tin Can.

Sustained, and held not anticipated, *Banker v. Bostwick*, 3 Fed. Rep., 517.

- 43378.** Bouvet, J. June 28, 1864. Metal Cans.

Reissue No. 1804, Nov. 1, 1864.

Examined; held valid and infringed, *De Florez v. Raynolds*, 14 Blatch., 505. Held not anticipated, *Ibid.*, 16 Blatch., 397. See, also, *De Florez v. Raynolds*, 17 Blatch., 436.

- 43462.** Brodie, J. July 5, 1864. Amalgating Barrels.

Sustained, *Brodie v. Ophir Quicksilver Mining Co.*, 5 Sawyer, 608.

- 43463.** Rousell, Delangre & Robin. July 5, 1864. Decorating Tin Plates.
Reissue No. 7556, March 13, 1877.
Construed to be for the substitution of old equivalent means for the production of possibly better but not different results; is invalid for undue expansion of original, *Flower v. Rayner*, 5 Fed. Rep., 793.
- 43516.** Marshall, W. C. July 12, 1864. Preserving Meat.
Reissues Nos. 6451 and 6452, May 25, 1875.
Patentability of subject-matter doubted. *Wilson Packing Co. v. Clapp*, 8 Biss., 154.
Held wanting in patentable invention and novelty. Is void, 8 Biss., 545.
- 43636.** Carr & Akin. July 26, 1864. Burrs for Knitting Machine.
Reissue No. 8391, Sept. 3, 1878.
Claim 1 construed, and limited in order to be sustained, to be for a patentable structure, and not infringed by making same device to be used in a different structure. Claims 2 and 3 construed and limited in view of original, *Campbell v. Kavanaugh*, 11 Fed. Rep., 83.
- 43669.** Clark, Wm. J. Aug. 2, 1864. Manufacture of Bolts.
Reissue No. 6291, Feb. 16, 1875.
Construed, limited, and not infringed as limited, *Clark v. Kennedy Mfg. Co.*, 14 Blatch., 79.
- 43851.** Howe, J. C. Aug. 16, 1864. Metallic Cartridges.
Construed and limited in view of state of art. Claims 1 and 2 infringed, *Forehand v. Porter*, 15 Fed. Rep., 256.
- 43858.** Morehouse, C. B. Aug. 16, 1864. Whip-sockets.
Reissue No. 5713, Dec. 30, 1873.
Construed to be for particular means and held not infringed, *Merriam v. Van Nest*, 3 B. & A., 209.
- 43979.** Destouy, A. Aug. 30, 1864. Metal Moldings.
Reissue No. 7609, Apr. 17, 1877.
Claim 3 invalid in view of thirteen years' delay in reissuing, *Combined Patents Can Co. v. Lloyd*, 11 Fed. Rep., 149.
- 43987.** Hall, C. Aug. 30, 1864. Chain-stretching Machine.
Sustained, and not anticipated by a single prior abandoned and publicly unknown machine. Claim construed and infringed, *Hall v. Bird*, 6 Blatch., 438.
- 44073.** Carter & Mets. Sept. 6, 1864. Extension Table Slide.
Reissue No. 4317, April 4, 1871.
Broadly construed is for substitution of material; invalid for want of invention; not infringed if limited, *Carter v. Messinger*, 11 Blatch., 34.
- 44129.** Walker, E. L. Sept. 6, 1864. Hay Elevator.
Reissue No. 2429, Dec. 18, 1866.
Held valid and infringed, *Nellis v. Pennock Mfg. Co.*, 22 O. G., 1131. See, also, *Nellis v. McLanahan*, 6 Fish., 286.
- 44249.** Wortendyke, J. B. Sept. 13, 1864. Machine for Cutting Paper for Twine.
Reissue No. 1825, Nov. 22, 1864.
Wortendyke v. White, 2 Ban. & Ard., 25.
- 44528.** Goddard, E. Oct. 4, 1864. Glue.
Reissue No. 4072, July 12, 1870.
Construed, and held wanting in patentable invention and novelty, *Milligan & Higgins Glue Co. v. Upton*, 97 U. S., 3. Construed to be for reducing the bulk of the article, and held wanting in patentable invention, *Ibid.*, 4 Cliff., 237.
- 44561.** Stilwell, E. R. Oct. 4, 1864. Feed Water Feeder.
Reissue No. 2160, Jan. 23, 1866.
Claim 1 construed and held not infringed, *Stilwell & Bierce Mfg. Co. v. Cincinnati Gas Light Co.*, 1 Ban. & Ard., 610.
Reissue No. 3618, Aug. 24, 1869.
Claims 1 and 2 construed. Claim 2 is for a combination producing a new result, not an aggregation; held novel and sufficiently described, *Ibid.*, 1 Ban. & Ard., 610.
- 44624.** Hartshorn, S. Oct. 11, 1864. Spring Fixture for Shades.
Reissue No. 2756, Aug. 27, 1867.
Construed and held infringed, *Hartshorn v. Almy*, 1 Holmes, 493. Infringed by patentable improvement embracing it, *Hartshorn v. Shorey*, 2 Ban. & Ard., 233. Not anticipated by single, similar prior forgotten device not designed to operate in the same way; sustained and infringed by an improvement, *Hartshorn v. Tripp*, 7 Blatch., 120. Void for delay in reissuing, *Hartshorn v. Eagle Shade Roller Co.*, 18 Fed. Rep., 90.

- 44684.** Albertson, A. Oct. 11, 1864. Bottle Stopper.
Construed; claims 1 and 2 held not infringed, *Matthews v. Schoneberger*, 18 Blatch., 356. See, also, *Matthews v. Chambers*, 6 Fed. Rep., 874.
- 44731.** Kelly, M. J. Oct. 18, 1864. Atmosphere Cooler.
Reissue No. 7643, April 24, 1877.
Construed in view of state of art; limited; sustained and infringed, *Bate Refrigerator Co. v. Toffey*, 6 Fed. Rep., 514. Claim 5 construed to be an enlarged claim for matter not omitted from original by inadvertence, and is invalid, *Bate Refrigerator Co. v. Eastman*, 32 O. G., 517.
- 44960.** Kittle, S. P. Nov. 8, 1864. Spring Mattress.
Reissue No. 2092, Oct. 17, 1865.
Claims 1 and 2 construed; held novel and infringed, *Kittle v. Frost*, 9 Blatch., 214.
- 45106.** Wood, J. Nov. 15, 1864. Car-brake Shoe.
Held not infringed, *National Car-brake Shoe Co. v. Boston & Albany R. Co.*, 15 Fed. Rep., 462.
- 45296.** Foy, L. H. Nov. 29, 1864. Corset Skirt Supporter.
Reissue No. 4831, March 26, 1872.
Held valid on stipulation filed by both parties, *Foy v. Hunter*, 9 O. G., 542, and 9 O. G., 543.
- 45334.** Moore, D. M. Dec. 6, 1864. Wrench.
Construed, and held not anticipated by prior device of same capacity but different structure; not abandoned by prior experimental use, *Sinclair v. Backus*, 4 Fed. Rep., 539.
- 45422.** McKay & Blake. Dec. 13, 1864. Sewing Machine.
McKay v. Mace, 23 Fed. Rep., 76.
- 45590.** Cross, R. & A. Dec. 27, 1864. Pail-graining Machine.
Construed to cover both the machine and particular design; sustained; claim 2 is for patentable matter, *Clark v. Bousfield*, 10 Wall., 133.
- 45647.** Shoup, W. Dec. 27, 1864. Oil Well Pump.
Held wanting in novelty, *Shoup v. Henrici*, 2 Ban. & Ard., 249.

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- 45803.** Mason, M. B. Jan. 3, 1865. Desulphurizing Ores.
Claim 1 anticipated by No. 41,897, and declared void as interfering therewith, *Gold & Silver Separating Co. v. United States Disintegrating Co.*, 6 Blatch., 307.
- 45957.** Billings, W. B. Jan. 17, 1865. Coal Oil Stove.
Claims construed; claim 2 is for a double use, and is wanting in invention; claims 1, 2, 3 and 4 held wanting in novelty; claim 5 not infringed, *Couse v. Johnson*, 4 Ban. & Ard., 501.
- 45993.** Hoffman, J. H. Jan. 24, 1865. Paper Collar.
Reissue No. 2034, July 25, 1865.
Construed to be a new article of manufacture; novel and valid, *Hoffman v. Stiefel*, 7 Blatch., 58. Construed; held valid; involves invention, although all the elements are old; is infringed by substitution of equivalents and colorable evasion, *Hoffman v. Aronson*, 8 Blatch., 324.
- 46027.** Rogers, S. Jan. 24, 1865. Hay Elevator.
Reissue No. 2260, May 29, 1866.
Held valid and infringed, *Nellis v. Pennock Mfg. Co.*, 22 O. G., 1131. See, also, *Nellis v. McLanahan*, 6 Fish., 286.
- 46217.** Cross, J. R. Feb. 7, 1865. Packing for Oil Wells.
Reissue No. 7772, July 3, 1877.
Claims 1 and 2 construed and limited to original in order to be sustained; not infringed as limited, *Consolidated Oil Well Packer Co. v. Eaton*, 12 Fed. Rep., 865.
- 46300.** Johnston, S. Feb. 7, 1865. Harvester Rake and Reel.
Reissue No. 2951, March 26, 1868.
Dorsey Revolving Rake Harvester Co. v. Bradley Mfg. Co., 12 Blatch., 202.
- 46424.** Robjohn, T. Feb. 14, 1865. Ruffle Machine.
Reissue No. 6566, July 27, 1875.
Held novel; claims 8 and 9 construed and held infringed, *Wooster v. Blake*, 8 Fed. Rep., 429. Claims 8 and 9 held invalid for expansion, *Wooster v. Howe Machine Co.*, 21 Fed. Rep., 67, and *v. Handy*, 21 Fed. Rep., 51.
- 46495.** Potter, W. L. Feb. 21, 1865. Roofing Composition.
Reissue No. 2684, July 16, 1867.
Construed; held novel as limited by disclaimer; sustained and infringed, *Plastic Slate Roofing Co. v. Moore*, 1 Holmes, 167.

- 46507.** Taylor, W. B. S. Feb. 21, 1865. Flexible Tubing.
Construed; patentee held first and original inventor; infringed by substitution of known equivalent, *Taylor v. Archer*, 8 Blatch., 315.
- 46553.** Eickemeyer, R. Feb. 28, 1865. Machine for Stretching Hat Bodies.
Reissue No. 3217, Dec. 1, 1868.
Combination claims 2 and 3 held not anticipated by prior existing uncombined elements; held novel, and infringed by improvement, *Eickemeyer Hat Blocking Machine Co. v. Pearce*, 10 Blatch., 403.
- 46568.** Loewenberg. Feb. 28, 1865. Fabric for Hats.
Reissue No. 2587, Apr. 30, 1867.
Held not infringed, *Baldwin v. Shultz*, 9 Blatch., 494.
- 46615.** Brown, G. W. Feb. 28, 1865. Seed Planter.
Reissue No. 6384, April 20, 1875.
Construed, limited, and sustained as involving invention; is infringed, *Brown v. Deere & Co.*, 2 McCrary, 422. See, also, *Brown v. Deere & Co.*, 2 McCrary, 425.
- 46629.** Bergen, G. I. March 7, 1865. Corn Planter.
Claim 6 held to have been in public use and well known for more than two years prior to date of application, *McFarland v. Deere & Mansur Mfg. Co.*, 22 Fed. Rep., 781. Construed and held void in conformity with above decision, *McFarland v. Brown*, 22 Fed. Rep., 787.
- 46705.** Reynolds, H. A. March 7, 1865. Velocipede.
Reissue No. 8252, May 28, 1878.
Invalid, right to reissue having been abandoned by delay, *Pope Mfg. Co. v. Marqua*, 15 Fed. Rep., 400.
- 46871.** Bolton, J. March 21, 1865. Sewing Machine Tuck Marker.
Reissue No. 4196, Dec. 13, 1870.
Compared with original, and held invalid for enlargement of claim and for unreasonable delay of five years in reissuing, *Singer Mfg. Co. v. Goodrich*, 15 Fed. Rep., 455.
- 47107.** Hoffman, J. H. April 4, 1865. Paper Collar.
Hoffman v. Stiefel, 7 Blatch., 58.
- 47133.** Root, J. B. April 4, 1865. Oil Well Pump.
Novelty doubted; claim 2 construed and held wanting in novelty, *Doubleday v. Beatty*, 11 Fed. Rep., 729.
- 47135.** Seaver, C. April 4, 1865. Clasp for Pocket-books.
Construed; scope defined; held novel, valid and infringed, *Zinn v. Weiss*, 7 Fed. Rep., 914.
- 47385.** Bennet & Gibbs. April 25, 1865. Soap Manufacture.
Held useful, and infringed by a licensee from an owner of an unassignable shop-right, *Gibbs v. Hoefner*, 19 Fed. Rep., 323.
- 47458.** Roberts, E. A. L. April 25, 1865. Explosive.
Held novel and valid; claim 1 infringed, *Roberts v. Schreiber*, 2 Fed. Rep., 855. Sustained; not anticipated by abandoned experiment, and is infringed, *Roberts v. Reed Torpedo Co.*, 3 Brewster, 558. See, also, *Roberts v. Valley*, 14 Fed. Rep., 167.
- 47551.** Irwin, J. H. May 2, 1865. Lantern.
Construed, and not infringed as limited, *Adams v. Howard*, 19 Fed. Rep., 317. See, also, *Adams v. Howard*, 22 Fed. Rep., 656.
- 47574.** Saladee, C. W. May 2, 1865. Harness-buckle.
Reissue No. 8829, July 29, 1879.
Construed and limited in view of prior patent; sustained and not infringed, *Walters v. Crandal*, 11 Fed. Rep., 868.
- 47764.** Bristol, C. B. May 16, 1865. Snap Hook.
Construed, in view of state of art, to be for a patentable combination; limited in order to be sustained, and claim 1 infringed, *Fitch v. Bragg & Co.*, 8 Fed. Rep., 588.
- 47938.** Earl & Holcraft. May 30, 1865. Wool-oiling Apparatus.
Infringed, *Earl v. Dexter*, 1 Holmes, 412.
- 48036.** Arkell & Smith. June 6, 1865. Paper Bag.
Construed to be for a "result" of the means described—a paper bag; patentable; sustained and infringed, *Arkell v. Hurd Paper Bag Co.*, 7 Blatch., 475.
- 48048.** Buerk, J. E. June 5, 1865. Watchman's Time Detector.
Reissue No. 3869, March 8, 1870.
Held properly reissued in order to limit the term, in view of prior French patent, *Buerk v. Valentine*, 9 Blatch., 479. Sustained; is for a novel combination; valid and infringed, *Buerk v. Imhauser*, 1 Ban. & Ard., 137. Not anticipated, *Ibid.*, 14 Blatch., 19. Held novel, *Imhauser v. Buerk*, 101 U. S., 464. See, also, *Buerk v. Imhauser*, 2 Ban. & Ard., 465; 10 O. G., 907.

- 48300.** Moyer, E. D. June 20, 1865. Bottle Stopper.
Held not infringed, *Hicks v. Moeller*, 4 Ban. & Ard., 434.
- 48366.** Carpenter, R. W. June 27, 1865. Tremolo.
Reissue No. 3665, Oct. 5, 1869.
Sustained as novel; claim 1 is not for a principle, but for the described means, and is infringed, *Hitchcock v. Tremaine*, 8 Blatch., 440. Novelty sustained, *Hitchcock v. Tremaine*, 9 Blatch., 550. Not infringed by sale of one old element of the combination to licensees under the patent, *Saxe v. Hammond*, 1 Holmes, 453. See, also, *Hitchcock v. Tremaine*, 9 Blatch., 385; Tremolo Patent, 23 Wall., 518.
- 48407.** Jenkins, N. June 27, 1865. Self-closing Faucet.
Construed and limited; held novel, and not anticipated by a similar prior device which had not been used, *Zane v. Peck Bros. & Co.*, 9 Fed. Rep., 101. Held novel, *Ibid.*, 3 Ban. & Ard., 36. Construed in view of state of art; limited and not infringed, *Zane v. Soffe*, 110 U. S., 200. Held novel; valid for limited improvement claimed, and not infringed, *Zane v. Loffe*, 2 Fed. Rep., 229. See, also, *Zane v. Peck*, 23 O. G., 191.
- 48555.** Hart, Wm. H. July 4, 1865. Door Bolt.
Subject-matter held novel, original, useful and patentable, *Stanley Works v. Sargent & Co.*, 8 Blatch., 344.
- 49129.** May, J. M. Aug. 1, 1865. Drills for Boring Wells.
Reissue No. 6337, March 16, 1875.
Rouse v. Fletcher, 9 O. G., 838.
- 49140.** Nimmo, G. Aug. 1, 1865. Molding Crucibles and Pots.
Reissue No. 4608, Oct. 24, 1871.
Construed, held novel, useful and infringed, *Pickering v. Phillips*, 4 Cliff., 383. Invalid in view of prior knowledge and use, *Pickering v. McCullough*, 3 Ban. & Ard., 279; 104 U. S., 310.
- 49290.** Miltimore, J. H. Aug. 8, 1865. Lantern.
Reissue No. 9422, Oct. 19, 1880.
Adams v. Meyrose, 10 Fed. Rep., 671; *v. Meyrose Mfg. Co.*, 12 Fed. Rep., 440.
- 49349.** Lyon, B. M. Aug. 8, 1865. Machine for Forming Welts.
Infringed, *Merriam v. Smith*, 11 Fed. Rep., 588.
- 49414.** Johnson, J. Aug. 15, 1865. Steam Valve.
Construed, held valid and infringed, *Jenkins v. Johnson*, 9 Blatch., 516.
- 49469.** Caldwell, E. J. Aug. 15, 1865. Gas Stove.
Reissue No. 7077, April 25, 1876.
Construed, and limited in view of state of art, and held not infringed, *Tift v. Sharp*, 18 Blatch., 138.
- 49502.** Chesebrough, R. A. Aug. 22, 1865. Purifying Coal Oil.
Held novel and sustained. Patentee held first and original inventor, and diligent in reducing his invention to practice, *National Filtering Oil Co. v. Arctic Oil Co.*, 8 Blatch., 416.
- 49572.** Walker, J. H. Aug. 22, 1865. Mode of Cutting Boot and Shoe Soles.
Held wanting in patentable invention in view of state of art, being analogous to a double use, *Walker v. Rawson*, 4 Ban. & Ard., 128.
- 49903.** Martin, F. Sept. 12, 1865. Packing for Oil Wells.
Reissue No. 7244, July 25, 1876.
Claim 4 construed to be for a combination, and not an aggregation; held novel, *Consolidated Oil Well Packer Co. v. Eaton*, 12 Fed. Rep., 835.
- 49948.** Christy, J. Sept. 12, 1865. Car-brake Shoe.
National Car-brake Shoe Co. v. Railroad Cos., 23 O. G., 1034.
- 49951.** Goodale, E. W. Sept. 12, 1865. Paper Bag Machine.
Claim 1 construed and held infringed, *Union Paper Bag Machine Co. v. Newell*, 11 Blatch., 379. See, also, *Union Paper Bag Machine Co. v. Newell*, 11 Blatch., 519.
- 49984.** Collins, M. H. Sept. 19, 1865. Lamps.
Claim construed to be for a combination, and infringed by manufacture and sale of a part useless without the entire combination, with intent to have it completed by purchaser, *Wallace v. Holmes*, 9 Blatch., 65.
- 49992.** Field & Pullman. Sept. 19, 1865. Sleeping Car.
Reissue No. 6648, Sept. 21, 1875.
Pullman v. B. & O. R. Co., 4 Hughes, 236.
- 50073.** Hunt, Z. Sept. 19, 1865. Coal Stove.
Reissue No. 6709, Oct. 19, 1875.
Claim 3 void for aggregation, *Perry v. Co-operative Foundry Co.*, 12 Fed. Rep., 436.
- 50255.** Matthews, J. Oct. 3, 1865. Soda Water Fountain.
Reissue No. 9028, Jan. 6, 1880.

- Claims 5 and 7 held anticipated; claims 4, 6, 8 and 9 sustained and infringed, *Matthews v. Spangenberg*, 23 O. G., 92. See, also, *Matthews v. Spangenberg*, 14 Fed. Rep., 350; 15 Fed. Rep., 813.
- 50364.** Jordan & Smith. Oct. 10, 1865. Wrench.
Reissue No. 5294, Feb. 25, 1873.
Sustained as for patentable subject-matter involving invention, *Collins Co. v. Coes*, 3 Fed. Rep., 225. Construed to be for application to a device of a feature already in use for same purpose in another form of tool, and held not to involve invention, *Collins Co. v. Coes*, 21 Fed. Rep., 38. See, also, *Collins Co. v. Coes*, 8 Fed. Rep., 517.
- 50318.** Westhead, M. B. Oct. 3, 1855. Device for arranging Tapes (granted under act 1867).
Held valid for term of seventeen years, notwithstanding the prior fourteen year English patent of patentee, *Goff v. Stafford*, 3 Ban. & Ard., 610.
- 50591.** Irwin, J. H. Oct. 24, 1865. Lamp.
Construed, in view of state of art, to be for special device; sustained, and is infringed, *Adams v. Illinois Mfg. Co.*, 4 Ban. & Ard., 543. Construed, and held to be for simple change in location, which, remedying a grave defect, constitutes a patentable improvement; not anticipated by a prior application accompanied by an inoperative model; is infringed, *Adams v. Howard*, 19 Fed. Rep., 317. See, also, *Adams v. Howard*, 22 Fed. Rep., 656.
- 50614.** Mudge, B. Oct. 24, 1865. Sinking Wells.
Peck *v. Collins*, 103 U. S., 660.
- 50617.** Nobel, A. Oct. 24, 1865. Exploding Nitro-glycerine.
Reissues Nos. 4818 and 4819, March 19, 1872. Compound. Products.
Construed to be for compounds; invalid for new matter, and as for invention different from that contained in the original process patent, *Atlantic Giant Powder Co. v. California Powder Works*, 3 Sawyer, 448. Void for want of identity with original process patent, *Powder Co. v. Powder Works*, 98 U. S., 126.
Reissue No. 5798, March 17, 1874.
Limited, and held not infringed, *Atlantic Giant Powder Co. v. Mowbray*, 2 Ban. & Ard., 442. Construed, limited and not infringed, *Atlantic Giant Powder Co. v. Hulings*, 21 Fed. Rep., 519.
Reissue No. 5800, March 17, 1874.
Limited, and held not infringed, *Atlantic Giant Powder Co. v. Mowbray*, 2 Ban. & Ard., 442. See, also, *Atlantic Giant Powder Co. v. California Powder Works*, 98 U. S., 126.
- 50626.** Pingree, S. M. Oct. 24, 1865. Apparatus for Making Extracts from Tan Bark.
Construed to be for a combination, and not infringed by use of less than all its elements, *Bridge v. Brown*, 1 Holmes, 205. See, also, *Bridge v. Brown*, 1 Holmes, 53.
- 50723.** Linville & Piper. Oct. 31, 1865. Wrought Iron Bridges.
Construed, and limited in view of claims and specifications, and held not infringed, *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S., 274. Construed to be for use of article in a particular application and not infringed by its manufacture and sale, *Ibid*, 5 Fish., 468.
- 50860.** Tyler, Chandler & Standish. Nov. 7, 1865. Pocket-lighter.
Reissue No. 8490, Nov. 12, 1878.
Construed; held properly reissued; is novel, valid, and infringed by a formal difference only, *Selden v. Stockwell Gas Burner Co.*, 19 Blatch., 544.
- 50919.** Dickerson & Stuber. Nov. 14, 1865. Oil Well Pump.
Claim 2 construed to be for an aggregation; held wanting in invention, *Doubleday v. Roess*, 11 Fed. Rep., 737.
- 50938.** Kelly, T. J. Nov. 14, 1865. Gas Stove Burner.
Reissue No. 6833, Jan. 4, 1876.
Construed to be for a combination of old and new elements, and infringed by use of one of the new elements, *Sharp v. Tiff*, 18 Blatch., 132.
- 51085.** Rathbone & Hailes. Nov. 21, 1865. Coal Stove.
Construed; description held vague and not cured by disclaimer, *Hailes v. Albany Stove Co.*, 16 Fed. Rep., 240.
- 51145.** See ¶ 9, p. 774.
- 51167.** Fowler & Morgan. Nov. 28, 1865. Packing for Oil Wells. Reissue No. 8491, Nov. 12, 1878. Claim 1 construed, and held an unwarrantable enlargement of original, and void, *Consolidated Oil Well Packer Co. v. Eaton*, 12 Fed. Rep., 855.
- 51292.** Bussy & McLeod. Dec. 5, 1865. Reservoir Cooking Stove.
Reissue No. 5435, June 3, 1873.
Construed, in view of state of art, to be for a new combination of old elements involving invention, and not for an aggregation; claim 1 held wanting in novelty; claim 4 sus-

tained, and infringed by a colorable change, *Bussy & McLeod v. Wager*, 2 Ban. & Ard., 229. See, also, *Ibid.*, 9 O. G., 594.

51310. Hamilton, P. Dec. 5, 1865. Saw-mills.

Construed to be for a combination constituting an improvement on an old machine; sufficiently described; infringed by change in attachment of parts obtaining the same movement, *Ives v. Hamilton*, 92 U. S., 426. Construed, and held not limited to particular adjustment shown in drawing, *Hamilton v. Ives*, 3 Fish., 244. Sustained as novel, *Hamilton v. Rollins*, 5 Dill., 495. See, also, *Hamilton v. Kingsbury*, 17 Blatch., 264; 17 Blatch., 460; 15 Blatch., 64.

51364. Tinker, J. B. Dec. 5, 1865. Mowing Machine.

Construed, and held not infringed, *Tinker v. Wilber Eureka Mower and Reaper Mfg. Co.*, 1 Fed. Rep., 138.

51379. Winslow, I. Dec. 5, 1865. Knife for Removing Corn.

Void for public use more than two years prior to date of application, *Jones v. Barker*, 11 Fed. Rep., 597. Held wanting in patentable novelty, *Jones v. McMurry*, 2 Hughes, 527.

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51928. Crompton, G. Jan. 9, 1866. Shedding Mechanism for Looms.

Reissue No. 5718, Jan. 6, 1874.

Construed and held not infringed, *Crompton v. Knowles*, 7 Fed. Rep., 199.

51991. Berdan, H. Jan. 9, 1866. Breech Loader.

Reissue No. 3118, Sept. 15, 1868.

Patentability doubted. Patentee held not to be the inventor, *Berdan Fire-arms Mfg. Co. v. Remington & Sons*, 3 O. G., 688.

52008. Lord, E. Jan. 9, 1866. Cleaning Cotton, etc.

Lord v. Whitehead & Atherton Machine Co., 33 O. G., 499.

52015. Belknap, F. G. Jan. 16, 1866. Amalgamator.

Construed to be for a combination; limited and not infringed, *Coolidge v. McCone*, 2 Sawyer, 571.

52169. Holt, H. Jan. 23, 1866. Marking Wheel.

Reissue No. 6714, Oct. 26, 1875.

Claim 2 limited and held not infringed, *Holt v. Keeler*, 22 O. G., 1291.

51145. Christman, J. Nov. 28, 1865. Pump Filter.

Reissue No. 5804, March 24, 1874.

Construed, and held to be for a combination and not an aggregation. Claim 1 sustained; claim 2 invalid for want of novelty, *Christman v. Rumsey*, 17 Blatch., 148.

52439. Morehouse, C. B. Feb. 6, 1866. Whip Sockets.

Reissue No. 4071, July 12, 1870.

Construed to be for a combination of old elements; limited and not infringed, *Merriam v. Drake*, 9 Blatch., 336.

52726. Magoun, A. B. Feb. 20, 1866. Adjustable Window Frame.

Reissue No. 4698, Jan. 2, 1872.

Invalid in view of broad claims covering a prior invention, *Adjustable Window Screen Co. v. Boughton*, 1 Ban. & Ard., 327.

52730. McMillin, J. S. Feb. 20, 1866. Capstans.

Invalid for public use more than two years prior to date of application, *McMillin v. Barclay*, 5 Fish., 189. See, also, *McMillin v. Rees*, 1 Fed. Rep., 722; *v. St. Louis & Miss. Valley Transportation Co.*, 18 Fed. Rep., 260.

52763. Spafford, N. H. Feb. 20, 1866. Bristles Machine.

Wilkins v. Spafford, 3 Ban. & Ard., 274.

52779. Woodward, J. Feb. 20, 1866. Paste.

Held novel, useful, valid, and infringed by use of an equivalent, *Woodward v. Morrison*, 1 Holmes, 124.

52835. Fales, J. Feb. 27, 1866. Carpet Lining.

Reissue No. 4296, March 14, 1871.

Construed; validity of broad claim doubted, *Fales v. Wentworth*, 1 Holmes, 96. See, also, *American Carpet Lining Co. v. Beale*, 5 Ban. & Ard., 529.

52960. Brooks, Gates & Burleigh. March 6, 1866. Rock Drill.

Claim 3 construed to be for a combination; its infringement doubted, *Burleigh Rock Drill Co. v. Lobdell*, 1 Holmes, 450.

53003. Hull, L. March 6, 1866. Gage Lathe.

Reissue No. 7262, Aug. 15, 1876.

Construed; not anticipated by abandoned experiment; infringed by substitution involving formal change only, *American Whip Co. v. Lombard*, 4 Cliff., 495.

53011. Leavitt, T. H. March 6, 1866. Peat Machine.
Leavitt v. Connecticut Peat Co., 6 Blatch., 139.
53075. Wood, F. March 6, 1866. Landau Carriage Doors.
Wood v. Wells, 6 Fish., 382.
53251. Littlefield, D. G. March 13, 1866. Coal Burner.
Reissue No. 4006, May 31, 1870.
Construed to be for an improvement on a prior patent, Perry v. Littlefield, 17 Blatch., 272. See, also, Perry v. Littlefield, 18 O. G., 571.
53345. Rogers, S. March 20, 1866. Hay Elevator.
Nellis v. Pennock Mfg. Co., 22 O. G., 1131; v. McLanahan, 6 Fish., 286.
53584. Dewey & Tillotson. Apr. 3, 1866. Well Reservoir.
Reissue No. 4165.
Held wanting in novelty, Tillotson v. Munson, 5 Biss., 426.
53630. Kneeland, E. Y. Apr. 3, 1865. Piston.
Sustained; patentee held first and original inventor, Kneeland v. Sheriff, 2 Fed. Rep., 901.
53633. Knox & Corrister. Apr. 3, 1866. Fluting Machine.
Reissue No. 3861, March 1, 1870.
Held novel and valid, Knox v. Loweree, 1 Ban. & Ard., 589.
53706. Tucker, E. W. Apr. 3, 1866. Bed Bottom.
Reissue No. 6338, March 16, 1875.
Dunks v. Grey, 5 Ban. & Ard., 634.
53794. Densmore, J. & A. Apr. 10, 1866. Petroleum Car.
Reissue No. 2261, May 29, 1866.
Claims construed to be for combinations separate in their nature and which may be used apart, Densmore v. Schofield, 4 Fish., 148. Held wanting in novelty and patentability; claims held to be frivolous, *Ibid.*, 102 U. S., 375.
53883. Ross, G. Apr. 10, 1866. Molding and Casting.
Smith v. Marshall & Co., 10 O. G., 375.
53927. Sanford & Wheeler. Apr. 10, 1866. Sewing Machine for Hat Linings.
Held novel and infringed, Sanford v. Messer, 1 Holmes, 149. Construed to be for a combination and held not infringed, Sanford v. Merrimack Hat Co., 4 Cliff., 404.
54033. Spafford, N. H. Apr. 17, 1866. Bristle Machine.
Wilkins v. Spafford, 3 Ban. & Ard., 274.
54034. Spafford, N. H. Apr. 17, 1866. Bristle Combing Machine.
Wilkins v. Spafford, 3 Ban. & Ard., 274.
54170. Jones, J. W. Apr. 24, 1866. Knife for removing Corn.
Held wanting in novelty, Jones v. Barker, 11 Fed. Rep., 597; v. McMurry, 2 Hughes, 527.
54323. Foy, L. H. May 1, 1866. Bustles.
Held valid on stipulation filed by both parties, Foy v. Hunter, 9 O. G., 543.
54554. Jenkins, N. May 8, 1866. Elastic Packings.
Reissue No. 3579, Aug. 3, 1869.
Held novel. Claim 1 construed and held infringed, Jenkins v. Johnson, 9 Blatch., 516. Construed, and limited in view of specification, and held not infringed, Clarke v. Johnson, 16 Blatch., 495. Construed, and held not infringed by a substitution of material developing other and different properties, Clarke v. Johnson, 18 Blatch., 450. Held novel and infringed, Jenkins v. Walker, 1 Holmes, 120. See, also, Nelson v. McMann, 16 Blatch., 139.
54649. Morris, A. May 8, 1866. Excavator Scoop.
Morris v. Shelbourne, 8 Blatch., 266.
54860. Clark & Garretson. May 22, 1866. Mop-head.
Garretson v. Clark, 15 Blatch., 70; 17 Blatch., 256; 111 U. S., 120.
54938. Moore, G. R. May 22, 1866. Stove.
Reissue No. 9247, June 8, 1880.
Claims 1 and 4 invalid for want of invention, Perry v. Co-operative Foundry Co., 12 Fed. Rep., 149.
55299. Hudson, T. S. June 5, 1866. Manufacture of Type.
Construed, sustained, and held not infringed, Hudson v. Draper, 4 Cliff., 178.
55469. Cole, H. H. June 12, 1866. Fluting Machine.
Reissue No. 4349, April 25, 1871.
Held good and valid. Patentee held first and original inventor, Cole v. Kennedy, 9 O. G., 1110.

- 55598.** Ashcroft, J. June 19, 1866. Governing Steam Boilers.
Held infringed, Chalmer Spence Patent Non-conductor Co. v. Pierce, 9 Fed. Rep., 152.
Held valid. Patentee held first and original inventor, Chalmer Spence Patent Non-conductor Co. v. Cramp, 5 Ban. & Ard., 66.
- 55614.** Burt & Dunn. June 19, 1866. Cutting Corn from Cob.
Reissue No. 8854, Aug. 19, 1879.
Void for delay in reissuing, Jones v. Barker, 11 Fed. Rep., 597.
- 55630.** Dennis, P. June 19, 1866. Shovel-plows.
Patentee held first and original inventor; patent is infringed, Dennis v. Eddy, 11 O. G., 833.
- 55901.** Plimpton, J. L. June 26, 1866. Parlor-skate.
Sustained as for a patentable improvement on his prior patents, and is infringed, Plimpton v. Winslow, 3 Fed. Rep., 333. Void for public use and sale for more than two years prior to date of application, *Ibid.*, 14 Fed. Rep., 919.
- 56102.** Rowell, J. S. & I. July 3, 1866. Cultivator.
Reissue No. 2909, March 31, 1868.
Construed and limited to combination of old elements, and not infringed by a combination of only some of them, Rowell v. Lindsay, 10 Biss., 217. Construed to be for a combination, and not infringed by the omission of an element, *Ibid.*, 113 U. S., 97.
- 56166.** Boardman, B. July 10, 1866. Improved Tool.
Claim 1 construed; limited, sustained, and not infringed, Tower v. Bemis & Call Hardware & Tool Co., 19 Fed. Rep., 498.
- 56259.** Parsons, C. C. July 10, 1866. Soap Manufacture.
Construed and limited to particular form, as patentee was not the first in the art. Held novel, Parsons v. Colgate, 15 Fed. Rep., 600.
- 56261.** Platt, C. M. July 10, 1866. Buttons.
Construed; held useful, novel and infringed, Platt v. United States Patent Button, etc., Mfg. Co., 9 Blatch., 342.
- 56345.** Barnes, S. H. July 17, 1866. Corset Spring.
Reissue No. 3624, Aug. 31, 1869.
Construed; held novel and patentable; infringed by part of the combination prepared to be applied to the entire combination, Barnes v. Straus, 9 Blatch., 553.
Reissue No. 5216, Jan. 7, 1873.
Held invalid for abandonment by public use more than two years prior to date of application, Egbert v. Lippman, 15 Blatch., 295; 104 U. S., 333.
- 56365.** Cabell, S. G. July 17, 1866. Fluting Machine.
Reissue No. 3856, May 1, 1870.
Novelty and validity sustained; claims 1 and 3 infringed, Knox v. Loweree, 1 Ban. & Ard., 589.
- 56686.** Bussey & McLeod. July 24, 1866. Cooking Stove.
Reissue No. 3815, Feb. 1, 1870.
Construed and limited in view of state of art; claims 3 and 4 held to be duplicate; claim 3 held wanting in invention, Bussey v. Excelsior Mfg. Co., 110 U. S., 131.
- 56737.** Evans, A. July 31, 1866. Paper Cuffs.
Claim 2 held novel and patentable, Union Paper Collar Co. v. Van Deusen, 10 Blatch., 109.
- 56801.** Roemer, Wm. July 31, 1866. Traveling Bag.
Held invalid for want of novelty and for prior use, Roemer v. Simon, 1 Ban. & Ard., 138.
See, also, Roemer v. Simon, 95 U. S., 214.
- 56869.** Jennings, R. July 31, 1866. Augur Machine.
Held not abandoned by an experimental use, Jennings v. Pierce, 15 Blatch., 42.
- 57057.** Gresham, J. Aug. 7, 1866. Injector for Boiler.
Not anticipated by a suggestion as to what must be done, but not telling how to do it; sustained and held infringed, Nathan v. New York Elevated R. Co., 2 Fed. Rep., 229.
- 57232.** Wheeler & Manley. Aug. 14, 1866. Machine for Pouncing Hat Bodies.
Held not anticipated by an invention prior to their date of application, but subsequent to their date of reduction to practice, Nichols v. Pearce, 7 Blatch., 567.
- 57245.** Beschke, Wm. Aug. 14, 1866. Lamp.
Construed in view of state of art; limited, and not infringed, Ashcroft v. Hollings, 11 O. G., 879.
- 57271.** Adams, Jr., I. Aug. 21, 1866. Coating Metals with Metal.
United Nickel Co. v. American Nickel Plating Works, 4 Ban. & Ard., 74.
- 57443.** Miller & Reichert. Aug. 21, 1866. Billiard Register.
Construed and limited in view of state of art, and held not infringed, Passenger Fare Enumerator Co. v. Metropolitan R. Co., 4 Ban. & Ard., 116.

- 57574.** Sargent, J. Aug. 28, 1866. Lock.
Reissue 4696, Jan. 2, 1872.
Sargent v. Yale Lock Mfg Co., 17 Blatch., 249; 17 Blatch., 244.
- 58020.** Ewing, M. P. Sept. 11, 1866. Lubricant.
Reissue No. 7321, Sept. 26, 1876.
Expanded claim held void, being for a product not limited to process, as in original; also for delay in reissuing, *Vacuum Oil Co. v. Buffalo Lubricating Oil Co.*, 20 Fed. Rep., 850.
- 58294.** Richardson, G. W. Sept. 25, 1866. Safety Valve.
Construed and limited in view of state of art, and not infringed as limited, *Consolidated Safety Valve Co. v. Crosby*, 7 Fed. Rep., 768; *v. Kunkle*, 14 Fed. Rep., 732. Held sufficiently described and valid, *Consolidated Safety Valve Co. v. Crosby Steam Gauge & Valve Co.*, 113 U. S., 157.
- 58437.** Lemmen, J. Oct. 2, 1866. Bed Fastenings.
Haven & Co. v. Brown, 6 Fish., 413.
- 58447.** Mellon, E. Oct. 2, 1866. Locomotive Wheels.
Construed and limited to claim, *Lehigh Valley R. Co. v. Mellon*, 104 U. S., 112. See, also, *Mellon v. Delaware, Lackawana & W. R. Co.*, 21 O. G., 1616.
- 58612.** Davenport, F. S. Oct. 9, 1866. Gang Plow.
Reissue No. 8986, Dec. 2, 1879.
Construed and limited in view of state of art; void for expanded claim, *Newton v. Furst & Bradley Mfg Co.*, 14 Fed. Rep., 465.
- 58901.** Simpson, E. L. Oct. 16, 1866. Dental Rubber.
Goodyear v. Evans, 6 Blatch., 121.
- 58962.** Naylor, Wm. Oct. 16, 1866. Steam Safety Valve.
Reissue No. 3727, Nov. 9, 1869.
Limited and sustained in view of state of art, although claiming certain features originally disclaimed; is not infringed, *Ashcroft v. Boston & Lowell R. R.*, 1 Holmes, 366. Construed and limited in view of disclaimer in patentee's English patent; is not infringed, 97 U. S., 189.
- 59144.** Swett, C. Oct. 23, 1866. Bale Tie.
Construed; held infringed; is not abandoned, *Johnsen v. Fassman*, 1 Woods, 138.
Reissue No. 4896, May 7, 1872.
If broadly construed, is void; if limited, is not infringed, *Johnsen v. Beard*, 2 Ban. & Ard., 50.
- 59286.** Spafford, N. H. Oct. 30, 1866. Bristle Machine.
Wilkins v. Spafford, 3 Ban. & Ard., 274.
- 59319.** Redmond, O. Oct. 30, 1866. Packing for Oil Wells.
Reissue No. 7494, Feb. 6, 1877.
Claims 1 and 5 construed and limited to original patent in order to be sustained; not infringed as limited, *Consolidated Oil Well Packer Co. v. Eaton*, 12 Fed. Rep., 865.
- 59375.** Evory & Heston. Nov. 6, 1866. Boot and Shoe.
Construed, and held infringed by an improvement of greater simplicity and cheapness, *Evory v. Burt*, 15 Fed. Rep., 112. Held to be infringed, *Evory v. Candee*, 2 Fed. Rep., 542. See, also, *Evory v. Candee*, 17 Blatch., 200; 5 Ban. & Ard., 67.
- 59458.** Roulstone, E. A. G. Nov. 6, 1866. Trunk Molding.
Reissue No. 7149, May 30, 1876.
Construed and compared with original, and held valid notwithstanding omissions. Is for mechanical skill only, and wanting in patentable novelty, *Gould v. Ballard*, 3 Ban. & Ard., 324.
- 59603.** Hill, S. L. Nov. 13, 1866. Letter Blocks.
Construed and limited in view of state of art, and held not infringed, *Hill v. Houghton*, 1 Ban. & Ard., 291.
- 59733.** Wright, T. Nov. 13, 1866. Broom.
Reissue No. 2598, May 14, 1867.
Construed to be for same invention as original, and claim, if enlarged, sustained, in view of prompt reissuing before intervening rights had accrued; is infringed, *McArthur v. Brooklyn R'y Supply Co.*, 19 Fed. Rep., 263.
- 59913.** Knox, S. R. Nov. 20, 1866. Fluting Machine.
Reissue No. 3938, April 26, 1870.
Novelty and validity sustained, *Knox v. Loweree*, 1 Ban. & Ard., 589.
- 59915.** Lallement, P. Nov. 20, 1866. Velocipede.
Reissue No. 7972, Nov. 27, 1871.
Held invalid; right to reissue abandoned by delay, *Pope Mfg. Co. v. Marqua*, 15 Fed. Rep., 400.

59936. Roberts, E. A. L. Nov. 20, 1866. Method of Increasing Capacity of Oil Wells.

Construed and held not to be for a law of nature; is not anticipated by unsuccessful experiments; held novel and infringed, *Roberts v. Dickey*, 4 Brewster, 260. Construed broadly, in view of state of art, *Roberts v. Roter*, 5 Fish., 295.

Reissue No. 6258, Jan. 26, 1875.

Held novel; is not anticipated by abandoned experiment; is infringed, *Roberts v. Schreiber*, 2 Fed. Rep., 855. See, also, *Roberts v. Walley*, 26 O. G., 107.

60151. De Puy, A. T. Dec. 4, 1866. Printer's Galley.

Reissue No. 6326, March 9, 1875.

Patentee held first and original inventor; infringed by use of well known substitute, *Hoe & Co. v. Cole & Co.*, 13 O. G., 500. Patentee held first and original inventor; construed; sustained, and infringed by change of form and substitution of well known equivalent, *Hoe v. Tuthill*, 3 Ban. & Ard., 206.

60196. King, W. R. Dec. 4, 1866. Baling Press.

Construed to be for a combination, and infringed by substitution of well known equivalent, *King v. Louisville Cement Co.*, 6 Fish., 334.

60442. Tufts, O. Dec. 11, 1866. Elevator.

Tufts v. Boston Machine Co., 1 Holmes, 459.

60476. Chipman, G. W. Dec. 18, 1866. Carpet Lining.

Reissue No. 4066, July 12, 1870.

Construed and held infringed, *Chipman v. Wentworth*, 1 Holmes, 96.

60606. Woodbury, E. F. Dec. 18, 1866. Whip.

Construed, and sustained as for a patentable invention and not for a double use; is infringed, *Strong v. Noble*, 6 Blatch., 477.

60657. Decker, L. Dec. 18, 1866. Cushion for Billiard Table.

Reissue No. 3323, March 9, 1869.

Is for same invention as original; novel and infringed, *Decker v. Grote*, 10 Blatch., 331. Limited in view of state of art, and held infringed, *Decker v. Silverbrandt*, 13 Blatch., 187. See, also, *Decker v. Griffith*, 10 Blatch., 343 (note); *v. New York Belting & Packing Co.*, 6 Fish., 374.

1867.

61172. De Forest, T. B. Jan. 15, 1867. Binding for Skirt.

Construed; held valid and infringed, *Day v. Combination Rubber Co.*, 2 Fed. Rep., 570; *v. Schwab*, 2 Fed. Rep., 544.

61207. Jurgensen, J. Jan. 15, 1867. Stem-setting Watch.

Reissue No. 4334, April 11, 1871.

Construed, and held infringed, *Jurgensen v. Magin*, 9 Blatch., 294.

61480. Spafford, N. H. Jan. 22, 1867. Bristle Combing and Assorting.

Wilkins v. Spafford, 3 Ban. & Ard., 274.

61482. Stephenson, J. Jan. 22, 1867. Street Cars.

Reissue No. 6697, Oct. 11, 1875.

Construed to embody nothing in addition to what was shown in original model and drawing; sustained as for same invention as original, *Stephenson v. Second Avenue R. Co.*, 1 Fed. Rep., 416.

61628. Meyer, R. Jan. 29, 1867. Buckle-fastening.

Reissue No. 7129, May 23, 1876.

Held properly reissued, valid and infringed, *Schuessler v. Davis*, 13 O. G., 1011. Claims 2 and 3 construed, held novel and infringed, *Loercher v. Crandal*, 11 Fed. Rep., 872. See, also, *Metal Stamping Co. v. Crandall*, 18 O. G., 1531.

61680. Page, A. H. Jan. 29, 1867. Clothes Wringer.

Reissue No. 5223, Jan. 7, 1873.

Construed and limited in view of original to a combination including a swivel joint, and not infringed by omission of the joint, *Metropolitan Wringing Machine Co. v. Young*, 14 Blatch., 46.

61796. Bethea, J. C. Feb. 5, 1867. Plows.

Reissue No. 3094, Aug. 25, 1868.

Whitely v. Fisher, 4 Fish., 248.

61900. Warner, A. Feb. 5, 1867. Hub.

Reissue No. 5366, April 22, 1873.

Held to be for same invention as original; valid, and claims 1, 2, and 3 infringed, *Hall & Co. v. Jones*, 3 Ban. & Ard., 455.

62231. Steele, J. S. Feb. 19, 1867. Sand Box for Carriage Axles.

Construed to be for an old device used for same purpose with same result, without change

- in the application; held wanting in novelty, *Goodyear v. Hartford Spring Axle Co.*, 23 Fed. Rep., 36.
- 62232.** Stockbridge, C. H. Feb. 19, 1867. Stocks for Bits. Reissue No. 6350, March 23, 1875. Construed and held infringed by formal change, *Miller's Falls Co. v. Backus*, 5 Ban. & Ard., 53.
- 62342.** See 9th ¶ on this page.
- 62378.** Stevens, J. L. Feb. 26, 1867. Egg Transporting Case. Reissue No. 8091, Feb. 19, 1878. Sustained in view of original and held novel, *Coburn v. Schroeder*, 19 Blatch., 377. Is for a patentable invention; validity reaffirmed, *Ibid.*, 22 O. G., 1538. Held infringed, *Coburn v. Brainard*, 16 Fed. Rep., 412. See, also, *Coburn v. Shroeder*, 11 Fed. Rep., 425; *v. Clark*, 15 Fed. Rep., 804; *v. Shroeder*, 19 Blatch., 493; *McKay v. Wooster*, 2 Sawyer, 373.
- 62406.** Gosling, J. W. Feb. 26, 1867. Step Cover. Reissue No. 5644, Nov. 4, 1873. Construed in view of original; if broadly, is for a different invention, and wanting in novelty; not infringed if limited, *Gosling v. Roberts*, 106 U. S., 39.
- 62492.** King, G. E. Feb. 26, 1867. Fluting Machine. Reissue No. 3000, June 23, 1868. Sustained; infringed by change in location merely, *King v. Mandelbaum*, 8 Blatch., 468. Held novel; sustained and infringed, *Kursheedt v. Werner*, 12 Blatch., 530; *King v. Werner*, 12 Blatch., 270. Construed and held not infringed, *Werner v. King*, 96 U. S., 218. Reissue No. 3001, June 23, 1868. Sustained and held infringed, *King v. Mandelbaum*, 8 Blatch., 468. Held wanting in novelty, *King v. Werner*, 12 Blatch., 270.
- 62807.** Bardell & Smith. March 12, 1867. Coal Scuttle. Reissue No. 3138, May 18, 1869. Claim 1 construed and limited to location of parts, and not infringed by change in relative location producing a better result, *Habeman v. Whitman*, 5 Ban. & Ard., 530.
- 63104.** Schoerken. March 19, 1867. Match Box. Held anticipated by a prior French patent, *Schoerken v. Swift & Courtney Mfg. Co.*, 19 Blatch., 209.
- 63229.** De Witt, H. C. March 26, 1867. Burning Oil. *Patterson v. Kentucky*, 97 U. S., 506.
- 62342.** Howlett, E. J. Feb. 26, 1867. Tools for Manufacture of Paper Bags. Reissue No. 6050, Sept. 15, 1874. Claims 2 and 5 held to be for equivalent devices and wanting in novelty, *Union Paper Bag Machine Co. v. Atlas Bag Co.*, 6 Fed. Rep., 398.
- 63353.** Zwicki, C. March 26, 1867. Looms. Claims 1 and 2 construed; utility of claim 3 doubted, *Taft v. Steere*, 19 Fed. Rep., 600.
- 63418.** Morton, J. April 2, 1867. Water Tank for Railways. Reissue No. 5544, Aug. 19, 1873. Invalid for illegal affidavit to reissue petition, *Poage v. McGowan*, 15 Fed. Rep., 398.
- 63419.** Munson, F. April 2, 1867. Bond and Coupon Register. Held patentable, novel, useful; valid, and infringed, *Munson v. Mayor, etc., of New York*, 18 Blatch., 237. See, also, *Munson v. Mayor, etc., of New York*, 22 O. G., 586; 16 Fed. Rep., 560.
- 63480.** Carihfield, A. R. April 2, 1867. Lantern. Held not infringed, *Steam Gauge & Lantern Co. v. Miller*, 21 Fed. Rep., 514.
- 63770.** Weston, D. M. April 9, 1867. Centrifugal Machine. Reissue No. 2845, Jan. 14, 1868. Construed; claim 5 held novel and infringed, *Weston v. Nash*, 1 Holmes, 488.
- 63889.** Hawes, C. L. April 16, 1867. Hotel Register. Not void for prior public use, *Hawes v. Antisdell*, 2 Ban. & Ard., 10. Limited to claim and held infringed, *Hawes v. Gage*, 5 O. G., 494. Construed, *Hawes v. Washburn*, 5 O. G., 481. Sustained in view of prior adjudication, *Hawes v. Cook*, 5 O. G., 493.
- 63917.** McMillin, J. S. April 16, 1867. Capstans. Held not abandoned either as to application or invention; is novel, involves invention; patentee is first and original inventor; held to be infringed, *McMillin v. Barclay*, 5 Fish., 189. Construed and limited to specific combination, and held not infringed, *McMillin v. St. Louis & Vicksburgh Anchor Line*, 23 Fed. Rep., 169. Construed to be for analogous use involving mechanical skill only, *Morris v. McMillin*, 112 U. S., 244. Construed to be for method, and not invalidated by prior patent for a combination use in practicing the method granted the same patentee, *McMillin v. Rees*, 1 Fed. Rep., 722.

63924. Mitchell, J. L. April 16, 1867. Hotel Register.

Hawes *v.* Gage, 5 O. G., 494.

64347. Merrill, H. April 30, 1867. Steam Heating Apparatus.

Claims 1 and 2 held too vague and general; claim 1 literally for a function, construed to be for the means; claims 1, 2 and 3 limited and not infringed, Albany Steam Trap Co. *v.* Felthousen, 20 Fed. Rep., 633.

64404. Bostock, E. May 7, 1867. Sewing Machine Tuck-creaser.

Held novel and infringed by an improvement, Bostock *v.* Goodrich, 21 Fed. Rep., 316. Construed to be for improvements on old machines, *Ibid.*, 25 Fed. Rep., 819.

64410. Draper, D. A. May 7, 1867. Forming Letters, etc., on Type-block.

Reissue No. 3442, May 18, 1869.

Claim 2 construed to be for an old article made on a new machine, and not for a new art of manufacture; is invalid for want of invention. Claim 1 held not infringed, Draper *v.* Hudson, 1 Holmes, 208.

64437. Mee, B. May 7, 1867. Hose Coupling.

Claims 1 and 2 held novel, patentable and infringed, Westinghouse *v.* Gardner & R. Air Brake Co., 2 Ban. & Ard., 55.

64910. Schaefer, C. A. May 21, 1867. Sash Supporter.

Reissue No. 8672, April 15, 1879.

Construed, limited, and held not infringed, Judd *v.* Babcock, 8 Fed. Rep., 605.

65019. Simpson, G. B. May 21, 1867. Conductor.

Construed, in view of state of art, to be for patentable substitution involving more than mere mechanical skill, and is not for a mere double use. Held valid, Colgate *v.* Western Union Telegraph Co., 15 Blatch., 365. Novelty of invention sustained, Colgate *v.* Gold & Stock Telegraph Co., 16 Blatch., 305.

Held not infringed by use of substance known, but not as an equivalent, at the date of his patent, Colgate *v.* Law Telegraph Co., 5 Ban. & Ard., 437. See, also, Colgate *v.* International Ocean Telegraph Co., 17 O. G., 194; *v.* Compagnie Française du Telegraphe de Paris a New York, 23 Fed. Rep., 82; *v.* Gold & Stock Telegraph Co., 4 Ban. & Ard., 559; *v.* Western Union Telegraph Co., 19 Fed. Rep., 828; 4 Ban. & Ard., 562; 14 O. G., 943.

65186. Eames & Seely. May 28, 1867. Soap.

Reissue No. 5007, July 30, 1872.

Construed to be for a difference in degree, not involving invention, and held void, Buchan *v.* McKesson, 18 Blatch., 485.

65230. Irwin, J. H. May 28, 1867. Lamp.

Claim 1 construed in view of state of art; held novel and infringed, Irwin *v.* Dane, 9 O. G., 642. See, also, Irwin *v.* Dane, 2 Biss., 442.

65267. Pierson, Wm. H. May 28, 1867. Plastic Compound from Vegetable Fibres.

Held not anticipated by English patent of 1856, enrolled subsequent to date of patentee's invention. Held not abandoned, Celluloid Mfg. Co. *v.* Crofut, 33 O. G., 235.

65573. Hollingsworth, J. June 11, 1867. Horse Rake.

Construed and limited; claim 1 anticipated by patentee's prior patent, Dodds *v.* Stoddard, 17 Fed. Rep., 645.

65648. Craig, S. F. June 11, 1867. Well Tube.

Held novel, and infringed by same device in which wire was substituted for solder to hold the gauze, Craig *v.* Smith, 2 Dill., 375. Construed to be for a combination of old elements; limited, and not infringed by omission of one of its elements, *Ibid.*, 4 Dill., 349. See, also, Craig *v.* Smith, 100 U. S., 226.

65664. Gilbert, J. J. June 11, 1867. Starch Manufacturing Machinery.

Claim 3 construed as a double claim, for a combination of three elements, and for a process; sustained; the process held valid and the combination novel; is infringed, New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co., 18 Fed. Rep., 638. See, also, New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co., 20 Fed. Rep., 505; 32 O. G., 1356; *v.* Peoria Grape Sugar Co., 21 Fed. Rep., 878.

66065. Barbarin, A. June 25, 1867. Bale Ties.

Reissue No. 7388; Nov. 7, 1876.

Washburn & Moen Mfg. Co. *v.* Wilson, 19 Fed. Rep., 233.

66130. Clark, J. B. June 25, 1867. Manufacture of Blanks for Carriage Thills.

Reviewed, in view of state of art, and held not infringed, Clark *v.* Beecher Mfg. Co., 7 Fed. Rep., 816; 31 O. G., 1169.

66182. Smith, L. B. June 25, 1867. Barbed Fence Wire.

Reissue No. 7136, May 23, 1876.

Held wanting in invention, Washburn & Moen Mfg. Co. *v.* Haish, 10 Biss., 65. See,

- also, Washburn & Moen Mfg. Co. *v.* Crowell, 1 Fed. Rep., 225; Iowa Barbed Steel Wire Co., *In re*, 5 Ban. & Ard., 279.
- 66316.** Forbes, J. July 2, 1867. Skate.
Turrell *v.* Bradford, 23 O. G., 1623.
- 66578.** Fulghum, J. P. July 9, 1867. Grain-drill.
Construed; limited, and not infringed, Grain Drill Manufacturer's Co. *v.* Rude, 23 Fed. Rep., 348.
- 66773.** Averill, D. R. July 16, 1867. Paint Compound.
Reissue No. 7031, April 4, 1876.
Held void for new matter, Averill Chemical Paint Co. *v.* National Mixed Paint Co., 9 Fed. Rep., 462.
- 66938.** Blair, J. B. July 23, 1867. Rubber Head for Lead Pencils.
Held wanting in invention and void, Rubber Tip Pencil Co. *v.* Howard, 9 Blatch., 490.
Construed and held void for want of novelty, Rubber Tip Pencil Co. *v.* Howard, 20 Wall., 498.
- 67046.** Hall, J. L. July 23, 1867. Safe Doors.
Claim 3 held to have been in public use and on sale for more than two years prior to date of application; held wanting in novelty and in invention, Hall *v.* Macneale, 107 U. S., 90.
- 67117.** Hunt, W. D. July 23, 1867. Barbed Fence Wire.
Reissue No. 6976, March 7, 1876.
Construed and compared with original; claim limited to invention shown therein, and sustained, Washburn & Moen Mfg. Co. *v.* Haish, 10 Biss., 83. Held novel in view of state of art, useful, valid, and infringed, *Ibid.*, 10 Biss., 63. See, also, Washburn & Moen Mfg. Co. *v.* Crowell, 1 Fed. Rep., 225; Iowa Barbed Steel Wire Co., *In re*, 5 Ban. & Ard., 279.
- 67222.** Sherman, J. H. July 30, 1867. Rolling Coulters.
Held not infringed, Manny *v.* Oyler, 16 Fed. Rep., 658.
- 67283.** Frost, C. H. July 30, 1867. Stove.
Reissue No. 5894, June 2, 1874.
Claims 4 and 11 held invalid for aggregation and want of invention, Perry *v.* Co-operative Foundry Co., 12 Fed. Rep., 436.
- 67398.** Bailey, L. Aug. 6, 1867. Bench Plane.
Reissue No. 6498, June 22, 1875.
Claims 3 and 4 construed, held novel and infringed, Stanley Rule & Level Co. *v.* Bailey, 14 Blatch., 510.
- 67470.** Weston, T. A. Aug. 6, 1867. Pulley.
Sustained; application held not abandoned, Weston *v.* White, 13 Blatch., 448. Term held limited by prior foreign patent to patentee, *Ibid.*, 13 Blatch., 364.
- 67642.** Garretson, O. S. Aug. 13, 1867. Mop-head.
Taylor *v.* Garretson, 9 Blatch., 156; Garretson *v.* Clark, 14 O. G., 485; 111 U. S., 120.
- 68248.** Smith & Denniston. Aug. 27, 1867. Stone Crusher.
Held wanting in patentable invention; claim 1 is for patentable subject-matter, Smith *v.* Frazer, 5 Fish., 543.
- 68282.** Brown, C. Aug. 27, 1867. Baling Hay.
Validity doubted, as being for the application of a well known process to an analogous object, Faulks *v.* Kamp, 17 Blatch., 432. See, also, Faulks *v.* Kamp, 10 Fed. Rep., 675.
- 68322.** Hyatt, T. Aug. 27, 1867. Illuminating Roofs.
Reissue No. 9883, Sept. 27, 1881.
Decreed invalid for claims broader than original, and for delay in reissuing, Hyatt *v.* Southworth, 15 Fed. Rep., 751. See, also, Lake *v.* Fitzgerald, 6 Fish., 420.
- 68361.** Goldwaith, J. F. Sept. 3, 1867. Shoe Buttoner.
Brooks *v.* Moorehouse, 3 Ban. & Ard., 229.
- 68426.** Everest, B. H. Sept. 3, 1867. Apparatus for Distilling Petroleum.
Claims 1 and 12 void for want of novelty, Vacuum Oil Co. *v.* Buffalo Lubricating Oil Co., 23 Fed. Rep., 891.
- 68446.** Konold, C. Sept. 3, 1867. Die for Swaging, etc.
Held novel and not invalidated by doubtful evidence of priority of invention, Konold *v.* Klein, 3 Ban. & Ard., 226.
- 68595.** Bickford, D. Sept. 10, 1867. Knitting Machine.
Held novel and infringed, Bickford *v.* Laporte, 2 Fed. Rep., 214.
- 68633.** Magoun, J. Sept. 10, 1867. Mold for making Glass Goblets.
Magoun *v.* New England Glass Co., 3 Ban. & Ard., 114.
- 68656.** Salgee, O. Sept. 10, 1867. Hose Coupling.
Held infringed, Watson *v.* Smith, 7 Fed. Rep., 350.

- 68674.** Wheeler, L. H. Sept. 10, 1867. Wind-mill.
Reissue No. 8826, July 29, 1879.
Construed and held not infringed, *Eclipse Wind-mill Co. v. May*, 17 Fed. Rep., 344.
- 68808.** Tucker, W. C. Sept. 10, 1867. Carriage Axles.
Reissue No. 8719, May 20, 1879.
Construed and limited in view of original and state of art, and held not infringed, *Ives v. Hartford Spring & Axle Co.*, 11 Fed. Rep., 510.
- 69176.** Campbell, Wm. Sept. 24, 1867. Curtain Fixture.
Reissue No. 7367, Oct. 31, 1876.
Held valid, the delay in reissuing having arisen from actual mistake developed by testimony in a suit, and being that from which no innocent person could have suffered, *Hartshorn v. Eagle Shade Roller Co.*, 18 Fed. Rep., 90.
- 69255.** Schröder, J. Sept. 24, 1867. Cultivator.
Reissue No. 7497, Feb. 6, 1877.
Construed and limited to a combination of old elements, and held not infringed, *Pattee v. Moline Plow Co.*, 10 Biss., 377.
- 69629.** Cleveland, C. H. Oct. 8, 1867. Suspender.
Construed, *Cleveland v. Towle*, 3 Fish., 525.
- 69713.** Shireman, J. H. Oct. 8, 1867. Horse Hay-rake.
Reissue No. 7988, Dec. 11, 1877.
Held novel, patentable; for same invention as original, and is infringed, *Wisner v. Dodd*, 2 Fed. Rep., 781. Construed to be for a novel combination; claims 4, 5 and 6 sustained, *Wisner v. Grant*, 7 Fed. Rep., 485. Construed to be for a novel combination with new mode of operation; claim 2 is not for a patentable combination in view of state of art; claims 4, 5 and 6 infringed, *Wisner v. Grant*, 5 Ban. & Ard., 215.
- 69789.** Flood, E. F. Oct. 15, 1867. Wagon Reach.
Construed to be for change of form not involving patentable invention, and held wanting in novelty, *Flood v. Hicks*, 2 Biss., 169.
- 70063.** Allen, E. Oct. 22, 1867. Mechanical Movement.
Hill v. Whitcomb, 1 Holmes, 317.
- 70075.** Curtis & Worden. Oct. 22, 1867. Whip Socket.
Reissue No. 8581, Feb. 18, 1879.
Sustained; patentees held joint inventors; not anticipated by abandoned experiment; claim 4 void for new matter and want of invention, *Worden v. Fisher*, 11 Fed. Rep., 505. Claims 1, 2 and 3 construed; held valid and infringed in conformity with above, *Worden v. Searls*, 21 Fed. Rep., 406. See, also, *Searls v. Worden*, 21 O. G., 1955.
- 70309.** Wyman, H. Oct. 29, 1867. Shuttle Box Mechanism for Looms.
Reissue No. 6567, July 27, 1875.
Construed to be for a new combination of new parts, and not infringed by use of old parts common to it and to prior machines, *Crompton v. Knowles*, 7 Fed. Rep., 204.
- 70324.** Dike, S. Oct. 29, 1867. Truss and Supporter.
Held to differ in degree only from prior inventions, and is wanting in novelty, *Elastic Truss Co. v. Page*, 4 Ban. & Ard., 328.
- 70627.** Scott, E. W. Nov. 5, 1867. Whip Socket.
Reissue No. 5400, March 6, 1873.
Construed and held valid in view of original and state of art; infringed by patentable improvement embracing the invention, *Searls v. Van Nest*, 3 Ban. & Ard., 121. Construed in view of drawings and specification to be for same invention as original; held novel, valid and infringed, *Searls v. Worden*, 11 Fed. Rep., 501.
- 70728.** Lockwood, J. K. Nov. 12, 1867. Circular Saw.
Reissue No. 8076, Feb. 5, 1878.
Construed to be for a different invention from original and held void, *Curtis v. Branch*, 5 Ban. & Ard., 189.
- 70773.** Allen, E. Nov. 12, 1867. Printing Press.
Hill v. Whitcomb, 1 Holmes, 317.
- 71241.** Stewart, T. B. Nov. 19, 1867. Car Axle Boxes.
Reissue No. 3243, Dec. 22, 1868.
Claim 1, if broadly construed, is wanting in novelty; not infringed if limited, *Baltimore Car Wheel Co. v. North Baltimore Passenger R'y Co.*, 21 Fed. Rep., 47.
- 71244.** Thatcher, J. M. Nov. 19, 1867. Air-heating Furnace.
Construed, held novel, and not infringed, *Thatcher Heating Co. v. Spear*, 1 Fed. Rep., 411. Construed, held novel, patentable, and infringed, *Thatcher Heating Co. v. Carbon Stove Co.*, 4 Ban. & Ard., 68.

- 71560.** Watt, G. Nov. 26, 1867. Plow.
Reissue No. 3609, Aug. 17, 1869.
Watt *v.* Starke, 17 O. G., 1092.
- 71643.** Richardson, G. B. Dec. 3, 1867. Salt Bottle Caster.
Construed to be an improvement upon and infringement of Crossman's patent, Star Salt Caster Co. *v.* Crossman, 4 Cliff., 568. Infringed, *Ibid.*, 3 Ban. & Ard., 281; Star Salt Caster Co. *v.* Alden, 10 Fed. Rep., 555.
- 71680.** Barry, C. Dec. 3, 1867. Machine for making Tin Cans.
Reissue No. 3143, Oct. 6, 1868.
Claim 3 construed and limited in view of specification, and held wanting in novelty, Barry *v.* Gugenheim, 5 Fish., 452.
- 71873.** Harris, J. Dec. 10, 1867. Car Axle Boxes.
Reissue No. 9881, Sept. 27, 1881.
Claim 3 held void and abandoned by delay in reissuing, Baltimore Car Wheel Co. *v.* North Baltimore Passenger R'y Co., 21 Fed. Rep., 47.
- 72061.** Martin, E. & P. E. Dec. 10, 1867. Process for refining and converting Cast Iron into Cast Steel.
Hewitt *v.* Pennsylvania Steel Co., 31 O. G., 1687.
- 72110.** Stow, H. W. Dec. 10, 1867. Pavement.
Reissue No. 3274, Jan. 19, 1869.
Void in part for want of novelty, Stow *v.* City of Chicago, 8 Biss., 47. Claims 1 and 3 construed, limited, and held wanting in novelty in view of state of art, *Ibid.*, 104 U. S., 547.
- 72324.** Pauly, W. Dec. 17, 1867. Comb.
India Rubber Co. *v.* Phelps, 8 Blatch., 85.
- 72360.** Brady, E. L. Dec. 17, 1867. Dredge-boat.
Reviewed, not anticipated, sustained, and held infringed, Brady *v.* Atlantic Works, 4 Cliff., 408. Held to involve mechanical skill only, and wanting in patentable novelty, Atlantic Works *v.* Brady, 107 U. S., 192. See, also, Brady *v.* Atlantic Works, 3 Ban. & Ard., 577.
- 72505.** Kirby, J. Dec. 24, 1867. Bung Cutter.
Held not infringed, Kirby Bung Mfg. Co. *v.* White, 1 McCrary, 155. See, also, Kirby *v.* Armstrong, 10 Biss., 135.
- 72946.** Webb, R. L. Dec. 31, 1867. Reversible Locks and Latches.
Patentee held first and original inventor; is not an abandoned experiment, and was not abandoned, Russell & Erwin Mfg. Co. *v.* Mallory, 10 Blatch., 140. Construed, and held infringed by use with supperadded device, Russell & Erwin Mfg. Co. *v.* Corbin, 12 Blatch., 36.

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- 72988.** Eaton, J. S. Jan. 7, 1868. Trunk.
Maier *v.* Brown, 17 Fed. Rep., 736.
- 73012.** Irwin, J. H. Jan. 7, 1868. Lamp.
Construed in view of state of art; held novel and infringed, Irwin *v.* Dane, 9 O. G., 642. Infringed *prima facie*, *Ibid.*, 2 Biss., 442.
Reissue No. 8611, March 4, 1879.
Considered, Steam Gauge & Lantern Co. *v.* Miller & Co., 8 Fed. Rep., 314. Held not infringed, *Ibid.*, 21 Fed. Rep., 514.
- 73255.** Morse, Wm. A. Jan. 14, 1868. Pens.
Examined and held infringed, Morse Fountain Pen Co. *v.* Esterbrook Steel Pen Mfg. Co., 3 Fish., 515.
- 73259.** Owens, J. A. Jan. 14, 1878. Starch Manufacture.
Reissue No. 9732, May 31, 1881.
Sustained, New York Grape Sugar Co. *v.* American Grape Sugar Co., 10 Fed. Rep., 835.
- 73279.** Amidon, C. H. Jan. 14, 1868. Bit Stock.
Construed; held not anticipated and is infringed, Miller's Falls Co. *v.* Ives & Co., 14 Blatch., 169.
- 73425.** Green, N. W. Jan. 14, 1868. Driven Wells.
Reissue No. 4372, May 9, 1871.
Construed to be for a patentable combination of old elements to apply a new idea, constituting a new and useful process; was not abandoned; patentee held first and original inventor, Andrews *v.* Carman, 13 Blatch., 307. Construed; held novel, useful and not abandoned, Andrews *v.* Wright, 3 Ban. & Ard., 329; *v.* Cross, 19 Blatch., 294. Construed and held not infringed, Andrews *v.* Long, 2 McCrary, 577. Held infringed, Andrews *v.* Creegan, 19 Blatch., 113; Green *v.* Gardner, 22 O. G., 683.
Sustained, in view of prior decisions, and held infringed, Andrews *v.* Eames, 15 Fed.

Rep., 109. Sustained, in view of prior decisions, and held novel, in view of conflicting evidence, *Green v. French*, 11 Fed. Rep., 591. Held to be for a different invention from original, wanting in novelty and abandoned, *Andrews v. Hovey*, 16 Fed. Rep., 387. See, also, *Green v. French*, 4 Ban. & Ard., 169; *v. Barney*, 19 Fed. Rep., 420; *Andrews v. Spear*, 4 Dill., 472; 2 Ban. & Ard., 602; *v. Denslow*, 14 Blatch., 182.

73524. Golay, S. Jan. 21, 1868. Millstone Dressing.

Claims 1 and 3 invalid and void, in view of interfering patent No. 38,670, *Gilmore v. Golay*, 3 Fish., 522.

73684. Wood, J. H. Jan. 21, 1868. Coal Wagon.

Claims construed to be for the separate old elements of the combination, and not for the combination; held wanting in novelty, *Delaware Coal and Ice Co. v. Packer*, 1 Fed. Rep., 851. Construed and held not infringed, *Ibid.*, 24 O. G., 1273.

Reissue No. 9368, Aug. 31, 1830.

Claim 1 held void for aggregation; claim 2 held to be for a novel and patentable combination, and not for an aggregation, *Wood v. Packer*, 17 Fed. Rep., 650.

73597. Crane, T. Jan. 28, 1868. Knitting Machine.

Reissue No. 7338, Oct. 31, 1876.

Decreed valid, *Franz & Pope Knitting Machine Co. v. Bickford*, 18 O. G., 734. Declared good, valid and infringed, *Franz & Pope Knitting Machine Co. v. Lamb Knitting Machine Mfg. Co.*, 19 O. G., 1000.

73938. Straus, L. Jan. 28, 1868. Apparatus for Cleaning Privies.

Held infringed, *Odorless Excavating Co. v. Lauman*, 12 Fed. Rep., 788; *v. McCauley*, 2 Ban. & Ard., 570.

73943. Allen, E. Feb. 4, 1868. Printing Press.

Hill v. Whitcomb, 1 Holmes, 317.

74068. Fischer, V. Feb. 4, 1868. Sheet Metal Molding Machine.

Claim 4 held infringed, *Fischer v. Neil*, 6 Fed. Rep., 89; *v. O'Shaughnessey*, 6 Fed. Rep., 92. Claims 2 and 4 construed, and held novel, *Fisher v. Wilson*, 16 Blatch., 220; *v. Hayes*, 19 Blatch., 26. See, also, *Fischer v. Hayes*, 16 Fed. Rep., 469; 22 Fed. Rep., 92; 22 Fed. Rep., 529; 20 O. G., 242; 20 O. G., 601; 20 O. G., 672.

74254. Bein & Ulrich. Feb. 11, 1867. Children's Carriage.

Held not anticipated by an imperfect experiment; is novel, and infringed by sale of part with intent to have it combined as in the patent, *Richardson v. Noyes*, 2 Ban. & Ard., 398.

74342. Graham, A. B. Feb. 11, 1868. Harvester.

Sustained as novel, and held infringed, *Graham v. McCormick*, 10 Biss., 39. Sustained in conformity with above; held infringed, *Graham v. Geneva Lake Mfg. Co.*, 11 Fed. Rep., 138.

74379. Kelly, M. Feb. 11, 1868. Barbed Fence Wire.

Reissue No. 6902, Feb. 9, 1876.

Construed; compared with original, and sustained, *Washburn & Moen Mfg. Co. v. Haish*, 10 Biss., 83. Held novel in view of state of art; valid and infringed, *Ibid.*, 10 Biss., 65. Construed in view of original; void for expanded claim and laches in reissuing, *Washburn & Moen Mfg. Co. v. Fuchs*, 16 Fed. Rep., 661. See, also, *Washburn & Moen Mfg. Co. v. Haish*, 9 Biss., 141; *v. Crowell & Co.*, 1 Fed. Rep., 225; *Iowa Barbed Steel Wire Co., In re*, 5 Ban. & Ard., 279.

74392. Mallory, G. Feb. 11, 1868. Hats.

Held to involve invention and is novel; claim construed and limited in order to be sustained, *Mallory Mfg. Co. v. Marks*, 11 Fed. Rep., 887. Construed in conformity with above and held not infringed, *Mallory Mfg. Co. v. Hickok*, 20 Fed. Rep., 116; *v. Hickok*, 25 Fed. Rep., 827.

74435. Shelton, C. R. Feb. 11, 1868. Whip Tip.

Reissue No. 7382, Nov. 7, 1876.

Construed and limited to particular device in order to be sustained; is not infringed, *American Whip Co. v. Hampden Whip Co.*, 1 Fed. Rep., 87.

74515. Davis, C. F. Feb. 18, 1868. Grain Drill.

Reissue No. 8589, Feb. 18, 1879.

Construed; held novel, valid and infringed, *Davis v. Brown*, 19 Blatch., 263.

74613. Shaw. Feb. 18, 1868. Lead Pipe.

Reissue No. 3744, Nov. 23, 1869.

Claim 2 construed; held novel, valid and infringed, *Shaw v. Colwell Lead Co.*, 11 Fed. Rep., 711.

74672. De Forest & Gilbert. Feb. 18, 1868. Spring for Hoop Skirt.

Construed and held infringed, *Young v. Lippman*, 9 Blatch., 277. See, also, *Young v. Lippman*, 2 O. G., 342.

- 74723.** Semple, E. Feb. 18, 1868. Trunk Fastening.
Reissue No. 8521, Dec. 10, 1878.
If broadly construed is invalid; not infringed, if limited, *Cowell v. Sessions*, 17 Fed. Rep., 450.
- 74862.** Stow, H. W. Feb. 25, 1868. Street Pavement.
Construed to be for non-patentable substitution of a new material, and held wanting in novelty, *Stow v. City of Chicago*, 8 Biss., 47.
- 75217.** Taylor, G. H. March 3, 1868. Exercise Apparatus.
Construed and held infringed; patentee held first and original inventor, *Taylor v. Wood*, 12 Blatch., 110.
- 75218.** Taylor, G. H. March 3, 1868. Exercise Apparatus.
Construed and held infringed; patentee held first and original inventor, *Taylor v. Wood*, 12 Blatch., 110.
- 75344.** Bailey, Jr., T. R. March 10, 1868. Hydrant.
Reissue No. 6990, March 14, 1876.
Claim 1 held to be for entirely new invention not claimed or suggested in original, and void for abandonment by delay in reissuing; claim 3 limited and held wanting in novelty, *Flower v. City of Detroit*, 22 Fed. Rep., 292.
- 75383.** Davis, J. S. March 10, 1868. Harvester.
Toledo Mower & Reaper Co. v. Johnston Harvester Co., 32 O. G., 1010.
- 76343.** Pfeil, J. C. Apr. 7, 1868. Rolling Coulters.
Reissue No. 4533, Aug. 29, 1871.
Construed and held wanting in novelty, *Manny v. Oyler*, 16 Fed. Rep., 658.
- 76394.** Brock, W. E. April 7, 1868. Dummies for Clothing.
Construed to be for a mere substitution of old material, for a cognate use, and held wanting in patentable novelty in view of state of art, *Palmenbing v. Buchholz*, 23 O. G., 632.
- 76491.** McFarland & Campbell. Apr. 7, 1868. Metal Tenon for Blind Slats.
Sustained and held infringed, *McFarland v. Spencer*, 23 Fed. Rep., 150.
- 76646.** McGill, Wm. C. Apr. 14, 1868. Conductor's Register.
Claim 1 construed and held wanting in novelty, *Railway Register Mfg Co. v. Highland St. R'y Co.*, 4 Ban. & Ard., 116.
- 76654.** Page, C. G. Apr. 14, 1868. Induction Coil and Circuit Breaker.
Reissue No. 4588, Oct. 10, 1871.
Claims 11, 12 and 13 construed; held valid and infringed; novelty sustained. Patent construed in view of the special act granting it, *Page v. Holmes Burglar Alarm Co.*, 17 Blatch., 484. See, also, *Page v. Holmes Burglar Alarm Co.*, 18 Blatch., 118; *Gamewell Fire Alarm Telegraph Co. v. City of Chilicothe*, 7 Fed. Rep., 351.
- 79651.** Johnson & Sumner. July 7, 1868. Lumber Drier.
Curren v. Burdsall, 27 O. G., 1319.
- 76760.** Holden, C. B. Apr. 14, 1868. Hay Rake.
Reissue No. 8475, Nov. 5, 1878.
Broad claim intended to be secured, held wanting in novelty, *Wisnor v. Grant*, 7 Fed. Rep., 922.
- 76773.** Johns, H. W. Apr. 14, 1868. Roofing Composition.
Reissue No. 5951, June 30, 1874.
Held to be for a different invention from that described in the original, *United States & Foreign Salamander Felting Co. v. Haven*, 3 Dill., 131.
- 76834.** Smith, E. J. Apr. 14, 1868. File Holder.
Reissue No. 4864, Apr. 9, 1872.
Held not infringed, *Smith v. Woodruff*, 1 MacArthur, 459.
- 76993.** Calahan, E. A. Apr. 21, 1868. Printing Telegraph.
Reissue No. 3810, Jan. 25, 1870.
Sustained as to sufficiency of reissue petition and oath; claim 3 held novel and infringed, *Gold and Stock Telegraph Co. v. Wiley*, 17 Fed. Rep., 234. Claim 2 construed in view of state of art; held not to enlarge the original claim, and is infringed. Term held not limited by English patent sealed five months after issue of the domestic patent, although filed at a date prior to such issue, *Gold and Stock Telegraph Co. v. Commercial Telegraph Co.*, 23 Fed. Rep., 340. See, also, *Gold and Stock Telegraph Co. v. Pearce*, 19 Fed. Rep., 419; *v. Commercial Telegraph Co.*, 22 Fed. Rep., 838.
- 77482.** Griffiths, H. S. May 5, 1868. Suspension Ring for Business Cards.
Reissue No. 5067, Sept. 24, 1872.
Construed, and held wanting in novelty, *Griffiths v. Holmes*, 8 Fed. Rep., 154.

- 77512.** Mershon, A. H. May 5, 1868. Damper for Hot Air Furnaces.
Reissue No. 4695, Jan. 2, 1872.
Mershon *v.* Pease Furnace Co., 32 O. G., 1011.
- 77706.** Arden, H. May 5, 1868. Car Elevator.
Reissue No. 7042, April 11, 1876.
Enlarged claims 1 to 7 held void for delay in reissuing; claims 8 to 12 not infringed,
Arden *v.* Jewett, 32 O. G., 1240.
- 77715.** Chabot, C. May 12, 1868. Sewing Machine.
Chabot *v.* American Button Hole, etc., Co., 6 Fish., 71.
- 77933.** Taylor, G. H. May 12, 1878. Exercise Apparatus.
Construed, and held infringed, Taylor *v.* Wood, 12 Blatch., 110.
- 77938.** Welling, Wm. M. May 12, 1868. Artificial Ivory.
Reissue No. 5940, June 30, 1874.
Construed, and limited in view of state of art, and held infringed, Welling *v.* La Bau,
12 Fed. Rep., 875.
- 78317.** Nobel, A. May 26, 1868. Explosive Compound.
Reissue No. 5799, March 17, 1874.
Novelty sustained, Atlantic Giant Powder Co. *v.* Parker, 16 Blatch., 281. Novelty and
validity sustained, and held infringed, Atlantic Giant Powder Co. *v.* Rand, 16 Blatch.,
250. Void for claim including new matter, Atlantic Giant Powder Co. *v.* California Vig-
orit Powder Co., 6 Sawyer, 508. Is for same invention as original; sustained and held not
infringed, Atlantic Giant Powder Co. *v.* Dittmar Powder Co., 17 Blatch., 531.
Construed and held infringed by substitution of an equivalent for one of the elements,
Ibid., 20 O. G., 1380. Construed; held not broader than original; sustained and infringed
by a patentable improvement in which an equivalent is substituted, Atlantic Giant Pow-
der Co. *v.* Mowbray, 12 O. G., III. Construed, held valid and infringed, Atlantic Giant
Powder Co. *v.* Goodyear, 3 Ban. & Ard., 161. See, also, Atlantic Giant Powder Co. *v.*
California Vigorit Powder Co., 98 U. S., 126; 5 Fed. Rep., 196.
Reissue No. 10,267, Jan. 9, 1883.
Not void for being reissued in identical form of original, Giant Powder Co. *v.* Safety
Nitro Powder Co., 19 Fed. Rep., 509.
- 78320.** Owens, J. A. May 26, 1868. Starch Tray.
Validity doubted, New York Grape Sugar Co. *v.* American Grape Sugar Co., 10 Fed.
Rep., 835. Construed to be for substitution of material not involving invention, New York
Grape Sugar Co. *v.* Buffalo Grape Sugar Co., 18 Fed. Rep., 638.
- 78644.** Chase, S. E. June 9, 1868. Finishing Nails.
Reissue No. 5207, Dec. 31, 1872.
Claim 2 held substantially the same as claim 1 of original. Sustained; held novel and
infringed. Globe Nail Co. *v.* U. S. Horse Nail Co., 19 Fed. Rep., 819.
- 78769.** Swan, J. June 9, 1868. Machine for making Curved Augers.
Reissue No. 5624, Oct. 21, 1873.
Construed; held novel; combination claim 1 held not infringed; claim 2, to the art,
infringed, Bruff *v.* Ives, 14 Blatch., 198.
- 78829.** Reedy, H. J. June 9, 1868. Hoisting Machines.
Reedy *v.* Scott, 23 Wall., 352.
- 78854.** Adair, W. June 16, 1868. Pump.
Adair *v.* Thayer, 20 O. G., 523.
- 78880.** Lemman, J. June 16, 1868. Band Saw Guide.
Construed and not infringed, Fay *v.* Cordesman Bros., 109 U. S., 408
- 78932.** Davis, W. June 16, 1868. Preserving Meat.
Reissue No. 3119, Sept. 15, 1868.
Claims held to be for different invention from original in view of ambiguous original
drawings, and void to that extent, Hammond *v.* Franklin, 22 Fed. Rep., 833.
- 78958.** Guillod, E. June 16, 1868. Construction of Drilling Jars.
Sustained as involving patentable invention, Dick *v.* Oil Well Supply Co., 25 Fed. Rep.,
105. See, also, Dick *v.* Struthers, 25 Fed. Rep., 103.
- 79279.** Taylor, H. June 23, 1868. Lubricator.
Patentee held prior inventor, notwithstanding an accidental prior making of a single
similar article by defendant, Pelton & Taylor *v.* Waters, 1 Ban. & Ard., 599.
- 79528.** Benson, S. June 30, 1868. Mill-gearing.
Gates *v.* Benson, Comm'r's Decisions for 1870, p. 65.
- 79534.** Mellen, G. H. June 30, 1868. Baby Jumper.
Sustained; claim 1 infringed, Tibbats *v.* Daby, 11 Fed. Rep., 903.
- 79661.** See ¶ 12, p. 785.

- 79958.** Crosby, R. R. July 14, 1868. Lamp Chimney.
Reissue No. 7659, May 8, 1877.
Sustained as novel, valid, and infringed, *Shirley v. Sanderson*, 8 Fed. Rep., 905. Held to be for a combination not claimed in the original and intentionally omitted therefrom; void for delay in reissuing, *Shirley v. Mayer*, 25 Fed. Rep., 38.
- 79989.** Lazear, H. Y. July 14, 1868. Gas Heater.
Construed and held novel, *Sharp v. Dover Stamping Co.*, 103 U. S., 250.
- 80121.** Bickford. July 21, 1868. Knitting Machine.
Reissue No. 6423, May 11, 1875.
Sustained as valid, in the absence of original in evidence; held novel and infringed, *Bickford v. Laporte*, 2 Fed. Rep., 214.
- 80235.** Stuart & Wenyss. July 21, 1868. Guard Plate for Stove.
Construed; held useful, novel, and infringed, *Stuart v. Schantz*, 6 Fish., 35.
- 80269.** Bostock, E. July 28, 1868. Sewing Machine Tuck-creaser.
Held novel and infringed by improvement, *Bostock v. Goodrich*, 21 Fed. Rep., 316. Construed to be for improvements on old machines, *Ibid.*, 25 Fed. Rep., 819.
- 80492.** Lewis, S. July 28, 1868. Still Water Dam.
Construed and held not infringed, *Cammeyer v. Newton*, 12 Blatch., 122; 94 U. S., 225.
Reissue No. 6249, Jan. 26, 1875.
Construed, and held to omit an essential element of the original, and to contain a combination claim not in the original; is void, *Ibid.*, 4 Ban. & Ard., 159.
- 80774.** Sladdin, J. Aug. 4, 1868. Machine for making Loom Harness.
Reissues Nos. 4509 and 4510, July 8, 1871.
Emmons v. Sladdin, 2 Ban. & Ard., 199.
- 81010.** Roots, P. H. & F. M. Aug. 11, 1868. Cases for Rotary Blowers.
Reissue No. 3570, July 27, 1869.
Construed; sustained, and held infringed, *Hyndman v. Root*, 97 U. S., 224. Liberally construed; held novel, and infringed by use of a readily-adopted and well-known substitute, *Root v. Hyndman*, 6 Fish., 439.
- 81132.** Brickill, W. A. Aug. 18, 1868. Feed Water Heater.
Construed and sustained, *Brickill v. City of New York*, 18 Blatch., 273.
- 81432.** Tarrent, E. Aug. 25, 1868. Turning Machine.
Reissue No. 5487, July 15, 1873.
Claim construed to be for a different invention from original, and void, *Torrent & Arms Lumber Co. v. Rodgers*, 112 U. S., 659.
- 81743.** Broadnax. Sept. 1, 1868. Apparatus for Rendering Lard.
Reissue No. 5925, June 23, 1874.
Construed and limited in view of state of art, and held not infringed, *Broadnax v. Central Stock Yard & Transit Co.*, 4 Fed. Rep., 214.
- 81888.** Gilbert, C. Sept. 8, 1868. Starch Separator.
Sustained, *New York Grape Sugar Co. v. American Grape Sugar Co.*, 10 Fed. Rep., 835.
Declared valid, *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 Fed. Rep., 638.
See, also, *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 20 Fed. Rep., 505; 32 O. C., 1356; *v. Peoria Grape Sugar Co.*, 21 Fed. Rep., 878.
- 81948.** Roach, F. Sept. 8, 1868. Self-closing Faucet.
Reissue No. 7571, March 27, 1877.
Held not infringed, *Zane v. Peck*, 9 Fed. Rep., 101.
- 82262.** Wintergerst, C. Sept. 15, 1868. Vapor Burner.
Reissue No. 8784, July 1, 1879.
Held invalid for expansion of original invention and changed claims, *Doane & Wellington Mfg. Co. v. Smith*, 15 Fed. Rep., 459.
- 82580.** Babcock, F. Sept. 29, 1868. Window Sash Holder.
Construed and limited to a combination of old elements, and held novel and infringed, *Babcock v. Judd*, 1 Fed. Rep., 408.
Reissue No. 9301, July 20, 1880.
Claim 3 held not infringed by the substitution of a new element in the combination of old elements, *Ibid.*, 15 Fed. Rep., 160.
- 82606.** Crouch, G. Sept. 29, 1868. Shawl Strap.
Reissue No. 4289, March 7, 1871.
Construed to be for improvement in degree by substitution of a well known equivalent, and held void for want of invention and novelty, *Crouch v. Roemer*, 103 U. S., 797. Void for prior knowledge and use, *Crouch v. Roemer*, 2 Ban. & Ard., 637. Sustained as useful and novel; claims 1 and 2 infringed, *Crouch v. Speer*, 1 Ban. & Ard., 145.

83283. Huie, H. R. Oct. 20, 1868. Gang Plow.

Construed to be for a combination of old elements, *Carter v. Baker*, 1 Sawyer, 512.

83497. Hicks, P. Oct. 27, 1868. Wagon Reach.

Construed to be for a mere substitution of material, not involving invention, *Hicks v. Kelsey*, 18 Wall., 670.

83909. Bonnaz, A. Nov. 10, 1868. Sewing Machines for Embroidering.

Infringement found, *Cornely v. Hendrickx*, 12 O. G., 431.

83910. Bonnaz, A. Nov. 10, 1868. Sewing Machines for Embroidering.

Infringement found, *Cornely v. Hendrickx*, 12 O. G., 431. Held not invalid because its prior French patent had been adjudged invalid abroad, *Cornely v. Marckwald*, 17 Fed. Rep., 83.

83924. Cabell, S. G. Nov. 10, 1868. Fluting Machine.

Reissue No. 4653, Nov. 28, 1871.

Novelty and validity sustained; claims 1 and 2 infringed, *Knox v. Loweree*, 1 Ban. & Ard., 589.

83925. Cahill, M. S. Nov. 10, 1868. Bronzing Leather.

Construed; held useful, properly described, novel, and not anticipated by certain vague formulæ; is valid and infringed, *Cahill v. Brown*, 3 Ban. & Ard., 580. Held, in view of state of art to be for a new and useful invention; is sufficiently described, and infringed, *Cahill v. Beckford*, 1 Holmes, 48.

84062. Kelly, M. Nov. 17, 1868. Barbed Fence Wire.

Reissue No. 7035, April 4, 1876.

Held wanting in invention, *Washburn & Moen Mfg. Co. v. Haish*, 10 Biss., 65.

Reissue No. 7036, April 4, 1876.

Washburn & Moen Mfg. Co. v. Crowell, 1 Fed. Rep., 225; *Iowa Barbed Steel Wire Co., In re*, 5 Ban. & Ard., 279.

84517. Terry, S. B. Dec. 1, 1868. Pallets of Clock Escapements.

Held to involve invention in view of state of art, and sustained, *Terry Clock Co. v. New Haven Clock Co.*, 3 Ban. & Ard., 232. Construed to be broader than the invention, and wanting in novelty, *Ibid.*, 4 Ban. & Ard., 121.

84803. Davis, T. B. Dec. 8, 1868. Scoops.

Construed; held to involve invention, and not invalid for public use more than two years prior to date of application instituted without inventor's consent (acts 1836 and 1839), *Davis v. Fredericks*, 19 Fed. Rep., 99.

85374. Estabrook, J. M. Dec. 29, 1868. Screw Peg for Boots and Shoes.

Construed and limited in view of state of art in order to be sustained; not infringed as limited, *Estabrook v. Dunbar*, 2 Ban. & Ard., 427.

85472. Patric, C. E. Dec. 29, 1868. Grain Drill.

Reissue No. 6274, Feb. 2, 1875.

Construed; limited, and not infringed. *Grain Drill Manufacturer's Co. v. Rude*, 23 Fed. Rep., 348.

1869.

85526. Hinckel, F. Jan. 5, 1869. Washing Shavings.

Reissue No. 8099, Feb. 26, 1878.

Construed, in view of state of art, to be for a new combination of old parts and not for a process; is for same invention as original; novel, and infringed, *Brainard v. Cramme*, 12 Fed. Rep., 621.

85598. Lewis, S. Jan. 5, 1869. Adjustable Still Water Dam.

Cammeeyer v. Newton, 12 Blatch., 122.

85602. Morris, A. Jan. 5, 1869. Excavator.

Morris v. Shelbourne, 8 Blatch., 266.

85814. Guidet, C. Jan. 12, 1869. Pavement.

Reissue No. 4106, Aug. 23, 1870.

Held to be for a patentable invention, *Guidet v. Barber*, 5 O. G., 149. Held invalid for prior public use of device differing in degree only, *Guidet v. City of Brooklyn*, 3 Ban. & Ard., 291. Construed to be for improvement in degree, involving mechanical skill only and not invention; held void, *Ibid.*, 105 U. S., 550. See, also, *Guidet v. Palmer*, 10 Blatch., 217.

85963. Richardson, G. W. Jan. 19, 1869. Safety Valve.

Construed and limited in view of state of art, and not infringed as limited, *Consolidated Safety Valve Co. v. Kunkle*, 14 Fed. Rep., 732; *v. Crosby*, 7 Fed. Rep., 768. Held valid, novel and infringed, *Consolidated Safety Valve Co. v. Crosby Steam Gauge & Valve Co.*, 113 U. S., 157.

- 86112.** Sturges, R. C. Jan. 19, 1869. Harness Saddle Pad.
Held novel, *American Saddle Co. v. Hogg*, 1 Holmes, 177.
- 86115.** Van Marter, B. P. Jan. 19, 1869. Tub for Distilling Oils.
Reissue No. 3612, Aug. 17, 1869.
Construed and limited in view of state of art, and held not infringed, *Van Marter v. Miller*, 15 Blatch., 562.
- 86152.** Hancock, J. T. Jan. 26, 1869. Boiler Injector.
Not invalid because of attorney's oath in place of patentee's to amended specification (act 1836). Claims construed to be for combinations involving invention, and not for aggregations, and are sufficiently described in the specification. Held novel, useful and infringed, *Hancock Inspirator Co. v. Jenks*, 21 Fed. Rep., 911. See, also, *Hancock Inspirator Co. v. Jenks*, 19 Fed. Rep., 918.
- 86440.** Peard, J. Feb. 2, 1869. School Desks.
Claim 2 limited in view of state of art, and not infringed, *Peard v. Johnson*, 23 Fed. Rep., 507.
- 86549.** Irwin, J. H. Feb. 2, 1869. Lamp.
Construed, and held novel, *Irwin v. Dane*, 9 O. G., 642. See, also, *Irwin v. Dane*, 2 Biss., 442.
- 86841.** Kendall & Trested. Feb. 9, 1869. Coating Compound.
Held not infringed, *Baldwin v. Shultz*, 9 Blatch., 494.
- 87163.** Geier, P. Feb. 23, 1869. Rendering Wooden Bungs Impervious.
Construed and sustained, *Geir v. Goetinger*, 1 Ban. & Ard., 553.
- 87241.** Burdett, R. Feb. 23, 1869. Reed Organ.
Claim 1 construed and held novel; claim 2 held useful, patentable, and infringed; claim 4 held to be for an adaptation wanting in invention and novelty, *Burdett v. Estey*, 15 Blatch., 349. Claim 2 construed and held not infringed, *Ibid.*, 16 Blatch., 105. Construed, limited, and not infringed, *Estey v. Burdett*, 109 U. S., 633. See, also, *Burdett v. Estey*, 19 Blatch., 1.
- 87359.** Palmer, H. L. March 2, 1869. Apparatus for Lining Paper Board.
Reissue No. 8883, Sept. 2, 1879.
Construed to be for a combination of old elements, and not infringed by use of part only of the combination, *Faurot v. Hawes*, 3 Fed. Rep., 456.
- 87413.** Holly, B. March 2, 1869. Water Supply Regulator.
Reissue No. 5132, Nov. 5, 1872.
Claim 1 limited to original and sustained, *Holly v. Union City*, 14 O. G., 5. Claim construed to be for a combination and not for a principle; held novel, valid, and infringed by use with an improvement, *Holly v. Vergennes Machine Co.*, 18 Blatch., 327.
- 87628.** Brown, A. P. March 9, 1869. Wind Wheel.
Continental Windmill Co. v. Empire Windmill Co., 8 Blatch., 295.
- 87853.** Kappes, J. G. March 16, 1869. Mosaic Floor.
Construed to be for mechanical skill not involving invention; novelty doubted, *Kappes v. Hartung*, 23 Fed. Rep., 187.
- 87950.** Marinoni, A. H. March 16, 1869. Printing Press.
Held novel, useful and patentable; claim 3 construed to be for a combination in which the result is the product of the successive action of all the elementary parts; is infringed, *Hoe v. Cottrell*, 17 Blatch., 546.
- 88216.** Rutter, J. W. March 23, 1869. Ore and Stone Crusher.
Reissue No. 3633, Sept. 7, 1869.
Not void for laches in reissuing; claim 1 is for same invention as original; construed in view of model, and held infringed, *Frazer v. Gates & Scoville Iron Works*, 23 Fed. Rep., 439.
- 88287.** Fischer, L. March 30, 1869. Vapor Burner.
Reissue No. 7706, May 29, 1877.
Construed, held novel, sustained, and is not infringed, *Watkins v. City of Cincinnati*, 8 Fed. Rep., 325.
- 88318.** McGregor & Voll. March 30, 1869. Sash Fastener.
Reissue No. 6693, Oct. 11, 1875.
Construed and limited in view of prior inventions of one of the joint patentees, *Hopkins & Dickinson Mfg. Co. v. Corbin*, 14 Blatch., 396. Construed and limited in order to be sustained, and held not infringed, *Ibid.*, 103 U. S., 786.
- 88365.** Carstaedt. March 30, 1869. Take-up Mechanism for Looms.
Reissue No. 5150, Nov. 19, 1872.
Claims construed, limited, and held novel; claim 2 infringed, *Carstaedt v. United States Corset Co.*, 13 Blatch., 119. Infringed by substitution of an equivalent having additional functions, *Ibid.*, 13 Blatch., 371.

- 88413.** Robinson, J. G. March 30, 1869. Gang Plow.
Combination claim 1 construed and held invalid in view of state of art, and anticipated by devices which might lack some of the elements, but supplying them by the peculiar structure of other elements, *Gilbert v. Weir Plow Co.*, 22 Fed. Rep., 428.
- 88557.** Eichholtz, M. Apr. 6, 1869. Cultivator.
Reissue No. 7738, June 12, 1877.
Construed and limited to combination of old elements, and held not infringed, *Pattee v. Moline Plow Co.*, 10 Biss., 377.
- 88660.** O'Neil, A. Apr. 6, 1869. Sheet Copper Boiler.
Reissue No. 7913, Oct. 16, 1877.
Construed, and held not infringed by a process which omits one of its steps and substitutes another and different step, *Cotter v. New Haven Copper Co.*, 23 O. G., 740.
- 88765.** De Golyer. Apr. 6, 1869. Block Pavement.
Held wanting in novelty, *Stow v. City of Chicago*, 8 Biss., 47.
- 88830.** Andrews & Ogden. Apr. 13, 1869. Cheese Manufacture.
Reissue No. 6117, Nov. 3, 1874.
Hubbell v. De Land, 22 O. G., 1883.
- 88844.** Miles, D. Apr. 13, 1869. Extinguishing Fires.
Reissue No. 4994, July 16, 1872.
Claim 1 anticipated by prior invention; not novel, *Northwestern Fire Extinguisher Co. v. Phila. Fire Extinguisher Co.*, 1 Ban. & Ard., 177.
- 88929.** Westinghouse, Jr., G. April 13, 1869. Car Brake.
Reissue No. 5504, July 29, 1873.
Held valid, patentable and novel; claims 1 and 7 infringed, *Westinghouse v. Gardner*, etc., *Air Brake*, 2 Ban. & Ard., 55.
- 88971.** Matthews, E. G. April 13, 1869. Seeder and Planter.
Claim 1 construed to be for non-patentable substitution of material; claims 5 and 7 held infringed, *Holbrook v. Small*, 2 Ban. & Ard., 396. See, also, *Holbrook v. Small*, 3 Ban. & Ard., 625.
- 89025.** Carroll, W. T. April 20, 1869. Spinning Frame.
Reissue No. 6386, April 20, 1875.
Held valid, and not abandoned by prior sale of incomplete invention, *Draper v. Wattles*, 3 Ban. & Ard., 618.
- 89233.** Morgan, Jr., R. P. April 20, 1869. Elevated Railway.
Limited to particular devices, and held not infringed, *Morgan Elevated R'y Co. v. Pullman*, 14 Fed. Rep., 648.
- 89304.** Fulton, C. April 27, 1869. Stove.
Reissue No. 9252, June 15, 1880.
Claim 1 construed to be for a difference in degree, not involving invention, and is invalid, *Perry v. Co-operative Foundry Co.*, 12 Fed. Rep., 149.
- 89531.** Welling, Wm. M. April 27, 1869. Artificial Ivory.
Construed to be for the substitution in an old combination for an inert material of another equivalent inert material, and held wanting in invention, *Welling v. Crane*, 21 Fed. Rep., 707.
- 89620.** Bevin, A. G. May 4, 1869. Metallurgic Furnace.
Held to involve invention and utility; void for public use for more than two years prior to date of application, *Bevin v. East Hampton Bell Co.*, 5 Fish., 23.
- 89646.** Fisher, C. J. May 4, 1869. Horse Collar Pad.
If construed broadly is wanting in novelty; not infringed, if limited, *Voss v. Fisher*, 113 U. S., 213.
- 89770.** Irwin, J. H. May 4, 1869. Lamp.
Construed; held novel and infringed, *Irwin v. Dane*, 9 O. G., 642.
Reissue No. 8598, Feb. 25, 1879.
Held infringed, *Steam Gauge & Lantern Co. v. Miller*, 8 Fed. Rep., 314. Construed, and held not infringed, *Ibid.*, 21 Fed. Rep., 514. See, also, *Steam Gauge & Lantern Co. v. Miller*, 11 Fed. Rep., 718; *Irwin v. Dane*, 2 Biss., 442.
- 90143.** Wineman, P. May 18, 1869. Pump.
Reissue No. 7006, March 21, 1876.
Construed without reference to obvious error consisting in incorrect lettering of drawing, and held not infringed by a similar tube with a single flare in place of the two flares of the patent. *National Pump Cylinder Co. v. Simmons Hardware Co.*, 18 Fed. Rep., 324.
- 90268.** Ingels, J. May 18, 1869. Grain Drill.
Reissue No. 3976, May 17, 1870.
Sustained and held novel, *Ingels v. Mast*, 6 Fish., 415. See, also, *Ingels v. Mast*, 1 Flip., 424.

- 90284.** Merrill, J. May 18, 1869. Hydrocarbon Oils.
Construed to be for product of the described process, and not infringed as limited by a similar product of a different process, *Merrill v. Yeoman*, 1 Holmes, 331. Construed to have properly described and claimed a process, and not its product, *Ibid.*, 94 U. S., 568.
- 90334.** Atwood, J. May 25, 1869. Curing Fish.
Construed to be for a patentable improvement in the art, *Crowell v. Harlow*, 1 Fed. Rep., 140. Construed, and limited to process for curing fish, and not infringed by a like process used after the fish were cured, *Crowell v. Beardsley*, 12 Fed. Rep., 627. See, also, *Crowell v. Harlow*, 3 Ban. & Ard., 478; *v. Parmenter*, 3 Ban. & Ard., 480.
- 90443.** Gradewitz, S. May 25, 1869. Composition for Artificial Ivory.
Void for want of novelty, *Olendorf v. Eckler*, 2 Fed. Rep., 570.
- 90584.** Roberts, J. May 25, 1869. Step Cover.
Gosling v. Roberts, 22 O. G., 1785.
- 90902.** Whidden, H. F. June 1, 1869. Shoe Nail.
Held a novel, useful and patentable invention to corrugate a smooth shoe nail, in view of state of art, showing other different shoe nails had been corrugated before, *Dunbar v. Albert Tack Co.*, 4 Fed. Rep., 543. Held valid and infringed, *Dunbar v. Estabrook*, 4 Fed. Rep., 545.
- 90930.** Coll, H. June 8, 1869. Siphon Pump.
Sheriff v. Fulton, 22 O. G., 87.
- 91108.** Fletcher, A. C. June 8, 1869. Postage Stamp.
Construed, limited, and held not infringed, *Fletcher v. Selden*, 16 Blatch., 468; *v. Blake*, 19 O. G., 221.
- 91133.** Howard, J. June 8, 1869. Preparing Paper for Roofing.
Held novel, useful, patentable, not abandoned; patentee held first and original inventor; held infringed, *Howard v. Christy*, 2 Ban. & Ard., 457.
- 91144.** Matthews, E. G. June 8, 1869. Cultivator.
Claim 4 infringed, *Holbrook v. Small*, 2 Ban. & Ard., 396. See, also, *Holbrook v. Small*, 3 Ban. & Ard., 625.
- 91150.** Monce, S. G. June 8, 1869. Tool for Cutting Glass.
Held not anticipated by a prior cutter for a different purpose, where the same structure occurred accidentally and not intentionally; held not ambiguous, and is novel, *Monce v. Adams*, 12 Blatch., 1. Held wanting in novelty, *Monce v. Woodward*, 4 Ban. & Ard., 307.
- 91201.** Barry, Wm. June 15, 1869. Pipe Reamer and Squarer.
Construed to be for adaptation of a new use to an old device, not involving invention, but mere mechanical change, *Barry v. Crane Bros. Mfg. Co.*, 22 Fed. Rep., 396.
- 91474.** Moulé & Girdlestone. June 15, 1869. Water Closet.
Reissues Nos. 4137 and 4138, Oct. 4, 1870.
Earth Closet Co. v. Fenner, 5 Fish., 15.
- 92146.** Bickford. July 6, 1869. Knitting Machines.
Reissue No. 6424, May 11, 1875.
Sustained as valid in absence of original in evidence; held novel and infringed, *Bickford v. Laporte*, 2 Fed. Rep., 214.
- 92275.** Crane, M. G. July 6, 1869. Fire Alarm Signal.
Reissue No. 8896, Sept. 16, 1876.
Gamewell Fire Alarm Telegraph Co. v. City of Chilicothe, 7 Fed. Rep., 351.
- 92355.** Polsey, A. M. July 6, 1869. Nails.
Held novel and infringed by unsubstantial variation, *Globe Nail Co. v. U. S. Horse Nail Co.*, 19 Fed. Rep., 819.
- 92379.** Singer, C. July 6, 1869. Rocking Chair.
Construed; claim 2 held to be for mechanical change and wanting in patentable invention, *Singer Rocking Chair Co. v. Tobey Furniture Co.*, 14 Fed. Rep., 38.
- 92718.** Glass, Wm. July 20, 1869. Injector.
Held not infringed, *Scaife v. Fulton's Sons*, 2 Ban. & Ard., 235.
- 92822.** Hart, O. N. July 20, 1869. Hot Air Furnace.
Reissue No. 7254, Aug. 8, 1876.
Held to be for same invention as original; valid, novel, and infringed by use with a patented improvement, *Flint v. Roberts*, 4 Ban. & Ard., 165.
- 92942.** Dudley, W. U. July 20, 1869. Hand Mirror.
Construed; sustained; is not abandoned; is infringed, *Clark v. Scott*, 9 Blatch., 301. Construed, limited and not infringed, *Florence Mfg. Co. v. Boston Diatite Co.*, 1 Holmes, 415.
- 93096.** Kneppler, A. July 27, 1869. Spring Bed Bottom.
Construed and held void for want of invention in view of state of art, *Ames v. Carleton Spring Bed Co.*, 32 O. G., 1238.

93157. Adams, I. Aug. 3, 1869. Electro-deposition of Nickel.

Held valid and infringed, *United Nickel Co. v. Authes*, 1 Holmes, 155; *v. Keith*, 1 Holmes, 328; *v. Manhattan Brass Co.*, 16 Blatch., 68. Claims 3 and 4 construed and held novel and valid, *United Nickel Co. v. Harris*, 15 Blatch., 319. Not invalidated by disclaimer in subsequent English and domestic patents; construed and sustained in conformity with 15 Fed. Rep., 739; claims 1 and 4 infringed, *United Nickel Co. v. Melchior*, 17 Fed. Rep., 340. Claim 1 construed to be for a new method of using solutions requiring specific conditions by the absence of specified injurious elements, and is infringed by the use of an equivalent solution; claim 4 is for a novel and patentable article of manufacture and is infringed, *United Nickel Co. v. Pendleton*, 15 Fed. Rep., 739. Claims 1 and 4 held infringed; novelty and utility held established by immediate extensive use subsequent to patenting. Not anticipated by laboratory experiment, *United Nickel Co. v. California Electrical Works*, 25 Fed. Rep., 475.

93215. McWilliams, J. Aug. 3, 1869. Die Holder.

Reissue No. 9123, March 23, 1880.

Held valid and infringed, *McWilliams Mfg. Co. v. Blundell*, 11 Fed. Rep., 419.

93244. Stilwell, E. R. Aug. 3, 1869. Feed Water Feeder.

Claims 3 and 4 construed; patentee held first and original inventor, *Stilwell & Bierce Mfg. Co. v. Cincinnati Gas Light Co.*, 1 Ban. & Ard., 610.

93267. Gilbert & Barker. Aug. 3, 1869. Apparatus for Carburing Air.

Gilbert & Barker Mfg. Co. v. Bussing, 12 Blatch., 426.

93268. Gilbert & Barker. Aug. 3, 1869. Carburing Air Apparatus.

Construed to be for a patentable change in location of parts involving invention; held novel and infringed, *Gilbert & Barker Mfg. Co. v. Tirrell*, 12 Blatch., 144. Construed in view of state of art to be for a combination, and held wanting in novelty, *Gilbert & Barker Mfg. Co. v. Walworth Mfg. Co.*, 2 Ban. & Ard., 271.

93322. Madison & McLaughlin. Aug. 3, 1869. Street Car.

McLaughlin v. People's Railway Co., 21 Fed. Rep., 574.

93369. Thomas & Mast. Aug. 3, 1869. Grain Drill.

Reissue No. 4091, Aug. 2, 1870.

Construed and limited in view of state of art, and not infringed, *Grain Drill Manufacturer's Co. v. Rude*, 23 Fed. Rep., 348.

93391. Locke, E. A. Aug. 3, 1869. Revenue Stamp for Barrels.

Construed, held novel and infringed, *Benedict & Burnham Mfg. Co. v. Hollister*, 4 Fed. Rep., 83. Construed, and held to involve mechanical skill only and not invention, in view of state of art, *Hollister v. Benedict & Burnham Mfg. Co.* 113 U. S., 59.

93441. Holmes, G. H. Aug. 10, 1869. Take-up for Looms.

Reissue No. 8298, June 25, 1878.

Construed to be for same invention as original; sustained, and held not infringed, *Holmes v. Plainville Mfg. Co.*, 9 Fed. Rep., 757.

93449. Jones, H. K. Aug. 10, 1869. Graduating Carpenter's Square.

Reissue No. 5408, May 13, 1873.

Claim 2 held wanting in novelty; claims 3, 5 and 6 sustained, and infringed by formal difference, *Hart Mfg. Co. v. Sargeant*, 3 Ban. & Ard., 265.

93472. Perkins, C. P. Aug. 10, 1869. Wind-mill.

Reissue No. 8443, Oct. 8, 1878.

Validity doubted; held not infringed, *Eclipse Wind-mill Co. v. May*, 17 Fed. Rep., 344.

93563. Smith, H. J. Aug. 10, 1869. Electrical Machine.

Bogart v. Hinds, 33 O. G., 1268.

93775. Webber, J. W. Aug. 17, 1869. Kindling Wood.

Construed to be for an aggregation, wanting in patentable invention, *Alcott v. Young*, 16 Blatch., 134.

93910. Russell, N. C. Aug. 17, 1869. Preparation of Leather.

Reissue No. 3816, Feb. 1, 1870.

Claims construed and limited, *Russell v. Klein*, 19 Wall., 433. Held to be for a different invention from original, and wanting in novelty and validity, *Russell v. Dodge*, 93 U. S., 460. See, also, *Russell v. Place*, 94 U. S., 606; 9 Blatch., 173.

94013. Lewis, T. S. Aug. 24, 1869. Removing Green Corn from the Cob.

Limited in view of state of art, and held not infringed, *Jones v. Barker*, 11 Fed. Rep., 597.

94062. Ballard & Waddell. Aug. 24, 1869. Wooden Pavement.

Sustained and infringed, *Ballard v. City of Pittsburgh*, 12 Fed. Rep., 783.

94063. Ballard v. Waddell. Aug. 24, 1869. Wooden Pavement.

Sustained and infringed, *Ballard v. City of Pittsburgh*, 12 Fed. Rep., 783.

- 94064.** Barclay, J. Aug. 24, 1869. Plated Metal Bracelet.
Reissue No. 4192, Dec. 6, 1870.
Held novel and infringed, *Barclay v. Thayer*, 12 Blatch., 107.
- 94203.** Hayes, G. Aug. 31, 1869. Ventilator.
Reissue No. 8597, Feb. 25, 1879.
Held to be for a patentable combination; is valid and infringed, *Hayes v. Borkel*, 11 Fed. Rep., 87. Construed, and held to be for a different invention from original, and void, *Hayes v. Seton*, 12 Fed. Rep., 120. See, also, *Hayes v. Dayton*, 18 O. G., 1406; 20 Fed. Rep., 690; *v. Bickelhaupt*, 19 O. G., 177; *v. Leton*, 5 Fed. Rep., 521.
- 94469.** Brown, H. L. Sept. 7, 1869. Hand-car for Railroads.
Reissue No. 5274, Feb. 11, 1873.
Construed to be for a combination, and not infringed by use of less than all the elements, *Brown v. Hinkley & Cole*, 6 Fish., 370.
- 94747.** Holly, B. Sept. 14, 1869. Safety Valve.
Construed; held valid and infringed, *Holly v. Vergennes Machine Co.*, 18 Blatch., 327.
- 94780.** Siebert, N. Sept. 14, 1869. Lubricator.
Reissue No. 8740, June 3, 1879.
Final claims held void for new matter, *Siebert Cylinder Oil Cup Co. v. Harper Steam Lubricator Co.*, 4 Fed. Rep., 328.
- 94881.** Flagg, T. J. Sept. 14, 1869. Felt Suspender End.
Sustained; patentee held first and original inventor, *Fisk v. Church*, 5 Fish., 540. See, also, *Fisk v. West, Bradley & Cary Mfg. Co.*, 19 O. G., 545.
- 94947.** Covell, E. T. Sept. 21, 1869. Can.
Reissue No. 4777, March 5, 1872.
Claim 3 limited to conform with original, and not infringed as limited, *Covell v. Pratt*, 18 Blatch., 126.
- 95004.** Davis, C. H. Sept. 21, 1869. Box Loop.
Reissue No. 6974, March 7, 1876.
On comparison with original, held to be within the scope of a reissue; is novel, valid and infringed, *Crandal v. Walters*, 9 Fed. Rep., 659. Held properly reissued; not anticipated by a device requiring exercise of invention to adapt it to patentee's invention, *Crandal v. Parker Carriage Goods Co.*, 20 Fed. Rep., 851.
- 95262.** Pelham, T. M. Sept. 28, 1869. Hod Elevator.
Limited to specific device in view of prior invention, and held not infringed, *Pelham v. Demarest*, 12 Fed. Rep., 494.
- 95458.** Garver, D. L. Oct. 5, 1869. Harrows.
Reissue No. 9148, Apr. 13, 1880.
Held not enlarged by reference to state of art inserted therein. The seven claims held separately included within the broad construction given the single original claim; sustained and held infringed, *Reed v. Chase*, 25 Fed. Rep., 94.
- 95465.** Graebe & Liebermann. Oct. 5, 1869. Artificial Alizarine.
Reissue No. 4321, Apr. 4, 1871. Product.
Construed; is for same invention as original; a proper case for reissue and valid, *Badische Anilin, etc., Co. v. Higgins*, 15 Blatch., 290. Construed; held novel, sustained, and infringed, *Badische Anilin, etc., Co. v. Cochrane*, 16 Blatch., 155. Construed to be for a new manufacture and composition of matter, and sustained, *Badische Anilin, etc., Co. v. Hamilton*, 3 Ban. & Ard., 235.
Construed, and limited to a product identical with that produced by the original process, and not infringed as limited, *Cochrane v. Badische Anilin, etc., Co.*, 111 U. S., 293. Held to be for a new article of manufacture which is new in fact, *Badische Anilin, etc., Co. v. Cummins*, 4 Ban. & Ard., 489.
- 95466.** Graham, S. P. Oct. 5, 1869. Carriage Body and Seat.
Reissue No. 4780, March 5, 1872.
Doubted whether it is for a patentable substitution of material; held novel and infringed, *Comstock v. Sandusky Seat Co.*, 3 Ban. & Ard., 188.
- 95517.** Riley & Bissell. Oct. 5, 1869. Composition for Covering Boilers.
Reissue No. 4134, Sept. 27, 1870.
Held novel and valid, *United States & Foreign Salamander Felting Co. v. Asbestos Felting Co.*, 10 O. G., 828. Construed, *United States & Foreign Salamander Felting Co. v. Merrimack Mfg. Co.*, 2 Ban. & Ard., 167. See, also, *United States & Foreign Salamander Felting Co. v. Haven*, 3 Dill., 131.
- 95655.** Coburn, G. L. Oct. 12, 1869. Calendar.
Ambler v. Whipple, 20 Wall., 246; *v. Choteau*, 107 U. S., 586.

- 95689.** Howard, J. Oct. 12, 1869. Machine for Preparing Paper for Roofing.
Held novel, useful, and not abandoned; patentee held first and original inventor, *Howard v. Cristy*, 2 Ban. & Ard., 457.
- 95894.** George, H. W. Oct. 19, 1869. Box Toes for Boots and Shoes.
Held to be for an analogous use, not involving invention, consisting in a change of location only, in placing inside of a shoe what had before been placed outside, *Truss v. Shuter*, 26 O. G., 1210.
- 96037.** Root, J. B. Oct. 19, 1869. Art of Making Metallic Tubes.
Construed and limited in view of state of art; sustained, and held not infringed, *Root v. Lamb*, 7 Fed. Rep., 222.
- 96605.** Milligan, J. C. Nov. 9, 1869. Biscuit Pan.
Held wanting in novelty, *Lalace & Grosjean Mfg. Co. v. U. S. Stamping Co.*, 23 Fed. Rep., 800.
- 96778.** Collignon, N. & C. O. Nov. 16, 1869. Folding Chairs.
Construed and held infringed by formal change, *Collignon v. Hayes*, 8 Fed. Rep., 912.
- 96959.** Race & Matthews. Nov. 16, 1869. Hydrant Casing.
Held wanting in novelty, *Matthews v. Boston Machine Co.*, 105 U. S., 54.
Reissue No. 10,452, Feb. 26, 1884.
Construed to be for an improvement on, and not for same invention as his prior patent; properly reissued in view of above decision holding the original claim too broad, *Matthews v. Flower*, 33 O. G., 887.
- 97236.** Grimsley & Shelly. Nov. 23, 1869. Side-saddle Tree.
Construed as limited by claim, and held not infringed, *Burns v. Meyer*, 100 U. S., 671.
- 97375.** Farnham, J. M. Nov. 30, 1869. Bedstead Frame.
Sustained and held infringed, *Woven Wire Mattress Co. v. Whittlesey*, 8 Biss., 23.
Reissue No. 7704, May 29, 1877.
Held novel and not anticipated by prior abandoned experiment; claim construed to be for a combination, and held infringed by a colorable evasion, *Whittlesey v. Ames*, 9 Biss., 225. Claims 1 and 3 sustained and held infringed, *Woven Wire Mattress Co. v. Wire Web Bed Co.*, 1 Fed. Rep., 222; 8 Fed. Rep., 87. Construed in view of original drawings and specifications; limited in view of state of art and prior decisions, and claims 1 and 2 held not infringed, *Woven Wire Mattress Co. v. Simmons*, 10 Biss., 394. Construed and held infringed in conformity with prior decisions, *Woven Wire Mattress Co. v. Palmer*, 5 Ban. & Ard., 455. Claims 1 and 2 construed and limited in conformity with original. Claims 3 and 4 sustained and infringed by use with a superadded result, *Hartford Woven Wire Mattress Co. v. Peerless Wire Mattress Co.*, 23 Fed. Rep., 587.
- 97418.** Lyman, H. A. Nov. 30, 1869. Corsets.
Reissue No. 6100, Oct. 27, 1874.
Decreed valid, *Thompson v. Jacobs*, 12 O. G., 890.
- 97454.** Spill, D. Nov. 30, 1869. Xyloidine.
Construed; held novel, sustained, and infringed, *Spell v. Celluloid Mfg. Co.*, 18 Blatch., 190. Limited and held not infringed, *Ibid.*, 10 Fed. Rep., 290. Held that in so far as it is only for using a solvent weaker than had been used before, it does not involve invention, *Ibid.*, 21 Fed. Rep., 631. See, also, *Spill v. Celluloid Mfg. Co.*, 22 Fed. Rep., 94.
- 97920.** Holcomb, D. I. Dec. 14, 1869. Fruit Jars.
Construed; held novel and sustained; not anticipated by a prior combination omitting one of its elements, *Watson v. Cunningham*, 4 Fish., 528; *McCully v. Cunningham*, 19 Pitts. L. J., 142.
- 98087.** Montague, C. Dec. 21, 1869. Printing Press.
Held a novel and valid combination of old elements; patentee held first and original inventor, *Child v. Boston & Fairhaven Iron Works*, 1 Holmes, 303. See, also, *Child v. Boston & Fairhaven Iron Works*, 19 Fed. Rep., 258; *Boston & Fairhaven Iron Works, In re*, 23 Fed. Rep., 880.

1870.

- 98571.** Dennett, C. C. Jan. 4, 1870. Concrete Arches for Buildings.
Laver v. Dennett, 25 O. G., 882.
- 98727.** Welling, Wm. M. Jan. 4, 1870. Composition resembling Horn.
Construed, in view of state of art, to involve mechanical skill only, and held wanting in novelty, *Welling v. Crane*, 14 Fed. Rep., 571.
- 98787.** McLaughlin, F. Jan. 11, 1870. Brush.
Construed; held not anticipated by an abandoned experiment; is infringed, *Murphy v. Eastman*, 1 Holmes, 113. The combination held infringed by a similar combination embracing an additional feature, *Murphy v. Kissling*, 1 Holmes, 432.

- 98854.** Dittmar, C. Jan. 18, 1870. Explosive Compound.
Construed to be for a composition made by process specified, and not infringed by omission of essential step of process, *Dittmar v. Rix*, 1 Fed. Rep., 342.
- 98865.** Harris, W. Jan. 18, 1870. Non-conducting Boiler Covering.
Construed and limited in view of reference to specification, *Evans v. Kelly*, 9 Biss., 251.
- 99032.** Theberath, C. M. Jan. 18, 1870. Covering Harness Trimming.
Held invalid for public use more than two years prior to date of application, *Theberath v. Rubber and Celluloid Harness Trimming Co.*, 15 Fed. Rep., 246. Held infringed, *Ibid.*, 3 Fed. Rep., 151. See, also, *Theberath v. Celluloid Mfg. Co.*, 3 Fed. Rep., 143.
- 99299.** Doyle, P. Feb. 1, 1870. Molds for Ingots.
Construed. Not defeated by knowledge here of its use abroad, patentee being innocent of such knowledge. Held novel and valuable in view of state of art, and infringed by mechanical equivalent and by improvement, *Doyle v. Spaulding*, 19 Fed. Rep., 744.
- 99425.** Franz & Pope. Feb. 1, 1870. Knitting Machine.
Declared good, valid, and infringed, *Franz & Pope Knitting Machine Co. v. Lamb Knitting Machine Mfg. Co.*, 19 O. G., 1000.
- 99426.** Franz & Pope. Feb. 1, 1870. Knitting Machine.
Decreed valid, *Franz & Pope Knitting Machine Co. v. Bickford*, 18 O. G., 734.
- 99443.** Irwin, J. H. Feb. 8, 1870. Lamp.
Held novel, *Irwin v. Dane*, 9 O. G., 642. See, also, *Irwin v. McRoberts*, 16 O. G., 853; *v. Dane*, 2 Biss., 442.
- 99765.** Dunks, C. H. Feb. 15, 1870. Spring Bed Bottom.
Dunks v. Grey, 5 Ban. & Ard., 634.
- 100053.** Miller, R. P. Feb. 22, 1870. Dies.
Reissue No. 8694, May 6, 1879.
Claim 1 held to be for matter distinctly disclaimed in original and is void for new matter; claim 2 held valid and infringed, *Atwater Mfg. Co. v. Beecher Mfg. Co.*, 8 Fed. Rep., 608. Claim 1 held as above, and is wanting in novelty; claim 2 construed to be for an aggregation, *Beecher Mfg. Co. v. Atwater Mfg. Co.*, 114 U. S., 523.
- 100121.** Crandall, W. E. Feb. 22, 1870. Children's Carriage.
Reissue No. 4223, Jan. 7, 1871.
Claims 1, 2, 3 and 5 held wanting in novelty, *Crandall v. Richardson*, 8 Fed. Rep., 808; *v. Dare*, 11 Fed. Rep., 902.
- 100143.** Hayes, G. Feb. 22, 1870. Sky-light.
Reissue No. 8674, April 15, 1879.
Held to involve invention; sustained, held novel and infringed, *Hayes v. Borkel*, 11 Fed. Rep., 87. Construed, and claims sued on held to be for a different invention from original and void, *Hayes v. Seton*, 12 Fed. Rep., 120. Claim 8 void, *Hayes v. Bickelhaupt*, 21 Fed. Rep., 567. See, also, *Hayes v. Bickelhaupt*, 19 O. G., 177; *v. Dayton*, 18 O. G., 1406; *v. Leton*, 5 Fed. Rep., 521.
- 100229.** Willis, H. L. Feb. 22, 1870. Sand Paper Holder for Buffing Shoes.
Construed, in view of state of art, to be for a patentable invention; claim 1 infringed, *Buzzell v. O'Connell*, 4 Fed. Rep., 325.
- 100335.** Spear, J. March 1, 1870. Base Burning Stove.
Reissue No. 6206, Jan. 5, 1875.
Claims 4, 6, 7, 8 and 12 invalid for substitution not involving invention, and for aggregation, *Perry v. Co-operative Foundry Co.*, 12 Fed. Rep., 436.
- 100354.** Bauman, C. A. March 1, 1870. Steam Boiler Covering.
Held invalid, *United States & Foreign Salamander Felting Co. v. Asbestos Felting Co.*, 13 Blatch., 454. Claim 1 held invalid on interference with No. 114, 711, *Ibid.*, 18 Blatch., 312.
- 100715.** Blackburn & Woodside. March 15, 1870. Fare Register.
Reissue No. 7120, May 16, 1876.
Construed; limited, and held not infringed in view of state of art, *Passenger Fare Enumerator, etc., Co. v. Metropolitan R. Co.*, 4 Ban. & Ard., 116.
- 100839.** Andrews, W. D. March 15, 1870. Friction Wheel for Gearing.
Wanting in novelty; patentee held not first and original inventor, *Delamater v. Woodruff*, 11 Fed. Rep., 414.
- 101140.** Lawyer & Gasten. March 22, 1870. Sewing Machine.
Claim 2 not novel, *Raymond v. Singer Mfg. Co.*, 11 Fed. Rep., 427.
- 101175.** Spill, D. March 22, 1870. Xyloidine.
Construed, held novel, sustained and infringed, *Spill v. Celluloid Mfg. Co.*, 18 Blatch., 190. Claim 2 construed to be for the application of an old process to analogous use not involving invention, *Ibid.*, 21 Fed. Rep., 631. See, also, *Spill v. Celluloid Mfg. Co.*, 22 Fed. Rep., 94.

- 101295.** Mellen, G. H. March 29, 1870. Children's Carriage.
Not infringed, *Tibbats v. Daby*, 11 Fed. Rep., 903.
- 101529.** Smith, F. April 5, 1870. Die for Chord-bar Heads.
Construed to be for a change in form not involving invention, and wanting in novelty, *Smith v. American Bridge Co.*, 8 Biss., 312.
- 101583.** Clarke, E. April 5, 1870. Registering Steam Gauge.
Reissue No. 4775, March 5, 1872.
Construed, limited, and held infringed, *United States Steam Gauge Co. v. American Steam Gauge Co.*, 1 Holmes, 309.
- 101590.** Cowing, T. April 5, 1870. Wood Pavement.
Construed, and held novel; application not abandoned, *Ballard v. City of Pittsburgh*, 12 Fed. Rep., 783.
- 101931.** Simonds, N. J. April 12, 1870. Leather Cutting Press.
Claim 4 limited to specific mechanism, in view of state of art, and held not infringed, *Richardson v. Bresnahan*, 23 Fed. Rep., 897.
- 101994.** Forseyth, J. B. April 19, 1870. Elastic Roller Manufacture.
Reissue No. 5081, Oct. 1, 1872.
Construed to be for a combination of old elements in an old mode to produce a new and useful result; limited, and not infringed in view of state of art, *Forseyth v. Clapp*, 1 Holmes, 278.
- 102179.** Stewart, A. W. April 19, 1870. Folding Chair.
Reissue No. 6076, Oct. 6, 1874.
Construed; claim 1 sustained as novel and useful; claim 2 void for want of novelty, *Stewart v. Mahoney*, 5 Fed. Rep., 302.
- 102187.** Warth, A. April 19, 1870. Stop Valve for Petroleum Packages.
Construed, limited, and claim held not infringed, *Meissner v. Devoe Mfg. Co.*, 9 Blatch., 363.
- 102218.** Brown, H. April 26, 1870. Oil Stone Holder.
Sustained and held infringed by improvement embodying the patented invention, *Union Stone Co. v. Allen*, 14 Fed. Rep., 353.
- 102529.** Franz & Pope. May 3, 1870. Knitting Machine.
Declared good, valid, and infringed, *Franz & Pope Knitting Machine Co. v. Lamb Knitting Machine Mfg. Co.*, 19 O. G., 1000.
- 102587.** Pearl, O. May 3, 1870. Bobbins and Spindles.
Reissue No. 6036, Sept. 1, 1874.
Construed and limited; claim 3 held infringed, *Pearl v. Appleton Co.*, 3 Fed. Rep., 153.
Construed, limited, held novel, and to involve invention; claims 1, 2 and 3 infringed, *Pearl v. Ocean Mills*, 2 Ban. & Ard., 469.
- 102662.** Dickerson & Whipple. May 3, 1870. Process and Apparatus for Liquid Fuel for Light and Heat.
Ambler v. Whipple, 20 Wall., 546.
- 102748.** Adams, I. May 10, 1870. Electro-deposition of Nickel.
Held valid, novel and infringed, *United Nickel Co. v. Authes*, 1 Holmes, 155; *v. Keith*, 1 Holmes, 328; *v. Melchior*, 17 Fed. Rep., 340.
- 102913.** Mason, J. L. May 10, 1870. Fruit Jar.
Construed to be for a combination; seems not to involve invention, in view of disclaimer; invalid for abandonment by use more than two years prior to date of application, *Consolidated Fruit Jar Co. v. Wright*, 12 Blatch., 149. Void for abandonment by sale more than two years prior to date of application, *Ibid.*, 94 U. S., 92.
- 102936.** Hancock, W. S. May 10, 1870. Broom.
Gillespie v. Cummings, 3 Sawyer, 259.
- 103125.** Barker, A. May 17, 1870. Soldering Iron.
Reissue No. 8781, July 1, 1879.
Construed to be for a combination, in which form is of the essence of the invention; limited to that shown in drawings and specification, and held not infringed, *McMurry v. Mallory*, 4 Hughes, 265. Held not reissued for the purpose of a more perfect description, because of the identity of drawing and description. Claims 1, 2 and 3 void, being broader than original; claims 4 and 5 not infringed, *Ibid.*, 111 U. S., 97.
- 103406.** Woolcocks, T. J. May 24, 1870. Speaking Tube Whistle.
Construed; not abandoned; claim 1 infringed by use of substantial equivalent in form for one of its elements, *Woolcocks v. Many*, 9 Blatch., 139.
- 103594.** Flynn, F. May 31, 1870. Top for Rubber Shoes.
Construed, and held wanting in patentable novelty, *Woonsocket Rubber Co. v. Candee*, 23 Fed. Rep., 797.

- 103834.** Blood, H. S. June 7, 1870. Derrick.
Converse *v.* Cannon, 2 Woods, 7.
- 104271.** Clough, T. June 14, 1870. Gas Burner.
Claim 1 held wanting in novelty; claim 2 limited and sustained in view of state of art, and held not infringed, Clough *v.* Gilbert & Barker Mfg. Co., 3 Ban. & Ard., 523. Claims 1 and 2 construed, held novel, valid, and patentee being first in the art, infringed by substitution of known equivalents, *Ibid.*, 106 U. S., 166.
- 104318.** Irwin, J. H. June 14, 1870. Lantern.
Considered, Steam Gauge & Lantern Co. *v.* Miller & Co., 8 Fed. Rep., 314. Claim 1 construed, and infringed by use of an equivalent form, *Ibid.*, 21 Fed. Rep., 514. Infringement doubted, Steam Gauge & Lantern Co. *v.* St. Louis Railway Supply Mfg. Co., 33 O. G., 889.
- 104323.** Knox & Osborn. June 14, 1870. Ore Roasting Furnace.
Infringed by change in location of parts without change of function, Knox *v.* Great Western Quicksilver Mining Co., 3 Sawyer, 422; 6 Sawyer, 430. Not infringed, *Ibid.*, 4 Fed. Rep., 809; Knox *v.* New Ideria Mining Co., 4 Fed. Rep., 813.
- 104376.** Thatcher, J. M. June 14, 1870. Fire-place Heater.
Claims 1 and 2 construed to be for aggregations of old parts, and void, Thatcher Heating Co. *v.* Burtis, 12 Fed. Rep., 569. Held infringed, Thatcher Heating Co. *v.* Drummond, 3 Ban. & Ard., 138.
- 104412.** Bostwick, J. A. June 21, 1870. Soldering Iron.
Reissue No. 8466, Oct. 29, 1878.
Construed to be for a combination in which form is of the essence of the invention; limited to that shown in the drawings and specification, and held not infringed, McMurry *v.* Mallory, 4 Hughes, 265. Claim 1 held to be for a different invention from original, and void; claim 2 not infringed, *Ibid.*, 111 U. S., 97.
- 104585.** Hardy & Wood. June 21, 1870. Rotary Blower.
Infringed by use of equivalent, Hyndman *v.* Roots, 97 U. S., 224.
- 105030.** Bigelow, H. H. July 5, 1870. Heel Machine for Boots and Shoes.
United States *v.* Thatcher, 2 MacArthur, 24.
- 105187.** Franz & Pope. July 12, 1870. Knitting Machine.
Declared good, valid and infringed, Franz & Pope Knitting Machine Co. *v.* Lamb Knitting Machine Mfg Co., 19 O. G., 1000.
- 105338.** Hyatt, J. W. & I. S. July 12, 1870. Treating, etc., Pyroxeline.
Reissue No. 5928, June 23, 1874.
Celluloid Mfg. Co. *v.* Goodyear Dental Vulcanite Co., 13 Blatch., 375.
- 105599.** Schillinger, J. J. July 19, 1870. Concrete Pavement.
Reissue No. 4364, May 2, 1871.
Construed in view of disclaimer and held infringed, Schillinger *v.* Gunther, 14 Blatch., 152. Construed in view of disclaimer, *Ibid.*, 15 Blatch., 303. Sustained as not insufficient from fraudulent intent, *Ibid.*, 17 Blatch., 66. Construed and sustained in accordance with prior decisions, Schillinger *v.* Greenway Brewing Co., 17 Fed. Rep., 244. Held valid in view of prior decisions; infringed by a difference in degree only, consisting in the use of a known equivalent, Kuhl *v.* Mueller, 21 Fed. Rep., 510. See, also, California Artificial Stone Paving Co. *v.* Molitor, 31 O. G., 1044. Construed and held infringed, California Artificial Stone Paving Co. *v.* Perine, 7 Sawyer, 190. Held not infringed by one mode used; is infringed by the other, California Artificial Stone Paving Co. *v.* Freeborn, 17 Fed. Rep., 735.
- 105768.** Barker, J. F. July 26, 1870. Gas Burner.
Held valid, for new, useful and patentable modifications, Clough *v.* Gilbert & Barker Mfg. Co., 106 U. S., 178.
- 105833.** Nye, S. R. July 26, 1870. Horse Hay Rake.
Reissue No. 9731, May 31, 1881.
Claims 1 and 5 void, as expanded claims, Nye *v.* Allen, 15 Fed. Rep., 114.
- 106021.** Anderson, J. H. Aug. 2, 1870. Broom.
Gillespie *v.* Cummings, 3 Sawyer, 259.
- 106089.** Smith, Wm. Aug. 2, 1870. Water Closet Receiver.
Construed; held novel, useful, and not on public sale more than two years prior to date of application, Smith *v.* O'Connor, 2 Sawyer, 461.
- 106094.** Topham, Wm. H. Aug. 2, 1870. Spittoon.
Reissue No. 5514, July 29, 1873.
Claim 2 is for same invention as original; held wanting in novelty, Havemeyer *v.* Bonnell, 21 Fed. Rep., 406; *v.* Randall, 21 Fed. Rep., 404.

- 106101.** Warth, A. Aug. 2, 1870. Cloth Cutting Machine.
Reissue No. 5186, Dec. 10, 1872.
Limited, and held not infringed, *Warth v. Browning*, 5 Ban. & Ard., 341.
- 106157.** Hayes, G. Aug. 9, 1870. Skylight.
Reissue No. 8675, Apr. 15, 1879.
Held to involve invention; sustained, and is infringed, *Hayes v. Borkel*, 11 Fed. Rep., 870. Claim 2 construed, limited, and not infringed, *Hayes v. Seton*, 12 Fed. Rep., 120. Claims 1, 2, and 7, introduced after nine years' delay, held void, *Hayes v. Bickelhaupt*, 21 Fed. Rep., 567. Claim 2 construed, in view of words "as specified," to include elements in the original, but omitted in the reissue claim, and thus held to correspond with original; is not infringed, *Ibid.*, 23 Fed. Rep., 183. Claim 6 held not infringed, *Hayes v. Dayton*, 20 Fed. Rep., 690. See, also, *Hayes v. Bickelhaupt*, 19 O. G., 177; *v. Leton*, 5 Fed. Rep., 521; *v. Dayton*, 18 O. G., 1406.
- 106597.** Mann, R. J. Aug. 23, 1870. Sieve.
Construed, and limited to particular combination, and held not infringed, *Adams Mfg. Co. v. St. Louis Wire, etc., Co.*, 3 Ban. & Ard., 77.
- 107817.** Scaife, W. B. Sept. 27, 1870. Boiler for Stoves.
Reissue No. 4467, July 17, 1871.
Decreed invalid and void, *Scaife v. Mageus*, 19 O. G., 791.
- 108055.** Riley, J. Oct. 4, 1870. Composition for Covering Steam Boilers.
Construed, *United States & Foreign Salamander Felting Co. v. Merrimack Mfg. Co.*, 2 Ban. & Ard., 167.
- 108270.** Knight, G. W. Oct. 11, 1870. Spinning Ring Holder.
Draper v. Wattles, 16 O. G., 629.
- 108300.** Sessions, A. J. Oct. 11, 1870. Trunk Rollers.
Construed, and strictly limited in view of state of art; if limited, not infringed; is for a double use, *Sessions v. Gould*, 33 O. G., 1139.
- 108384.** Norton, C. P. Oct. 18, 1870. Cultivator.
Reissue No. 5557, Aug. 26, 1873.
Construed, and limited to combination of old parts, and held not infringed, *Pattee v. Moline Plow Co.*, 10 Biss., 377.
- 108408.** Tilghman, B. C. Oct. 18, 1870. Sand Blast.
Held novel and valid; claim 1 construed to be for a process or art, and is infringed, *Tilghman v. Morse*, 9 Blatch., 421. See, also, *Tilghman v. Hartell*, 2 Ban. & Ard., 260; *Hartell v. Tilghman*, 99 U. S., 547.
- 108753.** Boomer, Boschert & Morse. Nov. 1, 1870. Cheese Press.
Reissue No. 5256, Jan. 28, 1873.
Construed; is for same invention as original; novel and valid, *Boomer v. United Power Press Co.*, 13 Blatch., 107.
- 108827.** Rayer & Lincoln. Nov. 1, 1870. Sewing Machine Attachment.
Reissue No. 9176, April 27, 1880.
Claims 1 and 3 construed to be enlarged, and void for delay in reissuing, *Rayer & Lincoln Seaming Machine Co. v. American Printing Co.*, 19 Fed. Rep., 428.
- 108898.** Fischer, H. Nov. 1, 1870. Bottle Faucet.
Held valid; not void for prior foreign use without publication, and is infringed, *Worswick Mfg. Co. v. Steiger*, 17 Fed. Rep., 250.
- 109372.** Ball & Fitts. Nov. 22, 1870. Water Meter.
Reissue No. 5806, March 24, 1874.
Construed to be for a combination, and not infringed by omission of one of its parts, *Union Water Meter Co. v. Desper*, 101 U. S., 337.
- 109444.** Parker, J. Nov. 22, 1870. Fly-trap.
Reissue No. 6811, Dec. 21, 1875.
Construed, in view of state of art, to be for mechanical skill only; held wanting in patentable novelty and invalid, *National Mfg. Co. v. Meyers*, 15 Fed. Rep., 237. See, also, *National Mfg. Co. v. Meyers*, 7 Fed. Rep., 355.
- 109446.** Perkins, G. C. Nov. 22, 1870. Woven Wire Mattress Fabrics.
Construed, in view of state of art, to involve mechanical skill only, *Hartford Woven Wire Mattress Co. v. Peerless Wire Mattress Co.*, 23 Fed. Rep., 587.
- 110070.** Potter, C. L. Dec. 13, 1870. Attaching Button Shanks.
Construed, limited, sustained, and held not infringed, *Potter v. Thayer*, 1 Holmes, 293.
- 110205.** Coll, H. Dec. 20, 1870. Siphon Pump.
Reissue No. 9199, May 18, 1880.
Construed, in view of original, and held invalid for claim expanded after nine years' acquiescence, *Sheriff v. Fulton*, 12 Fed. Rep., 136.

- 110222.** Fisher. Dec. 20, 1870. Hydraulic Mining Apparatus
Reissue No. 5193, Dec. 17, 1872.
Claim 2 construed to be for a mechanical substitution and held anticipated; combination claims 1 and 3 held not infringed, *Fisher v. Craig*, 3 Sawyer, 69.

1871.

- 110630.** Cauhapé, P. Jan. 3, 1871. Pill Manufacture.
Held novel; claim 2 construed to be for a combination and not an aggregation, and is infringed, *McKesson v. Carndick*, 19 Blatch., 158.
- 110722.** Ball, A. Jan. 3, 1871. Plow.
Cook v. Birdwell, 20 O. G., 1083.
- 110779.** Needham, C. Jan. 3, 1871. Casting Car Wheels.
Held wanting in novelty and patentability, *Needham v. Washburn*, 4 Cliff., 254.
- 110803.** Tillinghast, C. P. Jan. 3, 1871. Car Ventilator.
Reissue No. 9572, Feb. 15, 1881.
Tillinghast v. Hicks, 23 O. G., 739.
- 110839.** Fetter, D. Jan. 17, 1871. Drive-screw.
Reissue No. 8121, March 12, 1878.
Sustained and held infringed, *Fetter v. Newhall*, 17 Fed. Rep., 841. Construed and not infringed, *Ibid.*, 20 Fed. Rep., 113; *Fetter v. Oliver Bros. & Phillips*, 20 Fed. Rep., 114.
- 111001.** Raecke, L. Jan. 17, 1871. Filter.
Reissue No. 8894, Sept. 16, 1876.
Construed and limited in view of state of art; held invalid for expanded claim, *Lansburgh v. Hasbrouck*, 16 Fed. Rep., 566.
- 111403.** Thompson, S. Jan. 31, 1871. Cleaning and Polishing Coffee.
Held infringed, *New York Coffee Polishing Co. v. Wilson*, 2 Fed. Rep., 904.
- 111564.** Patterson & Bishop. Feb. 7, 1871. Ratchet Coupling for Barges.
Held a patentable combination involving invention, and is valid; patentee held first inventor, *Patterson v. Duff*, 20 Fed. Rep., 641.
- 111585.** Todd, W. Feb. 7, 1871. Washboard.
Reissue No. 6673, Oct. 5, 1875.
Construed and limited and held not infringed, in view of state of art, *Duff v. Stirling Pump Co.*, 107 U. S., 636. Claim 2, in form for a combination, construed in view of specification to be for an article of manufacture, and sustained, *Duff v. Calkins*, 25 O. G., 601. Construed and limited in conformity with prior decision and not infringed, *Duff v. St. Louis Wooden Ware Works*, 22 Fed. Rep., 340.
- 111632.** Goodrich & Colburn. Feb. 7, 1871. Planing Machine.
Reissue No. 8438, Oct. 1, 1878.
Claim 4 construed to be for elements contained by implication in original claim, limited in order to be sustained, and, as limited, not infringed, *Fay v. Fraser*, 11 Biss., 422. Broad claim construed, and limited in view of original and state of art, and held not infringed, *Fay v. Preble*, 14 Fed. Rep., 652.
- 111798.** Adams, T. Feb. 14, 1871. Chewing Gum.
Held useful; not invalidated by prior foreign public use not known to patentee; construed to be for the application of an old contrivance to a new use, and held wanting in invention, *Adams v. Loft*, 4 Ban. & Ard., 495.
- 111881.** Seibert, N. Feb. 14, 1871. Lubricator.
Held void on an interference, as being a later patent for the same invention, and patentee not being first inventor, *Garratt v. Seibert*, 98 U. S., 75; *Seibert v. Garratt*, 8 O. G., 600.
- 111962.** Meyer & Evans. Feb. 21, 1871. Rubber Overshoes.
Reissue No. 4977, July 16, 1872.
Construed to be for a double use, and held wanting in patentable novelty and invention, *Meyer v. Pritchard*, 12 Blatch., 101. See, also, *Meyer v. Goodyear Rubber Co.*, 11 Fed. Rep., 891.
- 112137.** Fricke, J. R. Feb. 28, 1871. Copper Cable Lightning Rods.
Construed, limited, and held not infringed, *Fricke v. Hum*, 22 Fed. Rep., 302.
- 112594.** Hays, G. March 14, 1871. Sky-light.
Reissue No. 8688, April 22, 1879.
Construed to be for a patentable combination involving invention; held novel, valid, and infringed, *Hayes v. Borkel*, 11 Fed. Rep., 87. Claims 1, 3 and 5 construed to be for different invention from original, and held void; claim 2 limited, and not infringed as limited, *Hays v. Seton*, 12 Fed. Rep., 120. Claim 2 held identical with original claim 1; held valid and infringed, *Hays v. Bickelhaupt*, 23 Fed. Rep., 183. Claim 2 held not infringed; claim 6

- held void for expansion, *Hays v. Dayton*, 20 Fed. Rep., 690. See, also, *Hays v. Bickelhaupt*, 19 O. G., 177; *v. Leton*, 5 Fed. Rep., 521; *v. Dayton*, 18 O. G., 1406.
- 112930.** Kreisler, B. March 21, 1871. Tiling for Fire-proof Buildings.
Reissue No. 5174, Dec. 3, 1872.
Held wanting in novelty, in view of prior state of art, *Fryer v. Maurer*, 20 Fed. Rep., 916. Construed to be for introducing in a known structure a known equivalent for one of its features, and held wanting in invention, *Ibid.*, 19 Fed. Rep., 756.
- 112937.** Locke, J. C. March 21, 1871. Trunk Fastening.
Reissue No. 8520, Dec. 10, 1878.
Construed; if broadly, is invalid; if limited, not infringed, *Cowell v. Sessions*, 17 Fed. Rep., 450.
- 112977.** Sternbergh, W. March 21, 1871. Cheese Hoops.
Reissue No. 8832, Aug. 5, 1879.
Construed; limited, held novel and not infringed, *Tyler v. Welch*, 18 Blatch., 209. Claim 1, if construed broadly, will enlarge the invention; if limited, is a duplication of claim 2; held void; claim 2 held valid and infringed, *Tyler v. Galloway*, 12 Fed. Rep., 567. See, also, *Tyler v. Galloway*, 22 Fed. Rep., 1294.
- 113055.** Hyatts & Perkins. March 28, 1871. Dental Plates from Pyroxyline.
Celluloid Mfg. Co. *v.* Goodyear Dental Vulcanite Co., 13 Blatch., 375.
- 113328.** New, T. April 4, 1871. Waterproof Collars.
Reissue No. 7920, Oct. 23, 1877.
Construed and held void for want of novelty, *New v. Lawrence*, 3 Fed. Rep., 714.
- 113612.** Adams, I. April 11, 1871. Electro-plating with Nickel.
United Nickel Co. *v.* Authes, 1 Holmes, 155.
- 113649.** Gamewell, J. N. April 11, 1871. Fire Alarm Telegraph.
Reissue No. 8891, Sept. 9, 1876.
Gamewell Fire-alarm Telegraph Co. *v.* City of Chillicothe, 7 Fed. Rep., 351.
- 113832.** Ashcroft, J. April 18, 1871. Treating Coffee.
Reissue No. 4479, July 25, 1871, Division A.
Construed and sustained in view of specification, and not infringed by omission of an element of the process, *Arnold v. Phelps*, 20 Fed. Rep., 315.
- 114068.** Van Hagan, I. April 25, 1871. Pressing and Stamping Sheet Metal.
Decreed null and void subsequent to interference, *Sturges v. Van Hagen*, 6 Fish., 572.
- 114711.** Riley, J. May 9, 1871. Composition for Covering Steam Boilers.
Sustained on interference, *United States & Foreign Salamander Felting Co. v. Asbestos Felting Co.*, 18 Blatch., 312. Held infringed, *Ibid.*, 18 Blatch., 310. Held novel; claims 1 and 2 infringed by substitution of well known equivalent. Construed, *United States & Foreign Salamander Felting Co. v. Lawrence Mfg. Co.*, 2 Ban. & Ard., 167. See, also, *United States & Foreign Salamander Felting Co. v. Asbestos Felting Co.*, 10 O. G., 828.
- 115232.** Peard, J. May 23, 1871. School Desk.
Claims 1 and 2 construed to be for aggregations, *Peard v. Johnson*, 23 Fed. Rep., 507. See, also, *National School Furniture Co. v. Paton*, 16 Blatch., 563.
- 115565.** Bull, H. C. June 6, 1871. Apparatus for Cleaning Privies.
Reissue No. 6962, Feb. 29, 1876.
Construed; held to involve invention; is novel, and sustained, *Odorless Excavating Apparatus Co. v. Clements*, 4 Ban. & Ard., 540. Construed to be for a mistake (if any) apparent on face of patent, consisting in the claiming of a combination of too many elements; and held dedicated to public by delay in reissuing until after intervening rights had accrued to third parties, *Clements v. Odorless Excavating Apparatus Co.*, 109 U. S., 641.
- 115760.** McMurray & Hollingsworth. June 6, 1871. Soldering Tool.
Nominally for a combination of four elements, construed to be for one of three only; held in view of a prior patent to be for a change in form and not in substance, by the use of a mechanical equivalent not involving invention but mechanical skill only, *McMurray v. Miller*, 16 Fed. Rep., 471.
- 116138.** Barker, W. C. June 20, 1871. Bucket for Chain Pumps.
Reissue No. 6531, June 6, 1875.
Claims 1 and 2 held wanting in novelty, *Barker v. Stowe*, 15 Blatch., 49. Construed broadly; claims 1 and 2 infringed, *Ibid.*, 4 Ban. & Ard., 485. Construed, held novel, valid and infringed, *Barker v. Shoots*, 18 Fed. Rep., 647. Decree in favor of reissue set aside on account of a collusive case, *Barker v. Todd*, 15 Fed. Rep., 265. See, also, *Barker v. Todd*, 22 O. G., 1448; *v. Stowe*, 11 Fed. Rep., 303.
- 116266.** Cary, A. June 27, 1871. Method of Tempering Springs.
Process held infringed by substituting cooling by water for cooling by air, the substance of the invention being taken, *Cary v. Lowell Mfg. Co.*, 32 O. G., 1009. Construed to be

for a new application of an old process, producing a new, highly useful result; held patentable, and infringed by use of process with a higher degree of heat, *Cary v. Wolff*, 32 O. G., 257.

- 116922.** Blakeslee, E. E. July 11, 1871. Threading Sheet Metal Screws.
Detweiler v. Voegel, 19 Blatch., 482.
- 116935.** Day, C. T. July 11, 1871. Skate.
Reissue No. 8590, Feb. 18, 1879.
Held novel and infringed, *Spaeth v. Gibson*, 15 Fed. Rep., 810. See, also, *Spaeth v. Barney*, 22 Fed. Rep., 828.
- 117255.** Buffum, A. K. P. July 25, 1871. Machine for Making Wooden Gutters for Buildings.
Reissue No. 6675, Oct. 5, 1875.
Construed and limited in view of state of art; is for same invention as original; novel, and not infringed, *Buffum v. Oakland Mfg. Co.*, 4 Ban. & Ard., 599.
- 117430.** Knox & Osborn. July 25, 1871. Ore Roasting Furnace.
Construed and held not infringed, *Knox v. New Ideria Mining Co.*, 4 Fed. Rep., 813; *v. Quicksilver Mining Co.*, 4 Fed. Rep., 809.
- 117627.** Hatch, J. W. Aug. 1, 1871. Apparatus for Crimping the Stiffenings of Boots and Shoes.
Reissue No. 6319, March 9, 1875.
Broad claim 5 for process void, not being in original; claim 3 infringed, *Hatch v. Moffitt*, 15 Fed. Rep., 252.
- 117831.** Truby, J. W. Aug. 8, 1871. Show-case Sockets.
Reissue No. 5748, Jan. 27, 1874.
Construed to be for a substitution of material wanting in patentable invention, *Terhune v. Phillips*, 99 U. S., 592.
- 117841.** Westinghouse, Jr., G. Aug. 8, 1871. Steam-power Car-brake.
Reissue No. 5506, July 29, 1873.
Held valid; novel, patentable and infringed, *Westinghouse v. Gardner, etc.*, Air-brake, 2 Ban. & Ard., 55.
- 117925.** Pollard, W. H. Aug. 8, 1871. Gas Pump.
Gould's Mfg Co. v. Cowing, 12 Blatch., 243; 14 Blatch., 315; 105 U. S., 253.
- 118404.** Tate, W. J. Aug. 22, 1871. Quilting Machine.
Claim 8 construed and infringed, *Tate v. Thomas*, 22 Fed. Rep., 660.
- 118440.** Eastman, R. Aug. 29, 1871. Composition for Soap.
Sustained, and held infringed by material changes and additions in percentage composition, *Eastman v. Hinckel*, 5 Ban. & Ard., 1.
- 118617.** Cornell, G. B. Aug. 29, 1871. Bung Brush and Wrench.
Reissue No. 5026, Aug. 6, 1872.
Construed to be for a combination, and not infringed, *Schumacher v. Cornell*, 96 U. S., 549.
Reissues Nos. 5026 and 5027, Aug. 6, 1872.
Construed; limited, and held not infringed, *Cornell v. Littlejohn*, 2 Ban. & Ard., 324; 9 O. G., 922. Construed; are for patentable subject-matter, and infringed by change in form, *Cornell v. Downer & Bemis Brewing Co.*, 7 Biss., 346.
- 118622.** Marsh, T. Aug. 29, 1871. Cut Ring Supporter.
Draper v. Wattles, 16 O. G., 629.
- 118725.** Knapp, A. H. Sept. 5, 1871. Curtain Fixtures.
Reissue No. 6925, Feb. 15, 1876.
Claim 3 held to be for matter not found in original, *Knapp v. Shaw*, 15 Fed. Rep., 115. See, also, *Shaw v. Soule*, 20 Fed. Rep., 790.
- 119212.** Yale, Jr., L. Sept. 19, 1871. Post-office Box.
Reissue No. 8783, July 1, 1879.
Claims 4 and 5 void for new matter; claims 1, 2 and 3 sustained and infringed, *Yale Lock Mfg. Co. v. Scovill Mfg. Co.*, 18 Blatch., 248. Original held not inoperative or defective; reissue held not reissued for mistake in original; claim 2 construed and limited in view of file-wrapper and contents, and not infringed, *Yale Lock Mfg. Co. v. James*, 20 Fed. Rep., 903. Not infringed, *Yale Lock Mfg. Co. v. Scovill Mfg. Co.*, 15 Fed. Rep., 342.
- 119561.** Bogart, A. L. Oct. 3, 1871. Electric Gas Lighter.
Claim 1 construed in view of state of art; sustained, and held not anticipated by a burner made of substantially the same material but without thought of its insulating properties, and held to involve invention, *Bogart v. Hinds*, 34 O. G., 1510.
- 119705.** Heath, E. A. Oct. 10, 1871. Cuspadore.
Construed to be for substitution of material involving mechanical skill and not inven-

- tion; wanting in novelty, *Ingersoll v. Turner*, 7 Fed. Rep., 859. Construed to be for a novel and patentable invention; held valid and sustained, *United States Stamping Co. v. King*, 17 Blatch., 55. Held novel, valid, and infringed, *United States Stamping Co. v. Jewett*, 18 Blatch., 469. See, also, *Ingersoll v. Musgrove*, 14 Blatch., 541; *v. Jewett*, 16 Blatch., 378.
- 119846.** Henry, A. Oct. 10, 1871. Rifled Fire-arms.
Held to have expired with end of original foreign term, and not of extended foreign term; void for public use more than two years prior to date of application, *Henry v. Providence Tool Co.*, 3 Ban. & Ard., 501.
- 120057.** Gramme & D'Ivernois. Oct. 17, 1871. Magneto-electric Machine.
Held to have expired with termination of prior Austrian patent, *Gramme Electrical Co. v. Arnoux & Hochhausen Electrical Co.*, 17 Fed. Rep., 838.
- 120133.** Van Hoevenberg, H. Oct. 17, 1871. Printing Telegraph.
Construed and held not infringed, *Gold & Stock Telegraph Co. v. Wiley*, 17 Fed. Rep., 234.
- 120638.** Griggs, G. H. Nov. 7, 1871. Spark Arrester.
Reissue No. 5050, Sept. 10, 1872, and 5051, Sept. 10, 1872.
Construed, held novel and infringed, *Pike v. Providence & Worcester R. Co.*, 1 Holmes, 445.
- 120874.** Holmes & Roome. Nov. 14, 1871. Electrical Safe Covering.
Construed, and sustained for specific improvement; not void because of lapse of prior English patent for failure to pay tax, *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.*, 21 Fed. Rep., 458. Not limited by expiration of an English patent in which the device was not patented, *Ibid.*, 22 Fed. Rep., 341.
- 120949.** Doane & McKee. Nov. 14, 1871. Band Sawing Machine.
Construed and held not infringed, *Fay & Co. v. Cordesman Bros.*, 109 U. S., 408.
- 121119.** Morse, G. F. Nov. 21, 1871. Ornamenting Glass and Metal Surfaces.
Tilghman v. Morse, 9 Blatch., 421.
- 121158.** Cooke, C. L. Nov. 21, 1871. Railway Switches.
Reissue No. 7690, May 22, 1877.
Construed; held to cover a patentable improvement, and is novel, *Cooke v. New York Central & H. R. R. Co.*, 4 Ban. & Ard., 308.
- 121544.** Phillips, R. C. Dec. 5, 1871. Wooden Pavement.
Construed, and held infringed by a block with sides sliced off, as a subterfuge, *Phillips v. City of Detroit*, 2 Flip., 92. Construed to be for a change of material, and held void for want of invention and of novelty, *Ibid.*, 4 Ban. & Ard., 347. Construed in view of common knowledge, and held to involve mechanical skill only, *Ibid.*, 111 U. S., 604.
- 121569.** Alden, C. Dec. 5, 1871. Preserving Vegetable and Animal Substances.
Reissue No. 5648, Nov. 11, 1873.
Process claim 1 held wanting in novelty, *Alden Evaporating Fruit Co. v. Bowen*, 32 O. G., 1355.
- 121746.** Bauman, A. H. Dec. 12, 1871. Apparatus for Drying Sand.
Construed liberally, as not including in the combination claimed an element not mentioned therein, and not indispensable to its operation; sustained and infringed, *Bradley v. Dull*, 19 Fed. Rep., 913.
- 121920.** Winchell, J. F. Dec. 12, 1871. Fare-box.
Void for want of invention, *Slawson v. Grand Street, etc., R. Co.*, 17 Blatch., 512. Held to be for a new application of an old device not involving invention, 107 U. S., 649.
- 122001.** Eagleton, J. J. Dec. 19, 1871. Furniture Spring.
Held invalid, in view of unauthorized amendment constituting the essence of the invention, inserted in original application by attorney, *Eagleton Mfg. Co. v. West, Bradley & Cary Mfg. Co.*, 18 Blatch., 218. Held invalid for want of novelty, and not patentee's invention, *Ibid.*, 111 U. S., 490.
- 122030.** Kelleher & Randlett. Dec. 19, 1871. Boot and Shoe Pads.
Reissue No. 6698, Oct. 27, 1874.
Claim 4 invalid for new matter.
Reissues Nos. 6098 and 6099, Oct. 27, 1874.
Sustained and infringed, *Kelleher v. Darling*, 4 Cliff., 424.
- 122215.** Beckwith, N. F. Dec. 26, 1871. Saw-mill Dogs.
Construed; not anticipated by prior unsuccessful experiment; held novel, and infringed, *Allis v. Buckstaff*, 22 O. G., 1705. See, also, *Allis v. Stowell*, 5 Ban. & Ard., 458; 19 O. G., 727; 9 Fed. Rep., 304; 16 Fed. Rep., 783; 23 O. G., 1033; *Neacy v. Allis*, 22 O. G., 1621.

1872.

- 122520.** Frazer, M. B. Jan. 9, 1872. Cheese Hoop.
Tyler *v.* Galloway, 22 O. G., 2072.
- 123325.** Blackman, E. Feb. 6, 1872. Lamp Chimney.
Reissue No. 7417, Dec. 5, 1876.
Void for want of identity of invention with original, Blackman *v.* Hibbler, 17 Blatch., 333.
- 123603.** Albright, A. Feb. 13, 1872. Dies for Rubber-coated Harness.
Reissue No. 5155, Nov. 26, 1872.
Construed, and held infringed by a substitution involving colorable variation only; patentee held first inventor, Albright *v.* Celluloid Harness Trimming Co., 2 Ban. & Ard., 629.
See, also, Albright *v.* Teas, 23 O. G., 829.
- 123625.** Fish, W. L. Feb. 13, 1872. Sewing Machine Bobbin.
Fish *v.* Domestic Sewing Machine Co., 12 Fed. Rep., 495.
- 123687.** Franz & Pope. Feb. 13, 1872. Knitting Machine.
Declared good, valid, and infringed, Franz & Pope Knitting Machine Co. *v.* Lamb Knitting Machine Mfg. Co., 19 O. G., 1000.
- 123670.** Blessing, J. H. Feb. 13, 1872. Steam Trap.
Reissue No. 5549, Aug. 26, 1873.
Construed, and limited, in view of state of art; claim 1 held wanting in novelty; claim 5 not infringed, Albany Steam Trap Co. *v.* Felthousen, 20 Fed. Rep., 633.
- 123811.** Crowell, L. C. Feb. 20, 1872. Paper Bag.
Patentee held prior inventor on interference with No. 134,244, Union Paper Bag Machine Co. *v.* Crane, 1 Holmes, 429.
- 123927.** Parker, B. S. Feb. 20, 1872. Dies for Forging Ox-shoes.
Reissue No. 6113, Nov. 3, 1874.
Validity of claim 3 doubted, Gunn *v.* Savage, 25 Fed. Rep., 101.
- 124011.** Ritchie, D. A. Feb. 27, 1872. Tube.
Held valid, in view of sufficient description of the making of the article, Lamb *v.* Hamblen, 11 Fed. Rep., 722.
- 124180.** Warth, A. Feb. 27, 1872. Cloth Cutting Machine.
Limited and not infringed, Warth *v.* Browning, 5 Ban. & Ard., 341.
- 124218.** Pattee, J. H. March 5, 1872. Cultivator.
Reissue No. 6080, Oct. 6, 1874.
Construed, and limited to combination of old elements, and held not infringed, Pattee *v.* Moline Plow Co., 10 Biss., 377. Claim 2 held expanded beyond legal limits, and void, Pattee Plow Co. *v.* Kingman, 23 Fed. Rep., 801.
- 124319.** Beecher & Swift. March 5, 1872. Paper Box.
Construed, and limited to description; combination claim 1 held not infringed, Munson *v.* Hall, 19 Fed. Rep., 320.
- 124340.** Dalton, J. March 5, 1872. Ladies' Hair Nets.
If broadly construed, is for a substitution of material not involving invention; if limited to specific combination, is not infringed, Dalton *v.* Jennings, 12 Blatch., 96. Void for want of novelty and of invention, *Ibid.*, 93 U. S., 271.
- 124590.** Kells, P. H. March 12, 1872. Brick Machine.
Reissue No. 8867, Aug. 19, 1879.
Void for new matter, Kells *v.* McKenzie, 9 Fed. Rep., 248.
- 124878.** Blood, H. S. March 26, 1872. Derrick.
Converse *v.* Cannon, 2 Woods, 7.
- 125250.** Andrews, S. B. April 2, 1872. Spring Bed Bottoms.
Construed, and limited, in view of limitation in description, to a wooden frame in combination, and not infringed by an iron one, Harris *v.* Allen, 15 Fed. Rep., 106.
- 125329.** Price, D. C. April 2, 1872. Portable Show and Circus Seats.
Held not infringed, Price *v.* Kelley, 2 Ban. & Ard., 543; 20 O. G., 1452.
- 125421.** Turnbull & Webb, April 9, 1872. Bed Bottoms.
Reissue No. 5312, March 4, 1873.
Claim 2 construed broadly; is not valid; if limited, is not infringed; claim 3 construed, in view of state of art, to be for mechanical skill, not involving invention, National Wire Mattress Co. *v.* New York Braided Wire Mattress Co., 20 Fed. Rep., 119.
- 125547.** Day, A. April 9, 1872. Railway Track Cleaner.
Reissue No. 8388, Aug. 27, 1878.
Held infringed, Day *v.* Detroit City Railway Co., 22 O. G., 946. Claim 4 construed, in view of state of art, to be for a combination not involving invention, but mechanical skill only, Day *v.* Fairhaven & W. R. Co., 23 Fed. Rep., 189.

126285. Graves, R. C. April 30, 1872. Grates.

Reissue No. 9959, Dec. 6, 1881.

Construed, and limited, in view of state of art, to the particular combination described, and not infringed by use of less than all its elements, *Gould v. Spicer*, 20 Fed. Rep., 317.**126446.** Cochran, J. W. May 7, 1872. Breech Loader.Not abandoned by laches in prosecuting the application, nor by prior experimental use, *United States Rifle & Cartridge Co. v. Whitney Arms Co.*, 14 Blatch., 92.**126847.** Stearns, J. B. May 14, 1872. Duplex Telegraph.

Reissue No. 10,035, Feb. 7, 1872. Division C.

Claim 2 held valid and reissued within a reasonable time, in view of ambiguous original claim, which was not apparent on the face of the patent, *Western Union Telegraph Co. v. Baltimore & O. Telegraph Co.*, 25 Fed. Rep., 30.**126938.** Demartini & Chertizza. May 21, 1872. Ballasting Vessels.Not infringed by substituting for one element of the combination a new mode, not a mechanical equivalent, *American Ballast Log Co. v. Barnes*, 4 Hughes, 278. Sustained in conformity with prior decisions in other circuits, *American Ballast Log Co. v. Cotter*, 11 Fed. Rep., 728.**126968.** Keller, N. J. May 21, 1872. Sand and Gravel Separator.*Keller v. Stolzenbach*, 20 Fed. Rep., 47.**127045.** Gardner, G. May 21, 1872. Chair Seat.

Reissue No. 9094, Feb. 24, 1880.

Construed, in view of prior decisions, to be for applying an old process to an old material to obtain an old form, which, although mechanically better, does not involve invention, *Gardner v. Herz*, 12 Fed. Rep., 491.Reissue No. 7203, July 4, 1876, construed and held wanting in novelty, *Ibid.*, 16 Blatch., 303.**127090.** Moffitt, J. R. May 21, 1872. Heel-stiffener.

Reissue No. 6162, Dec. 8, 1874.

Claim 1 void for new matter, *Moffitt v. Rogers*, 106 U. S., 423. If broadly construed, is invalid; if limited, is not infringed, *Ibid.*, 4 Ban. & Ard., 225.**127098.** Osgood, J. H. May 21, 1872. Base Ball Cover.

Reissue No. 7046, April 11, 1876.

Construed to be for unpatentable mechanical adaptation, *Mahn v. Harwood*, 3 Ban. & Ard., 515. Invalid for unreasonable delay in reissuing the new and enlarged claims, *Ibid.*, 112 U. S., 354.**127159.** Draper, G. May 28, 1872. Bobbin and Spindle.

Reissue No. 6016, Aug. 18, 1874.

Held novel, useful and patentable; not void for new matter; claims 1, 3, 4 and 6 infringed, *Draper v. Potomska Mill Corporation*, 3 Ban. & Ard., 214.**127211.** Aram & Williams. May 28, 1872. Carriage Axle Turning Machine.Construed to be not merely for a combination of old elements, but to be for a new element made efficient when used with older devices; held novel and infringed, *Aram v. Moline Wagon Co.*, 16 Fed. Rep., 236.**127858.** Dorlan, J. M. June 11, 1872. Sizing Paper.*Dorlan v. Guie*, 25 Fed. Rep., 816.**127933.** Snow, G. B. June 11, 1872. Steam Bell Ringer.Construed and limited, *Snow v. Lake Shore & Mich. S. R'y Co.*, 18 Fed. Rep., 602.**127964.** Dedrick, C. H. June 18, 1872. Manufacture of Soles from Hides.Decreed to be void, claim being found to embrace what was in a former patent, *Adamson v. Dedrick*, 2 O. G., 523.**128411.** Matthews, J. June 25, 1872. Soda Fountain.

Reissue No. 8834, Aug. 5, 1879.

Construed; held broader than original, and void for delay in reissuing, *Matthews v. Iron-clad Mfg. Co.*, 21 Fed. Rep., 641. See, also, *Matthews v. Green*, 19 Fed. Rep., 649; *v. Iron-clad Mfg. Co.*, 19 Fed. Rep., 321.**128925.** Taylor, A. T. July 9, 1872. Trunk.Claim 3 construed to be for a combination, infringed by mere mechanical changes; held novel in view of state of art. Doubted whether all the claims can be joined in one patent, *Sessions v. Romadka*, 21 Fed. Rep., 124.**129018.** Fisher, Wm. B. July 16, 1872. Seed Steaming Apparatus.

Reissue No. 8615, March 11, 1879.

Held void for expanded claims, *Gage v. Kellogg*, 23 Fed. Rep., 891.**129338.** Hatch, J. W. July 16, 1872. Heel-stiffener.

Reissue No. 6388, April 20, 1875.

Validity doubted, *Hatch v. Moffitt*, 15 Fed. Rep., 252.

- 129844.** McCreary, J. July 23, 1872. Coupling and Steering Apparatus.
Reissue No. 5630, Oct. 28, 1873.
Sustained as for invention identical with original, and held not affected by immaterial alterations in the drawings; held novel and infringed, *McCreary v. Pennsylvania Canal Co.*, 5 Fed. Rep., 367.
- 129858.** Olmsted, J. July 23, 1872. Insulating Telegraph Wires.
Reissues Nos. 6954 (Process) and 6955 (Product), Feb. 29, 1876.
Invention construed to be for application of old process to a new subject, without substantial alteration, and not to involve invention; both reissues void, *Western Electric Mfg. Co. v. Ansonia Brass & Copper Co.*, 9 Fed. Rep., 706. Process construed, in view of state of art, to be for application of old process to same subject, without change in manner of applying it, and with no substantially distinct result, and is invalid for want of novelty, *Ibid.*, 114 U. S., 447.
- 129893.** Knapp, A. H. July 30, 1872. Curtain Fixture.
Reissue No. 7182, June 20, 1876.
Claim 2 held infringed, *Knapp v. Shaw*, 15 Fed. Rep., 115. See, also, *Shaw v. Soule*, 20 Fed. Rep., 790.
- 129901.** Osgood, E. July 30, 1872. Process for rendering Leather Flexible.
Reissue No. 8186, April 16, 1878.
Product claim 1 held abandoned, and void for laches in reissuing; claim 2 construed, and held not infringed. *Union Tubing Co. v. Patterson & Co.*, 23 Fed. Rep., 79.
- 130440.** Poling, G. Aug. 13, 1872. Cultivator.
Construed and limited to combination of old elements, and held not infringed, *Pattee v. Moline Plow Co.*, 10 Biss., 377.
- 130514.** Mann, R. J. Aug. 13, 1872. Sieve.
Dayton v. Wright & Herring, 11 O. G., 197.
- 130529.** Pennock, J. L. Aug. 13, 1872. Rolling Mill.
Rejected claim held a novel, useful and patentable combination, *Pennock, Ex parte*, 1 MacArthur, 531.
- 130672.** Sutro, H. Aug. 20, 1872. Cards for Wrapping Threads.
Reissue No. 6751, Nov. 13, 1875.
Construed, limited, sustained, and not infringed, *Sutro v. Moll*, 19 Blatch., 89.
- 130770.** Tirrell, J. P. Aug. 20, 1872. Electric Apparatus for Lighting Street Lamps.
Reissue No. 9743, June 7, 1881.
Construed; claim 5 held to be for a combination not in original, being for mechanism to operate the device claimed in original, *Electric Gas Lighting Co. v. Smith & Rhodes Electric Co.*, 23 Fed. Rep., 195. Claims 2 and 5 held invalid, being for matter not claimed in original, and delay in reissuing, intervening rights having accrued, *Electric Gas Lighting Co. v. Tillotson*, 21 Fed. Rep., 568.
- 130871.** Rouse, R. R. Aug. 27, 1872. Well Tubes.
Rouse v. Fletcher, 9 O. G., 838.
- 130961.** Webster, Wm. Aug. 27, 1872. Loom.
Specification held insufficient; claim 5 is for an aggregation, *Webster Loom Co. v. Higgins*, 15 Blatch., 447. Claim 5 construed to be for a combination of six elements, and infringed by substituting a well-known equivalent for one of them, *Webster v. New Brunswick Carpet Co.*, 1 Ban. & Ard., 84. Description held sufficient; claim 5 construed to be for a combination involving invention and not for an aggregation, and is infringed. Patentee held first and original inventor, *Webster Loom Co. v. Higgins*, 105 U. S., 580. See, also, *Webster Loom Co. v. New Brunswick Carpet Co.*, 2 Ban. & Ard., 67; *v. Higgins*, 13 Blatch., 349; *v. Short*, 10 O. G., 1019.
- 131004.** Huntington, F. M. Sept. 3, 1872. Machine for Punching and Stamping Metal.
Interfering patent No. 114,068 decreed void, *Sturges v. Van Hagen*, 6 Fish., 572.
- 131098.** Harper, J. M. Sept. 3, 1872. Fly-trap.
Reissue No. 6493, June 22, 1875.
Construed; limited and sustained, in view of state of art, and is infringed, *Harper v. Cook*, 5 Ban. & Ard., 50. See, also, *National Mfg. Co. v. Meyers*, 23 O. G., 1443.
- 131201.** Williams, L. F. Sept. 10, 1872. Overshoe.
Construed as not limited to specific shape of cut of each part of extension shown in drawing, and held infringed, *Williams v. Candee*, 18 Blatch., 140.
- 131217.** Hoe, R. M. Sept. 10, 1872. Printing Press.
Patent issued to joint inventors, one of whom, as sole inventor, filed caveat; held valid; claims 3 and 4 construed, and infringed, *Hoe v. Kahler*, 12 Fed. Rep., 111. Construed and above affirmed, *Ibid.*, 25 Fed. Rep. 271. See, also, *Hoe v. Boston Daily Advertiser*, 14 Fed. Rep., 914.

- 131616.** Hyde, I. Sept. 24, 1872. Water Wheel and Sewing Machine Combined.
Reissue No. 5590, Oct. 7, 1873.
Patentability doubtful; anticipated by description in prior English provisional specification, *Backus Water Motor Co. v. Tuerk, Jr.*, 17 Fed. Rep., 350.
- 131695.** Mason, J. L. Sept. 24, 1872. Fruit Jar.
Consolidated Fruit Jar Co. v. Whitney, 1 Ban. & Ard., 356.
- 131936.** Carter & Dwyer. Oct. 8, 1872. Base Burning Stove.
Reissue No. 6979, March 7, 1876.
Decreed valid and infringed, *Detroit Stove Works v. Michigan Stove Co.*, 12 O. G., 189.
- 132074.** Heyel, H. R. Oct. 8, 1872. Boxes.
Construed strictly in view of state of art, and held not infringed, *Ketcham v. Jaques*, 22 Fed. Rep., 399.
- 132111.** Stebins, T. Oct. 8, 1872. Hydraulic Elevator.
Construed and held infringed, *Stebins Hydraulic Elevator Mfg. Co. v. Stebins*, 4 Fed. Rep., 445.
- 132112.** Stebins, T. Oct. 8, 1872. Safety Devices for Elevators.
Held infringed, *Stebins Hydraulic Elevator Co. v. Stebins*, 4 Fed. Rep., 445.
- 132128.** Adams, A. H. Oct. 15, 1872. Corn-sheller.
Sustained as novel in view of state of art, and infringed by device differing in degree only, *Adams v. Joliet Mfg. Co.*, 3 Ban. & Ard., 1.
- 132208.** Hobbs, J. H. Oct. 15, 1872. Glass Ware.
Held novel, sustained, and infringed by improvement, *Hobbs v. King*, 8 Fed. Rep., 91.
- 132368.** Palmer, C. T. Oct. 2, 1872. Paper Boxes.
Claim 1 void for want of novelty, *Patterson v. Stapler*, 7 Fed. Rep., 210.
- 132547.** Snow, G. K. Oct. 29, 1872. Method of Cutting out Collars.
Construed to be for a neat application of a well known operation, not patentable in view of state of art, *Snow v. Taylor*, 14 O. G., 861.
- 132566.** Dederick, P. K. Oct. 29, 1872. Hay and Cotton Press.
Reissue No. 8130, March 19, 1878.
Claims 3, 5, 7, 8, 10 and 11 held invalid, *Dederick v. Cassell*, 9 Fed. Rep., 306. Reissue No. 8316, July 2, 1878. Claim 2 invalid; claim 1 valid, *Ibid.*, 9 Fed. Rep., 306.
- 132639.** Dederick, P. K. Oct. 29, 1872. Hay and Cotton Press.
Reissue No. 7984, Dec. 11, 1877.
Claim 5 invalid; claims 2 and 3 valid, *Dederick v. Cassell*, 9 Fed. Rep., 306.
Reissue No. 8312, July 2, 1878.
Claim 6 invalid, *Ibid.*, 9 Fed. Rep., 306.
- 132909.** Hull, D. C. Nov. 12, 1872. Whip Stock Manufacture.
Reissue No. 5651, Nov. 11, 1873.
Construed; claim 1 held novel and infringed; claim 2 void for want of novelty, *American Whip Co. v. Hampden Whip Co.*, 4 Fed. Rep., 536.
- 133217.** Garratt, W. T. Nov. 19, 1872. Lubricator.
Reissue No. 5328, March 18, 1873.
Sustained in interference for priority of invention, *Garratt v. Siebert*, 98 U. S., 75. Decreed void in interference, patentee not being first and original inventor, *Siebert v. Garratt*, 8 O. G., 600.
- 133601.** Stover, E. & D. C. Dec. 3, 1872. Windmill.
Reissue No. 6101, Oct. 27, 1874.
Held novel; claims 3, 4, 5 and 6 infringed, *Eclipse Windmill Co. v. Woodmanse Windmill Co.*, 32 O. G., 1605.
- 134105.** Snow, G. K. Dec. 17, 1872. Uniting Paper and Cloth.
Construed and held novel, *Snow v. Tapley*, 3 Ban. & Ard., 228.
- 134128.** Daddow, S. H. Dec. 24, 1872. Squib for Blasting.
Wanting in novelty, *Richards v. Hays*, 32 O. G., 1011.
- 134244.** Benner, L. D. Dec. 24, 1872. Paper Bags.
Held on interference subsequent to No. 123,811, *Union Paper Bag Machine Co. v. Crane*, 1 Holmes, 429.
- 134404.** Stow, H. M. Dec. 31, 1872. Wood Pavement.
Construed to be for the omission of an element in a prior combination; held wanting in invention, and void for want of novelty, *Stow v. City of Chicago*, 8 Biss., 47. Construed, limited and held wanting in novelty, *Ibid.*, 104 U. S., 547.
- 134486.** Price, D. C. Dec. 31, 1872. Portable Show and Circus Seats.
Held not infringed, *Price v. Kelley*, 2 Ban. & Ard., 534; 20 O. G., 1452.

1873.

- 134653.** Donn, H. D. Jan. 7, 1873. Saw-dog.
Reissue No. 6733, Nov. 9, 1875.
Claim 1 construed to be an expanded claim and held void, *Neacy v. Allis*, 22 O. G., 1621.
- 134690.** Manning, J. Jan. 7, 1873. Isinglass Manufacture.
Declared invalid for public use more than two years prior to date of application, *Manning v. Cape Ann Isinglass & Glue Co.*, 23 O. G., 2413.
- 135650.** Lloyd, E. Feb. 11, 1873. Puddling Furnace.
Construed; limited, sustained, and not infringed, *Lloyd v. Miller*, 19 Fed. Rep., 915.
- 135815.** Keene, G. A. Feb. 11, 1873. Carriage Step.
Construed; held novel and not anticipated by a rejected application, *Rubber-step Co. v. Metropolitan R. Co.*, 13 O. G., 549.
- 135899.** Foote, E. Feb. 18, 1873. Wire Bag Fastener.
Held not anticipated, and is novel, *Foote v. Frost*, 3 Ban. & Ard., 607.
- 136763.** Reed, G. A. March 11, 1873. Head Lining for Barrels.
Construed to be for mechanical skill, and held wanting in patentable invention, *Reed v. Reed & Folts*, 12 Blatch., 366.
- 136801.** Wollensak, J. F. March 11, 1873. Transom Lifter.
Reissue No. 9307, July 20, 1880.
Construed, and limited to particular combination described, in view of state of art, and held not infringed, *Wollensak v. Reiher*, 115 U. S., 87.
- 137702.** Matthews, J. April 8, 1873. Soda Fountain.
Reissue No. 8837, Aug. 5, 1879.
Held to have been on sale more than two years prior to date of application, *Matthews v. Iron Clad Mfg. Co.*, 21 Fed. Rep., 641. See, also, *Matthews v. Iron Clad Mfg. Co.*, 19 Fed. Rep., 321.
- 137873.** Albright, A. April 15, 1873. Rubber Coated Harness Trimming Manufacture.
Infringed by an experimental use only, *Albright v. Celluloid Harness Trimming Co.*, 2 Ban. & Ard., 629.
- 137893.** Cohn, M. April 15, 1873. Corset.
Invalid for want of novelty, *Cohn v. United States Corset Co.*, 12 Blatch., 225. Void because of prior published description in an English provisional specification, *Ibid.*, 93 U. S., 366.
- 137911.** Gilbert, C. April 15, 1873. Apparatus for Starch Manufacture.
Sustained, *New York Grape Sugar Co. v. American Grape Sugar Co.*, 10 Fed. Rep., 835. See, also, *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 20 Fed. Rep., 505; 32 O. G., 1356; *v. Peoria Grape Sugar Co.*, 21 Fed. Rep., 878.
- 138209.** Spooner, A. F. April 22, 1873. Baby Jumper.
Construed; held novel and infringed, *Spooner v. Dorn*, 24 Fed. Rep., 700.
- 138243.** Gates, J. April 29, 1873. Lubricator.
Sustained; patentee being prior inventor, *Siebert Cylinder Oil Cup Co. v. Phillips Lubricator Co.*, 10 Fed. Rep., 677.
- 138462.** Woodbury, J. P. April 29, 1873. Planing Machine.
Patentee held not original inventor; invention held abandoned subsequent to application, *Woodbury Patent Planing Machine Co. v. Keith*, 101 U. S., 479. Patentee held not original inventor; invention held not abandoned, *Ibid.*, 4 Ban. & Ard., 100.
- 138490.** Field, E. S. May 6, 1873. Bed Bottom.
Reissue No. 9919, Nov. 1, 1881.
Claims 1 and 2 void for expansion; if limited, not infringed, *National Wire Mattress Co. v. New York Braided Wire Mattress Co.*, 20 Fed. Rep., 119.
- 138491.** Field, E. S. May 6, 1873. Bed Bottom.
Reissue No. 9920, Nov. 1, 1881.
Nothing that is valid of the expanded reissue is infringed, *National Wire Mattress Co. v. New York Braided Wire Mattress Co.*, 20 Fed. Rep., 119.
- 139121.** Davis, J. W. May 20, 1873. Pantaloon Pocket Fastener.
Reissue No. 6335, March 16, 1875.
Held novel; involving patentable invention, and not mere double use or aggregation, *Strauss v. King*, 18 Blatch., 88.
- 139348.** Wood, T. H. May 27, 1873. Carriage Spring.
Reissue No. 6018, Aug. 18, 1874.
Sustained, *Brewster v. Parry*, 14 Fed. Rep., 694.
- 139365.** Bruce, D. W. May 27, 1873. Printing-type.
Construed, and held in view of specification to involve invention; is novel, *Bruce v. Marder*, 10 Fed. Rep., 750.

139784. Grebner, M. June 10, 1873. Wire Cage.

Reissue No. 8594, Feb. 25, 1879.

Construed to be for an enlargement of the original device, and held void, *Meyer v. Maxheimer*, 9 Fed. Rep., 99.**139820.** Sawyer, C. P. June 10, 1873. Cotton Gin.

Reissue No. 6169, Dec. 8, 1874.

Specification held insufficient; subject-matter involves a change of form only, wanting in invention; patentee is not first and original inventor, *Sawyer v. Miller*, 12 Fed. Rep., 725. Held, on interference, subsequent in date of invention to No. 167,679 (?), and declared void in part, *Sawyer v. Massey*, 25 Fed. Rep., 144.**139846.** McKeever, S. June 10, 1873. Cartridge Box.*McKeever v. United States*, 14 Court of Claims, 396; 18 Court of Claims, 757.**140020.** Eppinger, I. June 17, 1873. Bunch and Plug Tobacco.Sustained as a novel and patentable change of form, involving invention, *Eppinger v. Richey*, 14 Blatch., 307.**140536.** Pope, F. L. July 1, 1873. Electric Railroad Signal.Held not infringed; patentee not first and original inventor, *Electric R. R. Signal Co. v. Hall R. R. Signal Co.*, 6 Fed. Rep., 603. Construed to be for a new combination of old devices to accomplish a new result; limited, in view of specification, and held not infringed by an inherently different combination, *Ibid.*, 114 U. S., 87.**140619.** Firth, J. B. July 8, 1873. Cake Pans.Construed to be for a manufacture; held to involve invention; not anticipated by single uncombined elements; limited and infringed by improvement, *Bell v. United States Stamp- ing Co.*, 19 Fed. Rep., 312.**140635.** Merrill, Geo. July 8, 1873. Knitting Machine.Construed and limited in view of patent office requirements acquiesced in by patentee; as limited, is not infringed, *New York Belting & Packing Co. v. Sibley*, 15 Fed. Rep., 386.**141357.** Joyce, J. L. July 29, 1873. Boot and Shoe Manufacture.

Reissue No. 6480, June 8, 1875.

Construed, held valid and infringed, *Stevens v. Pritchard*, 4 Cliff., 417.**141473.** Thompson, S. R. Aug. 5, 1873. Bushing for Faucet Holes.

Reissue No. 8483, Nov. 12, 1878.

Construed to be for a different invention from original and invalid; combination in- fringed by sale of part with intent to procure infringement, *New York Bung & Bushing Co. v. Hoffman*, 9 Fed. Rep., 199.

Reissue No. 10,368, Aug. 25, 1883.

Claim 1 construed, in view of state of art, to be for a substitution of material not in- volving invention; if limited, not infringed, *New York Bung & Bushing Co. v. Doelger*, 23 Fed. Rep., 191. Decided in conformity with above, *New York Bung & Bushing Co. v. Foehrenbach*, 23 Fed. Rep., 195.**141587.** Painter, W. Aug. 5, 1873. Pump Valve.Held infringed, *Odorless Excavating Co. v. Lauman*, 12 Fed. Rep., 788; *v. McCauley*, 2 Ban. & Ard., 570.**142154.** Eachus, J. Aug. 26, 1873. Machine for Cutting Paper Boards.

Reissue No. 6315, March 2, 1875.

Original construed, and limited, in view of the then state of art, to the particular combi- nation of mechanical elements claimed; reissue process claim compared and held to be for a different invention from original, and void, *Eachus v. Broomall*, 115 U. S., 429.**142323.** Blessing, J. H. Sept. 2, 1873. Steam Traps.

Reissue No. 8286, June 18, 1878.

Construed and limited in view of state of art, and not infringed, *Albany Steam Trap Co. v. Felthousen*, 20 Fed. Rep., 633; 32 O. G., 1239.**142377.** Dunks, C. H. Sept. 2, 1873. Spring Bed Bottoms.*Dunks v. Grey*, 5 Ban. & Ard., 634.**142661.** Aston, J. B. Sept. 9, 1873. Black Washing Molds.*Smith v. Marshall & Co.*, 10 O. G., 375.**142810.** O'Haire, J. A. Sept. 16, 1873. Street Car.Construed, and held anticipated by a prior abandoned device demonstrated to be capable of accomplishing the result sought, *Stephenson v. Brooklyn Cross-Town R. Co.*, 19 Blatch., 473. Held wanting in novelty both as to the elements and the combination, in view of state of art at date of application; is not infringed, *Ibid.*, 114 U. S., 149.**142933.** Nation & Little. Sept. 16, 1873. Cooking Stove.Construed; claim 1 held void for want of novelty, *Bussey v. Excelsior Mfg. Co.*, 110 U. S., 131.

- 142934.** Nation & Little. Sept. 16, 1873. Cooking Stove.
Construed; claims 1 and 2 held void for want of novelty; claim 3 for aggregation, *Bussey v. Excelsior Mfg. Co.*, 110 U. S., 131.
- 143149.** Hayes, G. Sept. 23, 1873. Sky-light.
Reissue No. 8676, April 15, 1879.
Claim 1, if construed broadly, is not novel; if limited, not infringed, *Hayes v. Dayton*, 20 Fed. Rep., 690. See, also, *Hayes v. Bickelhaupt*, 19 O. G., 177; *v. Dayton*, 18 O. G., 1406; *v. Leton*, 5 Fed. Rep., 521.
- 143153.** Hayes, G. Sept. 23, 1873. Sky-light.
Reissue No. 8689, April 29, 1879.
Claim 3 held not infringed, *Hayes v. Seton*, 12 Fed. Rep., 120; *v. Dayton*, 20 Fed. Rep., 690. Claim 3 construed in view of disclaimer; held novel, valid, and infringed, *Hayes v. Bickelhaupt*, 23 Fed. Rep., 183. Construed, sustained, and infringed, *Ibid.*, 21 Fed. Rep., 567. See, also, *Hayes v. Bickelhaupt*, 19 O. G., 177; *v. Dayton*, 18 O. G., 1406; *v. Leton*, 5 Fed. Rep., 521.
- 143359.** Lippman, P. Sept. 30, 1873. Corset Clasp.
Construed to be for making and selling part of an old and known manufacture, as a new way of trade, and held not valid, *Seligman v. Day*, 14 Blatch., 72.
- 143396.** Daddow, E. A. Sept. 30, 1873. Squib for Blasting.
Reissue No. 8364, Aug. 6, 1878.
Held wanting in novelty, *Richards v. Hays*, 32 O. G., 1011.
- 143421.** Richardson, H. M. Oct. 7, 1873. Children's Carriage.
Construed and limited to specific device, *Richardson v. Noyes*, 2 Ban. & Ard., 398.
Reissue No. 10363, Aug. 7, 1883.
Claim 1 construed in view of state of art, and held to involve invention; is infringed, *Parker v. Stow*, 23 Fed. Rep., 252. Construed and sustained in view of above, and is infringed, *Parker v. Montpelier Carriage Co.*, 23 Fed. Rep., 886. See, also, *Parker v. McKee*, 32 O. G., 137.
- 143600.** Vinton, J. J. Oct. 14, 1873. Manufacture of Iron from Slag.
Construed to be for a double use, and void for want of novelty and invention, *Vinton v. Hamilton*, 104 U. S., 485.
- 143783.** Platts & Walden. Oct. 21, 1873. Crimping and Folding Leather.
Platts & Walden, *Ex parte*, 15 O. G., 827.
- 144164.** Teas, A. Oct. 28, 1873. Saddle-tree.
Teas v. Albright, 22 O. G., 2069; *Albright v. Teas*, 106 U. S., 613.
- 145726.** Crosby, G. H. Dec. 23, 1873. Pressure Gauges.
Construed; held novel and infringed, *Crosby Steam Gauge & Valve Co. v. Ashcroft Mfg. Co.*, 17 Fed. Rep., 85.
- 145787.** Collender, H. W. Dec. 23, 1873. Billiard Table.
Reissue No. 6469, June 1, 1875.
Construed; held wanting in novelty, *Collender v. Griffith*, 18 Blatch., 110.
- 146012.** Mége, H. Dec. 30, 1873. Treating Animal Fats.
Reissue No. 5868, May 12, 1874.
If broadly construed, is invalid; if limited, not infringed, *United States Dairy Co. v. Smith*, 19 Fed. Rep. See, also, *Brosnahan, In re*, 4 Dill., 1.
- 146085.** Mayall & Williams. Dec. 30, 1873. Printing Press Sheet Deliverer.
Reissue No. 7786, July 3, 1877.
Decree directing the issuing of the reissue, *Mayall & Williams*, 11 O. G., 1107.

1874.

- 146120.** Backus, O. J. Jan. 6, 1874. Water Motor.
Claim 1 held to involve mechanical skill only; claim 2 held not infringed, *Backus Water Motor Co. v. Tuerk, Jr.*, 17 Fed. Rep., 350.
- 146597.** Klein, J. C. Jan. 20, 1874. Picks.
Reissue No. 6951, Feb. 29, 1876.
Held novel and patentable, in view of new step in process, and is infringed, *Klein v. Kloman, Park & Co.*, 3 Ban. & Ard., 145.
- 146614.** Rice, H. W. Jan. 20, 1874. Steam Boiler.
Reissue No. 6422, May 4, 1875.
Construed to be for a different invention from original; held wanting in novelty and void, *Heald v. Rice*, 104 U. S., 437. See, also, *Rice v. Heald*, 13 Pac. L. R., 33.
- 146832.** Little, S. A. Jan. 27, 1874. Time Lock.
Reissue No. 8550, Jan. 21, 1879.
Claim 7 construed, and limited in view of state of art; held to involve invention, and is

- novel; claims 1 and 7 infringed, *Yale Lock Mfg. Co. v. Norwich National Bank*, 19 Blatch., 123. Claims 1 and 7 sustained, and infringed, *Yale Lock Mfg. Co. v. Berkshire National Bank*, 17 Fed. Rep., 531.
- 147045.** Cottle, S. Feb. 3, 1874. Chain, etc., for Necklace.
Reissue No. 5774, Feb. 24, 1874.
Construed, and limited to the described material; held a novel and patentable invention, and sustained, *Mulford v. Pearce*, 13 Blatch., 173. Claim 1 construed to involve mechanical skill only, and void for want of patentability, if not for novelty; claim 2 held void for want of novelty, *Pearce v. Mulford*, 102 U. S., 112. See, also, *Mulford v. Pearce*, 14 Blatch., 141.
- 147288.** Simonds & Emery. Feb. 10, 1874. Machinery for Molding Heel Stiffenings.
Not abandoned by experimental use, *Emery v. Cavanagh*, 17 Fed. Rep., 242.
- 147343.** Miles, P. Feb. 10, 1874. Bail-ears for Pails.
Construed, in view of state of art, to be for mechanical skill, and held not patentable; claim 2 void for aggregation, *Double Pointed Tack Co. v. Two Rivers Mfg. Co.*, 9 Biss., 258; 109 U. S., 117. Claim 2 held void for aggregation; claims 1 and 3 void; are for mere change of form, and not patentable, *Double Pointed Tack Co. v. Mann*, 5 Ban. & Ard., 465.
- 147423.** New, T. Feb. 10, 1874. Tank for Asphalt.
Reissue No. 6683, Oct. 5, 1875.
Held not infringed, *New v. Warren*, 22 O. G., 587.
Reissue No. 6684, Oct. 5, 1875.
Construed to be for the mere operation of a machine, and not patentable as a process. Invalid, not being claimed in original, *New v. Warren*, 22 O. G., 587.
- 147629.** Gale, H. Feb. 17, 1874. Plow-jointer.
Reissue No. 6824, Dec. 28, 1875.
Construed and sustained, *Gale Mfg. Co. v. Prutzman*, 17 O. G., 743.
- 147906.** Coté, L. Feb. 24, 1874. Machinery for Forming Boot and Shoe Stiffeners.
Reissue No. 7356, Oct. 24, 1876.
Held novel, and infringed, *Coté v. Moffitt*, 8 Fed. Rep., 15. See, also, *Coté v. Moffitt*, 15 Fed. Rep., 345.
- 148368.** Jones, W. March 10, 1874. Self-lubricating Axle.
Reissue No. 6129, Nov. 10, 1874.
Jones v. Field, 12 Blatch., 494.
- 148447.** Hahl, A. March 10, 1874. Electric Elevator Indicator.
Construed to be for a combination, and not an aggregation; is sufficiently described, novel, and involves invention, *Western Electric Mfg. Co. v. Chicago Electric Mfg. Co.*, 14 Fed. Rep., 691.
- 148497.** Saladee. March 10, 1874. Running Gear for Vehicles.
Reissue No. 9729, May 31, 1881.
Construed and limited, in view of state of art, and not infringed by omission of elements of the claim, *Saladee v. Racine Wagon and Carriage Co.*, 20 Fed. Rep., 686.
- 148538.** Wollensak, J. F. March 10, 1874. Transom Lifter.
Reissue No. 10,264, Dec. 26, 1882.
Claims alleged infringed; void for delay in reissuing, *Wollensak v. Reiher*, 22 Fed. Rep., 651. Held that the omission in the original of the reissue claims was a mistake apparent on face of patent, on examination with reasonable care, and void for unexplained delay in reissuing, *Ibid.*, 115 U. S., 96.
- 148596.** Clark, N. D. March 17, 1874. Lawn Sprinkler.
Pennington v. Hunt, 20 Fed. Rep., 195.
- 148737.** Millner, J. C. March 17, 1874. Tobacco Curing Furnace.
Reissue No. 9108, March 2, 1880.
Construed to be for a combination of old parts, and wanting in novelty and invention, *Millner v. Voss*, 4 Hughes, 262.
- 148747.** Pentlarge, P. March 17, 1874. Bungs for Casks.
Reissue No. 5937, June 30, 1874.
Claim 1 construed and held not infringed, *Pentlarge v. New York Bung & Bushing Co.*, 5 Ban. & Ard., 594. See, also, *Pentlarge v. Beetson*, 15 Blatch., 347; 15 Blatch., 352; 18 Blatch., 38.
- 148765.** Shorey, S. W. March 17, 1874. Sewing Machine Attachment.
Reissue No. 10,067, March 28, 1882.
Construed; held novel, useful and patentable. Properly reissued to correct seemingly inaccurate description; claim held identical with original; infringed by structural difference in form and size only, *Sewing Machine Co. v. Frame*, 28 O. G., 96.

- 149092.** Brainard, C. R. March 31, 1874. Compositor's Copy Distributor.
Sustained as involving patentable invention; held novel and infringed, *Brainard v. Pulsifer*, 7 Fed. Rep., 349. Held wanting in patentable novelty, in view of state of art, *Brainard v. Evening Post Ass'n*, 19 Fed. Rep., 422.
- 149276.** Wilson, J. W. March 31, 1874. Preserving Meat.
Reissue No. 6370, April 6, 1875.
Patentability doubted, *Wilson Packing Co. v. Clapp*, 8 Biss., 154. Construed and held void for want of novelty, *Wilson Packing Co. v. Hunter*, 10 Biss., 559. Construed and limited, in view of disclaimers to process set forth in specification; held to be for an aggregation, and void for want of novelty and of invention, *Ibid.* (Packing Co. Cases), 105 U. S., 566.
- 149480.** Hurcombe. Apr. 7, 1874. Umbrella Cases.
Construed and held infringed, *Odiorne v. Denney*, 3 Ban. & Ard., 278.
- 149589.** Lindsay & Kalb. Apr. 14, 1874. Fire Brick.
Foster v. Lindsay, 8 O. G., 1032; 3 Dill., 126.
- 149875.** McNish, C. A. April 21, 1874. Annealing Box.
Void for prior public use and abandonment, *McNish v. Everson*, 2 Fed. Rep., 899.
- 149896.** Van Geasen, H. Apr. 21, 1874. Clothes Tag.
Construed, limited and not infringed, *Kimball v. Cunningham*, 22 Fed. Rep., 445.
- 149954.** Royer, H. Apr. 21, 1874. Treating Raw Hide.
Process construed, limited and not infringed; doubted that patentee was first inventor, *Royer v. Chicago Mfg. Co.*, 20 Fed. Rep., 853.
- 150195.** Searls, A. Apr. 28, 1874. Whip Socket.
Reissue No. 9297, July 13, 1880.
Sustained and held infringed, *Searls v. Bouton*, 12 Fed. Rep., 140. Void for being broader than original, *Ibid.*, 12 Fed. Rep., 874; 12 Fed. Rep., 625. Held novel, *Searls v. Van Nest*, 5 Ban. & Ard., 456.
- 150305.** Dodge, J. W. Apr. 28, 1874. Finishing Tool for Boot and Shoe Edges.
Held to be for a practical machine; claims 4 and 5 held, in view of state of art, to involve invention; are valid and infringed, *Fifield v. Whittemore*, 17 Fed. Rep., 513.
- 150683.** Glidden, J. F. May 12, 1874. Barbed Fence Wire.
Reissue No. 6913, Feb. 8, 1876.
Construed; held to involve invention, and sustained, *Washburn & Moen Mfg. Co. v. Haish*, 10 Biss., 83. Held novel in view of state of art; useful, valid, and infringed, *Ibid.*, 10 Biss., 65. Construed in view of original; void for expanded claim and laches in reissuing, *Washburn & Moen Mfg. Co. v. Fuchs*, 16 Fed. Rep., 661. See, also, *Washburn & Moen Mfg. Co. v. Crowell*, 1 Fed. Rep., 225; *Iowa Barbed Steel Wire Co., In re*, 5 Ban. & Ard., 279.
- 150854.** Foster, A. F. May 12, 1874. Fire Brick Composition.
Foster v. Lindsay, 3 Dill., 126; 8 O. G., 1032.
- 150921.** Whitnum, S. May 12, 1874. Coal Scuttle.
Limited in view of patentee not being first in the art; not infringed, *Whitnum v. Seaman*, 4 Fed. Rep., 436.
- 150933.** Barton, E. C. May 19, 1874. Toy Bell.
Reissue No. 6644, Sept. 14, 1875.
Held novel, valid, and claims 1 and 2 infringed, *Gong Bell Mfg. Co. v. Clark*, 13 O. G., 274.
- 151477.** Dederick, P. K. June 2, 1874. Hay and Cotton Press.
Reissue No. 8292, June 18, 1878.
Dederick v. Cassell, 20 O. G., 1233.
- 151703.** Irwin, J. H. June 9, 1874. Lantern.
Considered, *Steam Gauge & Lantern Co. v. Miller & Co.*, 8 Fed. Rep., 314. Construed; claim 2 infringed, *Ibid.*, 21 Fed. Rep., 514. Infringement doubted, *Steam Gauge & Lantern Co. v. St. Louis Railway Supplies Mfg. Co.*, 33 O. G., 889.
- 151730.** Theobald, G. June 9, 1874. Saddle Trees.
Construed, and held not to cover the articles which were marked as patented under it, *Tompkins v. Butterfield*, 33 O. G., 758.
- 152560.** King, W. R. June 30, 1874. Plastering Hair Bale.
Held void for want of novelty and of patentable invention, *King v. Frostel*, 8 Biss., 510. Void for want of invention, being for old process applied to old materials, *King v. Gallun*, 109 U. S., 99.
- 152636.** Heyl, H. R. June 30, 1874. Paper Boxes.
Reissue No. 7488, Feb. 6, 1877.
Claim 2 construed to be for same invention as original; limited in view of state of art, and is not infringed, *Novelty Paper Box Co. v. Stapler*, 5 Fed. Rep., 919.

- 152649.** Kimball, Wm. S. June 30, 1874. Preparing Tobacco.
Construed broadly in view of state of art, and is infringed by substitution of equivalent for part of the process, *Kimball v. Hess*, 15 Fed. Rep., 393.
- 152864.** Pickles, J. C. July 7, 1874. Car Spring.
Reissue No. 6321, March 9, 1875.
Held not anticipated by an abandoned experiment; sustained and infringed, *Pickering v. Miller*, 16 Fed. Rep., 450.
- 153110.** Pennock, J. L. July 14, 1874. Puddling Furnace.
Declared good and valid, *Pennock v. Beale*, 13 O. G., 125.
- 153225.** Spies, A. B. July 21, 1874. Harrow.
Construed and sustained in view of state of art, and held infringed, *Ward v. Grand Detour Plow Co.*, 14 Fed. Rep., 696.
- 153965.** Kennedy, C. Aug. 11, 1874. Barbed Fence Wire.
Held novel in view of state of art, useful and infringed, *Washburn & Moen Mfg. Co. v. Haish*, 10 Biss., 65.
- 154400.** Knapp, A. H. Aug. 25, 1874. Curtain Fixture.
Claim 5 held wanting in novelty and invalid, *Knapp v. Shaw*, 15 Fed. Rep., 115. See, also, *Shaw v. Soule*, 20 Fed. Rep., 790.
- 154985.** Hibbard, G. W. Sept. 15, 1874. Feather Duster.
Sustained; patentee being first and original inventor, and interfering patent No. 177,933 set aside, *National Feather Duster Co. v. Hibbard*, 9 Fed. Rep., 558. Invention doubted, *National Feather Duster Co. v. Dearborne Duster Co.*, 24 O. G., 497.
- 154989.** Joyce, J. O. Sept. 15, 1874. Lifting Jack.
Claim 1 limited to combination of described parts and held not infringed, *Joyce v. Chillicothe Foundry and Machine Works*, 15 Fed. Rep., 260.
- 155077.** Field, J. F. Sept. 15, 1874. Glove Fastening.
Construed, limited and not infringed, *Field v. De Comean*, 5 Ban. & Ard., 40; *v. Ireland*, 19 Fed. Rep., 835.
- 165110.** Messer, L. June 29, 1875. Pocket-book Clasp.
Reissue No. 8106, Feb. 26, 1878.
Construed, sustained, held novel and infringed, *Zinn v. Weiss*, 7 Fed. Rep., 914.
- 155374.** Guilder, A. R. Sept. 29, 1874. Middlings Purifier.
Reissue No. 8386, Aug. 20, 1878.
Construed to be for a new combination of old elements and held infringed, *Consolidated Middlings Purifier Co. v. Guilder*, 3 McCrary, 186.
- 155451.** Knapp, R. Sept. 29, 1874. Buckboard Wagon.
Construed in view of patentee being first in the art; sustained and held infringed, *Knapp v. Joubert*, 19 Blatch., 148.
- 155534.** McDonald, H. M. Sept. 29, 1874. Skirt Protector.
Limited, in view of disclaimer, and held novel, *McDonald v. Blackmer*, 9 O. G., 746. Sustained, and held infringed, *McDonald v. Shepard*, 4 Fed. Rep., 228; 4 Ban. & Ard., 343; *v. Siedenbergh*, 4 Ban. & Ard., 586. See, also, *McDonald v. Shepard*, 10 Fed. Rep., 919; *v. Blackmer*, 4 Ban. & Ard., 78.
- 155601.** Vogler, H. Oct. 6, 1874. Trunk.
Reissue No. 6849, Jan. 11, 1876.
Construed broadly in view of state of art; held novel and infringed, *Vogler v. Semple*, 7 Biss., 382.
- 155670.** Painter & Keizer. Oct. 6, 1874. Pump for Emptying Cess-pools.
Held novel and infringed, *Odorless Excavating Co. v. McCauley*, 2 Ban. & Ard., 570.
- 155806.** Miller, F. C. Oct. 13, 1874. Cigar Molds.
Reissue No. 6662, Sept. 28, 1875.
Held novel, useful and patentable, *Miller & Peters Mfg. Co. v. Du Brul*, 2 Ban. & Ard., 618.
- 155814.** Stockton, W. Oct. 13, 1874. Water Closet.
Claim 1 construed to be for a combination of old elements involving invention; sustained and held infringed, *Stockton v. Maddock*, 10 Fed. Rep., 132.
- 155962.** McKay & Fairfield. Oct. 13, 1874. Nailing Machine for Boots and Shoes.
Reissue No. 7014, March 28, 1876.
Construed to be a deliberate contradiction of original; enlarged claims 1, 2 and 3 invalid; claim 4 not infringed, *McKay v. Stowe*, 17 Fed. Rep., 516.
- 156149.** Frey, J. A. Oct. 20, 1874. Coal Oil Stove.
Reissue No. 7751, June 19, 1877.
Limited to original term of prior foreign patent, exclusive of any extension of such foreign term, *Reissner v. Sharp*, 16 Blatch., 383. Not void for new matter, *Reissner v. Anness*

- & Blauvelt, 3 Ban. & Ard., 176. See, also, *Reissner v. Anness & Blauvelt*, 3 Ban. & Ard., 148; 13 O. G., 7.
- 156195.** Wheeler, Wm. H. Oct. 20, 1874. Windmill.
Reissue No. 9493, Dec. 7, 1880.
Construed and held infringed by use of an equivalent, *Eclipse Windmill Co. v. May*, 17 Fed. Rep., 344. Held novel, and claim 1 infringed, *Eclipse Windmill Co. v. Woodmanse Windmill Co.*, 32 O. G., 1605.
- 156267.** Barber, L. L. Oct. 27, 1874. Sewing Machine Cutting Attachment.
Reissue No. 7860, Aug. 28, 1877.
Claims 2 and 8 infringed, *Barber v. Hallett*, 10 Fed. Rep., 130.
- 156277.** Clark, C. B. Oct. 27, 1874. Shutter Hinge.
Lull v. Clark, 22 O. G., 1535.
- 156302.** Miller, J. October 27, 1874. Bottle Stopper.
Reissue No. 9002, Dec. 23, 1879.
Void, being on its face for a different invention from original, *Putnam v. Tinkham*, 4 Fed. Rep., 411. Claim 1 void for matter disclaimed in original, not constituting mistake or inadvertence, also for delay in reissuing, *Putnam v. Hutchinson*, 12 Fed. Rep., 127. Sustained over interfering patent No. 225,476. Infringed by substitution of equivalent constituting a colorable departure, *Ibid.*, 12 Fed. Rep., 131. See, also, *Putnam v. Hollender*, 11 Fed. Rep., 75.
- 156311.** Quirolo, A. Oct. 27, 1874. Stereoscope.
Reissue No. 6557, July 27, 1875.
Construed to be for putting an old device to a new use, and held wanting in novelty, *Quirolo v. Ardito*, 17 Blatch., 400.
- 156429.** Lindsay, J. P. Nov. 3, 1874. Sleeve Supporter.
Lindsay v. Stein, 21 O. G., 1613.
- 156858.** Presbrey, E. F. Nov. 17, 1874. Ornamenting Bracelets, etc.
Reissue No. 10,239, Nov. 14, 1882.
Construed broadly and held infringed, *Royce v. Fifield*, 18 Fed. Rep., 262.
- 157124.** Glidden, J. F. Nov. 24, 1874. Barbed Fence Wire.
Wanting in invention, *Washburn & Moen Mfg. Co. v. Haish*, 10 Biss., 65. Held, in view of its great utility, to involve invention; not anticipated by single prior device established only by conflicting evidence in the memory of witnesses twenty-five years back; sustained, *Washburn & Moen Mfg. Co. v. Grinnel Wire Co.*, 24 Fed. Rep., 23.
- 157367.** Bright, J. M. Dec. 1, 1874. Horse-collar.
Construed and limited, in view of state of art, to specific device, and not infringed, *Osmer v. Sickles Saddlery Co.*, 23 Fed. Rep., 724.
- 157395.** Hersome, C. Dec. 1, 1874. Shoe Buckle.
Held, in view of state of art, to be a novel and patentable improvement, and is infringed, *Emerson v. Howe*, 8 Fed. Rep., 327.
- 157508.** Glidden & Vaughan. Dec. 8, 1874. Barbing Fence Wires.
Reissue No. 7566, March 20, 1877.
Washburn & Moen Mfg. Co. v. Crowell, etc., Co., 1 Fed. Rep., 225; *Iowa Barbed Steel Wire Co., In re*, 5 Ban. & Ard., 279.
- 158249.** Cone, H. D. Dec. 29, 1874. Ruled Paper Manufacture.
Construed, in view of state of art, to be for a mere changing the space of lines; cannot be sustained independent of method, and does not constitute invention of a new product, *Cone v. Powers*, 4 Ban. & Ard., 107.

1875.

- 158406.** De Quillfeldt, C. Jan. 5, 1875. Bottle Stopper.
Reissue No. 7722, June 5, 1877.
Sustained, and not anticipated by an abandoned experiment, *Putnam v. Hollender*, 19 Blatch., 49. Sustained, and not anticipated by an abandoned experiment; claims 1 and 9 infringed, *Putnam v. Vom Hofe*, 19 Blatch., 63.
- 158482.** Foye, W. H. Jan. 5, 1875. Plow.
Construed in view of drawing; held useful, novel, and claims 1, 4 and 5 infringed, *Foye v. Nichols*, 22 O. G., 2243.
- 158604.** Siedler, C. Jan. 12, 1875. Plug Tobacco Label.
Reissue No. 7362, Oct. 24, 1876.
Held novel and valid, *Lorillard & Co. v. Dohan*, 9 Fed. Rep., 509. Claims 1 and 3 held wanting in invention, *Lorillard & Co. v. Ridgeway*, 4 Ban. & Ard., 564. Claim 1 held not infringed, *Lorillard & Co. v. Drummond Tobacco Co.*, 22 O. G., 1208. Claims 1, 3 and 4 construed, and limited in order to be sustained, and held not infringed, *Lorillard Co. v.*

- McAlpin, 22 O. G., 1208. Construed, held novel, valid, patentable and infringed, *Lorillard & Co. v. McDowell*, 2 Ban. & Ard., 531.
- 158869.** Streit, C. Jan. 19, 1875. Rocking Chair.
Reissue No. 9046, Jan. 13, 1880.
Construed; claims 1, 6 and 7 held not infringed; claim 5 void for new matter, for laches in reissuing, and for claiming what was impliedly disclaimed in original, *Streit v. Lauter*, 11 Fed. Rep., 309.
- 158967.** Mundy, Jos. S. Jan. 19, 1875. Friction Drum.
Reissue No. 9289, July 13, 1880.
Claim 4 construed to be for a novel and patentable combination, involving invention, and not mere mechanical skill, and is for a simplification of a prior machine; infringed by equivalents in combination, although supported differently, *Mundy v. Lidgerwood Mfg. Co.*, 20 Fed. Rep., 114. Construed as above, and infringed by substitution of well known equivalents, *Mundy v. Kendall*, 23 Fed. Rep., 591. See, also, *Mundy v. Lidgerwood Mfg. Co.*, 20 Fed. Rep., 191.
- 159433.** Matthews, J. Feb. 2, 1875. Vessel for Containing Gases and Liquids Under Pressure.
Claim 5, if broadly construed, is wanting in novelty; if limited, is not infringed; its prior use held a public, not an experimental, use, *Matthews v. Iron-clad Mfg. Co.*, 21 Fed. Rep., 641.
- 159467.** Strobridge, T. Feb. 2, 1875. Coffee Mill.
Reissue No. 7583, March 27, 1877.
Construed to be for a novel and patentable combination, involving invention, *Strobridge v. Lindsay*, 2 Fed. Rep., 692. Claim 1 infringed by dividing patented device into two parts, which, united, produced the same result in substantially the same way, *Ibid.*, 6 Fed. Rep., 510. Held to be for same invention as original; claim 1 construed to be for a combination; held novel and infringed, *Strobridge v. Landers*, 11 Fed. Rep., 880.
- 159577.** Hyslop, Jr., J. Feb. 9, 1875. Shoe-shank Machine.
Claim held to describe an operative device; is novel, patentable and infringed, *Jenkins v. Gurney*, 23 Fed. Rep., 898.
- 159741.** Barker, V. Feb. 16, 1875. Green Corn Cutters.
Construed and limited in view of state of art, and held infringed, *Jones v. Barker*, 11 Fed. Rep., 597.
- 159921.** Hart, Jr., W. H. Feb. 16, 1875. Neckties.
Reissue No. 7909, Oct. 9, 1877.
Claim 2, if construed broadly, is for new matter; if limited, is not infringed, *Hart v. Thayer*, 10 Fed. Rep., 746; 22 O. G., 1787.
- 159995.** Wolfe, D. J. Feb. 16, 1875. Torpedo Filling Machine.
Lilliendahl v. Detwiller, 18 Fed. Rep., 176.
- 160933.** Megraw, Wm. March 16, 1875. Brushes.
Held useful, novel, and infringed by mechanical equivalent, *Megraw v. Carroll*, 5 Ban. & Ard., 324.
- 161012.** Day, T. D. March 23, 1875. Skirt Protector.
Held valid and infringed, *Day v. Schwab*, 2 Fed. Rep., 544.
- 161490.** Curran & Wilcox. March 30, 1875. Lumber Drier.
Reissue No. 8846, Aug. 12, 1879.
Construed, and held infringed by the use of all the elements of the combination except one, one of the elements being made to perform in addition the function of the omitted element, *Burdsall v. Curran*, 27 O. G., 1320.
- 161568.** Stephenson, J. March 30, 1875. Signaling Drivers on Street Cars.
Construed to be for placing an old device in a new place without change of result, and held wanting in invention, *Stephenson v. Brooklyn Cross-Town Co.*, 19 Blatch., 473; 114 U. S., 149.
- 161848.** Wilson, W. J. April 6, 1875. Sheet Metal Can.
Reissue No. 7923, Oct. 23, 1877.
Patentability doubted, *Wilson Packing Co. v. Clapp*, 8 Biss., 154. Construed to be for a result of mechanical skill only, and void, *Ibid.*, 8 Biss., 545. Claims 1 and 3 held wanting in novelty, *Wilson v. Hunter*, 10 Biss., 559; *Packing Cases*, 105 U. S., 566.
- 162157.** Downton, R. L. April 20, 1875. Flour Manufacture.
Construed and held void for want of novelty, and for uncertainty, *Downton v. Yaeger Milling Co.*, 1 McCrary, 26. Held anticipated by prior publication, *Ibid.*, 25 O. G., 697. See, also, *Downton v. Yaeger Milling Co.*, 3 McCrary, 414; *v. Allis*, 9 Fed. Rep., 766.
- 162400.** Maxheimer, J. April 20, 1875. Bird Cage.
Construed, held novel and sustained, *Maxheimer v. Meyer*, 9 Fed. Rep., 460.

- 162731.** White, J. April 27, 1875. Globe Holder.
Reissue No. 7286, Aug. 29, 1876.
Construed in view of claim, and held wanting in novelty, *White v. Gleason Mfg. Co.*, 8 Fed. Rep., 917. Construed, and held wanting in novelty; disclaimer disregarded as not performing its proper office, *i. e.*, to take away and not to add or change, *Ibid.*, 17 Fed. Rep., 159.
- 162886.** Bickford, D. May 4, 1875. Knitting Machine.
Held novel and is infringed, *Bickford v. Laporte*, 2 Fed. Rep., 214.
- 163474.** Goddu, L. May 18, 1875. Boot and Shoe Nailing Machine.
Held not infringed, *McKay v. Stowe*, 17 Fed. Rep., 516.
- 163537.** Shuey, Wm. H. May 18, 1875. Circus Seats.
Held not infringed, *Price v. Kelley*, 2 Ban. & Ard., 534; 20 O. G., 1452.
- 163794.** Messer, L. May 25, 1875. Pocket-book Clasp.
Reissue No. 8123, March 12, 1878.
Construed; sustained, held novel, and infringed by a colorable change, *Zinn v. Weiss*, 7 Fed. Rep., 914.
- 163825.** Wallick, W. May 25, 1875. Enameling Moldings.
Sustained and infringed, *Wallick v. Cantrell*, 12 Fed. Rep., 790.
- 164858.** Mehling, G. F. June 22, 1875. Wood Graining Process.
Construed to be for process, each step of which is essential; held not infringed by omission of first and last step, in which alone consists its claim to novelty. Novelty doubted, *Heller v. Bauer*, 19 Fed. Rep., 96.
- 164889.** Whidden, H. F. June 22, 1875. Shoe Nail.
Held valid and infringed, *Dunbar v. Albert Field Tack Co.*, 4 Fed. Rep., 543; *v. Estabrook*, 4 Fed. Rep., 545.
- 165110.** See ¶ 10, p. 812.
- 165832.** Hornum, W. H. July 20, 1875. Fare Register. Reissue No. 8013, Dec. 25, 1877.
Horman Patent Mfg. Co. v. Brooklyn City R. Co., 15 Blatch., 444.
- 166395.** Marks, M. Aug. 3, 1875. Caps.
Reissue No. 7808, July 24, 1877.
Construed to be for a patentable invention identical with original; held novel and infringed, *Marks v. Fox*, 18 Blatch., 502. Construed; infringement doubted, *Marks v. Corn*, 11 Fed. Rep., 900. Validity doubted in view of being for matter applied for in original application; rejected, and rejection acquiesced in, *Arnheim v. Finster*, 32 O. G., 256.
- 166669.** Williams, I. F. Aug. 10, 1875. Overshoes.
Reviewed and held infringed, *Williams v. Candee*, 18 Blatch., 140.
- 166700.** Illingworth, J. Aug. 17, 1875. Molds for Ingots.
Novelty doubted, *Illingworth v. Spaulding*, 9 Fed. Rep., 154. Construed; sustained, and infringed by mechanical equivalent, *Doyle v. Spaulding*, 19 Fed. Rep., 744.
- 166810.** Randel, W. Aug. 17, 1875. Button-hole Attachment.
Wright v. Randel, 19 Blatch., 495.
- 166819.** Shedd, J. Aug. 17, 1875. Shutter Fastener.
Construed and limited to particular device; held novel and valid, *Shedd v. Washburn*, 9 Fed. Rep., 904.
- 166907.** Teas, A. Aug. 17, 1875. Saddle Trees.
Teas v. Albright, 22 O. G., 2069; *Albright v. Teas*, 106 U. S., 613.
- 167040.** Theberath, C. M. Aug. 24, 1875. Harness Mountings.
Construed to be for change in form, proportion or degree only, and held wanting in patentable novelty, *Theberath v. Rubber and Celluloid Harness Trimming Co.*, 15 Fed. Rep., 246. Infringed, *Ibid.*, 3 Fed. Rep., 151. See, also, *Theberath v. Celluloid Mfg. Co.*, 3 Fed. Rep., 143.
- 167123.** Rogers, J. S. Aug. 24, 1875. Process of extracting Gelatine from salted Fish Skins.
Reissue No. 9296, July 13, 1880.
Held infringed, and not anticipated by an abandoned experiment, *Gloucester Isinglass & Glue Co. v. Brooks*, 19 Fed. Rep., 426.
- 167455.** Lockwood, R. Sept. 7, 1875. India Rubber Eraser.
Sustained; patentee held prior inventor in view of diligence in securing patent over a subsequent original inventor, *Lockwood v. Cleveland*, 18 Fed. Rep., 37; *v. Cutter Tower Co.*, 18 Fed. Rep., 653.
Construed and sustained in conformity with prior decisions, and held that disclaimer limited the claim to what had before been sustained, *Lockwood v. Hooper*, 25 Fed. Rep., 910. See, also, *Lockwood v. Cleveland*, 20 Fed. Rep., 164; 6 Fed. Rep., 721; *v. Cutter Tower Co.*, 11 Fed. Rep., 724.

167570. Royer, L. C. Sept. 7, 1875. Grain Separator.

Construed to be for an inoperative combination of old elements, and not infringed by an operative machine with material change in relations and functions, *Royer v. Russell & Co.*, 9 Fed. Rep., 696.

167585. Stephenson, J. Sept. 7, 1875. Street Cars.

Construed to be for a non-patentable aggregation, *Stephenson v. Brooklyn Cross-Town R. Co.*, 114 U. S., 149; 19 Blatch., 473.

167679. Massey, O. W. Sept. 14, 1875. Cotton Gin.

Awarded priority of invention on interference with patent No. 139,820, *Sawyer v. Massey*, 25 Fed. Rep., 144.

167814. Wolfe & Lilliendahl. Sept. 14, 1875. Torpedo Envelope Machine.

Lilliendahl v. Detwiller, 18 Fed. Rep., 176.

168164. Lawther, A. B. Sept. 28, 1875. Process for Treating Oleaginous Seed.

Construed, in view of state of art, to be for mechanical changes in carrying into effect the well known old steps of the process, and not for a process, as claimed; held that patent could not be sustained for a process. Questioned whether means for carrying out process are sufficiently described, *Lawther v. Hamilton*, 21 Fed. Rep., 811.

169855. Shenfield, A. Nov. 9, 1875. Suspender Button Strap.

Construed, and limited, in view of state of art, and held not infringed, *Shenfield v. Schirmer*, 21 Fed. Rep., 241.

169931. Ulman, W. F. Nov. 9, 1875. Pianoforte Pedals.

Wilson v. Chickering, 14 Fed. Rep., 917.

170462. Badger, G. W. Nov. 30, 1875. Boot Tree.

Held novel, useful and infringed, *Cox v. Ramsdell*, 4 Ban. & Ard., 326.

170809. Blatherwick, N. J. Dec. 7, 1875. Horse Shoe.

Construed in view of state of art; sustained, and held not infringed, *Blatherwick v. Cary*, 10 Biss., 494.

170852. Hayes, G. Dec. 7, 1875. Ventilating Louvers.

Claim 1 held to be for an aggregation; claim 5 is for mechanical skill only, *Hays v. Bickelhaupt*, 21 Fed. Rep., 566.

170916. Teas, A. Dec. 7, 1875. Harness-saddles.

Albright v. Teas, 106 U. S., 613; *Teas v. Albright*, 23 O. G., 2069.

170980. Badger, G. W. Dec. 14, 1875. Boring Machine.

Construed to be for a combination of old elements; claim 1 not infringed by omission of one of the elements; claim 2 limited, sustained, and infringed by use of a mere substitute for one of the elements, *Cox v. Ramsdell*, 4 Ban. & Ard., 326.

171133. Hornum, W. H. Dec. 14, 1875. Fare Register.

Reissue No. 8014, July 25, 1877.

Horman Patent Mfg. Co. v. Brooklyn City R. Co., 15 Blatch., 444.

171190. Sullivan, E. O. December 14, 1875. Fire-engine Harness.

Claim 3 broadly construed, patentee being first in the field of invention; is not for an abstraction, but for an apparatus to carry it out, and is infringed by improvements and equivalents. Patentee's claim to first inventorship held insufficiently disproved, *Worswick Mfg. Co. v. City of Buffalo*, 20 Fed. Rep., 126.

171568. Hull, A. J. Dec. 28, 1875. Wash-board.

Duff v. Stirling Pump Co., 107 U. S., 636.

1876.

171642. Ball, A. Jan. 4, 1876. Plow.

Cook v. Birdwell, 20 O. G., 1083.

171926. Eastman & Cottier. Jan. 11, 1876. Water-closet Ventilation.

Held not anticipated, *Cottier v. Stimson*, 20 Fed. Rep., 906.

172346. Royer, H. Jan. 18, 1876. Raw Hide Fulling Machine Attachment.

Construed to be for the application of an old device to an analogous use not involving patentable invention, *Royer v. Chicago Mfg. Co.*, 20 Fed. Rep., 853.

172534. Wheeler, N. Jan. 18, 1876. Filling Wood.

Not anticipated by a prior combination similar in chemical properties, but of different properties as applied; construed, held novel, and infringed, *Bridgeport Wood Finishing Co. v. Hooper*, 18 Blatch., 459.

172639. Mallett, F. W. Jan. 25, 1876. Grinding Needles.

Porter Needle Co. v. National Needle Co., 17 Fed. Rep., 536; 22 Fed. Rep., 829.

172896. Stebins, T. Feb. 1, 1876. Hydraulic Elevator.

Construed, *Stebins Hydraulic Elevator Mfg. Co. v. Stebins*, 4 Fed. Rep. 445.

- 172993.** Gray, E. Feb. 1, 1876. Electric Annunciator for Elevators.
Sustained, *Western Electric Mfg. Co. v. Chicago Electric Mfg. Co.*, 17 Fed. Rep., 691.
- 173124.** Judson, C. Feb. 8, 1876. Corset Spring.
Reissue No. 7729, June 12, 1877.
Construed to be for a combination of old elements; held novel and useful, valid, and infringed; not void for prior knowledge and use, *Judson v. Bradford*, 3 Ban. & Ard., 539.
Construed; infringement doubted, *Hardy v. Marble*, 10 Fed. Rep., 752.
- 173366.** Stockwell, E. Feb. 8, 1876. Time Lock.
Claim 1 construed, and held to involve mechanical skill only, *Yale Lock Mfg. Co. v. Norwich National Bank*, 19 Blatch., 123.
- 173371.** Teas, A. Feb. 8, 1876. Coach Pad.
Albright v. Teas, 106 U. S., 613; *Teas v. Albright*, 22 O. G., 2069.
- 174465.** Bell, A. G. March 7, 1876. Telephone.
Claim 5 construed, held valid and infringed, *American Bell Telephone Co. v. Spencer*, 8 Fed. Rep., 509. Construed; art infringed, *American Bell Telephone Co. v. Dolbear*, 15 Fed. Rep., 448. Held not anticipated by a prior instrument (Reis') capable of similar action to a very limited extent when used in a way not intended by its inventor, *Ibid.*, 17 Fed. Rep., 604. Sustained; patentee held first and original inventor, *American Bell Telephone Co. v. People's Telephone Co.*, 22 Fed. Rep., 309. Prior use of Drawbaugh's instrument held not established, *Ibid.*, 25 Fed. Rep., 725. See, also, *American Bell Telephone Co. v. Ghegan*, 23 O. G., 537.
- 174506.** Everest, H. B. March 7, 1876. Determining Grade of Lubricating Oil.
Construed to be for a process independent of the apparatus used; involves sufficient invention to sustain the patent; not invalidated by insufficiently proved prior use; sustained and infringed, *Everest v. Buffalo Lubricating Oil Co.*, 20 Fed. Rep., 848. See, also, *Everest v. Buffalo Lubricating Oil Co.*, 22 Fed. Rep., 252.
- 174684.** Kendall, T. W. March 14, 1876. Cultivator Runner.
Not infringed, *Pattee Plow Co. v. Kingman*, 23 Fed. Rep., 801.
- 176094.** Sutherland, D. A. April 11, 1876. Boot and Shoe Manufacture.
Reissue No. 7510, Feb. 13, 1877.
Held wanting in novelty in view of state of art; is for a different invention from original, and invalid, *Smith v. Merriam*, 6 Fed. Rep., 903.
- 176402.** Goodwin, W. F. April 18, 1876. Harvester.
Claim 14 construed and limited, in view of state of art, to the specific devices in combination, and held not infringed, *Goodwin v. Warren*, 21 Fed. Rep., 575.
- 176636.** Howard, E. L. April 25, 1876. Treadles.
Whiting v. Graves, 13 O. G., 455.
- 176719.** Westcott, J. M. April 25, 1876. Grain Drill.
Construed and limited, in view of state of art, and not infringed, *Grain Drill Manufacturer's Co. v. Rude*, 23 Fed. Rep., 348.
- 177020.** Simon, W. May 2, 1876. Traveling Bag.
Reissue No. 9772, June 21, 1881.
Claims 1 and 2 held valid; claim 3 is old; claims 4 and 5 held void for expansion made five years after grant of original. Not infringed by copying old parts only, *Simon v. Neumann*, 20 Fed. Rep., 196.
- 177216.** Dederick, P. K. May 9, 1876. Hay and Cotton Press.
Reissue No. 8296, June 25, 1878.
Dederick v. Cassell, 20 O. G., 1233.
- 177296.** Sutherland, D. A. May 9, 1876. Sewing Machine Presser-foot.
Reissue No. 7558, March 17, 1877.
Held valid and infringed, *Smith v. Merriam*, 6 Fed. Rep., 713.
- 177334.** Hutchins, A. B. May 16, 1876. Hydrocarbon Stove.
Held not infringed, *Sharp v. Riessner*, 15 Fed. Rep., 919. See, also, *Sharp v. Riessner*, 9 Fed. Rep., 445.
- 177466.** Brummitt, F. E. May 16, 1876. Utilizing Leather of old Card Clothing.
Construed and held wanting in novelty, *Brummitt v. Howard*, 3 Fed. Rep., 801.
- 177851.** Kells, P. H. May 23, 1876. Brick Machine.
Reissue No. 8127, March 19, 1878.
Void for being on sale for more than two years prior to date of application, *Kells v. McKenzie*, 9 Fed. Rep., 284.
- 177939.** Hibbard, S. M. May 30, 1876. Feather Duster.
Set aside, patentee of interfering patent No. 154,985 being held first and original inventor, *National Feather Duster Co. v. Hibbard*, 9 Fed. Rep., 588.

- 177953.** Niedringhaus, F. G. & W. F. May 30, 1876. Enameled Iron Ware.
Reissue No. 7779, July 3, 1877.
Construed to be for both process and product; is valid and infringed, *St. Louis Stamping Co. v. Quinby*, 4 Ban. & Ard., 192. See, also, *St. Louis Stamping Co. v. Quinby*, 5 Ban. & Ard., 275.
- 177986.** Belt & Perkins. May 30, 1876. Metallic Covering for Buildings.
Held wanting in novelty, *Belt v. Crittenden*, 1 McCrary, 209.
- 178287.** Gibbons, R. June 6, 1876. Pantaloon.
Held novel, and infringed, *Elfelt v. Steinhart*, 6 Sawyer, 480.
- 178428.** Gibbons, R. June 6, 1876. Pantaloon.
Construed, limited, and held not infringed by omission of an element of the combination, *Elfelt v. Steinhart*, 6 Sawyer, 480.
- 178463.** Peters, G. M. June 6, 1876. Tool for attaching Sheet Metal Moldings.
Claims 1 and 2 held wanting in novelty; claims 3 and 4 held not infringed, *Peters v. Active Mfg. Co.*, 21 Fed. Rep., 319.
- 178869.** Moffitt, J. R. June 20, 1876. Machine for Manufacturing Stiffeners for Boots and Shoes.
Process claim construed to be for uniting in one process of two old processes, and held void for want of novelty, *Moffitt v. Rogers*, 8 Fed. Rep., 147.
- 178896.** Bates, J. A. June 20, 1876. Rubber Boots.
Claims 1 and 2 held invalid; claims 5 and 6 held novel, *Moffitt v. Cavanagh*, 17 Fed. Rep., 336.
- 178916.** Dunbar, G. W. June 20, 1876. Preserving Shrimp.
Reissue No. 9957, Dec. 6, 1881.
Sustained, and held no enlargement of the original, *Dunbar v. White*, 15 Fed. Rep., 747.
See, also, *White v. Dunbar*, 26 O. G., 353.
- 178994.** Buzzell, J. G. June 20, 1876. Abrasive Paper for Finishing Shoes, etc.
Held wanting in novelty, *Buzzell v. Fifield*, 7 Fed. Rep., 465.
- 179190.** Hatch, Wm. B. June 27, 1876. Spring Bed Bottom.
Reissue No. 9576, Feb. 15, 1881.
Hatch v. Adams, 22 Fed. Rep., 434; *v. Hall*, 22 Fed. Rep., 438.
- 179316.** Irish, B. T. June 27, 1876. Photography.
Single claim construed to be dual, and to embrace two processes; one process held wanting in novelty, the other held valid and infringed, *Irish v. Knapp*, 5 Ban. & Ard., 47.
- 179581.** Lyman, W. C. July 4, 1876. Traps for Exhaust Steam Pipes.
Construed, and limited in order not to include forms of devices given to public by patentee more than two years prior to date of application; is not infringed, *Lyman v. Maypole*, 19 Fed. Rep., 735.
- 179583.** Matthews, J. July 4, 1876. Soda Fountain.
Claim 1 held not infringed; claim 2 held wanting in novelty, *Matthews v. Iron-clad Mfg. Co.*, 21 Fed. Rep., 641.
- 180001.** Bussey & McLeod. July 18, 1876. Cooking Stove.
Construed; limited in view of state of art, and held not infringed, *Bridge v. Excelsior Mfg. Co.*, 17 O. G., 259. Construed, and limited to specific device in view of state of art; as limited, is not infringed, *Ibid.*, 105 U. S., 618. See, also, *Bussey v. Excelsior Mfg. Co.*, 1 McCrary, 161.
- 180676.** Teas, A. Aug. 1, 1876. Harness Saddle-tree.
Albright v. Teas, 106 U. S., 613; *Teas v. Albright*, 22 O. G., 2069.
- 180717.** Isaacs, M. C. Aug. 8, 1876. Railway Track Brooms.
Construed to be for a patentable change in form and sustained; patentee held first and original inventor, *Isaacs v. Abrams*, 3 Ban. & Ard., 616.
- 180886.** Jackson, M. T. Aug. 8, 1876. Vehicle Running Gear.
Sustained and held infringed, *Grier v. Castle*, 17 Fed. Rep., 523.
- 181113.** Stebins, T. Aug. 15, 1876. Hydraulic Elevator.
Construed, *Stebins Hydraulic Elevator Mfg. Co. v. Stebins*, 4 Fed. Rep., 445.
- 181512.** Worley & McCabe. Aug. 22, 1876. Finishing Plug Tobacco.
Construed to be for a process, and held void for public use more than two years prior to date of application, *Worley v. Loker Tobacco Co.*, 104 U. S., 340.
- 182633.** Berton, L. T. Sept. 26, 1876. Mirror.
Construed; held valid and not anticipated, *Hall v. Stern*, 15 Fed. Rep., 463; 20 Fed. Rep., 788.
- 182973.** Votti, C. Oct. 3, 1876. Shade Holder for Lamp.
Reissue No. 7511, Feb. 13, 1877.
Construed, and in the absence of a sufficient description of part infringed, limited to

that shown in drawing, and held not infringed, *Schneider v. Lovell*, 10 Fed. Rep., 666. Claim 1 held void for want of invention, and patent held void for insufficient description in the specification, *Schneider v. Thill*, 5 Ban. & Ard., 565. See, also, *Schneider v. Thill*, 5 Ban. & Ard., 595; 18 Blatch., 241.

Reissue No. 10,087, April 11, 1882.

Declared *prima facie* valid, *Schneider v. Bassett & Co.*, 22 O. G., 1447. Held to remedy defects of original patent, and of prior reissue, by a sufficient description; held infringed by manufacture and sale of one element of the combination incapable of use except in such combination, *Schneider v. Pountney*, 21 Fed. Rep., 399.

183347. Waring, Jr., G. Oct. 17, 1876. Pocket Check Book.

Reissue No. 8199, April 23, 1878.

Construed to be for same invention as original; claim 1 held novel, sustained, and infringed, *Waring v. Johnson*, 19 Blatch., 38.

183545. Dickey & Perry. Oct. 24, 1876. Heating Stove.

Claim 2 held to be for an aggregation, and is invalid, *Perry v. Co-operative Foundry Co.*, 12 Fed. Rep., 436.

183809. Knapp, A. H. Oct. 31, 1876. Curtain Fixture.

Claim 1 held valid, and infringed, *Knapp v. Shaw*, 15 Fed. Rep., 115. See, also, *Shaw v. Soule*, 20 Fed. Rep., 790.

183913. Evarts, J. A. Oct. 31, 1876. Extension Lamp Fixtures.

Reissue No. 7628, April 4, 1877.

Construed; existence of a patentable combination doubted, *Bradley & Hubbard Mfg. Co. v. Charles Parker Co.*, 17 Fed. Rep., 240. Construed, and held that the part infringed, while shown in the drawing, and a mechanical feature of the patented device, was not in the mind of the patentee an essential part of his invention, nor was it made a distinctive part of the patented improvement, *Ibid.*, 34 O. G., 249.

184281. Dunham, H. Nov. 14, 1876. Boot and Shoe Nailing Machine.

Construed; combination claims 1, 2 and 3 infringed, *Dunham v. Kimball*, 17 Fed. Rep., 810.

184310. Walker, C. W. Nov. 14, 1876. Pocket Comb Cases.

Held not void for want of novelty, *Walker Glass Co. v. Souweine*, 32 O. G., 1466.

184352. Duffy, J. N. Nov. 14, 1876. Apparatus for Drying Hides.

Patentee held first and original inventor of claims 2, 3 and 4; infringement not shown, *Duffy v. Reynolds*, 33 O. G., 621.

184855. Funk, J. Nov. 28, 1876. Lamp.

Claim 2 in the reissue application held novel, and should be allowed, *Funk's Application*, 3 MacArthur, 460.

184896. Perkins, E. L. Nov. 28, 1876. Pasteboard Manufacturing Machine.

Void for public use more than two years prior to date of application, *Perkins v. Nashua Card, etc., Co.*; 2 Fed. Rep., 451.

184933. Vogeley, A. Nov. 28, 1876. Apparatus for labeling Glass Plates.

Construed; held sufficient to show the best mode of applying the invention, although not so shown in drawing, *Vogeley v. Noel*, 18 Fed. Rep., 827.

185119. Miller & Worley. Dec. 5, 1876. Finishing Plug Tobacco.

Reissue No. 8060, Jan. 29, 1878.

Held wanting in novelty, *Miller v. Foree*, 9 Fed. Rep., 603. Claim 1 held broader than original; construed to be for the application of an old process to the same material at a different stage, held not patentable and wanting in novelty, *Miller v. Foree*, 33 O. G., 1497. See, also, *Liggett & Myers Tobacco Co. v. Miller*, 1 McCrary, 31; *Miller v. Liggett & Myers Tobacco Co.*, 3 McCrary, 275.

185716. Beatty, J. P. Dec. 26, 1876. Hats.

Construed to be for an aggregation involving mechanical skill only, and is not novel, *Beatty v. Hodges*, 19 Blatch., 381.

1877.

186225. Beland, L. Jan. 16, 1877. Drill-clamp.

Construed to be for a combination, and held not infringed, *Rumsey v. Buck*, 20 Fed. Rep., 697.

186369. Sargent, J. Jan. 16, 1877. Time Lock.

Construed, and strictly limited in view of history of the application, and held not infringed, *Sargent v. Hall Safe & Lock Co.*, 114 U. S., 63.

186628. Schalscha, J. Jan. 23, 1877. Cigar.

Construed, limited and not infringed, *Schalscha v. Sutro*, 19 Fed. Rep., 319.

186787. Bell, A. G. Jan. 30, 1877. Telephone.

Held infringed, *American Bell Telephone Co. v. Dolbear*, 15 Fed. Rep., 448; 17

- Fed. Rep., 604. Sustained, American Bell Telephone Co. v. People's Telephone Co., 22 Fed. Rep., 309. Prior use of Drawbaugh instrument held not established, *Ibid.*, 25 Fed. Rep., 725. See, also, American Bell Telephone Co. v. Ghegan, 23 O. G., 537.
- 186860.** Maynard, W. Jan. 30, 1877. Hydrating Chlorine Gas.
Not infringed by sale of less than the entire combination, Maynard v. Pawling, 3 Fed. Rep., 711.
- 187100.** Clark J. Feb. 6, 1877. Cheese-former for Cider Press.
Void for aggregation and want of novelty, Clark Pomace Holder Co. v. Ferguson, 17 Fed. Rep., 79.
- 187516.** Cooley, Wm. Feb. 20, 1877. Obtaining Cream from Milk.
Construed to cover a process accomplished by a combination of mechanical devices; is infringed; held not anticipated by a prior use not proceeded with so far as to discover its utility, Boyd v. Cherry, 4 McCrary, 70.
- 187899.** Pattee, H. H. Feb. 27, 1877. Cultivator Axles.
Wanting in novelty, Pattee Plow Co. v. Kingman, 23 Fed. Rep., 801.
- 187964.** Clark, Wm. A. March 6, 1877. Lubricator.
Construed and limited in view of state of art, and not infringed as limited, Jenks v. Swift, 25 Fed. Rep., 722.
- 188691.** Stultz, S. March 20, 1877. Ore Washer.
Reissue No. 9011, Dec. 30, 1879.
Claim 5, omitted in original by mistake of attorney, held a proper case for, and valid in reissue; not void for delay, no intervening rights having accrued; claims 4 and 5 construed and sustained, Stultz v. Armstrong & Son, 20 Fed. Rep., 843. See, also, Stultz v. Armstrong & Son, 25 Fed. Rep., 147.
- 188879.** Eells & Lord. March 27, 1877. Ships Pumps.
Construed broadly in view of state of art, and held infringed, Loud v. Stone, 11 Fed. Rep., 721.
- 188950.** Rice, E. March 27, 1877. Trunk Fastening.
Construed and held not infringed, Cowell v. Sessions, 17 Fed. Rep., 450.
- 189220.** Hicks, O. H. April 3, 1877. Hoes.
Considered, Cook v. Sandusky Tool Co., 26 O. G., 1114.
- 189250.** Milligan, C. H. April 3, 1877. Sheet Metal Vessels.
Held to be for matter inserted by unauthorized act of attorney, and which was not invented by inventor; is void, Milligan v. Lalanc & Grosjean Mfg. Co., 21 Fed. Rep., 570.
- 189405.** Warner, I. De Ver. April 10, 1877. Corsets.
Reissue No. 8114, March 5, 1878.
Warner v. Bassett, 19 Blatch., 145.
- 189432.** Curran & Wilcox. April 10, 1877. Lumber Drier.
Reissue No. 8840, Aug. 12, 1879.
Construed and held infringed, Burdsall v. Curran, 27 O. G., 1320.
- 190184.** Beck, A. May 1, 1877. Quilting Machine.
Reissue No. 9097, Feb. 24, 1880.
Claim for invention not in original, held invalid; other claim held valid, but not infringed, Dryfoos v. Wiese, 19 Fed. Rep., 315.
- 190368.** Reynolds, A. Q. May 1, 1877. Fruit-drier.
Construed and held infringed by substitution of mechanical equivalents, Wilt v. Grier, 5 Fed. Rep., 450.
- 190563.** Day, A. May 8, 1877. Railway Track Cleaner.
Day v. Detroit City Railway Co., 22 O. G., 946.
- 190655.** White, H. May 8, 1877. Shoe Tip.
Reissue No. 8536, Jan. 7, 1879.
Construed and limited, White v. Lee, 14 Fed. Rep., 789. See, also, White v. Lee, 3 Fed. Rep., 222; 4 Fed. Rep., 916.
- 190816.** Brown, Wm. P. May 15, 1877. Cultivator Coupling.
Claim 1 held not ambiguous, and not vitiated by a useless part of the claim, which was not used by infringer; construed to be for change of location of parts involving invention; held novel and infringed, Brown Mfg. Co. v. Deere & Co., 21 Fed. Rep., 709. Claim 1 construed in conformity with above; claims 1 and 2 infringed, Brown Mfg. Co. v. Buford, 21 Fed. Rep., 714.
- 191102.** Brooke, H. May 22, 1877. Glass Molds for Shade-holders.
Void for public use and sale more than two years prior to date of application, Schneider v. Thill, 5 Ban. & Ard., 565.

- 191103.** Brooke, H. May 22, 1877. Molds for Glass Shades.
Void for public use and sale more than two years prior to date of application, *Schneider v. Thill*, 5 Ban. & Ard., 565.
- 191171.** Parshall, C. H. May 22, 1877. Lubricator.
Not anticipated by a drawing showing a perfect machine, but not reduced to practice. Claim 6 construed, and limited, in view of state of art; held to be for a combination involving invention, and not for an aggregation, *Detroit Lubricator Mfg. Co. v. Renchard*, 9 Fed. Rep., 293.
- 191224.** Brooke, H. May 29, 1877. Glass Shade Manufacture.
Void for public use and sale more than two years prior to date of application, *Schneider v. Thill*, 5 Ban. & Ard., 565. See, also, *Schneider v. Thill*, 18 Blatch., 241.
- 191233.** Fosburgh, C. E. May 29, 1877. Canopy Tops.
Dare v. Boylston, 18 Blatch., 548.
- 191244.** Ladd, H. W. May 29, 1877. Spring Bed Bottoms.
Held to involve more than mere mechanical substitution, and sustained, *Ladd v. Tucker Mfg. Co.*, 4 Ban. & Ard., 344.
- 191400.** Buzzell, J. G. May 29, 1877. Whitening and Shaving Leather.
Claim 1 construed strictly to be for a combination of old elements, and not infringed by a different machine which could be forced to produce a similar result, *Buzzell v. Andrews*, 25 Fed. Rep., 822.
- 191405.** Clark & Harris. May 29, 1877. Soldering Process.
Construed in view of state of art, and held wanting in novelty, *Adams & Westlake Mfg. Co. v. Wilson Packing Co.*, 21 Fed. Rep., 648.
- 191656.** Class, Wm. F. June 5, 1877. Apparatus for Pumping Fluids from Casks.
Reissues Nos. 8025 and 8026, Jan. 8, 1878.
Held valid, being properly reissued with broader claims within four months. Reissue 8025 held infringed, *Worswick Mfg. Co. v. Steiger*, 17 Fed. Rep., 250.
- 191798.** Cross, A. T. June 12, 1877. Stylographic Pen.
Reissue No. 9716, May 24, 1881.
Construed; infringement doubted, *Cross v. Livermore*, 9 Fed. Rep., 607.
- 192008.** Randel, Wm. June 12, 1877. Button Hole Attachment for Sewing Machines.
Wright v. Randel, 19 Blatch., 495.
- 192098.** Toohey, M. June 19, 1877. Plaiting Machine.
Construed, and held not infringed, *Toohey v. Harding*, 4 Hughes, 254.
- 192386.** Pentlarge & Hirsch. June 26, 1877. Vent Bung.
Reissue No. 10,175, Aug. 1, 1882.
Held not interfered with by patent No. 203,316; construed and limited in view of prior inventions, *Pentlarge v. New York Bung & Bushing Co.*, 20 Fed. Rep., 314. See, also, *Pentlarge v. Pentlarge*, 19 Fed. Rep., 817; 22 Fed. Rep., 412.
- 193038.** Rogers, J. J. July 10, 1877. Beverage.
Construed, in view of state of art, to be a new and useful composition of matter, consisting in the substitution of a new element, *Rogers v. Ennis*, 15 Blatch., 47.
- 193476.** Bowker, H. L. July 24, 1877. Sirups and Mineral Waters.
Held novel and patentable; infringed by sale of materials with intent to have them combined and to procure infringement, *Bowker v. Dows*, 3 Ban. & Ard., 518.
- 193867.** Hammerschlag, S. Aug. 7, 1877. Waxing Paper.
Reissue No. 8460, Oct. 22, 1878.
Sustained and held infringed, *Hammerschlag v. Garrett*, 9 Fed. Rep., 43; *v. Scamoni*, 20 O. G., 1448. Sustained; claim 5 construed to be for an art consisting of four successive steps; claims 1, 2, 3 and 5 infringed, *Hammerschlag v. Scamoni*, 7 Fed. Rep., 584. Claim 5 limited to process consisting of certain essential steps, and not infringed by the omission of one of them, *Hammerschlag v. Garrett*, 10 Fed. Rep., 479. Claim 5 construed in conformity with above, and held infringed, *Hammerschlag Mfg. Co. v. Wood*, 18 Fed. Rep., 175.
- 194059.** Stultz, S. Aug. 14, 1877. Ore-washer.
Claim 3 construed and held novel; valid, and is for a combination and not an aggregation, *Stultz v. Armstrong & Son*, 20 Fed. Rep., 843. See, also, *Stultz v. Armstrong & Son*, 25 Fed. Rep., 147.
- 194519.** Harris, A. Aug. 28, 1877. Soldering Tool.
Held infringed, *Adams & Westlake Mfg. Co. v. Wilson Packing Co.*, 21 Fed. Rep., 648.
- 194662.** Etheridge, M. V. Aug. 28, 1877. Automatically Measuring Hides of Leather.
Held not infringed by a machine made only for exhibition at a fair, *Standard Measuring Machine Co. v. Teague*, 15 Fed. Rep., 390.

- 194743.** Tapley & Porter. Aug. 28, 1877. Automatic Leather Measurer.
Reissue No. 9204, May 18, 1880.
Held novel and broadly construed, being an entirely new art; is infringed, Standard Measuring Machine Co. v. Teague, 15 Fed. Rep., 390.
- 195233.** Roemer, Wm. Sept. 18, 1877. Combined Traveling-bag Lock and Handle.
Infringed by use with an addition thereto, Roemer v. Simon, 20 Fed. Rep., 197. See, also, Roemer v. Neuman, 19 Fed. Rep., 98; 23 Fed. Rep., 447.
- 195415.** Still, H. C. & J. R. Sept. 18, 1877. Saddle Tree.
Still & Bro. v. Reading, 9 Fed. Rep., 40.
- 195539.** Sargent, J. Sept. 25, 1877. Combined Time Lock.
Reissue No. 7947, Nov. 13, 1877.
Claim 3 construed, in view of state of art, to be for a novel combination of old elements producing a new result, involving invention, and is not for an aggregation; held valid and infringed, Yale Lock Mfg. Co. v. Norwich National Bank, 19 Blatch., 123. Claim 3 construed to be for a double use, and does not involve patentable novelty; held void, also, as a claim for a principle, Yale Lock Mfg. Co. v. Berkshire National Bank, 17 Fed. Rep., 531.
- 195948.** Plummer, W. S. Oct. 9, 1877. Fruit Drier.
Sustained and infringed, Corvallis Fruit Co. v. Curran, 7 Sawyer, 270.
- 196006.** Gayton, Wm. C. Oct. 9, 1877. Window Cleaner.
Reissue No. 8393, Sept. 3, 1878.
Construed to be for a new use of an old and well known article, involving mechanical skill only, and not invention, Perfection Window Cleaner Co. v. Bosley, 9 Biss., 385.
- 196425.** Brush, C. F. Oct. 23, 1877. Illuminating Points for Electric Lights.
Brush v. Condit, 20 Fed. Rep., 826.
- 196778.** Bickford, E. F. Nov. 6, 1877. Rubber Boot.
Held wanting in novelty, Boston Rubber Shoe Co. v. Lamkin, 18 Fed. Rep., 93.
- 197314.** Bate, J. J. Nov. 20, 1877. Preserving Meat during Transportation.
Held not invalid for want of novelty; is infringed, Bate Refrigerating Co. v. Gillett, 9 Fed. Rep., 387. Term held limited by Canadian patent issued prior to domestic patent, but not delivered, *Ibid.*, 22 O. G., 1205. Held valid for full term of domestic patent, and not limited by prior five-year Canadian patent, which has been declared void *ab initio*, *Ibid.*, 20 Fed. Rep., 192. Sustained in view of prior construction and state of art; claims construed, limited, and held infringed, Bate Refrigerating Co. v. Eastman, 11 Fed. Rep., 902. See, also, Bate Refrigerating Co. v. Gillett, 32 O. G., 1466.
- 197369.** Hoffman, D. Nov. 20, 1877. Tripod-head for Surveying.
Construed to be for a novel and patentable combination of old elements, and sustained, Hoffman v. Young, 2 Fed. Rep., 74.
- 197528.** Schmidt, F. E. Nov. 27, 1877. Button-hole Machine Feed Mechanism.
Construed to be for a particular combination, and not infringed by substituting a sliding link for the lever in combination, Schmidt v. Freese, 12 Fed. Rep., 563.
- 197807.** Wilson, W. Dec. 4, 1877. Collars.
Reissue No. 8169, April 9, 1878.
Construed to be for same invention as original; held novel and sustained, Wilson v. Coon, 18 Blatch., 532. Claims 1 and 4 held enlarged where there was no inadvertence, and are invalid, Coon v. Wilson, 113 U. S., 268.
- 197913.** Warner, I. De Ver. Dec. 4, 1877. Corset.
Warner v. Bassett, 19 Blatch., 145.
- 198432.** Stultz, S. Dec. 18, 1877. Ore Washer.
Claim 3 held novel, Stultz v. Armstrong & Son, 20 Fed. Rep., 843. See, also, Stultz v. Armstrong & Son, 25 Fed. Rep., 147.
- 198467.** Rogers, J. J. Dec. 25, 1877. Beverage.
Construed to be a new and useful composition of matter, Rogers v. Ennis, 15 Blatch., 47. Held novel and not infringed, Rogers v. Beecher, 3 Fed. Rep., 639.

1878.

- 199621.** Cross, A. T. Jan. 29, 1878. Stylographic Pen.
Construed; infringement doubted, Cross v. Livermore, 9 Fed. Rep., 607. Claim 1 construed to be for a patentable combination; held novel and infringed, Cross v. MacKinnon, 11 Fed. Rep., 601.
- 199948.** Wilson, J. G. Feb. 5, 1878. Connecting Blind-slats.
Held novel and infringed, Whitman v. James, 5 Ban. & Ard., 575.

- 200068.** Lever, J. S. Feb. 5, 1878. Book Binding.
Reissue No. 8195, April 23, 1878.
Held, on interference, later in date of invention than No. 239,927, Wire Book Sewing Machine Co. v. Stevenson, 11 Fed. Rep., 155.
- 200078.** McDonald, J. W. Feb. 5, 1878. Unhairing and Scouring Hides.
Held valid, McDonald v. Whitney, 32 O. G., 1465.
- 200214.** Miller, W. E. Feb. 12, 1878. Carriage Axles.
Construed, limited, and held not infringed, Ives v. Hartford Spring & Axle Co., 11 Fed. Rep., 510.
- 200939.** Sanborn, Kanouse & Sanborn. March 5, 1878. Fabric for Collars and Cuffs.
Held novel, involves invention, and is infringed, Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co., 23 Fed. Rep., 397; 32 O. G., 383. Sustained, *Ibid.*, 25 Fed. Rep., 482.
- 201536.** Kirk, E. C. March 19, 1878. Bronze Alloy.
Construed and limited to proportions used, and held not infringed by an alloy differing in proportions and in which one element was present as an impurity and not artificially added, Kirk v. Elkins Mfg. Co., 19 Fed. Rep., 417.
- 201670.** Hewitt, H. L. March 26, 1878. Sulky Plow.
Hapgood v. Hewitt, 11 Fed. Rep., 422.
- 202158.** Davis, F. April 9, 1878. Door Bolt.
Reissue No. 9901, Oct. 18, 1881.
Void for unreasonable delay in reissuing, Ives v. Sargent, 17 Fed. Rep., 447.
- 202660.** MaGuire, T. M. April 23, 1878. Hydraulic Power Accumulator.
Validity of patent questioned, McGuire v. Eames, 15 Blatch., 312. Void for failure to discriminate between the old part and the improvement, the claim being co-extensive with the specification, Maguire v. Eames, 18 Blatch., 321.
- 202673.** Smith & Thayer. April 23, 1878. Neck-tie Shields.
Held subsequent in date of invention to No. 220,610, Thayer v. Hart, 20 Fed. Rep., 693; 20 Fed. Rep., 696.
- 202735.** Lindsay, J. P. April 23, 1878. Sleeve-supporter.
Construed, held to involve invention, and is not for a duplication or double use; not abandoned by sale more than two years prior to date of application, nor by filing new application; held novel, and claim 2 infringed, Lindsay v. Stein, 10 Fed. Rep., 907.
- 203069.** Pennington & Beggs. April 30, 1878. Lawn Sprinkler.
Held to involve invention; held valid and infringed, Pennington v. King, 7 Fed. Rep., 462.
- 203226.** Watson, C. R. April 30, 1878. Grain Car Doors.
Construed, and strictly limited to combination of specific devices, in view of disclaimer in specification, and not infringed by use of part of the combination; invention doubted, Watson v. Cincinnati, L., St. L. & C. R'y Co., 23 Fed. Rep., 443.
- 203316.** Borst, G. May 7, 1878. Bungs.
Held not to interfere with No. 192,386; construed, and limited in view of prior inventions, Pentlarge v. New York Bung & Bushing Co., 20 Fed. Rep., 314.
- 203411.** Brush, C. F. May 7, 1878. Electric Lamps.
Reissue No. 8718, May 20, 1879.
Construed in view of properly made disclaimer. and held anticipated by public use in a factory of a prior perfected invention, which was subsequently laid aside, Brush v. Condit, 20 Fed. Rep., 826.
- 204321.** Hand & Caulier. May 28, 1878. Wardrobe Bedstead.
Claim 1 construed to be for a combination, and not infringed by use of two of its elements where the omitted element had a function of its own not performed by the elements used. Claim 2 limited and not infringed, Tobey Furniture Co. v. Colby, 34 O. G., 1276.
- 205129.** Packard, F. June 18, 1878. Shoes and Gaiters.
Evory v. Burt, 23 O. G., 2121.
- 205193.** Lefever, D. M. June 25, 1878. Breach-loading Fire-arm.
Construed, and limited in view of state of art to specific claim; held novel, valid, and not infringed, Lefever v. Remington & Sons, 22 O. G., 1537.
- 205927.** Underwood, F. July 9, 1878. Railroad Track Drill.
Construed to be for a combination, and held not infringed, Underwood v. Warren, 24 Fed. Rep., 183. See, also, Underwood v. Warren, 21 Fed. Rep., 573.
- 205942.** Graham, W. A. July 9, 1878. Method and Apparatus for Extinguishing Fires.
Held constitutionally granted by special act, after a lapse of forty years after date of application; held not to interfere with vested rights; was novel at date of application; claims construed and held properly joined in one patent; novelty and validity of claims 2 and 3 doubted; claims 1 and 4 sustained; specification held not deceptive nor misleading,

- Graham v. Johnston, 21 Fed. Rep., 40. See, also, Fire Extinguisher Mfg. Co. v. Graham, 16 Fed. Rep., 543.
- 206061.** Westland, C. S. July 16, 1878. Lamp.
Infringed by an improved device embodying it, White v. Heath, 10 Fed. Rep., 291.
- 206077.** Boykin & Carmer. July 16, 1878. Fertilizing Compound.
Held to be for a change in degree only, and for substitution of a known equivalent; void for want of invention and of novelty, Boykin v. Baker, 4 Hughes, 282.
- 206141.** Shepard, A. July 16, 1878. Coffee and Spice Mill.
Reissue No. 8866, Aug. 19, 1879.
Held novel, Peck v. Lindsay, 2 Fed. Rep., 688.
- 206514.** Williams, D. C. July 30, 1878. Sand Washer.
Limited to combination specified, and not infringed by omission of an essential element, Williams v. Stolzenbach, 23 Fed. Rep., 39.
- 206835.** Selden, G. Aug. 6, 1878. Cigar-lighter.
Construed and held not infringed, Selden v. Stockwell Self-lighting Gas Burner Co., 19 Blatch., 544.
- 207484.** Blessing, J. H. Aug. 27, 1878. Steam Traps.
Limited in view of state of art, and held infringed, Albany Steam Trap Co. v. Felthousen, 20 Fed. Rep., 633.
- 207738.** Hill & Prentice. Sept. 3, 1878. Box Creamery.
Wooster held inventor on interference, and entitled to patent for certain improvements thereon, Wooster v. Hill, 22 Fed. Rep., 830. Held to have abandoned the unclaimed matter shown in patent by not claiming it, Hill v. Commissioner of Patents, 33 O. G., 757.
- 207822.** Shaw, P. Sept. 10, 1878. Milk Can.
Butler v. Shaw, 21 Fed. Rep., 321.
- 208157.** Covert, J. C. Sept. 17, 1878. Rope Clamp.
Held infringed, Covert v. Curtis, 25 Fed. Rep., 43.
- 208541.** Roemer, Wm. Oct. 1, 1878. Locks for Satchels.
Sustained and infringed, Roemer v. Headley, 19 Fed. Rep., 205.
- 208595.** Hetherington, J. E. Oct. 1, 1878. Artificial Honeycomb Foundations.
Reissue No. 8962, Nov. 11, 1879.
Claim 1 held, in view of state of art, wanting in invention, Van Deusen v. Nellis, 18 Fed. Rep., 596.
- 209070.** Norton, E. Oct. 15, 1878. Paint Can.
Construed to be for a combination of old elements, and limited to precise device, and not infringed by a combination substantially different in one of its parts, Norton v. Haight, 22 Fed. Rep., 787.
- 209266.** Irwin, J. H. Oct. 22, 1878. Telephone Transmitter.
Claims 1 and 2 construed, and held not infringed, Irwin v. Metropolitan Telephone & Telegraph Co., 9 Fed. Rep., 517.
- 209393.** Hammerschlag, S. Oct. 29, 1878. Waxing Paper.
Claim 1 construed to be for a method, claim 2 for a combination of machinery; both claims infringed, Hammerschlag v. Scamoni, 7 Fed. Rep., 584. Examined; sustained and held infringed, Hammerschlag v. Wood, 18 Fed. Rep., 175. See, also, Hammerschlag v. Garrett, 21 O. G., 1199.
- 209701.** McGill, G. W. Nov. 5, 1878. Buckle.
Claim construed, limited and held infringed, Holmes, Booth & Haydens v. Osborn & Cheesman, 7 Fed. Rep., 671.
- 209826.** Moffitt, J. R. Nov. 12, 1878. Machine for Forming Boot and Shoe Stiffeners.
Claim 2 held invalid; claims 1, 3 and 4 sustained and infringed, Moffitt v. Cavanagh, 17 Fed. Rep., 336.
- 210714.** Sheeder, J. F. Dec. 10, 1878. Paper Board Manufacture.
Claim 2 construed and limited to combination of specific devices in view of state of art, and held not infringed, Sheeder v. Shannon, 25 Fed. Rep., 824.
- 210780.** Hyatt, J. W. Dec. 10, 1878. Piano Key Manufacture.
Held to involve invention; claim 1 construed and limited to plastic composition named, and infringed by covering a substantial portion of the key-board in place of all of it; claim 2 held incorrect as a process claim, Celluloid Mfg. Co. v. Pratt, 21 Fed. Rep., 313. Construed in conformity with above and held not infringed, Celluloid Mfg. Co. v. Comstock, 23 Fed. Rep., 38.
- 210797.** McDonald, J. W. Dec. 10, 1878. Unhairing and Scouring Hides.
Held novel and valid, in view of conflicting evidence; construed and held infringed, McDonald v. Whitney, 32 O. G., 1465.

1879.

- 212487.** Morris, J. B. Feb. 18, 1879. Sash Fastener.
Held not interfered with by patent No. 284,506, *Morris v. Kempshall Mfg. Co.*, 20 Fed. Rep., 121.
- 213323.** Coupe, W. March 18, 1879. Stretching Raw Hide.
Claims 1 and 3 held infringed, *Coupe v. Weatherhead*, 16 Fed. Rep., 673.
- 214513.** Miller, L. B. April 22, 1879. Sewing Machine.
Held, in view of state of art, to involve invention; construed and limited to specific device, and infringed by use with improvement, *Singer Mfg. Co. v. Henry Stewart Mfg. Co.*, 8 Fed. Rep., 920.
- 214706.** Ross, N. G. & T. D. April 22, 1879. Barbed Wire Machine.
Construed and limited, in view of state of art, to the combination claimed, and held not infringed, *Washburn & Moen Mfg. Co. v. Fuchs*, 16 Fed. Rep., 669.
- 215024.** Starrett, L. S. May 6, 1879. Try Square.
Reissue No. 9419, Oct. 19, 1880.
Claim 6 sustained and infringed, *Starrett v. Athol Machine Co.*, 14 Fed. Rep., 910.
- 215034.** Adams, Jr., I. May 6, 1879. Coating Articles with Vulcanizable Rubber.
Construed, and held not anticipated by prior published indefinite statements in certain prior patents, *Hood v. Boston Car-spring Co.*, 21 Fed. Rep., 67.
- 215548.** Weir, F. C. May 20, 1879. Railroad-frog.
Reissue No. 8914, Sept. 30, 1879.
Claim 2 construed and limited to device described, and held not infringed, *Weir v. Mor-den*, 21 Fed. Rep., 243.
- 215679.** Meller, L. May 20, 1879. Process for making Beer.
Held not infringed, *New Process Fermentation Co. v. Baltz*, 10 Fed. Rep., 289. Held subsequent to patent No. 205,572, *New Process Fermentation Co. v. Koch*, 21 Fed. Rep., 580. Held in view of state of art, the process being well-known before, that the claims for a particular process, irrespective of the means by which that process has been reached, cannot be sustained; and the mechanical means not having been used, held, that patent was not infringed, *New Process Fermentation Co. v. Maus*, 20 Fed. Rep., 725.
- 216025.** Delong, B. June 3, 1879. Seeder.
Construed and limited in view of state of art, and held not infringed, *Delong v. Bickford*, 22 O. G., 2242.
- 216256.** Brightman & Burrell. June 10, 1879. Harness Box-loop.
Construed, and held infringed by substitution of mechanical equivalent, *Brighton v. Wilson*, 18 Fed. Rep., 378.
- 216276.** Ives, E. D. June 10, 1879. Carriage Axles.
Ives v. Hartford Spring and Axle Co., 22 O. G., 1037.
- 216293.** Robinson, A. June 10, 1879. Tobacco Resweating Apparatus.
Construed, held novel and infringed, *Robinson v. Sutter*, 10 Biss., 100; 11 Fed. Rep., 798.
- 216344.** Penney, B. F. June 10, 1879. Shingle Machine.
Held invalid for want of novelty and for public use for more than two years prior to date of application, *Gibson v. Scribner*, 22 Fed. Rep., 840.
- 217519.** Fanning, J. July 15, 1879. Lemon-squeezer.
Construed, sustained and held infringed, *Onderdonk v. Fanning*, 4 Fed. Rep., 148. Construed to be for a combination of old elements, and not infringed by the substitution of a solid for a perforated bed, *Ibid.*, 19 Blatch., 363. See, also, *Onderdonk v. Fanning*, 2 Fed. Rep., 568.
- 217909.** Smith & Shannon. July 29, 1879. Paper Holder.
Construed and limited in view of state of art; held novel, valid and infringed, *Shannon v. Jones*, 10 Biss., 498.
- 217964.** Travers, J. P. July 29, 1879. Hammock.
Claim construed to be for a combination of six elements, and not infringed by a use of three of them only, *Travers v. Palmer*, 23 Fed. Rep., 511.
- 218032.** Jennings, A. G. July 29, 1879. Lace Purling.
Sustained in view of doubtful evidence of anticipation, and is infringed, *Jennings v. Kibbe*, 32 O. G., 653.
- 218220.** Bigelow, J. Aug. 5, 1879. Sweat Leather.
Greenwood v. Bracher, 1 Fed. Rep., 856.
- 218427.** Canan, J. Aug. 12, 1879. Dredging Machine Shovel.
Valid for term of prior foreign patent, although not so limited on its face and although granted for full domestic term, *Canan v. Pound Mfg. Co.*, 23 Fed. Rep., 185.
- 218564.** Parmelee, H. S. Aug. 12, 1879. Automatic Fire Extinguisher.
Construed; held valid and infringed, *Parmelee v. Burrit Hardware Co.*, 24 Fed. Rep., 785.

218758. Maxheimer, J. Aug. 19, 1879. Bird Cage.

Sustained, and held not anticipated by a prior construction showing the device, but not known to have the effect contemplated by patentee, and only accidentally occurring in such prior construction, *Maxheimer v. Meyer*, 9 Fed. Rep., 460.

219455. Frazer, S. Sept. 9, 1879. Lubricant.

United States v. Frazer, 22 Fed. Rep., 106.

219462. Gray, R. Sept. 9, 1879. Hat.

Construed and held novel, *Bernard v. Heimann*, 9 Fed. Rep., 400. Construed; held to involve invention, and held novel, *Ibid.*, 22 O. G., 1134.

219656. Schmidt, F. E. Sept. 16, 1879. Feed Mechanism for Button-hole Machine.

Claims 1, 2 and 3 construed to be for combinations, and held not infringed by substantial change in structure, *Schmidt v. Freese*, 12 Fed. Rep., 563.

220002. Wallace, R. Sept. 23, 1879. Spoons and Forks.

Product held novel and infringed, *Wallace v. Noyes*, 23 O. G., 435.

220003. Wallace, R. Sept. 23, 1879. Making Spoons and Forks.

Process construed in view of state of art; claim 1 sustained for patentable novelty and held infringed; claim 2 held wanting in novelty, *Wallace v. Noyes*, 23 O. G., 435.

220126. Cook, A. Sept. 30, 1879. Braid Pin.

Infringement doubted, *White v. Harris & Sons Mfg. Co.*, 3 Fed. Rep., 161. Held not infringed by patent No. 221,721, *White v. Noyes*, 2 Fed. Rep., 782.

220610. Hart, Wm. H., Jr. Oct. 14, 1879. Neck-wear Pins.

Held infringed, and prior in date of invention to patent No. 202,673, *Thayer v. Hart*, 20 Fed. Rep., 693; *Hart, Jr. v. Thayer*, 20 Fed. Rep., 696. See, also, *Thayer v. Hart*, 24 Fed. Rep., 558.

220767. McCloskey, J. Oct. 21, 1879. Soft Metal Trap.

Held wanting in invention, *McCloskey v. Du Bois*, 19 Blatch., 205; 20 O. G., 371; *v. Hamill*, 15 Fed. Rep., 750. Construed to be for improved quality of old product, and held wanting in patentable novelty, *McCloskey v. Du Bois*, 9 Fed. Rep., 38.

221062. Hayes, L. S. Oct. 28, 1879. Folding Chairs.

Collignon v. Hayes, 20 O. G., 447.

221310. Hotchkiss, A. E. Nov. 4, 1879. Clock Movement.

Reissue No. 10,062, March 14, 1882.

Parker & Whipple Co. v. Yale Lock Co., 18 Fed. Rep., 43.

221482. Underwood, J. M. Nov. 11, 1879. Whip-socket.

Construed in view of state of art, and held invalid for want of invention, *Searls v. Merriam*, 22 O. G., 1040.

222143. Mackaye, S. Dec. 2, 1879. Theater Appliances.

Mallory v. Mackaye, 22 O. G., 945.

222264. Flagg, T. J. Dec. 2, 1879. Scarfs.

Held not to have essentially misrepresented the state of the art, and is sufficiently definite as to subject-matter improved on; claim 1 construed to be for a patentable combination, and not for an aggregation; claims 2 and 3 are for patentable combinations; is infringed, *Fisk, Clark & Flagg v. Hollander Bros., MacA. & MacK.*, 355.

222379. Burr, S. S. Dec. 9, 1879. Folding Bedstead.

Reissue No. 9393, Sept. 28, 1880.

Andrews v. Fielding, 20 Fed. Rep., 123.

222420. Peroni, L. Dec. 9, 1879. Thermometer.

Reissue No. 10,189, Aug. 29, 1882.

Construed, sustained, and held not anticipated by an abandoned experiment; convex front infringed by an acute, slightly rounded angle, *Hicks v. Otto*, 19 Fed. Rep., 749. See, also, *Hicks v. Otto*, 17 Fed. Rep., 539.

222814. Cherry, J. G. Dec. 23, 1879. Cans for Transporting Cream.

Reissue No. 9811, July 19, 1881.

Held anticipated and void, *Cherry v. Swab*, 21 Fed. Rep., 246.

1880.

223311. Booth, Wm. Jan. 6, 1880. Celluloid Comb Manufacture.

Held to be for a double use and void for want of invention, *Celluloid Mfg. Co. v. Noyes*, 25 Fed. Rep., 319.

224076. Cohn, M. Feb. 3, 1880. Corset.

Birdseye v. Heilner, 34 O. G., 1392.

225108. Caro, H. March 2, 1880. Coloring Matter from Alphanaphthol.

Product claim construed broadly in view of patentee being first in the art, and held novel; *prima facie* infringement in view of chemical identity of product, independent of process used, *Pickhardt v. Packard*, 22 Fed. Rep., 530.

225318. Atkinson, J. W. March 9, 1880. Corn Planter.
Runstetler *v.* Atkinson, 23 O. G., 940.
225388. Irwin, J. H. March 9, 1880. Telephone Transmitter.
Claim 5 construed and held not infringed, Irwin *v.* Metropolitan Telephone & Telegraph Co., 9 Fed. Rep., 517.
225476. Hutchinson, C. G. March 16, 1880. Bottle Stopper.
Held void on interference with reissue No. 9002 of patent No. 156,302, Putnam *v.* Hutchinson, 12 Fed. Rep., 131.
225492. Scott, M. G. W. & W. D. March 16, 1880. Saucepan.
Claim 1 construed in view of state of art; doubted whether it is more than a substitution of material which does not involve invention; held not infringed, Scott *v.* Evans, 11 Fed. Rep., 726.
226845. Glasgow, W. April 22, 1880. Machine for Enameling or Preparing Mouldings for Gilding.
Held void for want of novelty, Glasgow *v.* Fritts, 22 Fed. Rep., 391.
227061. Russell & McDonald. April 27, 1880. Flanging Machine.
Held not anticipated by an abandoned, unsuccessful experiment; held to involve invention, and is infringed, Phillips, Nimick & Co. *v.* Carroll & Co., 23 Fed. Rep., 249.
227416. Cross, A. T. May 11, 1880. Stylographic Pen.
Novelty doubted, Cross *v.* Livermore, 9 Fed. Rep., 607.
228136. Sprague, L. A. May 25, 1880. Machine for making Buckle Levers.
Construed, sustained and infringed, Sprague *v.* Smith, 13 Fed. Rep., 721.
228233. Wade, Wm. W. June 1, 1880. Button Machine.
Wade *v.* Metcalf, 16 Fed. Rep., 130.
229283. Starrett, L. S. June 29, 1880. Try Square.
Held to involve invention, is valid, and infringed, Starrett *v.* Athol Machine Co., 14 Fed. Rep., 910.
229998. Goss, F. L. July 13, 1880. Feed for Printing Press.
Claim 1 construed to be for a certain result by the means shown, and not for the result, and so limited; held not infringed by use of different means; claim 2 held not infringed, Goss *v.* Cameron, 23 O. G., 741.
230105. Burr, S. S. July 20, 1880. Bedstead.
Andrews *v.* Fielding, 20 Fed. Rep., 123.
230778. Howe, W. B. Aug. 3, 1880. Packing Stick Candy in Packages.
Reissue No. 9942, Nov. 22, 1881.
Construed to be for a combination and not infringed by omission of an essential element, Howe *v.* Neemes, 18 Fed. Rep., 40.
231021. Demarest, E. B. Aug. 10, 1880. Hod Elevator.
Pelham *v.* Demarest, 22 O. G., 772.
231104. Runstetler, M. Aug. 10, 1880. Corn Planter.
Reissue No. 10,155, July 11, 1882.
Construed to be for a different invention from original and held invalid, Farmer's Friend Mfg. Co. *v.* Challenger Corn Planter Co., 23 Fed. Rep., 42.
231199. Sprague, L. A. Aug. 17, 1880. Machine for making Buckle Levers.
Construed, sustained and infringed, Sprague *v.* Smith, 12 Fed. Rep., 721.
231207. Benton, J. B. Aug. 17, 1880. Fare Register.
Canceled, and patent No. 233,915 issued in its place; which see.
231510. Underwood, J. M. Aug. 24, 1880. Whip-sockets.
Held valid and infringed, Searls *v.* Bouton, 12 Fed. Rep., 625. See, also, Searls *v.* Bouton, 12 Fed. Rep., 140.
232435. Barnes, J. H. Sept. 21, 1880. Ballasting Vessels.
American Ballast Log Co. of N. Y. *v.* Barnes, 21 O. G., 1029.
232561. Smith, S. N. Sept. 21, 1880. Lacing-hook Stock.
Construed, sustained, and held infringed, Smith *v.* Halkyard, 16 Fed. Rep., 414.
232975. Johnson, M. C. Oct. 5, 1880. Cutting Pliers.
Patentee held not first and original inventor, Thompson *v.* Hall, 33 O. G., 1140.
233035. Smith, E. Oct. 5, 1880. Mowing Machine.
Claims 2 and 3 infringed by formal difference, Hussey Mfg. Co. *v.* Deering & Co., 20 Fed. Rep., 795.
233116. Ross, N. G. & T. D. Oct. 12, 1880. Barbed Wire Cable.
Construed and limited to combinations claimed, in view of state of art, and held not infringed, Washburn & Moen Mfg. Co. *v.* Fuchs, 16 Fed. Rep., 669.
233409. Gowen, Wm. Oct. 19, 1880. Saw Dog.
Allis *v.* Buckstaff, 22 O. G., 1705.

- 233497.** Frazer, S. Oct. 19, 1880. Lubricant.
United States *v.* Frazer, 22 Fed. Rep., 106.
- 233511.** Holton, F. H. Oct. 19, 1880. India Rubber Eraser.
Declared void, patentee not being prior inventor, and for public use more than two years prior to date of application, Lockwood *v.* Cleveland, 18 Fed. Rep., 37; *v.* Cutter Tower Co., 18 Fed. Rep., 653. See, also, Lockwood *v.* Cleveland, 20 Fed. Rep., 164.
- 233574.** Strong, J. J. & K. M. Oct. 19, 1880. Insect Protector.
Subject-matter held to be a patentable invention, in view of state of art, Strong, *Ex parte*, 17 O. G., 446.
- 233915.** Benton, J. B. Nov. 2, 1880. Fare Register.
Issued for the same invention, on cancellation of patent No. 231,207. Held entitled to seventeen years term from Nov. 2, 1880, and not from date of canceled patent, Railway Register Mfg. Co. *v.* North Hudson C. R. Co., 23 Fed. Rep., 593. Invention held sufficiently shown, and amended claims properly inserted in original application, without verification by inventor's oath; held novel, and infringed by use of mechanical equivalent, *Ibid.*, 33 O. G., 355.
- 233932.** Ives, E. D. Nov. 2, 1880. Carriage Axles.
Ives *v.* Hartford Spring and Axle Co., 22 O. G., 1037.
- 234549.** Duke, Wm. L. Nov. 16, 1880. Baling Press.
Duke *v.* Graham, 19 Fed. Rep., 647.
- 236052.** Marsh. Dec. 28, 1880. Steam-engine Valve Gear.
Marsh *v.* Nichols, 15 Fed. Rep., 914.

1881.

- 236350.** Morley, J. H. Jan. 4, 1881. Button Sewing Machine.
Liberal construed, yet limited to mechanism described, although patentee is first in the art, and held not to include groups of instrumentalities independent of such mechanism, and held not infringed, Morley Sewing Machine Co. *v.* Lancaster, 23 Fed. Rep., 344.
- 236425.** Filley, G. F. Jan. 11, 1881. Cooking Stove.
Held infringed, Filley *v.* Littlefield, 25 Fed. Rep., 282.
- 238703.** Mellon, P. H. March 8, 1881. Metallic Spring Bed.
Held void for want of novelty, Mellon *v.* Smith Davis Mfg. Co., 23 Fed. Rep., 153.
- 238720.** Scott, W. March 8, 1881. Printing Press.
Butterworth *v.* Hoe, 29 O. G., 615.
- 238940.** Low, J. E. March 15, 1881. Dentistry.
International Tooth Crown Co. *v.* Mills, 22 Fed. Rep., 659.
- 239089.** Eastwick, J. H. March 22, 1881. Sulphate of Alumina Manufacture.
Patentee held prior inventor, Damon *v.* Eastwick, 22 O. G., 1709.
- 239927.** Brehmer, H. April 12, 1881. Binding Books.
Held novel, valid, and prior in date of invention to reissue No. 8195 of patent No. 200,068, on interference, Wire Book Sewing Machine Co. *v.* Stevenson, 11 Fed. Rep., 155.
- 240586.** Fraim, E. T. April 26, 1881. Padlock.
Reissue No. 10,272, Jan. 16, 1883.
Contestant for priority held estopped by his acquiescence in patentee's action, and patentee held first inventor. Claims 2 and 3 infringed, Fraim *v.* Keen, 25 Fed. Rep., 820.
- 241916.** Boyington, L. C. May 24, 1881. Spring Bed Bottom.
Held to involve mechanical skill only, and not invention, Ames *v.* Carleton Spring Bed Co., 32 O. G., 1238.
- 242332.** Shuter & Davis. May 31, 1881. Tips for Insoles.
Sustained as involving invention, Shuter *v.* Davis, 16 Fed. Rep., 564.
- 243674.** Forncrook, J. June 28, 1881. Honey Frame.
Construed to be for a new use of an old and well known article, and wanting in invention, Forncrook *v.* Root, 21 Fed. Rep., 328.
- 244224.** French, H. Q. July 12, 1881. Roof for Burial Vault.
Construed in view of state of art, and held wanting in patentable invention, French *v.* Carter, 25 Fed. Rep., 41.
- 245251.** Williams, T. F. Aug. 2, 1881. Revolving Dip-net.
Held void for want of novelty and of invention, Williams *v.* McCord, 19 Fed. Rep., 643.
- 246270.** Zeum, K. L. Aug. 23, 1881. Hand Glass.
Held infringed, Zeum *v.* Kaldenberg, 16 Fed. Rep., 539.
- 246606.** Filley, G. F. Sept. 8, 1881. Door for Cooking Stove.
Held infringed, Filley *v.* Littlefield, 25 Fed. Rep., 282.
- 248272.** Barney, E. H. Oct. 18, 1881. Skate.
Spaeth *v.* Gibson, 23 O. G., 1732.

248646. Gordon, C. Oct. 25, 1881. Apparatus for Drawing and Cooling Beer.
Held anticipated, *Magin v. McKay*, 32 O. G., 1237.
250247. Holliday, J. Nov. 29, 1881. Rosanilin Colors Manufacture.
Holliday v. Pickhardt, 12 Fed. Rep., 147.
250954. Odell, U. H. Dec. 13, 1881. Roller Mill.
Reissue No. 10,139, June 22, 1882.
Held reissued with reasonable diligence for an inadvertent omission; sustained and held infringed; claim 1 held wanting in novelty; claim 4 held novel, and not anticipated by a deficient prior English patent, *Odell v. Stout*, 22 Fed. Rep., 159.
251456. Nicodemus, F. C. & A. K. Dec. 27, 1881. Processing Apparatus.
Construed to be for an unpatentable combination of old elements and wanting in invention, *Nicodemus v. Frazier*, 19 Fed. Rep., 260.

1882.

252054. Peterson, E. A. C. Jan. 10, 1882. Bake Oven.
Infringed, *Peterson v. Simpkins*, 25 Fed. Rep., 486.
252374. Hawlowetz, J. Jan. 12, 1882. Ostrich Feather Trimming.
Held valid (*dictum*), *Kass v. Hawlowetz*, 33 O. G., 1135.
253781. Stevens, S. M. Feb. 14, 1882. Barbed Wire Machine.
Construed and limited to combination claimed, in view of state of art, and is not infringed, *Washburn & Moen Mfg. Co. v. Fuchs*, 16 Fed. Rep., 669.
254540. Deis, C. March 7, 1882. Egg and Sugar Beater.
Construed and limited to combination described, in view of state of art, and held not infringed, *Deis v. Doll*, 21 Fed. Rep., 523.
256504. Rosenwasser, N. April 18, 1882. Percolator.
Held wanting in invention, in view of state of art, *Rosenwasser v. Berry*, 22 Fed. Rep., 841.
259597. Smith, S. N. June 13, 1882. Lacing-hooks for Shoes.
Held not anticipated, *Smith v. Halkyard*, 16 Fed. Rep., 414.
260526. Benton, J. B. July 4, 1882. Fare Register.
Validity held not affected by description in prior patent granted same inventor, the application being on file at date of grant; is not for an aggregation, *Railway Register Mfg. Co. v. Broadway & Seventh Ave. R. Co.*, 22 Fed. Rep., 655.
261518. Koechlin & Witt. July 18, 1882. Dye.
United States ex rel. K. & W. v. Marble, 22 O. G., 1365.
262094. Newbury, H. F. Aug. 1, 1882. Time Lock.
Construed and held not infringed, *Newbury v. Mossman*, 21 Fed. Rep., 579.
262505. Teter, W. L. Aug. 8, 1882. Process and Apparatus for cleaning Grain.
Reissue No. 10,275, Jan. 23, 1883.
Graham v. Teter, 33 O. G., 758.
265061. Gunning, J. Sept. 26, 1882. Letter and Figure.
Void, patentee having fraudulently alleged that he was the first and original inventor, when he was not, *United States v. Gunning*, 22 Fed. Rep., 653; 23 Fed. Rep., 668. See, also, *United States v. Gunning*, 18 Fed. Rep., 511.
265145. Ransom, N. A. Sept. 26, 1882. Fare Register.
Held not invalidated by public use for experimental purposes only; is infringed, *Railway Register Mfg. Co. v. Broadway & 7th Ave. R. Co.*, 22 Fed. Rep., 655. See, also, *Railway Register Mfg. Co. v. Broadway & 7th Ave. R. Co.*, 32 O. G., 257.
266185. Moulton, H. W. Oct. 17, 1882. Bustles.
Higby v. Columbia Rubber Co., 18 Fed. Rep., 601.
268591. Abbott, T. Dec. 5, 1882. Baggage Check Holder.
Construed to be for a combination and held not infringed, *Abbott v. Hoole Mfg. & Baggage Check Co.*, 31 O. G., 1561.
269329. Scheidler, R. Dec. 19, 1882. Bed Plate for Steam-engine.
Construed to be for the application of an old device in an old way without change of result, and held void for want of novelty, *Scheidler v. Tustin*, 23 Fed. Rep., 887.

1883.

273585. Mosler, M. March 6, 1883. Fire-proof Safe.
Claims construed to be for aggregations, *Mosler Safe & Lock Co. v. Mosler, Brahmman & Co.*, 22 Fed. Rep., 901.
274325. Himmer, V. March 30, 1883. Electric Clocks.
Time Telegraph Co. v. Carey, 19 Fed. Rep., 322.
275092. Taylor, H. H. April 3, 1883. Capsule Machine.
In interference with patent No. 305,336, *Hubel v. Tucker*, 24 Fed. Rep., 701.

- 276430.** Lambert, J. April 24, 1883. Gauge for forming Artificial Flower Foundations.
Held to involve invention and sustained, *Lambert v. Hofheimer*, 18 Fed. Rep., 653.
- 277933.** Richmond, A. S. May 22, 1883. Artificial Denture.
International Tooth Crown Co. v. Mills, 22 Fed. Rep., 659.
- 277941.** Richmond, C. M. May 22, 1883. Artificial Denture.
International Tooth Crown Co. v. Mills, 22 Fed. Rep., 659.
- 277943.** Richmond, C. M. May 22, 1883. Artificial Denture.
International Tooth Crown Co. v. Mills, 22 Fed. Rep., 659.
- 279259.** Leach, Wm. F. June 12, 1883. Tables for Tile Machines.
Construed and limited in view of state of art; claims 4, 5 and 6 held not infringed,
Leach v. Chandler, 33 O. G., 237.
- 281640.** Mosler, M. July 17, 1883. Fire-proof Safe.
Construed; claims 1 and 2 held to be for mechanical skill only, and invalid for want of invention; claim 3 is for an aggregation, *Mosler Safe & Lock Co. v. Mosler, Brahmman & Co.*, 22 Fed. Rep., 901.
- 283136.** Mosler, M. Aug. 14, 1883. Fire-proof Safe.
Construed to be for mechanical skill only, and held invalid for want of invention, *Mosler Safe & Lock Co. v. Mosler, Brahmman & Co.*, 22 Fed. Rep., 901.
- 283602.** Hatchman, R. Aug. 21, 1883. Fire Pot for Stoves.
Hatchman, In re, 26 O. G., 738.
- 283931.** Swift, A. W. Aug. 28, 1883. Lubricator.
Validity doubted in view of same device shown, but not claimed in patentee's prior patent of March 21, 1882, *Swift v. Jenks*, 19 Fed. Rep., 641.
- 283962.** Brick, S. R. Aug. 28, 1883. Safety Gas Tank for Vessels.
Brick v. Staten Island R'y Co., 25 Fed. Rep., 553.
- 284506.** Sparks, Wm. E. Sept. 4, 1883. Sash Fastener.
Held not to interfere with patent No. 212,487, *Morris v. Kempshall Mfg. Co.*, 20 Fed. Rep., 121.
- 289488.** Yoder, L. T. Dec. 4, 1883. Candy Manufacture.
Claims 3 and 4 are for combinations of mechanical devices. Claim 3 held valid and infringed. Patentee who conceived, and not defendant workman who embodied it, held inventor, *Yoder v. Mills*, 25 Fed. Rep., 821.

1884.

- 298249.** Smith, E. May 6, 1884. Mowing Machine.
Construed, sustained, and held infringed by a formal difference, *Hussey Mfg. Co. v. Deering & Co.*, 20 Fed. Rep., 795.
- 305867.** Tucker, Wm. A. Sept. 30, 1884. Capsule Cutter.
In interference with patent No. 275,092, *Hubel v. Tucker*, 24 Fed. Rep., 701.
- 309197.** Clark, M. Dec. 16, 1884. Cash Carriers for Store Service.
Continental Store Service Co. v. New York Store Service Co., 31 O. G., 1561.
- 309198.** Clark, M. Dec. 16, 1884. Cash Carriers for Store Service.
Continental Store Service Co. v. New York Store Service Co., 31 O. G., 1561.
- 309199.** Clark, M. Dec. 16, 1884. Cash Carriers for Store Service.
Continental Store Service Co. v. New York Store Service Co., 31 O. G., 1561.
- 309200.** Clark, M. Dec. 16, 1884. Cash Carriers for Store Service.
Continental Store Service Co. v. New York Store Service Co., 31 O. G., 1561.
- 309201.** Clark, M. Dec. 16, 1884. Cash Carriers for Store Service.
Continental Store Service Co. v. New York Store Service Co., 31 O. G., 1561.
- 309202.** Clark, M. Dec. 16, 1884. Cash Carriers for Store Service.
Continental Store Service Co. v. New York Store Service Co., 31 O. G., 1561.
- 309505.** Clark, M. Dec. 16, 1884. Cash Carriers for Store Service.
Continental Store Service Co. v. New York Store Service Co., 31 O. G., 1561.

1885.

- 317676.** Sawyer & Man. May 12, 1885. Electric Light.
Held valid, although granted to an assignee of record, who at date of grant had parted with his interest, *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 33 O. G., 1597.

TABLE 2.

A TABLE OF PARTICULAR REISSUE PATENTS UPON WHICH SUIT HAS BEEN BROUGHT, ARRANGED CHRONOLOGICALLY,

And giving after each reissue patent the number of the original patent, on reference to which, in Table 1, will be found the reissue repeated, and under the reissue the suits in which it was involved, as also the construction, etc., given it in such suits.

1834.

Knight, I. July 10, 1834. Railroad Cars. Original, March 18, 1829.

1836.

Knight, I. Apr. 28, 1836. Railroad Cars. Original, March 18, 1829.

Goulding, J. July 29, 1836. Wool Manufacturing Machine. Original, Dec. 15, 1826.

Stanley, H. Nov. 28, 1836. Stove. Original, Dec. 17, 1832.

1838.

3. Stephens, H. Apr. 21, 1838. Coloring Matter. Original, No. 441.

1839.

17. Carver, E. Nov. 16, 1839. Cotton Gin Ribs. Original, No. 777.

1841.

31. Smith, J. C. March 18, 1841. Preparing Palm Leaf. Original, April 3, 1835.

1842.

48. Orr, I. Nov. 12, 1842. Stove. Original, Jan. 20, 1836.

1844.

60. Allen, E. Jan. 15, 1844. Gun Locks. Original, No. 461.

1845.

67. Du Faur, F. Jan. 23, 1845. Generating and Applying Heat. Original, No. 2558.

71. Woodworth, Wm. July 8, 1845. Planing Mill. Original, Dec. 27, 1828.

72. See 1177.

1846.

79. Morse, S. F. B. Jan. 5, 1846. Electric Telegraph. Magnetic. Original, No. 1647.

82. Hanson, J. & H. March 14, 1846. Lead Pipe. Original, No. 2021.

1847.

92. Tyler, P. B. May 1, 1847. Cotton Press. Original, No. 3885.

96. Hovey, W. June 19, 1847. Grinding Tools. Original, No. 4204.

1848.

117. Morse, S. F. B. June 13, 1848. Electric Telegraph. Original, No. 1647.

118. Morse, S. F. B. June 13, 1848. Electric Telegraph. Morse Register. Original, No. 4453.

124. Colt, S. Oct. 24, 1848. Revolving Fire-arms. Original, Feb. 25, 1836.

1849.

140. Whipple, M. D. July 31, 1849. Ginning Machine. Original, No. 1839.

142. Battin, J. Sept. 4, 1849. Coal Breaker. Original, No. 3292.

156. Goodyear, C. Dec. 25, 1849. Process of Manufacturing India Rubber. Original, No. 3633.

157. Same.

1851.

187. Serrell, A. J. Jan. 7, 1851. Molding Machine. Original, No. 5575.
 [192. Additional improvement. Griscom & Denn. Feb. 23, 1858. Lime Kiln. Original, No. 18,635.]
 200. Corliss, G. H. May 13, 1851. Cut-off for Steam-engines. Original, No. 6162.

1852.

217. Smith, A. May 11, 1852. Parti-coloring Yarn. Original, No. 7446.

1853.

231. Hodge, N. March 1, 1853. Operating Car Brakes. Original, No. 6762.
 239. McCormick, C. H. May 24, 1853. Harvester. Original, No. 5335.
 243. Serrell, A. J. June 21, 1853. Molding Machine. Original, No. 5575.
 247. Crompton, W. Sept. 13, 1853. Loom. Original, No. 491.

1854.

255. Judson, J. & A. Jan. 10, 1854. Valves for Governors. Original, No. 7755.
 259. Ketchum, W. F. Feb. 28, 1854. Harvester Attachment. Original, No. 8724.
 278. Singer, I. M. Oct. 3, 1854. Sewing Machine. Original, No. 8294.

1855.

302. Frost & Monroe. March 13, 1855. Middling Purifier. Original, No. 6148.
 303. Hyatt, T. April 3, 1855. Vault Cover. Original, No. 4266.
 305. Palmer & Williams. April 10, 1855. Harvester. Original, No. 8192.
 306. Sanders, B. D. April 10, 1855. Winnowing Machine. Original, No. 6545.
 313. Carter & Rees. June 19, 1855. Nut and Washer Machine. Original, No. 8322.
 325. Sangster, H. & J. Aug. 21, 1855. Lantern. Original, No. 8154.
 331. Haines, J. Nov. 6, 1855. Harvester. Original, No. 6245.

1856.

- 345-346. Wilson, A. B. Jan. 22, 1856. Sewing Machine. Original, No. 7776.
 355. Johnson, W. H. Feb. 26, 1856. Sewing Machine. Original, No. 10,597.
 361. Kenyon, W. March 18, 1856. Nuts. Original, No. 8427.
 362. Arnold, J. March 18, 1856. Loom. Original, July 15, 1829.
 372. Carhart, J. June 24, 1856. Bellows for Musical Instrument. Original, No. 4912.
 396. Wells, H. A. Sept. 30, 1856. Machine for Making Hat Bodies. Original, No. 4472.
 409. Wells, H. A. Oct. 7, 1856. Machine for Making Hat Bodies. Original, No. 4472.
 401. Sherwood, J. P. Oct. 7, 1856. Door-lock. Original, No. 2886.
 404. Wyckoff & Morrison. Oct. 14, 1856. Boring Machine. Original, No. 13,606.
 409. Baldwin, S. K. Nov. 4, 1856. Machine for Cutting Shoe Pegs. Original, No. 2725.
 414. Wilson, A. B. Dec. 9, 1856. Sewing Machine. Original, No. 7776.

1857.

427. Osborn, W. Feb. 17, 1857. Bonnet Machine. Original, No. 15,570.
 446. Thompson, M. March 31, 1857. Furnace for Wet Fuel. Original, No. 12,678.
 449. Hussey, O. April 14, 1857. Reaper. Original, No. 5227.
 455. Sanford, D. W. C. April 21, 1857. Refrigerator. Original, No. 13,802.
 466. Ketchum, W. F. June 2, 1857. Harvester Attachment. Original, No. 8724.
 468. Atwood, A. June 9, 1857. Cast-iron Car Wheel. Original, No. 5112.
 484. Carhart, J. Aug. 18, 1857. Bellows for Musical Instrument. Original, No. 4912.
 501. Woodward, E. F. Sept. 29, 1857. Hoop-skirt. Original, No. 17,602.

1858.

518. Morey & Johnson. Jan. 12, 1858. Sewing Machine. Original, No. 6099.
 521. Hubbell, Wm. W. Jan. 19, 1858. Explosive Shell. Original, No. 14,133.
 540. Moffitt, J. R. March 23, 1858. Grain Separator. Original, No. 9432.
 545. Haines, J. April 13, 1858. Harvester. Original, No. 13,523.
 554. Cahoon, C. W. May 11, 1858. Seeding Machine. Original, No. 18,083.
 555. Frost & Monroe. May 11, 1858. Middlings Purifier. Original, No. 1648.
 556. Goodyear, N. May 18, 1858. India Rubber. Original, No. 3633.
 557. Same.
 568. Grover & Baker. June 15, 1858. Sewing Machine. Original, No. 7931.
 608. Watt & Burgess. Oct. 5, 1858. Paper Pulp Manufacture. Original, No. 11,343.
 623. Case, J. Nov. 16, 1858. Seed Planter. Original, No. 12,231.

1859.

648. Jones, E. F. Jan. 11, 1859. Lamp. Original, No. 20,159.
 666. Kenyon, W. Feb. 15, 1859. Nuts. Original, No. 8427.

723. Sylla & Adams. May 17, 1859. Harvester. Original, No. 10,038.
 724. Same.
 726. Same.
 742. Hussey, O. June, 21, 1859. Reaping Machine. Original, No. 5227.
 747. Jenkins, H. June 28, 1859. Wire Grating Manufacture. Original, No. 5006.
 758. Corliss, G. H. July 12, 1859. Cut-off for Steam-engines. Original, No. 6162.
 759. Same.
 760. Same.
 761. Same.
 762. Same.
 763. Same.
 780. Corliss, G. H. July 26, 1859. Cut-off Gear. Original, No. 8253.
 786. Fairclough, J. Aug. 2, 1859. Balancing Mill Stones. Original, No. 22,356.
 797. Meyer, L. O. B. Aug. 16, 1859. Vulcanizing Caoutchouc. Original, No. 10,741.
 853. Blanchard, T. Nov. 15, 1859. Wood-bending Machine. Original, No. 6951.
 870. Draper, J. Dec. 27, 1859. Skeleton Skirt. Original, No. 25,701.

1860.

875. Wheeler, C., Jr. Jan. 3, 1860. Harvester. Original, No. 12,044.
 876. Same.
 877. Same.
 878. Same.
 879. Same.
 906. Sampson, B. E. Feb. 21, 1860. Horse Car Coupling. Original, No. 21,026.
 907. Sickles, F. E. Feb. 21, 1860. Lifting Valve. Original, No. 4199.
 908. Same.
 909. Same.
 910. Same.
 911. Same.
 912. Same.
 917. Hussey, O. Feb. 28, 1860. Reaping Machine. Original, No. 5227.
 920. Rice, B. F. March 6, 1860. Paper Bag Machine. Original, No. 17,184.
 933. Osborn, W. March 27, 1860. Bonnet Machine. Original, No. 15,570.
 947. Marshall, M. April 24, 1860. Loom. Original, No. 6939.
 963. Tompkins & Johnson. May 15, 1860. Knitting Machine. Original, No. 13,586.
 978. Carr, Wm. S. June 12, 1860. Water Closet. Original, No. 15,474.
 985. Steadman, T. S. June 19, 1860. Harvester. Original, No. 10,967.
 986. Same.
 1003. Seymour, W. H. July 10, 1860. Harvester. Original, No. 8212.
 1036. Brown, G. W. Sept. 11, 1860. Seed Planter. Original, No. 9893.
 1037. Same.
 1038. Same.
 1039. Same.
 1049. Southworth, A. S. Sept. 25, 1860. Plate Holder for Cameras. Original, No. 12,700.
 1062. Monroe, E. P. Oct. 16, 1860. Egg Beater. Original, No. 23,694.
 1084. Goodyear, C. Nov. 20, 1860. Vulcanizing Caoutchouc. Original, No. 3633.
 1085. Same.
 1086. Wells, A. H. Dec. 4, 1860. Machine for making Hat Bodies. Original, No. 4472.
 1087. Same.
 1091. Brown, G. W. Dec. 11, 1860. Seed Planter. Original, No. 12,811.
 1092. Same.
 1093. Same.
 1094. Same.
 1095. Same.

1861.

1109. Palmer & Williams. Jan. 1, 1861. Harvester. Original, No. 8192.
 1110. Same.
 1112. Sickles, F. E. Jan. 1, 1861. Valves for Steam-engines. Original, No. 3802.
 1113. Same.
 1126. Allen, A. H. Jan. 15, 1861. Seats. Original, No. 12,017.
 1137. Parkhurst, S. R. Feb. 12, 1861. Ginning Machine. Original, No. 4023.
 1145. Ross & Marshall. Feb. 26, 1861. Sewing Machine. Original, No. 13,499.
 1149. Nishwitz, F. March 5, 1861. Harvester. Original, No. 19,377.

1154. Howe, E., Jr. March 19, 1861. Sewing Machine. Original, No. 4750.
 1177. (Same as 72) Seymour, W. H. May, 7, 1861. Harvester. Original, No. 8212.
 1211. Kirby, W. A. July 9, 1861. Harvester. Original, No. 26,114.

1862.

1260. Sickles, F. E. Jan. 21, 1862. Steam-engine. Original, No. 4199.
 1262. Densmore, B. Jan. 28, 1862. Harvester. Original, No. 8720.
 1263. Sickles, F. E. Jan. 28, 1862. Valve for Steam-engine. Original, No. 3802.
 1268. Allen, E. Feb. 4, 1862. Revolver. Original, No. 28,951.
 1272. Treadwell, D. Feb. 4, 1862. Cannon Manufacture. Original, No. 13,927.
 1280. Frost & Monroe. Feb. 25, 1862. Middlings Purifier. Original, No. 1648.
 1299. Birdsell, J. C. April 8, 1862. Clover Huller. Original, No. 20,249.
 1312. Morris, J. C. May 27, 1862. Wood-bending Machine. Original, No. 14,405.
 1322. Gray, A. W. July 1, 1862. Horse Power. Original, No. 15,693.
 1368. Fish, W. L. Dec. 23, 1862. Lamp Chimney. Original, No. 35,598.

1863.

1388. Akins & Felthousen. Jan. 20, 1863. Sewing Machine. Original, No. 8282.
 1390. Kirkham, W. S. Jan. 27, 1863. Door-lock. Original, No. 32,521.
 1393. Moore, L. Feb. 4, 1863. Seed Drill. Original, No. 5522.
 1394. Same.
 1395. Same.
 1397. Treadwell & Hailes. Feb. 4, 1863. Base Burning Stove. Original, No. 32,257.
 1400. Hale & Goodman. Feb. 10, 1863. Cutting irregular Forms. Original, No. 4120.
 1448. Watt & Burgess. April 7, 1863. Paper Pulp Manufacture. Original, No. 11,343.
 1449. Same.
 1456. Spaulding, N. W. April 21, 1863. Setting Teeth in Saws. Original, No. 33,270.
 1470. Yale, L., Jr. April 28, 1863. Locks. Original, No. 32,331.
 1483. Chase, L. C. May 26, 1863. Buckles. Original, No. 26,013.
 1506. Henderson, J. C. June 30, 1863. Stove. Original, No. 28,482.
 1514. Chase, L. C. July 28, 1863. Halter Ring. Original, No. 32,180.
 1515. Dennis, P. Aug. 4, 1863. Cultivator. Original, No. 19,412.
 1518. Mann, B. A. Aug. 4, 1863. Skirt Machine. Original, No. 34,026.
 1527. Richards, J. Aug. 25, 1863. Scroll-saw Guide. Original, No. 35,390.
 1541. Baker, Wm. Sept. 22, 1863. Clapboard Joint. Original, No. 10,903.
 1543. Bachelder, J. Sept. 22, 1863. Sewing Machine. Original, No. 6439.
 1562. Paham, C. Nov. 3, 1863. Sewing Machine. Original, No. 11,971.
 1564. Shaw, D. Nov. 3, 1863. Smut Mill. Original, No. 8861.
 1583. Nicolson S. Dec. 1, 1863. Wooden Pavement. Original, No. 11,491.

1864.

1596. Fish, W. L. Jan. 5, 1864. Lamp Chimney. Original, No. 35,598.
 1606. Putnam, H. W. Jan. 19, 1864. Bottle Stopper Fastener. Original, No. 23,263.
 1646. Gray, S. S. March 29, 1864. Collars. Original, No. 38,961.
 1649. Fuzzard, W. April 5, 1864. Surface-sizing Fibrous Material. Original, No. 41,214.
 1651. Shaw, J. April 5, 1864. Apparatus for Saving Silver from Waste Solutions. Original, No. 35,842.
 1682. Palmer & Williams. May 31, 1864. Harvester. Original, No. 8192.
 1683. Seymour, W. H. May 31, 1864. Harvester. Original, No. 8212.
 1709. Allender, J. June 21, 1864. Clothes Wringer. Original, No. 22,539.
 1714. Goulding, J. June 28, 1864. Wool Manufacturing Machine. Original, Dec. 15, 1826.
 1748. Norton, M. P. Aug. 23, 1864. Hand Stamp. Original, No. 38,175.
 1764. Clissold, Wm. Sept. 13, 1864. Wool-lubricating Machine. Original, No. 36,603.
 1804. Bouvet, J. Nov. 1, 1864. Metal Cans. Original, No. 43,378.
 1807. Allender, J. Nov. 8, 1864. Clothes Wringer. Original, No. 22,539.
 1821. Sands, T. Nov. 15, 1864. Machine for making Knitting Needles. Original, No. 38,987.
 1823. Littlefield, D. G. Nov. 22, 1864. Coal Burner. Original, No. 10,448.
 1825. Wortendyke, J. B. Nov. 22, 1864. Machine for Cutting Paper for Twine. Original, No. 44,249.
 1826. Booth, J. L. Nov. 29, 1864. Grain Separator. Original, No. 25,484.
 1828. Hunt, W. Nov. 29, 1864. Collar. Original, No. 11,376.

1865.

1848. Cummings, J. A. Jan. 10, 1865. Artificial Gums and Plates. Original, No. 43,009.
 1869. Fowler, F. F. Feb. 14, 1865. Hay Elevator. Original, No. 27,899.
 1871. Same.
 1874. Waterman, H. Feb. 14, 1865. Tempering Wires. Original, No. 21,286.
 1888. Hoffheins, R. Feb. 28, 1865. Harvester. Original, No. 40,481.
 1904. Cummings, J. A. March 21, 1865. Artificial Gums and Plates. Original, No. 43,009.
 1914. Sabin, H. W. March 28, 1865. Horse Rake. Original, No. 7813.
 1915. Same.
 1916. Clark, Wm. J. March 28, 1865. Bolt Manufacture. Original, No. 43,669.
 1922. Pingree, S. W. March 28, 1865. Extracting Tan Bark. Original, No. 41,782.
 1934. Allender, J. April 18, 1865. Clothes Wringer. Original, No. 22,539.
 1935. Bergen, G. I. April 18, 1865. Corn Planter. Original, No. 40,789.
 1940. Davidson, C. H. & H. E. April 25, 1865. Syringe. Original, No. 16,956.
 1948. Allen, E. May 9, 1865. Cartridge Case Machine. Original, No. 27,094.
 1952. Hicks, W. C. May 9, 1865. Fire-arms. Original, No. 16,797.
 1980. Lockwood, W. E. June 6, 1865. Collars. Original, No. 23,771.
 1981. Same.
 1988. Hagan, W. E. June 6, 1865. Stove. Original, No. 41,897.
 2005. Richardson, F. B. June 20, 1865. Syringe. Original, No. 31,626.
 2034. Hoffman, J. H. July 25, 1865. Paper Collar. Original, No. 45,998.
 2046. Draper, J. Aug. 1, 1865. Hoop Skirt. Original, No. 25,700.
 2087. Wardwell, J. G. Oct. 10, 1865. Stone Channeling Machine. Original, No. 40,584.
 2088. Same.
 2092. Kittle, S. P. Oct. 17, 1865. Spring Mattress. Original, No. 44,960.
 2102. Hoffheins, R. Nov. 7, 1865. Harvester. Original, No. 40,481.
 2125. Bachelder, J. Dec. 12, 1865. Sewing Machine. Original, No. 6439.
 2133. Williams, I. A. Dec. 19, 1865. Locomotive Lamp. Original, No. 35,122.

1866.

2145. Blake, E. W. Jan. 9, 1866. Stone Crusher. Original, No. 20,542.
 2159. Stilwell, E. R. Jan. 23, 1866. Feed Water Feeder. Original, No. 44,561.
 2160. Same.
 2165. Moody, S. A. Jan. 30, 1866. Corset. Original, No. 42,591.
 2166. Henshaw, J. R. Feb. 6, 1866. Self-mousing Hook. Original, No. 21,879.
 2171. Hayden, H. W. Feb. 13, 1866. Brass Kettles. Original, No. 8589.
 2183. Boardman, B. March 6, 1866. Wire Staples. Original, No. 19,747.
 2213. Clissold, Wm. March 27, 1866. Wool-lubricating Machine. Original, No. 36,603.
 2224. Hoffheins, R. April 10, 1866. Harvester. Original, No. 35,315.
 2257. Osborn, W. May 29, 1866. Bonnet Machine. Original, No. 15,570.
 2260. Rogers, S. May 29, 1866. Hay Elevator. Original, No. 46,027.
 2261. Densmore, J. & A. May 29, 1866. Petroleum Car. Original, No. 53,794.
 2309. Evans, A. July 10, 1866. Paper Collar. Original, No. 38,664.
 2311. Woodward, D. A. July 10, 1866. Solar Camera. Original, No. 16,700.
 2319. Bussey & McLeod. July 24, 1866. Cooking Stove. Original, No. 51,292.
 2354. Marsh, J. S. Sept. 11, 1866. Reaping Machine. Original, No. 37,630.
 2355. Tucker, H. Sept. 11, 1866. Bronzing or Coloring Iron. Original, No. 40,964.
 2356. Same.
 2367. Graham, E. H. Oct. 2, 1866. Picker-staff Motion in Looms. Original, No. 30,441.
 2380. Dundas, J. Oct. 16, 1866. Cultivator. Original, No. 22,859.
 2386. Albertson, A. Oct. 30, 1866. Bottle Stopper. Original, No. 36,266.
 2406. Bigelow, E. Dec. 4, 1866. Syrup Caster. Original, No. 19,824.
 2415. Harrington, J. R. Dec. 11, 1866. Carpet Lining. Original, No. 14,585.
 2429. Walker, E. L. Dec. 18, 1866. Hay Elevator. Original, No. 44,129.

1867.

2459. Henderson, J. C. Jan. 15, 1867. Coal Stove. Original, No. 28,482.
 2487. Coe, C. W. Feb. 19, 1867. Drilling and Screw-cutting Machine. Original, No. 37,433.
 2490. Hoffheins, R. Feb. 19, 1867. Harvester. Original, No. 40,481.
 2500. Huson, E. March 5, 1867. Wagon Gearing. Original, No. 16,648.
 2511. Collender, H. W. March 19, 1867. Billiard Table Cushion. Original, No. 19,074.
 2529. Reay, G. H. March 26, 1867. Envelope Machine. Original, No. 39,702.

2569. Thompson, G. April 16, 1867. Alkali. Original, No. 15,957.
 2570. Same.
 2571. Same.
 2587. Loewenberg. April 30, 1867. Fabric for Hats. Original, No. 46,568.
 2597. Hosford, E. N. May 7, 1867. Pulvurulent Acid. Original, No. 14,722.
 2598. Wright, T. May 14, 1867. Broom. Original, No. 59,733.
 2608. Sylla & Adams. May 14, 1867. Harvester. Original, No. 10,038.
 2610. Wheeler, C., Jr. May 14, 1867. Harvester. Original, No. 12,044.
 2626. Graham, E. H. May 28, 1867. Picker-staff motion in Looms. Original, No. 30,441.
 2632. Wheeler, C., Jr. May 28, 1867. Harvester. Original, No. 12,367.
 2654. Foy, L. H. June 18, 1867. Corset Skirt Supporters. Original, No. 39,910.
 2656. Smith, Wm. June 18, 1867. Elastic Fabric. Original, No. 9653.
 2667. Teel, A. C. July 2, 1867. Gate. Original, No. 40,777.
 2682. Grosjean, F. July 16, 1867. Spoons and Forks. Original, No. 34,252.
 2684. Potter, W. L. July 16, 1867. Roofing Composition. Original, No. 46,495.
 2707. King & Freese. July 30, 1867. Bridge. Original, No. 33,384.
 2711. Bigelow, E. Aug. 6, 1867. Soda Water Apparatus. Original, No. 22,697.
 2748. Nicolson, S. Aug. 20, 1867. Wooden Pavement. Original, No. 11,491.
 2756. Hartshorn, S. Aug. 27, 1867. Spring Fixture for Shades. Original, No. 44,624.
 2765. Gersten, C. Sept. 17, 1867. Lamps. Original, No. 22,723.
 2769. Sawyer, H. Oct. 1, 1867. Putting up, etc., Powders. Original, No. 41,097.
 2805. Francis & Lemate. Nov. 26, 1867. Composition for inking Rollers. Original, No. 43,192.
 2829. Sargeant, I. A. Dec. 31, 1867. Clothes Wringer. Original, No. 21,029.

1868.

2843. Smith, Wm. Jan. 14, 1868. Weaving. Original, No. 9653.
 2844. Same.
 2845. Weston, D. M. Jan. 14, 1868. Centrifugal Machine. Original, No. 63,770.
 2909. Rowell, J. S. & I. March 31, 1868. Cultivator. Original, No. 56,102.
 2942. Wells, H. A. May 19, 1868. Machine for making Hat Bodies. Original, No. 4472.
 2951. Johnston, S. May 26, 1868. Harvester Rake and Reel. Original, No. 46,300.
 2979. Hosford, E. N. June 9, 1868. Pulvurulent Acid. Original, No. 14,722.
 2982. Dorsey, O. June 9, 1868. Harvester Rake. Original, No. 14,350.
 2994. Whitcomb, G. June 16, 1868. Hay Rake. Original, No. 21,712.
 2995. Same.
 3000. King, G. E. June 23, 1868. Fluting Machine. Original, No. 62,492.
 3001. Same.
 3014. Smith, Wm. June 30, 1868. Div. B. Elastic Fabric. Original, No. 9653.
 3033. Ketchum, W. F. July 14, 1868. Harvester Attachment. Original, No. 8724.
 3034. Same.
 3066. Du Puy, A. T. Aug. 4, 1868. Printer's Galley. Original, No. 60,151.
 3070. Silverthorn, N. Aug. 4, 1868. Boot and Shoe Tip. Original, No. 26,329.
 3079. Sarven, J. D. Aug. 11, 1868. Carriage Wheels. Original, No. 17,520.
 3082. Riechman, C. Aug. 11, 1868. Lamp. Original, No. 21,576.
 3094. Bethea, J. C. Aug. 25, 1868. Plow. Original, No. 61,796.
 3096. Martin, E. & P. E. Aug. 25, 1868. Process for refining Cast-iron. Original, No. 72,061.
 3118. Berdan, H. Sept. 15, 1868. Breech-loader. Original, No. 51,991.
 3119. Davis, W. Sept. 15, 1868. Preserving Meat. Original, No. 78,932.
 3143. Barry, C. Oct. 6, 1868. Machine for making Tin Cans. Original, No. 71,680.
 3186. Lovatt, J. Nov. 10, 1868. Skate. Original, No. 28,495.
 3192. Taylor, L. Nov. 10, 1868. Mop-head. Original, No. 22,990.
 3215. Taylor, L. Nov. 24, 1868. Mop-head. Original, No. 22,990.
 3217. Eickemeyer, R. Dec. 1, 1868. Machine for stretching Hat Bodies. Original, No. 46,553.
 3218. Rose, I. M. Dec. 1, 1868. Marking Clothes in Sewing Machine. Original, No. 40,084.
 3243. Stewart, T. B. Dec. 22, 1868. Car-axle Boxes. Original, No. 71,241.

1869.

3252. Nyce, B. M. Jan. 5, 1869. Preserving Fruit. Original, No. 31,734.
 3265. Siemens, C. W. & F. Jan. 12, 1869. Regenerator Furnace. Original, No. 41,788.
 3268. Baker, Wm. Jan. 19, 1869. Clapboard Joint. Original, No. 10,903.
 3274. Stow, H. W. Jan. 19, 1869. Pavement. Original, No. 72,110.
 3323. Decker, L. March 9, 1869. Billiard Table. Original, No. 60,657.

3335. Day, S. F. March 23, 1869. Electro-magnetic Telegraph. Original, No. 42,842.
 3361. Voelter, H. April 6, 1869. Reducing Wood to Paper Pulp. Original, No. 21,161.
 3372. Nishwitz, F. April 13, 1869. Harvester. Original, No. 19,377.
 3377. Nobel, A. April 13, 1869. Nitro-Glycerine. Original, No. 50,617.
 3378. Same.
 3405. Brodie, G. April 27, 1869. Bale Tie. Original, No. 23,291.
 3434. Murdock, J. G. May 11, 1869. Hydrant. Original, No. 38,694.
 3438. Bardell & Smith. May 18, 1869. Coal Scuttle. Original, No. 62,807.
 3442. Draper, D. A. May 18, 1869. Forming Letters on Type Blocks. Original, No. 64,410.
 3444. Carpenter, R. W. May 18, 1869. Tremolo Attachment. Original, No. 48,366.
 3445. La Baw, G. W. May 18, 1869. Miter Machine. Original, No. 12,956.
 3460. Jackson, S. E. & M. P. May 25, 1869. Mowing Machine. Original, No. 18,975.
 3483. Taft, G. C. June 1, 1869. Wrench. Original, No. 40,590.
 3514. Slemmon, M. G. June 22, 1869. Plow. Original, No. 30,357.
 3517. Gallahue, A. C. June 22, 1869. Machine for Pegging Shoes. Original, No. 23,361.
 3523. Henderson, J. C. June 29, 1869. Coal Stove. Original, No. 28,482.
 3531. Hayward, D. July 6, 1869. India Rubber Manufacture. Original, No. 11,608.
 3533. Gallahue, A. C. July 6, 1869. Machine for Pegging Shoes. Original, No. 9947.
 3570. Roots, P. H. & F. M. July 27, 1869. Rotary Blower Cases. Original, No. 81,010.
 3576. Francis, L. Aug. 3, 1869. Ink. Original, No. 41,887.
 3579. Jenkins, N. Aug. 3, 1869. Elastic Packing. Original, No. 54,554.
 3586. Norton, M. P. Aug. 3, 1869. Hand Stamp. Original, No. 38,175.
 3609. Watt, G. Aug. 17, 1869. Plow. Original, No. 71,560.
 3612. Van Marter. Aug. 17, 1869. Tub for Distilling Oils. Original, No. 86,115.
 3618. Stilwell, E. R. Aug. 24, 1869. Feed Water Feeder. Original, No. 44,561.
 3624. Barnes, S. H. Aug. 31, 1869. Corset Spring. Original, No. 56,345.
 3633. Rutter, J. W. Sept. 7, 1869. Ore and Stone Crusher. Original, No. 88,216.
 3665. Carpenter, R. W. Oct. 5, 1869. Tremolo. Original, No. 48,366.
 3666. Ball, H. Oct. 12, 1869. Oven. Original, No. 15,753.
 3682. Taylor, L. Oct. 19, 1869. Mop-head. Original, No. 22,990.
 3690. Leschot, R. Oct. 26, 1869. Rock Drill. Original, No. 39,235.
 3727. Naylor, Wm. Nov. 9, 1869. Steam Safety Valve. Original, No. 58,962.
 3744. Shaw. Nov. 23, 1869. Lead Pipe. Original, No. 74,613.
 3747. Westlake, W. Nov. 23, 1869. Lantern. Original, No. 42,520.
 3768. Lawton & Bliss. Dec. 21, 1869. Hose Coupling. Original, No. 23,033.

1870.

3794. Shaw, D. Jan. 11, 1870. Smut-mill. Original, No. 8861.
 3798. Hicks, W. C. Jan. 18, 1870. Fire-arms. Original, No. 16,797.
 3810. Calahan, E. A. Jan. 25, 1870. Printing Telegraph. Original, No. 76,993.
 3815. Bussey & McLeod. Feb. 1, 1870. Cooking Stove. Original, No. 56,686.
 3816. Russell, N. C. Feb. 1, 1870. Preparing Leather. Original, No. 93,910.
 3826. Frink, I. P. Feb. 8, 1870. Reflector. Original, No. 27,898.
 3827. Same.
 3852. Jordan & Smith. Feb. 22, 1870. Wrench. Original, No. 50,364.
 3856. Cabell, S. G. March 1, 1870. Fluting Machine. Original, No. 56,365.
 3861. Knox & Corrister. March 1, 1870. Fluting Machine. Original, No. 53,633.
 3863. Reckendorfer, J. March 1, 1870. Pencil. Original, No. 36,854.
 3869. Buerk, J. E. March 8, 1870. Watchman's Time Detector. Original, No. 48,048.
 3909. Elwell, H. H. April 5, 1870. Knob-latch. Original, No. 39,280.
 3929. McKenzie, D. April 19, 1870. Baker's Oven. Original, No. 28,130.
 3932. Smith, J. R. April 26, 1870. Cultivator. Original, No. 28,016.
 3938. Knox, S. R. April 26, 1870. Fluting Machine. Original, No. 59,913.
 3946. Symmes, J. May 3, 1870. Breech Loader. Original, No. 22,094.
 3972. Crandall, W. E. May 17, 1870. Child's Carriage. Original, No. 100,121.
 3976. Ingels, J. May 17, 1870. Grain Drill. Original, No. 90,268.
 3995. Hayden, H. W. May 24, 1870. Brass Kettles. Original, No. 8589.
 3996. Same.
 4006. Littlefield, D. G. May 31, 1870. Coal Burner. Original, No. 53,251.
 4026. Ball, H. June 14, 1870. Oven. Original, No. 15,753.
 4027. Bisbee, A. June 14, 1870. Steam Gauge Cock. Original, No. 13,563.
 4066. Chipman, G. W. July 12, 1870. Carpet Lining. Original, No. 60,476.
 4071. Morehouse, C. B. July 12, 1870. Whip Sockets. Original, No. 52,439.
 4072. Goddard, E. July 12, 1870. Glue. Original, No. 44,528.

4085. Holly, B. Aug. 2, 1870. Water Supply Regulator. Original, No. 87,413.
 4091. Thomas & Mast. Aug. 2, 1870. Grain Drill. Original, No. 93,369.
 4096. Tuttle, J. H. Aug. 9, 1870. Saw. Original, No. 9807.
 4106. Guidet, C. Aug. 23, 1870. Stone Pavement. Original, No. 85,814.
 4116. Sarven, J. D. Sept. 6, 1870. Carriage Wheels. Original, No. 17,520.
 4134. Riley & Bissell. Sept. 27, 1870. Composition for Covering Boilers. Original, No. 95,517.
 4137. Moulé & Girdlestone. Oct. 4, 1870. Water Closet. Original, No. 91,474.
 4138. Same.
 4143. Norton, M. P. Oct. 4, 1870. Hand Stamp. Original, No. 38,175.
 4144. Same.
 4165. Dewey & Tillotson. Oct. 25, 1870. Well Reservoir. Original, No. 53,584.
 4187. Horton, J. M. Nov. 29, 1870. Auger Handle. Original, No. 35,856.
 4192. Barclay, J. Dec. 6, 1870. Plated Metal Bracelets. Original, No. 94,064.
 4196. Bolton, J. Dec. 13, 1870. Tuck Marker for Sewing Machine. Original, No. 46,871.
 4202. Bussell, C. T. Dec. 13, 1870. India Rubber and Steel Spring. Original, No. 10,280.

1871.

4223. Crandall, W. E. Jan. 3, 1871. Child's Carriage. Original, No. 100,121.
 4240. Slawson, J. B. Jan. 24, 1871. Fare Box. Original, No. 17,899.
 4281. Mann, H. F. Feb. 28, 1871. Harvester, Original, No. 15,044.
 4289. Crouch, G. March 7, 1871. Shawl Strap. Original, No. 82,606.
 4296. Fales, J. March 14, 1871. Carpet Lining. Original, No. 52,835.
 4317. Carter & Mets. April 4, 1871. Extension Table Slide. Original, No. 44,073.
 4321. Graebe & Liebermann. April 4, 1871. Artificial Alizarine. Original, No. 95,465.
 4334. Jurgensen, J. April 11, 1871. Watch Stem Setting. Original, No. 61,207.
 4349. Cole, H. H. April 25, 1871. Fluting Machine. Original, No. 55,469.
 4364. Schillinger, J. J. May 2, 1871. Concrete Pavement. Original, No. 105,599.
 4372. Green, N. W. May 9, 1871. Driven Well. Original, No. 73,425.
 4383. McQuinston, T. May 16, 1871. Plow. Original, No. 25,843.
 4418. Voelter, H. June 6, 1871. Reducing Wood to Paper Pulp. Original, No. 21,161.
 4467. Scaife, W. B. July 11, 1871. Boiler for Stoves. Original, No. 107,817.
 4479. Ashcroft, J. July 25, 1871. Process for Treating Coffee. Original, No. 113,832.
 4484. Ketchum, W. F. July 25, 1871. Harvester. Original, No. 20,719.
 4486. Louis, L. July 25, 1871. Melodeon. Original, No. 16,094.
 4509. Sladdin, J. July 8, 1871. Machine for making Loom Harness. Original, No. 80,774.
 4510. Same.
 4516. Swan, J. Aug. 15, 1871. Machine for making Curved Augers. Original, No. 78,769.
 4533. Pfeil, J. C. Aug. 29, 1871. Rolling Coulters. Original, No. 76,343.
 4588. Page, C. G. Oct. 10, 1871. Induction Coil and Circuit Breaker. Original, No. 76,654.
 4598. Tarr & Wonson. Oct. 17, 1871. Paint for Ship's Bottom. Original, No. 40,515.
 4599. Same.
 4608. Nimmo, G. Oct. 24, 1871. Molding Crucibles. Original, No. 49,140.
 4653. Cabell, S. G. Nov. 28, 1871. Fluting Machine. Original, No. 83,924.
 4672. Ketchum, W. F. Dec. 12, 1871. Harvester Attachment. Original, No. 8724.
 4673. Same.
 4675. Robertson, T. J. W. Dec. 12, 1871. Hand Stamp. Original, No. 18,249.
 4683. Lyman, A. S. Dec. 26, 1871. Cooling and Ventilating Rooms. Original, No. 14,510.

1872.

4695. Mershon, A. H. Jan. 2, 1872. Damper for Hot-air Furnace. Original, No. 77,512.
 4696. Sargent, J. Jan. 2, 1872. Lock. Original, No. 57,574.
 4698. Magoun, A. B. Jan. 2, 1872. Adjustable Window Frame. Original, No. 52,726.
 4712. Deuchfield, J. Jan. 16, 1872. Cooling and Drying Meal. Original, No. 19,984.
 4731. Bantz, G. Feb. 6, 1872. Furnace for Burning Wet Fuel. Original, No. 20,616.
 4775. Clarke, E. March 5, 1872. Registering Steam Gauge. Original, No. 101,583.
 4777. Covell, E. T. March 5, 1872. Can. Original, No. 94,947.
 4780. Graham, S. P. March 5, 1872. Carriage Body and Seat. Original, No. 95,466.
 4793. Howes & Throop. March 5, 1872. Grain Separator. Original, No. 19,637.
 4815. Nobel, A. March 19, 1872. Exploding Nitro-Glycerine. Original, No. 50,617.
 4816. Same.
 4818. Same. Nitro-Glycerine.
 4819. Same. Nitro-Glycerine.
 4831. Foy, L. H. March 26, 1872. Corset Skirt Supporters. Original, No. 45,296.

4864. Smith, E. J. April 9, 1872. File Holder. Original, No. 76,834.
 4870. Johnson, A. April 16, 1872. Fastening Metallic Coverings. Original, No. 17,331.
 4887. Race & Matthews. April 30, 1872. Hydrant Casing. Original, No. 19,206.
 4896. Swett, C. May 7, 1872. Bale Tie. Original, No. 59,144.
 4937. Williams, I. F. June 4, 1872. Flocking Machine for Rubber. Original, No. 33,808.
 4977. Meyer & Evans. July 16, 1872. Rubber Overshoes. Original, No. 111,962.
 4994. Miles, D. July 16, 1872. Extinguishing Fires. Original, No. 88,844.
 5004. Warth, A. July 23, 1872. Cloth Cutting Machine. Original, No. 106,101.
 5007. Eames & Seely. July 30, 1872. Soap. Original, No. 65,186.
 5026. Cornell, G. B. Aug. 6, 1872. Bung Brush and Wrench. Original, No. 118,617.
 5027. Same.
 5050. Griggs, G. H. Sept. 10, 1872. Spark Arrester. Original, No. 120,638.
 5051. Same.
 5067. Cary & Griffiths. Sept. 24, 1872. Suspension Ring for Business Cards. Original, No. 77,482.
 5081. Forseyth, J. B. Oct. 1, 1872. Manufacture of Elastic Rollers. Original, No. 101,994.
 5109. Hunt, W. Oct. 22, 1872. Collar. Original, No. 11,376.
 5132. Holley, B. Nov. 5, 1872. Water Supply Regulator. Original, No. 87,413.
 5150. Carstaedt. Nov. 19, 1872. Take-up Mechanism for Looms. Original, No. 88,365.
 5154. Swain, A. M. Nov. 19, 1872. Turbine Wheel. Original, No. 28,314.
 5155. Albright, A. Nov. 26, 1872. Dies for Rubber-coated Harness. Original, No. 123,603.
 5174. Kreischer, B. Dec. 3, 1872. Tiling for Fire-proof Buildings. Original, No. 112,930.
 5180. Douglas, A. Dec. 10, 1872. Sewing Machine Guide. Original, No. 21,659.
 5186. Warth, A. Dec. 10, 1872. Cloth Cutting Machine. Original, No. 106,101.
 5193. Fisher. Dec. 17, 1872. Hydraulic Mining Apparatus. Original, No. 110,222.
 5207. Chase, S. E. Dec. 31, 1872. Finishing Nails. Original, No. 78,644.

1873.

5216. Barnes, S. H. Jan. 7, 1873. Corset Spring. Original, No. 56,345.
 5223. Page, A. H. Jan. 7, 1873. Clothes Wringer. Original, No. 61,680.
 5235. Morehouse, C. B. Jan. 14, 1873. Whip Socket. Original, No. 43,858.
 5253. McGregor & Voll. Jan. 21, 1873. Sash Fastener. Original, No. 88,318.
 5256. Boomer, Boschert & Morse. Jan. 28, 1873. Cheese Press. Original, No. 108,753.
 5259. Lockwood, W. E. Jan. 28, 1873. Cuffs and Collars. Original, No. 23,771.
 5274. Brown, H. L. Feb. 11, 1873. Hand-car for Railroads. Original, No. 94,469.
 5282. Winsor, J. S. Feb. 11, 1873. Weaver's Harness. Original, No. 12,175.
 5294. Jordan & Smith. Feb. 25, 1873. Wrench. Original, No. 50,364.
 5312. Turnbull & Webb. March 4, 1873. Bed Bottom. Original, No. 125,421.
 5328. Garratt, W. T. March 18, 1873. Lubricator. Original, No. 133,217.
 5333. Brodie, G. March 25, 1873. Bale Tie. Original, No. 23,291.
 5366. Walker, A. April 22, 1873. Hub. Original, No. 61,900.
 5400. Searls & Scott. May 6, 1873. Whip Socket. Original, No. 70,627.
 5408. Jones, H. K. May 13, 1873. Graduating Carpenter's Square. Original, No. 93,449.
 5412. Ambrose, J. E. May 20, 1873. Lamps. Original, No. 30,381.
 5434. Roberts, E. A. L. June 3, 1873. Oil Well. Original, No. 59,936.
 5435. Bussy & McLeod. June 3, 1873. Cooking Stove. Original, No. 51,292.
 5459. Spear, J. June 17, 1873. Base-burning Stove. Original, No. 100,335.
 5460. Same.
 5487. Tarrent, E. July 15, 1873. Log-turning Machine. Original, No. 81,432.
 5504. Westinghouse, G., Jr. July 29, 1873. Steam Power Car-brake. Original, No. 88,929.
 5506. Same. Original, No. 117,841.
 5514. Topham, Wm. H. July 29, 1873. Spittoon. Original, No. 106,094.
 5544. Morton, J. Aug. 19, 1873. Water Tank for Railways. Original, No. 63,418.
 5549. Blessing, J. H. Aug. 26, 1873. Steam Trap. Original, No. 123,670.
 5557. Norton, C. P. Aug. 26, 1873. Cultivator. Original, No. 108,384.
 5590. Hyde, I. Oct. 7, 1873. Combined Water Wheel and Sewing Machine. Original, No. 131,616.
 5619. Nobel, A. Oct. 21, 1873. Explosive Compound. Original, No. 78,317.
 5620. Same. Exploding Nitro-Glycerine.
 5621. Same. Exploding Nitro-Glycerine.
 5624. Swan, J. Oct. 21, 1873. Machine for making Curved Augers. Original, No. 78,769.
 5630. McCreary, J. Oct. 28, 1873. Coupling and Steering Apparatus. Original, No. 129,844.
 5644. Gosling, J. W. Nov. 4, 1873. Step Cover. Original, No. 62,406.

5648. Alden, C. Nov. 11, 1873. Preserving Vegetable and Animal Substances. Original, No. 121,569.
 5650. Hayes, G. Nov. 11, 1873. Sky-light. Original, No. 112,594.
 5651. Hull, D. C. Nov. 11, 1873. Manufacture of Whip Stocks. Original, No. 132,909.
 5693. Hayes, G. Dec. 23, 1873. Sky-light. Original, No. 100,143.
 5701. Fullam, A. I. Dec. 23, 1873. Shearing Sheep. Original, No. 42,572.
 5713. Morehouse, C. B. Dec. 30, 1873. Whip Sockets. Original, No. 43,858.

1874.

5718. Crompton, G. Jan. 6, 1874. Shedding Mechanism for Looms. Original, No. 51,928.
 5748. Truby, J. W. Jan. 27, 1874. Show-case Sockets. Original, No. 117,831.
 5774. Cottle, S. Feb. 24, 1874. Chain for Necklace. Original, No. 147,045.
 5786. Lyman, A. S. March 10, 1874. Cooling and Ventilating Rooms. Original, No. 14,510.
 5798. Nobel, A. March 17, 1874. Exploding Nitro-Glycerine. Original, No. 50,617.
 5799. Same. Explosive Compound.
 5800. Same. Exploding Nitro-Glycerine.
 5804. Christman, J. March 24, 1874. Pump Filter. Original, No. 51,145.
 5806. Ball & Fitts. March 24, 1874. Water Meter. Original, No. 109,372.
 5841. Cochrane, Wm. F. April 21, 1874. Bolting Flour. Original, No. 37,317.
 5868. Mege, H. May 12, 1874. Treating Animal Fats. Original, No. 146,012.
 5894. Frost, C. H. June 2, 1874. Stove. Original, No. 67,283.
 5903. Hull, L. June 2, 1874. Machine for Cutting Caoutchouc. Original, No. 37,446.
 5907. Fulton, C. June 9, 1874. Stove. Original, No. 89,304.
 5925. Broadnax, A. June 23, 1874. Apparatus for Rendering Lard. Original, No. 81,743.
 5927. Carter & Dwyer. June 23, 1874. Base-burning Stove. Original, No. 131,936.
 5928. Hyatt, J. W. & I. S. June 23, 1874. Treating and Molding Pyroxyline. Original, No. 105,338.
 5937. Pentlarge, P. June 30, 1874. Bung for Casks. Original, No. 148,747.
 5940. Welling, Wm. M. June 30, 1874. Artificial Ivory. Original, No. 77,938.
 5951. Johns, H. W. June 30, 1874. Roofing Composition. Original, No. 76,773.
 6016. Draper, G. Aug. 18, 1874. Bobbin and Spindle. Original, No. 127,159.
 6018. Wood, T. H. Aug. 18, 1874. Carriage Springs. Original, No. 139,348.
 6029. Cochrane, Wm. F. Aug. 25, 1874. Bolting Flour. Original, No. 37,321.
 6030. Same. Original, No. 37,318.
 6036. Pearl, O. Sept. 1, 1874. Bobbins and Spindles. Original, No. 102,587.
 6050. Howlett, E. J. Sept. 15, 1874. Tools for Manufacture of Paper Bags. Original, No. 62,342.
 6071. Donn, H. D. Sept. 29, 1874. Saw Dogs. Original, No. 134,653.
 6076. Stewart, A. W. Oct. 6, 1874. Folding Chair. Original, No. 102,179.
 6080. Pattee, J. H. Oct. 6, 1874. Cultivator. Original, No. 124,218.
 6098. Kelleher & Randlett. Oct. 27, 1874. Boot and Shoe Pads. Original, No. 122,030.
 6099. Same.
 6100. Lyman, H. A. Oct. 27, 1874. Corset. Original, No. 97,418.
 6101. Stover, E. & D. C. Oct. 27, 1874. Windmill. Original, No. 133,601.
 6113. Parker, B. S. Nov. 3, 1874. Dies for Forging Ox-shoes. Original, No. 127,927.
 6117. Andrews & Ogden. Nov. 3, 1874. Cheese Manufacture. Original, No. 88,830.
 6129. Jones, W. Nov. 10, 1874. Self-lubricating Axle. Original, No. 148,368.
 6131. Slemmon, M. G. Nov. 10, 1874. Plow. Original, No. 30,357.
 6138. Meyer & Evans. Nov. 17, 1874. India Rubber Shoes. Original, No. 111,962.
 6162. Moffitt, J. R. Dec. 8, 1874. Heel-stiffener. Original, No. 127,090.
 6166. Nimmo, G. Dec. 8, 1874. Molding Crucibles. Original, No. 49,140.
 6169. Sawyer, P. C. Dec. 8, 1874. Cotton Gin. Original, No. 139,820.

1875.

6206. Spear, J. Jan. 5, 1875. Base-burning Stove. Original, No. 100,335.
 6249. Lewis, S. Jan. 26, 1875. Removing Obstructions under Water. Original, No. 80,492.
 6258. Roberts, E. A. L. Jan. 26, 1875. Oil Well. Original, No. 59,936.
 6274. Patric, C. E. Feb. 2, 1875. Grain Drill. Original, No. 85,472.
 6291. Clark, Wm. J. Feb. 16, 1875. Bolt Manufacture. Original, No. 43,669.
 6315. Eachus, J. March 2, 1875. Machine for Cutting Paper Boards. Original, No. 142,154.
 6319. Hatch, J. W. March 9, 1875. Apparatus for Crimping the Stiffenings of Boots and Shoes. Original, No. 117,627.
 6321. Pickles, J. C. March 9, 1875. Car Spring. Original, No. 152,864.
 6326. De Puy, A. T. March 9, 1875. Printer's Galley. Original, No. 60,151.

6335. Davis, J. W. March 16, 1875. Pantaloon. Original, No. 139,121.
 6337. May, J. M. March 16, 1875. Drills for Well Boring. Original, No. 49,129.
 6338. Tucker, E. W. March 16, 1875. Bed Bottoms. Original, No. 53,706.
 6350. Stockbridge, C. H. March 23, 1875. Stocks for Bits. Original, No. 62,232.
 6369. Lovatt, J. April 6, 1875. Skates. Original, No. 28,495.
 6370. Wilson, W. J. April 6, 1875. Preserving Meat. Original, No. 149,276.
 6384. Brown, G. W. April 20, 1875. Seed Planter. Original, No. 46,615.
 6386. Carroll, W. T. April 20, 1875. Spinning Frame. Original, No. 89,025.
 6388. Hatch, J. W. April 20, 1875. Heel Stiffener. Original, No. 129,338.
 6397. McKenzie, D. April 20, 1875. Baker's Oven. Original, No. 28,130.
 6422. Rice, H. W. May 4, 1875. Steam Boiler. Original, No. 146,614.
 6423. Bickford. May 11, 1875. Knitting Machine. Original, No. 80,121.
 6424. Same. Original, No. 92,146.
 6451. Marshall, W. C. May 25, 1875. Preserving Meat. Original, No. 43,516.
 6452. Same.
 6467. Bosworth, C. F. June 1, 1875. Sewing Machine. Original, No. 38,807.
 6469. Collender, H. W. June 1, 1875. Billiard Table. Original, No. 145,787.
 6480. Joyce, J. L. June 8, 1875. Boot and Shoe Manufacture. Original, No. 141,357.
 6493. Harper, J. M. June 22, 1875. Fly Trap. Original, No. 131,098.
 6498. Bailey, L. June 22, 1875. Bench Plane. Original, No. 67,398.
 6531. Barker, W. C. July 6, 1875. Chain Pump. Original, No. 116,138.
 6542. Earle, T. July 13, 1875. Egg Beater. Original, No. 39,134.
 6550. Johnson, A. F. July 20, 1875. Sewing Machine. Original, No. 42,292.
 6557. Quirolo, A. July 27, 1875. Stereoscope. Original, No. 156,311.
 6565. Pipo, J. A. July 27, 1875. Ruffler. Original, No. 37,550.
 6566. Robjohn, T. July 27, 1875. Ruffler. Original, No. 46,424.
 6567. Wyman, H. July 27, 1875. Shuttle-box Mechanism for Looms. Original, No. 70,309.
 6580. Root, S. E. Aug. 3, 1875. Clock Dial. Original, No. 23,950.
 6594. Cochran, Wm. F. Aug. 17, 1875. Bolting Flour. Original, No. 37,321.
 6595. Same.
 6609. Tyler, S. W. Aug. 24, 1875. Harvester. Original, No. 30,651.
 6644. Barton, E. C. Sept. 14, 1875. Toy Bell. Original, No. 150,933.
 6648. Field & Pullman. Sept. 21, 1875. Sleeping Car. Original, No. 49,992.
 6660. Huston, E. Sept. 28, 1875. Wagon Gearing. Original, No. 16,648.
 6662. Miller, F. C. Sept. 28, 1875. Cigar Molds. Original, No. 155,806.
 6673. Todd, W. Oct. 5, 1875. Wash-board. Original, No. 111,585.
 6675. Buffum, A. K. P. Oct. 5, 1875. Machine for making Wooden Gutters. Original, No. 117,255.
 6678. Nye, S. R. Oct. 5, 1875. Horse Hay Rake. Original, No. 105,833.
 6683. New, T. Oct. 5, 1875. Tank for Asphalt. Original, No. 147,423.
 6684. Same.
 6693. McGregor & Voll. Oct. 11, 1875. Sash-fastener. Original, No. 88,318.
 6697. Stephenson, J. Oct. 11, 1875. Street Cars. Original, No. 61,482.
 6709. Hunt, Z. Oct. 19, 1875. Coal Stove. Original, No. 50,073.
 6714. Holt, H. Oct. 26, 1875. Marking Wheel. Original, No. 52,169.
 6733. Donn, H. D. Nov. 9, 1875. Saw Dogs. Original, No. 134,653.
 6751. Sutro, H. Nov. 16, 1875. Cards for Wrapping Threads. Original, No. 130,672.
 6811. Parker, J. Dec. 21, 1875. Fly-trap. Original, No. 109,444.
 6824. Gale, H. Dec. 28, 1875. Plow-jointer. Original, No. 147,629.

1876.

6833. Kelly, T. J. Jan. 4, 1876. Gas Stove Burner. Original, No. 50,938.
 6844. Ambrose, J. E. Jan. 11, 1876. Lamps. Original, No. 30,381.
 6849. Vogler, H. Jan. 11, 1876. Trunk. Original, No. 155,601.
 6902. Kelly, M. Feb. 8, 1876. Barbed Fence Wire. Original, No. 74,379.
 6913. Glidden, J. F. Feb. 8, 1876. Barbed Fence Wire. Original, No. 150,683.
 6914. Same.
 6925. Knapp, A. H. Feb. 15, 1876. Curtain Fixtures. Original, No. 118,725.
 6951. Klein, J. C. Feb. 29, 1876. Picks. Original, No. 146,597.
 6954. Olmsted, J. Feb. 29, 1876. Insulating Telegraph Wires. Process. Original, No. 129,858.
 6955. Same. Product.
 6962. Bull, H. C. Feb. 29, 1876. Apparatus for Cleaning Privies. Original, No. 115,565.
 6974. Davis, C. H. March 7, 1876. Box Loop. Original, No. 95,004.

6976. Hunt, W. D. March 7, 1876. Barbed Fence Wire. Original, No. 67,117.
 6979. Carter & Duyer. March 7, 1876. Base-burning Stove. Original, No. 131,936.
 6990. Bailey, T. R., Jr. March 14, 1876. Hydrant. Original, No. 75,344.
 7006. Wineman, P. March 21, 1876. Pump. Original, No. 90,143.
 7014. Fairfield, H. P. March 28, 1876. Nailing Machine for Boots and Shoes. Original, No. 155,962.
 7031. Averill, D. R. April 4, 1876. Paint Compound. Original, No. 66,773.
 7034. Judson, C. April 4, 1876. Corset Spring. Original, No. 173,124.
 7035. Kelly, M. April 4, 1876. Barbed Fence Wire. Original, No. 84,062.
 7036. Same.
 7042. Arden, H. April 11, 1876. Car Elevator. Original, No. 77,706.
 7046. Osgood, J. H. April 11, 1876. Base Ball Cover. Original, No. 127,098.
 7061. Winslow, I. April 18, 1876. Canning Green Corn. Original, No. 35,274.
 7067. Same. Original, No. 34,928.
 7069. Fish, W. L. April 18, 1876. Lamp Chimney. Original, No. 35,598.
 7077. Caldwell, E. J. April 25, 1876. Gas Stove. Original, No. 49,469.
 7120. Blackburn & Woodside. May 16, 1876. Fare Register. Original, 100,715.
 7129. Meyer, R. May 23, 1876. Buckle-fastening. Original, No. 61,628.
 7136. Smith, L. B. May 23, 1876. Barbed Fence Wire. Original, No. 66,182.
 7149. Roulstone, E. A. G. May 30, 1876. Trunk Molding. Original, No. 59,458.
 7151. Lovatt, J. May 30, 1876. Skate. Original, No. 28,495.
 7174. Strobridge, T. June 13, 1876. Coffee Mill. Original, No. 159,467.
 7182. Knapp, A. H. June 20, 1876. Curtain Fixture. Original, No. 129,893.
 7203. Gardner, Wm. July 4, 1876. Chair Seat. Original, No. 127,045.
 7244. Martin, F. July 25, 1876. Packing for Oil Wells. Original, No. 49,903.
 7254. Hart, O. N. Aug. 8, 1876. Hot Air Furnace. Original, No. 92,822.
 7262. Hull, L. Aug. 15, 1876. Gauge Lathe. Original, No. 55,003.
 7286. White, J. Aug. 29, 1876. Globe Holder. Original, No. 162,731.
 7321. Ewing, M. P. Sept. 26, 1876. Lubricant. Original, No. 58,020.
 7356. Coté, L. Oct. 24, 1876. Machinery for forming Boot and Shoe Stiffeners. Original, No. 147,906.
 7362. Siedler, C. Oct. 24, 1876. Plug Tobacco Label. Original, No. 158,604.
 7367. Campbell, Wm. Oct. 31, 1876. Curtain Fixtures. Original, No. 69,176.
 7368. Crane, T. Oct. 31, 1876. Knitting Machine. Original, No. 73,697.
 7382. Shelton, C. R. Nov. 7, 1876. Whip Tips. Original, No. 74,435.
 7388. Barbarin, A. Nov. 7, 1876. Bale Tie. Original, No. 66,065.
 7417. Blackman, E. Dec. 5, 1876. Lamp Chimney. Original, No. 123,325.

1877.

7488. Heyl, H. R. Feb. 6, 1877. Paper Boxes. Original, No. 152,636.
 7494. Redmond, O. Feb. 6, 1877. Packing for Oil Wells. Original, No. 59,319.
 7497. Schröder, J. Feb. 6, 1877. Cultivator. Original, No. 69,255.
 7510. Sutherland, D. A. Feb. 13, 1877. Boot and Shoe Manufacture. Original, No. 176,094.
 7511. Votti, C. Feb. 13, 1877. Shade-holder for Lamp. Original, No. 182,973.
 7556. Roussel, Delangre & Robin. March 13, 1877. Decorating Tin Plates. Original, No. 43,463.
 7558. Sutherland, D. A. March 13, 1877. Presser-foot for Sewing Machine. Original, No. 177,296.
 7566. Glidden & Vaughan. March 20, 1877. Barbing Fence Wires. Original, No. 157,508.
 7571. Roach, F. March 27, 1877. Self-closing Faucet. Original, No. 81,948.
 7583. Strobridge, T. March 27, 1877. Coffee Mill. Original, No. 159,467.
 7609. Destouy, A. April 17, 1877. Metal Moldings. Original, No. 43,979.
 7628. Evarts, J. A. April 24, 1877. Lamp Fixtures. Original, No. 183,913.
 7643. Kelley, M. J. April 24, 1877. Atmosphere Cooler. Original, No. 44,731.
 7659. Crosby, R. R. May 8, 1877. Lamp Chimney. Original, No. 79,985.
 7682. Miller, H. May 15, 1877. Sheet Metal Can. Original, No. 38,974.
 7690. Cooke, C. L. May 22, 1877. Railway Switches. Original, No. 121,158.
 7704. Farnham, J. M. May 29, 1877. Bedstead Frame. Original, No. 97,375.
 7706. Fischer, L. May 29, 1877. Vapor Burner. Original, No. 88,287.
 7722. De Quillfeldt, C. June 5, 1877. Bottle Stopper. Original, No. 158,406.
 7729. Judson, C. June 12, 1877. Corset Spring. Original, No. 173,124.
 7738. Eichholtz, M. June 12, 1877. Cultivator. Original, No. 88,557.
 7751. Frey, J. A. June 19, 1877. Coal Oil Stove. Original, No. 156,149.
 7753. Lockwood, J. K. June 19, 1877. Circular Saw. Original, No. 70,728.

7772. Cross, J. R. July 3, 1877. Packing for Oil Wells. Original, No. 46,217.
 7779. Niedringhaus, F. G. & W. F. July 3, 1877. Enameled Iron Ware. Original, No. 177,953.
 7786. Mayall & Williams. July 3, 1877. Printing Press Sheet Deliverer. Original, No. 146,085.
 7808. Marks, M. July 24, 1877. Caps. Original, No. 166,395.
 7860. Barber, L. L. Aug. 29, 1877. Cutting Attachment for Sewing Machine. Original, No. 156,267.
 7886. Bailey, T. H. Sept. 18, 1877. Valves. Original, No. 41,471.
 7909. Hart, W. H., Jr. Oct. 9, 1877. Necktie. Original, No. 159,921.
 7913. O'Neil, A. Oct. 16, 1877. Sheet Copper Boiler. Original, No. 88,660.
 7920. New, T. Oct. 23, 1877. Water-proof Cellars. Original, No. 113,328.
 7923. Wilson, W. J. Oct. 23, 1877. Sheet Metal Can. Original, No. 161,848.
 7927. Tyler, Chandler & Standish. Oct. 23, 1877. Pocket Lighter. Original, No. 50,860.
 7928. Same.
 7947. Sargent, J. Nov. 13, 1877. Combined Time Lock. Original, No. 195,539.
 7972. Lallement, P. Nov. 27, 1877. Velocipede. Original, No. 59,915.
 7981. Dederick, P. K. Dec. 11, 1877. Hay and Cotton Press. Original, No. 132,566.
 7982. Same.
 7984. Same. Original, No. 132,639.
 7985. Bosworth, C. F. Dec. 11, 1877. Sewing Machine. Original, No. 38,807.
 7988. Shireman, J. H. Dec. 11, 1877. Horse Hay Rake. Original, No. 69,713.
 8013. Hornum, W. H. Dec. 25, 1877. Fare Register. Original, No. 165,832.
 8014. Same. Original, No. 171,133.

1878.

8025. Class, Wm. F. Jan. 8, 1878. Apparatus for Pumping Fluids from Casks. Original, No. 191,656.
 8026. Same.
 8060. Miller & Worley. Jan. 29, 1878. Finishing Plug Tobacco. Original, No. 185,119.
 8063. Beck, A. Jan. 29, 1878. Quilting Machine. Original, No. 190,184.
 8076. Lockwood, J. K. Feb. 5, 1878. Circular Saw. Original, No. 70,728.
 8091. Stevens, J. L. Feb. 19, 1878. Egg Transporting Case. Original, No. 62,378.
 8099. Brainard, E. D. Feb. 26, 1878. Washing Shavings. Original, No. 85,526.
 8106. Messer, L. Feb. 26, 1878. Pocket-book Clasp. Original, No. 165,110.
 8114. Warner, I. De Ver. March 5, 1878. Corset. Original, No. 189,405.
 8121. Fetter, D. F. March 12, 1878. Drive Screw. Original, No. 110,839.
 8123. Messer, L. March 12, 1878. Pocket-book Clasp. Original, No. 163,794.
 8127. Kells, P. H. March 19, 1878. Brick Machine. Original, No. 177,851.
 8130. Dederick, P. K. March 19, 1878. Hay and Cotton Press. Original, No. 132,566.
 8169. Wilson, W. April 9, 1878. Collars. Original, No. 179,807.
 8186. Osgood, E. April 16, 1878. Process for rendering Leather flexible. Original, No. 129,901.
 8195. Lever, J. S. April 23, 1878. Book-binding. Original, No. 200,068.
 8199. Waring, G., Jr. April 23, 1878. Pocket Check-book. Original, No. 183,347.
 8252. Reynolds, H. A. May 28, 1878. Velocipede. Original, No. 46,705.
 8286. Blessing, J. H. June 18, 1878. Steam Trap. Original, No. 142,323.
 8292. Dederick, P. K. June 18, 1878. Hay and Cotton Press. Original, No. 151,477.
 8296. Dederick, P. K. June 25, 1878. Hay and Cotton Press. Original, No. 177,216.
 8298. Holmes, G. H. June 25, 1878. Take-up for Looms. Original, No. 93,441.
 8312. Dederick, P. K. July 2, 1878. Hay and Cotton Press. Original, No. 132,639.
 8316. Same. Original, No. 132,566.
 8364. Daddow, E. A. Aug. 6, 1878. Squib for Blasting. Original, No. 143,396.
 8386. Guilden, A. R. Aug. 20, 1878. Middlings Purifier. Original, No. 155,374.
 8388. Day, A. Aug. 27, 1878. Railway Track-cleaner. Original, No. 125,547.
 8391. Carr & Akin. Sept. 3, 1878. Bprrs for Knitting Machines. Original, No. 43,636.
 8393. Gayton, Wm. C. Sept. 3, 1878. Window Cleaner. Original, No. 196,006.
 8438. Goodrich & Colburn. Oct. 1, 1878. Planing Machine. Original, No. 111,632.
 8443. Perkins, C. P. Oct. 8, 1878. Windmill. Original, No. 93,472.
 8460. Hammerschlag, S. Oct. 22, 1878. Waxing Paper. Original, No. 193,867.
 8466. Bostwick, J. A. Oct. 29, 1878. Soldering Iron. Original, No. 104,412.
 8475. Field, W. H. Nov. 5, 1878. Hay Rake. Original, No. 76,760.
 8483. Thompson, S. R. Nov. 12, 1878. Bushing for Faucet Holes. Original, No. 141,473.
 8490. Tyler, Chandler & Standish. Nov. 12, 1878. Pocket Lighter. Original, No. 50,860.

8491. Fowler & Morgan. Nov. 12, 1878. Packing for Oil Wells. Original, No. 51,167.
 8520. Locke, J. C. Dec. 10, 1878. Trunk Fastening. Original, No. 112,937.
 8521. Semple, E. Dec. 10, 1878. Trunk Fastening. Original, No. 74,723.

1879.

8536. White, H. Jan. 7, 1879. Shoe Tip. Original, No. 190,655.
 8550. Little, S. A. Jan. 21, 1879. Time Lock. Original, No. 146,832.
 8581. Curtis & Worden. Feb. 18, 1879. Whip Socket. Original, No. 70,075.
 8589. Davis, C. F. Feb. 18, 1879. Grain Drill. Original, No. 74,515.
 8590. Day, C. T. Feb. 18, 1879. Skate. Original, No. 116,935.
 8594. Grebner, M. Feb. 25, 1879. Wire Cage. Original, No. 139,784.
 8597. Hayes, G. Feb. 25, 1879. Ventilator. Original, No. 94,203.
 8598. Irwin, J. H. Feb. 25, 1879. Lantern. Original, No. 89,770.
 8611. Irwin, J. H. March 4, 1879. Lantern. Original, No. 73,012.
 8615. Fisher, Wm. B. March 11, 1879. Seed Steaming Apparatus. Original, No. 129,018.
 8672. Schaefer, C. A. April 15, 1879. Sash Supporter. Original, No. 64,910.
 8674. Hayes, G. April 15, 1879. Sky-light. Original, No. 100,143.
 8675. Same. Original, No. 106,157.
 8676. Same. Original, No. 143,149.
 8688. Hayes, G. April 22, 1879. Sky-light. Original, No. 112,594.
 8689. Same. Original, No. 143,153.
 8694. Miller, R. P. May 6, 1879. Dies. Original, No. 100,053.
 8718. Brush, C. F. May 20, 1879. Electric Lamp. Original, No. 203,411.
 8719. Tucker, W. C. May 20, 1879. Carriage Axles. Original, No. 68,808.
 8740. Seibert, N. June 3, 1879. Lubricator. Original, No. 94,780.
 8781. Barker, A. July 1, 1879. Soldering Iron. Original, No. 103,125.
 8783. Yale, L., Jr. July 1, 1879. Postoffice Box. Original, No. 119,212.
 8784. Wintergerst, C. July 1, 1879. Vapor Burner. Original, No. 82,262.
 8826. Wheeler, L. H. July 29, 1879. Windmill. Original, No. 68,674.
 8829. Saladee, C. W. July 29, 1879. Harness-buckle. Original, No. 47,574.
 8832. Sternbergh, W. Aug. 5, 1879. Cheese-hoop. Original, No. 112,977.
 8834. Matthews, J. Aug. 5, 1879. Soda Fountain. Original, No. 128,411.
 8837. Same. Original, No. 137,702.
 8840. Curran & Wilcox. Aug. 12, 1879. Lumber Drier. Original, No. 189,432.
 8846. Same. Original, No. 161,490.
 8854. Burt & Dunn. Aug. 19, 1879. Cutting Corn from the Cob. Original, No. 55,614.
 8866. Shepard, A. Aug. 19, 1879. Coffee and Spice Mill. Original, No. 206,141.
 8867. Kells, P. H. Aug. 19, 1879. Brick Machine. Original, No. 124,590.
 8883. Palmer, H. L. Sept. 2, 1879. Apparatus for lining Board Paper. Original, No. 83,359.
 8891. Gamewell, J. N. Sept. 9, 1879. Fire-alarm Telegraph. Original, No. 113,649.
 8894. Raecke, L. Sept. 16, 1879. Filter. Original, No. 111,001.
 8896. Crane, M. G. Sept. 16, 1879. Fire-alarm Telegraph. Original, No. 92,275.
 8914. Weir, F. C. Sept. 30, 1879. Railroad Frog. Original, No. 215,548.
 8962. Hetherington, J. E. Nov. 11, 1879. Artificial Honey-comb Foundation. Original, No. 208,595.
 8986. Davenport, F. S. Dec. 2, 1879. Gang Plow. Original, No. 58,612.
 9002. Miller, J. Dec. 23, 1879. Bottle Stopper. Original, No. 156,302.
 9011. Stultz, S. Dec. 30, 1879. Ore Washing Apparatus. Original, No. 188,691.

1880.

9028. Matthews, J. Jan. 6, 1880. Soda Water Fountain. Original, No. 50,255.
 9043. Blake, L. R. Jan. 13, 1880. Boots and Shoes. Original, No. 29,561.
 9046. Streit, C. Jan. 13, 1880. Rocking Chair. Original, No. 158,869.
 9094. Gardner, G. Feb. 24, 1880. Chair Seat. Original, No. 127,045.
 9097. Beck, A. Feb. 24, 1880. Quilting Machine. Original, No. 190,184.
 9108. Millner, J. C. March 2, 1880. Tobacco Curing Furnace. Original, No. 148,737.
 9123. McWilliams, J. March 23, 1880. Die Holder. Original, No. 93,215.
 9148. Garver, D. L. April 13, 1880. Harrows. Original, No. 95,458.
 9176. Rayer & Lincoln. April 27, 1880. Sewing Machine Attachment. Original, No. 108,827.
 9199. Coll, H. May 18, 1880. Siphon Pump. Original, No. 110,205.
 9204. Tapley & Porter. May 18, 1880. Automatic Leather Measurer. Original, No. 194,743.
 9247. Moore, G. R. June 8, 1880. Stove. Original, No. 54,938.
 9252. Fulton, C. June 15, 1880. Stove. Original, No. 89,304.
 9289. Mundy, Jos. S. July 13, 1880. Friction Drum. Original, No. 158,967.

9296. Rogers, J. S. July 13, 1880. Process of Extracting Gelatine from Salted Fish Skins. Original, No. 167,123.
 9297. Searls, A. July 13, 1880. Whip Socket. Original, No. 150,195.
 9301. Babcock, F. July 20, 1880. Window Sash Holder. Original, No. 82,580.
 9307. Wollensak, J. F. July 20, 1880. Transom Lifter. Original, No. 136,801.
 9368. Wood, J. H. Aug. 31, 1880. Coal Wagon. Original, No. 73,684.
 9393. Burr, S. S. Sept. 28, 1880. Folding Bedstead. Original, No. 222,379.
 9419. Starrett, L. S. Oct. 19, 1880. Try Square. Original, No. 215,024.
 9422. Miltimore, J. H. Oct. 19, 1880. Lantern. Original, No. 49,290.
 9493. Wheeler, Wm. H. Dec. 7, 1880. Windmill. Original, No. 156,195.

1881.

9572. Tillinghast, C. P. Feb. 15, 1881. Car Ventilator. Original, No. 110,803.
 9576. Hatch, Wm. B. Feb. 15, 1881. Spring Bed Bottom. Original, No. 179,190.
 9716. Cross, A. T. May 24, 1881. Stylographic Pen. Original, No. 191,798.
 9729. Saladee. May 31, 1881. Running Gear for Vehicles. Original, No. 148,497.
 9731. Nye, S. R. May 31, 1881. Horse Hay-rake. Original, No. 105,833.
 9732. Owens, J. A. May 31, 1881. Starch Manufacture. Original, No. 73,259.
 9743. Tirrell, J. P. June 7, 1881. Electric Apparatus for Lighting Street Lamps. Original, No. 130,770.
 9772. Simon. June 21, 1881. Traveling Bag. Original, No. 177,020.
 9811. Cherry, J. G. July 19, 1881. Cream Can. Original, No. 222,814.
 9881. Harris, J. Sept. 27, 1881. Car-axle Boxes. Original, No. 71,873.
 9883. Hyatt, T. Sept. 27, 1881. Illuminating Roofs. Original, No. 68,332.
 9901. Davis, F. Oct. 18, 1881. Door Bolt. Original, No. 202,158.
 9919. Field, E. S. Nov. 1, 1881. Bed Bottom. Original, No. 138,490.
 9920. Same. Original, No. 138,491.
 9942. Howe, W. B. Nov. 22, 1881. Packing Stick Candy in Packages. Original, No. 230,778.
 9957. Dunbar, G. W. Dec. 6, 1881. Preserving Shrimp. Original, No. 178,916.
 9959. Gould, D. R. Dec. 6, 1881. Grates. Original, No. 126,285.

1882.

10035. Stearns, J. B. Feb. 7, 1882. Duplex Telegraph. Original, No. 126,847.
 10062. Hotchkiss, A. E. March 14, 1882. Clock Movement. Original, No. 221,310.
 10067. Shorey, S. W. March 28, 1882. Sewing Machine Attachment. Original, No. 148,765.
 10087. Votti, C. April 11, 1882. Shade-holder for Lamp. Original, No. 182,973.
 10139. Odell, U. H. June 20, 1882. Roller Mill. Original, No. 250,954.
 10155. Runstetler, M. July 11, 1882. Corn Planter. Original, No. 231,104.
 10175. Pentlarge & Hirsch. Aug. 1, 1882. Vent Bung. Original, No. 192,386.
 10189. Peroni, L. Aug. 29, 1882. Thermometer. Original, No. 222,420.
 10239. Presbrey, E. F. Nov. 14, 1882. Ornamenting Bracelets. Original, No. 156,858.
 10264. Wollensak, J. F. Dec. 26, 1882. Transom Lifter. Original, No. 148,538.

1883.

10267. Nobel, A. Jan. 9, 1883. Explosive Compound. Original, No. 78,317.
 10272. Fraim, E. T. Jan. 16, 1883. Padlock. Original, No. 240,586.
 10275. Teter, W. L. Jan. 23, 1883. Process and Apparatus for Cleaning Grain. Original, No. 262,505.
 10363. Richardson, H. M. Aug. 7, 1883. Carriage. Original, No. 143,421.
 10368. Thompson, S. R. Aug. 14, 1883. Bushing for Faucet Holes. Original, No. 141,473.
 10452. Race & Matthews. Feb. 26, 1884. Hydrants. Original, No. 96,959.

TABLE 3.

A TABLE OF PARTICULAR PATENTS UPON WHICH SUIT HAS BEEN BROUGHT, ARRANGED TOPICALLY, ACCORDING TO SUBJECT-MATTER.

NOTE.—The number or date following the title is that of the patent, on reference to which, in Table 1, will be found thereunder the suits in which it was involved, as also the construction, etc., given it in such suits.

NOTE.—A topic marked thus † is that of a particular patent not found in Tables 1, 2 or 4, owing to the absence of sufficient data by which to identify it. It is followed by the suits in which it was involved; the construction of the patent in such suits; the reissues of such patent; the suits in which the reissue or reissues were involved, as also the construction given them in such suits.

Alizarine, Artificial. 95,465.
 Alkali. 15,957.
 Amalgamating Barrels. 43,462.
 Amalgamator. 40,874; 52,015.
 Animal Fats, Treating. 146,012.
 Annealing Box. 149,875.
 Anvil. 15,687.
 Apple-paring Machine. 10,078.
 Arches of Concrete. 98,571.
 Armor for Ships. 38,206.
 Auger. Pettibone. Feb. 12, 1814.
 Auger Handle. 35,856.
 Auger Machine. 56,869; 78,769.
 Axles for Carriages. 68,808; 200,214; 216,276; 233,932.
 Axles, Sand Box for Carriage. 62,232.
 Axles for Cultivators. 187,899.
 Axles, Self-lubricating. 148,368.
 Axle Bearing for Locomotive. 22,439.
 Axle Box Manufacture. 1252.
 Axle Box for Cars. 71,241; 71,873.
 Axle Box for Cars,† Lightner v. Brooks, 2 Cliff., 287; Same v. Kimball, 1 Lowell, 211; Same v. Boston & Albany R. R., 1 Lowell, 338.
 Axle Tree. Winans. July 20, 1831.
 Axle Turning Machine. 127,211.
 Baby Jumper. 79,534; 138,209.
 Baggage Check Holder. 268,591.
 Bail Ears for Pails. 147,343.
 Baling Press. 60,196; 234,549.
 Balance.† Vaughan v. East Tennessee, Va. & Ga. R. R., 1 Flip., 621.
 Bale Tie. 19,490; 23,291; 31,252; 59,144; 66,065.
 Ballasting Vessels. 126,938; 232,435.
 Bank Note Printing. Kneass. April 28, 1815.
 Barbed Wire Cable. 233,116.
 Barbed Wire Fence. 66,182; 67,117; 74,379; 84,062; 150,683; 153,965; 157,124.
 Barbed Wire Fence.† Barker Mfg. Co. v. Washburn & Moen Mfg. Co., 18 Fed. Rep., 172.
 Barbing Fence Wire. 157,508; 214,706; 253,781.
 Barrel Head Lining. 136,763.
 Base Ball Cover. 127,098.
 Bed Bottom. 33,685; 53,706; 125,421; 138,490; 138,491.
 Bed Bottom Spring. 93,096; 99,765; 125,250; 142,377; 179,190; 191,244; 241,916.
 Bed Plate for Steam-engine. 269,329.

TABLE 3.—TOPICAL LIST OF PATENTS.

Bedstead. Herbert. July 14, 1824. Nos. 797; 821; 58,437; 97,375; 204,321; 222,379; 230,105.
 Beer Cooler. 32,845.
 Beer Cooler.† Three patents. *Turrell v. Cammerer*, 3 Fish., 462.
 Beer Cooler and Drawer. 248,646.
 Beer Manufacture. 215,679.
 Bell. Parke. Dec. 19, 1808.
 Bell Ringer. 127,933.
 Bell Toy. 150,933.
 Bellows. 4912.
 Beverage. 193,038; 198,467.
 Bilge Lever for Ships. Thomas. Nov. 6, 1826.
 Billiard Register. 57,443.
 Billiard Table. 145,787.
 Billiard Table Cushion. 19,074; 60,656.
 Bird Cage. 162,400; 218,758.
 Bird Cage, Hanging.† *Perkins v. Hendryx*, 23 Fed. Rep., 418.
 Biscuit Pan. 96,605.
 Bit Stock. 73,279.
 Blind Slats. 199,948.
 Blowers, Cases for Rotary. 81,010.
 Blowers, Rotary. 104,585.
 Bobbins and Spindles. 102,583; 123,625; 127,159.
 Boiler. 107,817.
 Boiler. See, also, Paper Pulp Boiler.
 Boiler, Applying Waste Heat to. 1630.
 Boiler Covering. 95,517; 98,865; 100,354; 108,055.
 Boiler, Steam. 146,614.
 Boiler.† *Evans, C. Construed and limited. Cushing's Op.*, 7 Att'y Gen., 133.
 Boiler, Steam, Covering. 55,598; 114,711.
 Boiler, Steam, Safety Apparatus. 5254.
 Bolt. Reutgen. Nov. 17, 1776.
 Bolt Manufacture. 43,669.
 Bolt for Door. 48,555; 202,158.
 Bolting Flour. 37,317; 37,318; 37,319; 37,320; 37,321.
 Bonnet. 19,932; 33,978.
 Bonnet Machine. 15,570.
 Book Binding. 200,068; 239,927.
 Boot Burnisher. 28,181.
 Boot Seamer. Cahn. Subcombinations of combinations claimed in patentee's prior patents; held valid. *Cahn v. Wong Town On*, 19 Fed. Rep., 424.
 Boot Tree. 5876; 14,951; 19,508; 170,462.
 Boots and Shoes. Bedford. July 16, 1806. No. 59,375.
 Boots and Shoes, Manufacture. 29,561; 29,562; 141,357; 176,094.
 Boots and Shoes, Box Toes. 95,894.
 Boots and Shoes, Edges, Finishing Tool for. 150,305.
 Boots and Shoes, Heel Machine. 105,030.
 Boots and Shoes, Heel Polishing Machine. 39,546; 42,555.
 Boots and Shoes, Heel Stiffener. 127,090; 129,338.
 Boots and Shoes, Heel Stiffener Machine, 147,288; 147,906.
 Boots and Shoes, Nail. 164,889.
 Boots and Shoes, Nailing Machine. 155,962; 163,474; 184,281.
 Boots and Shoes, Paces. 122,030.
 Boots and Shoes, Stiffening Machine for Making. 117,627; 178,869; 209,826.
 Boots and Shoes, Soles Manufacture. 3857; 49,572; 127,964.
 Boots and Shoes, Tip. 26,329; 242,382.
 Boots and Shoes, Tip.† Held infringed by a valuable improvement embodying the patented machine. *Maynadier v. Tenney*, 2 Ban. & Ard., 615.
 Boring Machine. 13,606; 170,980.
 Bottle Stopper. 23,263; 36,266; 44,684; 48,300; 156,302; 158,406; 225,476.
 Box. 132,074.
 Box Loop. 95,004; 216,256.
 Box Manufacture. 40,507.
 Bracelet. 94,064.
 Bracelet, Ornamenting, etc. 156,858.

PATENTS.

- Brass-Kettle Machine. 8589; 12,227.
- Bread Finisher. Treadwell. Jan. 10, 1820.
- Bread Manufacture. Treadwell. May 18, 1826; Nevins. March 2, 1836.
- Brick, Fire-brick. 149,589; 150,854.
- Brick or Tile Manufacture, 97.
- Brick Machine. 2768; 17,999; 40,221; 124,590; 177,851.
- Bridge. 33,384; 50,723.
- Bridge.† Whipple v. Hutchinson, 4 Blatch., 190.
- Bristles Machine. 52,763; 54,033; 54,034; 59,286.
- Bristles, Preparing. 61,480.
- Bronze Alloy. 201,536.
- Bronzing Iron. 40,964.
- Bronzing Leather. 83,925.
- Broom. 59,733; 102,936; 106,021.
- Broom-making Machine. 18,770.
- Broom for Railroad Track. 180,717.
- Brush. 98,787; 160,933.
- Buckle. 26,013; 61,628; 209,701.
- Buckle.† Sargent Mfg. Co. v. Woodruff, 5 Biss., 444.
- Buckle Lever, Machine for making. 228,136; 231,199.
- Bung. 148,747; 192,386; 203,316.
- Bung Brush and Wrench. 118,617.
- Bung Cutter. 72,505.
- Bung, Rendering Wooden Bung impervious. 87,163.
- Burner for Gas. 17,530; 50,938; 104,271; 105,768.
- Burner for Vapor. 17,916; 20,324; 82,262; 88,287.
- Burner for Vapor.† Ward. Jeffries v. Wiester, 2 Sawyer, 135.
- Burning Fluid. 38,015.
- Burning Oil. 63,229.
- Bushing for Faucet Holes. 141,473.
- Bustles. 17,082; 54,323; 266,185.
- Bustles.† Hadlock, A. D. Hapgood v. Rosenstock, 23 Fed. Rep., 86.
- Button. 56,261.
- Button.† Wilde. Goddard v. White, 17 Fed. Rep., 845.
- Button-hole Attachment. 166,810.
- Button-hole Machine Feed Attachment. 197,528; 219,656.
- Button Machine. 228,233.
- Button. See Sewing Machine.
- Button Shanks. 110,070.
- Cake Pan. 140,619.
- Calendar. 95,655.
- Camera. 16,700.
- Camera, Plate Holder for. 12,700.
- Can. 43,371; 43,878; 94,947.
- Can for transporting Cream. 222,814.
- Can, Machine for making Tin Cans. 71,680.
- Can for Milk. 207,822; 222,814.
- Can for Paint. 24,748; 26,248; 109,070.
- Can of Sheet Metal. 38,974; 161,848.
- Candle Machine. 12,492.
- Candy Manufacture, 289,488.
- Candy, Packing Stick. 230,778.
- Cannon Manufacturer. See Ordnance.
- Canopy Top. 191,233.
- Caoutchouc. 1090; 10,339; 10,741.
- Caoutchouc Cutting Machine. 37,446.
- Caoutchouc.† Sustained, patentee having exercised reasonable diligence in applying therefor.
Ayling v. Hull, 2 Cliff., 494.
- Caps. 166,395.
- Capstan. 52,730; 63,917.
- Capsule Machine. 275,092; 305,867.
- Car for Coal. 5175.
- Car for Petroleum. 53,794.
- Car, Sleeper. 49,992.

TABLE 3.—TOPICAL LIST OF PATENTS.

Car, Sleeper.† Four patents. Woodruff v. Barney, 1 Bond, 528.
 Car, Street. 61,482; 93,322; 142,810; 167,585.
 Car for Railroad. Winans, Oct. 1, 1834. Cooper, Oct. 25, 1832. Knight, March 18, 1829. Nos. 389; 13,364.
 Car for Railroad.† Vaughan v. Central Pacific R. R., 4 Sawyer, 28.
 Car for Railroad.† Finch v. Rikeman, 2 Blatch., 301.
 Car for Railroad, Hand-car. 94,469.
 Car for Railroad, Doors for Grain Car. 203,226.
 Car Brake. 6762; 8552; 9109; 88,929; 117,841.
 Car Brake Shoe. 40,156; 45,106; 49,948.
 Car Brake Shoe.† Dunham v. Indiana & St. Louis R. R., 7 Biss., 223.
 Car Trucks.† Imlay, R. Gregerson v. Imlay, 4 Blatch., 503.
 Carburing Air Apparatus. 93,267; 93,268.
 Carding Engine. 6135.
 Carding Machine. 14,481; 18,124.
 Cards for Cotton and Wool. Whittemore. June 5, 1779.
 Cards for Wrapping Threads. 130,672.
 Carpet Lining. 52,835; 60,476.
 Carpet Lining Machine. 14,585.
 Carriage Axles. See Axles.
 Carriage for Children. 74,284; 100,121; 101,295; 143,421.
 Carriage Body and Seat. 95,466.
 Carriage Door. 53,075.
 Carriage Spring. 139,348.
 Carriage Step. 135,815.
 Carriage Thill Blank Manufacture. 66,130.
 Cartridge, 43,851.
 Cartridge Box. 139,846.
 Cartridge Case Machine. 27,094.
 Cash Carrier for Store Service. 309,197; 309,198; 309,199; 309,200; 309,201; 309,202; 309,505.
 Casters for Bedstead. 821.
 Caster for Salt. 39,889; 71,643.
 Caster for Syrup. 19,824.
 Celluloid Comb Manufacture. 223,311.
 Centrifugal Machine. 63,770.
 Chair. 127,045.
 Chair, Folding. 96,778; 221,062.
 Chair, Folding.† Stewart v. Mahoney, 5 Fed. Rep., 302.
 Chair, Rocking. 1531; 92,329; 158,869.
 Chair. See Seat.
 Chain, etc., for Necklace. 147,045.
 Chain-stretching Machine. 43,987.
 Check Book. 183,347.
 Cheese Former for Cider Press. 187,100.
 Cheese Hoop. 112,977; 122,520.
 Cheese Manufacture. 88,830.
 Cheese Press. 108,753.
 Chewing Gum. 111,798.
 Chlorine Gas, Hydrating. 186,860.
 Churns. 7531.
 Churns.† Thompson v. Canterbury, 2 McCrary, 332.
 Cigar. 186,628.
 Cigar Lighter. 206,835.
 Cigar Mold. See Mold.
 Clapboard Joint. 10,903.
 Clasp for Pocket-book. 47,135.
 Clock Dial. 23,950.
 Clock Escapement, Pallets of. 84,517.
 Clock Movement. 221,310.
 Cloth Cutting Machine. 106,101; 124,180.
 Clothes Tag. 149,896.
 Clothes Wringer. 21,029; 22,539; 61,680.
 Clover Huller. 20,249.
 Coach Pad. 173,371.

PATENTS.

Coal Breaker. 3292.
 Coal Car. See Car.
 Coal Scuttle. 62,807; 150,921.
 Coal Wagon. 73,684.
 Coating Compound. 86,841.
 Coffee, Treating. 111,403; 113,832.
 Coffee Mill. 159,467; 206,141.
 Coffin Lid. 38,713.
 Collar. 11,376; 38,961; 113,328; 132,547; 197,807.
 Collar. See Paper.
 Collar and Cuff. 23,771; 200,937.
 Columns. 35,582.
 Comb. 72,324; 223,311.
 Comb Case. 184,310.
 Comb-grates.† Held, in view of state of art, to involve mechanical skill only and not invention. *Weir v. N. Chicago Rolling Mill*, 9 Biss., 508.
 Comb-teeth. Tryon. Feb. 22, 1798.
 Compositor's Copy Distributor. 149,092.
 Conductor's Register. 76,646.
 Corn, Removing from Cob. 94,013; 55,614.
 Corn-cutter, Green. 159,741.
 Corn-sheller. 132,128; 38,002.
 Corn-planter. 40,789; 46,629; 225,318; 231,104.
 Corset. 42,591; 97,418; 137,893; 189,405; 197,913; 224,076.
 Corset and Bustle Manufacture. 22,532.
 Corset Clasp. 143,359.
 Corset Skirt Supporter. 39,910; 45,296.
 Corset Spring. 56,345; 173,124.
 Cotton Cleaner. 16,833; 29,971.
 Cotton Cleaning. 18,742; 52,008.
 Cotton and Wool Cleaning. 3120.
 Cotton Gin. 1839; 139,820; 167,679.
 Cotton Gin Rib. 777.
 Cotton Press. 3885.
 Cotton Press.† *Wicks v. Stevens*, 2 Woods, 310.
 Cotton and Hay Press. 132,566; 151,477; 177,216.
 Coupling for Barges. 111,564.
 Coupling for Horse-cars. 21,026.
 Coupling and Steering Apparatus. 129,844.
 Coupon and Bond Register. 63,419.
 Coupon Register.† *Munson v. Mayor, etc., of New York*, 19 Fed. Rep., 313.
 Covering for Boiler. See Boiler.
 Covering, Fastening Metallic. 17,331.
 Cream from Milk. 187,516.
 Creamery. 207,738.
 Crimping Machine. 37,033.
 Crusher. See Coal Breaker; Ore Crusher; Stone Crusher.
 Cuff. See Collar and Cuff.
 Cultivator. 4459; 10,467; 19,412; 22,859; 28,016; 31,133; 56,102; 69,255; 88,557; 91,144; 108,384; 124,218; 130,440; 174,684.
 Cultivator Axles. See Axles.
 Cultivator Coupling. 190,816.
 Cultivator Teeth. 16,364.
 Curing. See Preserving.
 Curtain Fixture. 69,176; 118,725; 129,893; 154,400; 183,809.
 Cut-off Gear. 6162; 8253.
 Cutlery. 2435.
 Cutting Pliers. 232,975.
 Dental Plate. 113,055.
 Dentistry. 238,940.
 Denture. 113,055; 277,933; 277,941; 277,943.
 Derrick. 103,834; 124,878.
 Desk. 86,440; 115,232.
 Desulphurizing Ores. 45,803.

TABLE 3.—TOPICAL LIST OF PATENTS.

Dies. 100,053; 101,529.
 Dies for Ox Shoes. 123,927.
 Dies for Rubber-coated Harness. 126,603.
 Dies for Swaging. 68,446.
 Dies Holder. 93,215.
 Dip Net. 245,251.
 Door Bolt. See Bolt.
 Door Fastening. 9765.
 Drawing Water from Wells. 15,273.
 Dredge-boat. 72,360.
 Dredging Machine Shovel. 218,427.
 Drier for Fruit. 190,368; 195,948.
 Drier for Hides. 184,352.
 Drier for Lumber. 79,661; 161,490; 189,432.
 Drier for Sand. 121,746.
 Drill for Railroad Track. 205,927.
 Drill for Rocks. 39,235; 52,960.
 Drill for Rocks.† American Diamond Rock Boring Co. v. Sutherland Falls Marble Co., 18 Blatch., 148.
 Drill for Wells. 49,129.
 Drill for Wells and Operating Engine.† Innis. Not void because of experimental public use and sale for more than two years prior to date of application. Innis v. Oil City Boiler Works, 22 Fed. Rep., 780.
 Drill Clamp. 186,225.
 Drilling Jars. 78,958.
 Driven Well. 73,425.
 Dummies for Clothing. 76,394.
 Dust Deflector. 13,676.
 Dye. 441; 225,108; 261,518.
 Dye Manufacture. 250,247.
 Dyeing Silk Woven Fabric. Stearns & Barrett. Sept. 9, 1818.
 Dyeing Yarn. 7446.
 Egg Beater. 23,694; 39,134; 254,540.
 Electric Annunciator for Elevator. 172,993; 148,447.
 Electric Bath. 38,389.
 Electric Battery.† Roosevelt. Roosevelt v. Western Electric Co., 20 Fed. Rep., 724.
 Electric Clock. 274,325.
 Electric Lamp. 203,411.
 Electric Lamp.† Weston. Brush v. Naugatuck R. Co., 32 O. G., 894.
 Electric Light. 317,676.
 Electric Light.† Consolidated Electric Light Co. v. Brush-Swan Electric Light Co., 20 Fed. Rep., 502.
 Electric Light, Illuminating Points. 196,425.
 Electric Light Pencil.† Consolidated Electric Light Co. v. Brush-Swan Electric Light Co., 20 Fed. Rep., 502.
 Electric Light, Treatment of Carbons.† Consolidated Electric Light Co. v. Brush-Swan Electric Light Co., 20 Fed. Rep., 502.
 Electric Light Regulator.† Ibid.
 Electric Light Lighter. 119,561; 130,770.
 Electric Railroad Signal. 140,536.
 Electric Safe Covering. 120,874.
 Electric Telephone. 174,465; 186,787.
 Electric Telephone Transmitter. 209,266; 225,388.
 Electric Telegraph. 1647; 4453; 4816; 6328; 6420; 42,842.
 Electric Telegraph, Duplex. 126,847.
 Electric Telegraph, Fire Alarm. 113,649.
 Electric Telegraph Printing. 76,993; 120,133.
 Electric Telegraph.† Morse v. O'Reilly, 6 Penn. L. J., 501.
 Electric Telegraph Wire. 65,019; 129,858.
 Electrical Machine. 93,563.
 Electrical Magneto-electric Machine. 120,057.
 Electrical Magneto-electric Machine.† Smith. Held not anticipated by foreign machines reaching the United States after the date of its invention. Claims 2 and 5 infringed. Western Dynamo Electric Machine v. Arnoux, 20 Fed. Rep., 112.

PATENTS.

Electro-deposition of Nickel. 93,157; 102,748; 113,612.
 Elevator. 25,061; 32,441; 60,442; 77,706.
 Elevator for Hay. 27,899; 44,129; 46,027; 53,345.
 Elevator for Hods. 95,262; 231,021.
 Elevator for Hods.† Construed, and limited in its scope to the arrangement described, and held not infringed by a device lacking an essential feature of the patented arrangement. *Dyer v. Nat. Hod Elevating Co.*, 24 Fed. Rep., 182.
 Elevator, Hydraulic. 132,111; 172,896; 181,113.
 Elevator for Grain. 34,992.
 Elevator Safety Device. 132,112.
 Enameling Moldings. 163,825.
 Engine, Regulating Steam for. 1868.
 Envelope Machine. 39,702; 41,395.
 Eraser. See India Rubber; Pencil.
 Ether. 4848.
 Excavator. 85,602.
 Excavator Scoop, 54,649.
 Exercise Apparatus. 77,933; 75,217; 75,218.
 Explosive. 47,458; 50,617; 78,317; 98,854.
 Fabric, Corded Elastic. 9653.
 Fare Box. 17,899; 121,920.
 Fare Register. 100,715; 165,832; 171,133; 231,207; 233,915; 265,145.
 Fat Bodies, Purifying. 11,766.
 Fats. See Animal; Rendering Lard.
 Faucet. 48,407; 81,948; 108,898.
 Feather Duster. 154,985; 177,939.
 Feed Water Feeder. 44,561; 93,244.
 Feed Water Heater. 81,132.
 Fertilizer. 206,077.
 Fire-alarm Signal. 92,275.
 Fire-alarm Telegraph. See Electric Telegraph.
 Fire-arms. Shaw, June 19, 1822. Colt, Feb. 25, 1836. Nos. 12,648; 12,649; 15,292; 16,797; 22,094; 28,951; 30,990; 37,052; 51,991; 119,846; 126,446; 205,193.
 Fire-arms.† *Smith v. Rifle Co.*, 3 Blatch., 545.
 Fire-engine. 1980.
 Fire Extinguishing. 88,844; 205,942; 218,564.
 Fire-place. 14,447.
 Fire-place Heater. 104,376.
 File-cutting Machine. 29,236.
 File Holder. 76,834.
 Filling Wood. 172,534.
 Filter. 111,001.
 Flanging Machine. 227,061.
 Flasks for Casting Iron Pipes. 37,037.
 Floor of Mosaic. 87,853.
 Flour Manufacture. 162,157.
 Flour Manufacture. See Bolting.
 Fluid Level. 7263.
 Fluting Machine. 53,633; 55,469; 56,365; 59,913; 62,492; 83,924.
 Fly-trap. 109,444; 131,098.
 Folding Guides.† *Wooster v. Marks*, 17 Blatch., 368.
 Foundation Strips.† *Ladd v. Cameron*, 25 Fed. Rep., 37.
 Friction Drum. 158,967.
 Friction Wheel for Gearing. 100,839.
 Fruit Drier. See Drier.
 Fruit Jars. 97,920; 102,913; 131,695.
 Furnace. 41,788; 71,244; 89,620; 92,822; 104,323.
 Furnace for Bagasse. 18,874.
 Furnace for Ore. 1396; 117,430.
 Furnace for Puddling. 135,650; 153,110.
 Furnace for Tobacco Curing. 148,737.
 Furnace for Tobacco Curing.† Construed to be for a combination, and not infringed by sale of some only of the elements. *Millner v. Schofield*, 4 Hughes, 258.
 Furnace for Wet Fuel. 20,616; 12,678.

TABLE 3.—TOPICAL LIST OF PATENTS.

Furnace Damper. 77,512.
 Furniture Spring. 122,001.
 Gauge for Forming Artificial Flower Foundations. 276,430.
 Gas Burner. See Burner.
 Gas Tank for Vessels. 283,962.
 Gate. 40,777.
 Gelatine from Fish Skins. 167,123.
 Gin. See Cotton.
 Glass Manufacture. 9789.
 Glass-cutting Tool. 91,150.
 Glass Ornamenting. 121,119.
 Glass Plate, Machine for Labeling. 184,933.
 Glass Shade Manufacture. 191,224.
 Glass-ware. 132,208.
 Globe Holder. 162,731.
 Glove Fastening. 155,077.
 Glue. 44,528.
 Grain Binders.† Seven patents. *Deering v. Winona Harvester Works*, 24 Fed. Rep., 90.
 Grain Cleaning. 262,505.
 Grain Drill. 66,578; 74,515; 85,472; 90,268; 93,369; 176,719.
 Grain Machinery.† *Murray v. Ager*, 20 O. G., 1311.
 Grain Separator. 9432; 19,637; 25,848; 41,232; 167,570.
 Grain Thresher and Cleaner. 542.
 Grates. 126,285.
 Grate-bars.† Seven reissue claims void for variance from original. *Gould v. Spicer*, 15 Fed. Rep., 344.
 Grist-mill. *Tyler*. Feb. 2, 1800.
 Gums, Artificial. 43,009.
 Gun Lock. 461.
 Hair Net. 124,340.
 Halter Ring. 32,180.
 Hammock. 217,964.
 Hammock.† *Palmer v. Travers*, 20 Fed. Rep., 501.
 Hand-stamp. 18,249; 37,175.
 Harness. 171,190.
 Harness Buckle. 47,574.
 Harness Mounting. 167,040.
 Harness Trimming, Covering. 99,032.
 Harrow. 95,458; 153,225.
 Harvester. *McCormick*. June 21, 1834. Nos. 2488, 3895; 5227; 5335; 6245; 8192; 8212; 8720; 8724; 9005; 9737; 10,038; 10,459; 10,967; 12,044; 12,367; 13,523; 15,044; 17,990; 18,975; 19,377; 20,719; 26,114; 30,651; 35,315; 37,630; 40,481; 51,364; 74,342; 75,383; 176,402; 233,035; 298,249.
 Harvester.† *Morse v. Davis*, 5 Blatch., 40.
 Harvester.† Held not anticipated by mere suggestion, and infringed by equivalent. *Graham v. Gammon*, 7 Biss., 490.
 Hat. 1503; 34,043; 74,392; 185,716; 219,462.
 Hat, Fabric for. 46,568.
 Hat Machinery. 14,845.
 Hat Bodies. *Grant*. Aug. 11, 1821.
 Hat Bodies, Machine for Making. 4472; 11,805.
 Hat Bodies, Manufacture. 9484; 9700.
 Hat Bodies, Pouncing Machine. 57,232.
 Hat Bodies, Stretching Machine. 46,553.
 Hat Brims, Curling. 30,379.
 Hat Lining, Sewing Machine for. 53,927.
 Hay Press. See Cotton and Hay.
 Heat, Generating and Applying. 2558.
 Heel-stiffener. See Boot and Shoe.
 Hernial Truss.† Construed, and limited, as claimed, to a combination, and held not infringed. *Becker v. Hastings*, 22 Fed. Rep., 827.
 Hide, Treating. 200,078; 210,797.
 Hide of Leather, Automatically Measuring. 194,662; 194,743.
 Hide, Raw Hide, Stretching. 213,323.

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Hide, Raw Hide, Treating. 149,954; 172,346.
 Hoe. 189,220.
 Hoisting Machine. 78,829.
 Hominy Machine. 24,104.
 Honey, Artificial. 17,264.
 Honey-comb Foundation, Artificial. 208,595.
 Honey Frame. 243,674.
 Hook, Self-mousing. 21,879.
 Hoop Skirt. 17,602; 20,681; 25,701.
 Hoop Skirt Spring. 74,672.
 Hopper-boy. Evans. Dec. 18, 1790.
 Horn Composition. 98,727.
 Horse Collar. 157,367.
 Horse Collar Pad. 89,646.
 Horse Power. 4595; 15,693.
 Horse Shoe. 170,809.
 Horse Shoe Machine. 17,665.
 Hose Coupling. 23,033; 34,476; 64,437; 68,656.
 Hose Pipe.† Reissue. Craig v. Fisher, 2 Sawyer, 345.
 Hotel Register. 63,889; 63,924.
 Hub. 61,900.
 Huller for Clover. 35,209.
 Hydrant. 38,694; 75,344.
 Hydrant Casing. 19,206; 96,959.
 Hydraulic Mining Apparatus. 110,222.
 Hydraulic Power Accumulator. 202,660.
 Hydrocarbon Oils. 90,284.
 Ice-Cutting Apparatus. Wyeth. March 18, 1829.
 Ice Pitcher. 18,546; 21,717.
 Illuminating Roofs. 63,332.
 India Rubber. 16; 3633; 8075.
 India Rubber.† Robinson, *Ex parte*, 2 Biss., 309.
 India Rubber Manufacture. 11,608.
 India Rubber, Coating Articles with. 215,034.
 India Rubber Coated Harness. 137,873.
 India Rubber, Dental. 58,901.
 India Rubber Eraser. 19,783; 66,938; 167,455; 233,511.
 India Rubber Boots. 178,896; 196,778.
 India Rubber Overshoes. 103,594; 111,962.
 India Rubber Overshoes.† Infringed. Cohn v. National Rubber Co., 15 O. G., 829.
 India Rubber Flocking Machine. 33,808.
 India Rubber, Shirred Fabric. 3461.
 Induction Coil and Circuit Breaker. 76,654.
 Injector for Boiler. 57,057; 86,152; 92,718.
 Ink. 7686; 41,887.
 Ink, Printer's. 43,192.
 Insect Protector. 233,574.
 Iron Manufacture. 25,235; 143,600.
 Iron, Manufacture of Wrought. 11,838.
 Iron Ware, Enameled. 177,953.
 Isinglass Manufacture. 134,690.
 Ivory, Artificial. 77,938; 89,531; 90,443.
 Jail. 24,307; 26,500; 27,222; 29,282.
 Jail Door Fastening. 26,108.
 Jelly Glass. 39,027.
 Kiln or Dry House.† Curran v. Craig, 22 Fed. Rep., 101.
 Kiln for Lime. 9736; 18,635.
 Knife for Removing Corn. 51,379.
 Knitting Needles. 6025.
 Knitting Machine. 9435; 9718; 9719; 13,586; 68,595; 73,697; 80,121; 92,146; 99,425; 99,426;
 102,529; 105,187; 123,687; 140,635; 162,886.
 Knitting Machine, Burrs for. 43,636.
 Knitting Needle Manufacture. 38,987.
 Knobs for Doors. 2197.

TABLE 3.—TOPICAL LIST OF PATENTS.

Lace Purling. 218,032.
 Lacing Hook. 259,597.
 Lacing Hook.† Construed to be for a combination; doubted that claims 1 and 7 are infringed by omission of an element. *Smith v. Halkyard*, 19 Fed. Rep., 602.
 Lacing Hook Stock. 232,561.
 Lacing Hook Stock.† Construed. *Smith v. Halkyard*, 19 Fed. Rep., 602.
 Lacteal Instrument. 22,018.
 Lamp. 12,550; 20,159; 21,576; 22,723; 28,762; 29,221; 30,381; 49,984; 50,591; 57,245; 65,230; 73,012; 86,549; 89,770; 99,443; 184,855; 206,061.
 Lamp for Locomotive. 35,122.
 Lamp Cap. 11,928.
 Lamp Chimney. 35,589; 79,985; 123,325.
 Lamp Fixture. 183,913.
 Lamp Shade Holder. 182,973.
 Lampblack. 3824.
 Lantern. 8154; 13,286; 42,520; 47,551; 49,290; 63,480; 104,318; 151,703.
 Lantern.† *Adams v. Meyrose*, 2 McCrary, 360.
 Latch. 39,280.
 Lathe. Blanchard, Sept. 6, 1819. Blanchard, Jan. 20, 1820. Nos. 4120; 16,936; 23,957; 29,534; 53,003; 81,432; 127,211.
 Lathe Chuck. 19,786.
 Lawn Sprinkler. 148,596; 203,069.
 Lead Pipe Machine. 5253; 2021.
 Lead Pipe. 74,613.
 Leather. Woodcock. May 8, 1809. No. 93,910.
 Leather, Crimping and Folding. 143,783.
 Leather Cutting Press. 101,931.
 Leather Ornamenting. 42,136.
 Leather, Rendering Flexible, 129,901.
 Leather, Splitting. 29,649; 191,400.
 Leather of old Card Clothing, Utilizing. 177,466.
 Lemon Squeezer. 217,519.
 Letter Block. 59,603.
 Letter and Figure. 256,061.
 Letter File. 9776.
 Letter Stamp. 38,175.
 Lever, Compound. Guyon. July 2, 1836.
 Lifting Jack. 154,989.
 Lightning Rod Machine. 25,534.
 Lightning Rod. 112,137.
 Liquid Fuel. 102,662.
 Locks. 30,140; 32,331; 57,574; 72,946.
 Locks.† *Greenleaf v. Yale Lock Mfg. Co.*, 17 Blatch., 253.
 Locks for Door. 2886; 32,521.
 Locks for Door, Keeper. 16,676.
 Locks for Satchel. 208,541.
 Locks, Time Lock. 146,832; 173,366; 186,369; 195,539; 262,094.
 Locks and Handle for Traveling Bag, Combined. 195,233.
 Locomotive Axle. See Axle.
 Loom. Stone, April 30, 1829. Arnold, July 15, 1829. Nos. 491; 3987; 6806; 6939; 63,353; 130,961.
 Loom Harness, Machine for Making. 80,774.
 Loom, Picker Staff Motion. 30,441.
 Loom Shedding, Mechanism for. 51,928.
 Loom, Shuttle Box, Mechanism for. 70,309.
 Loom, Take-up Mechanism for. 88,365; 93,441.
 Lubricant. 58,020; 79,279; 94,780; 111,881; 133,217; 138,243; 187,964; 191,171; 219,455; 233,497; 283,931.
 Lubricating Oil, Determining Grade of. 174,506.
 Mail Tags, Machine for Printing Wooden.† *Fayman*. Not infringed by use of a different machine and process. *Williams' Opinion*, 14 Att'y Gen., 209.
 Marking Wheel. 52,169.
 Martingale Ring. 37,941.
 Mat. 19,347.

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Matches. 68.
 Match Box. 63,104.
 Mattress Fabric, Woven Wire. 109,446.
 Mattress, Spring Mattress. 44,960.
 Mattress, Treating Moss for. 16,961.
 Meal, Cooling and Drying. 19,984.
 Mechanical Movement. 70,063.
 Medical Compound.† Construed and infringed by a variation in the proportions, but not in the principle. New York Pharmica! Asso. v. Tilden, 14 Fed. Rep., 740.
 Melodeon. 16,094.
 Metal, Cooling and Drying.† Herring v. Gas Consumers' Asso., 3 McCrary, 206.
 Metal, Coating with Metal. 57,271.
 Metal, Punching and Stamping. 131,004.
 Metallic Covering for Buildings. 177,986.
 Metallic Seams, Tool for Making.† Campbell v. Barclay, 5 Biss., 179.
 Metallic Shingles, Attaching.† American Iron Co. v. Anglo-American Roofing Co., 24 O. G., 1274.
 Middlings Purifier. 6148; 155,374.
 Mill for Grinding Bark. 1714.
 Mill Gearing. 79,528.
 Mill, Roller Mill. 250,954.
 Millstone, Balancing. 22,356.
 Millstone, Dressing. 38,670; 73,524.
 Millstone, Grinding. Smith. Jan. 29, 1830. No. 397.
 Mirror. 92,942; 182,633; 246,270.
 Miter Machine. 12,956.
 Mop Head. 22,990; 54,938; 67,643.
 Mortising Machine. 10,422.
 Mould for Bottles. 22,129.
 Mould for Buttons of Metal. Robbins. May 14, 1812.
 Mould for Cigar. 155,806.
 Mould for Glass Goblets. 68,633.
 Mould for Ingots. 99,299; 166,700.
 Mould for Rubber Pencil Head. 31,187.
 Mould for Shade-holder. 191,102; 191,103.
 Mould, Blackwashing. 142,661.
 Moulding and Casting. 53,883.
 Moulding Crucible Pots. 49,140.
 Moulding of Metal. 43,979.
 Moulding Machine. 10,204.
 Moulding Manufacture. 5575.
 Moulding, Machine for Enameling. 226,845.
 Mower. 9737; 18,975; 20,719; 51,364.
 Mower.† Bramer. Crandell v. Plano Mfg. Co., 32 O. G., 1123.
 Mower. See, also, Harvester.
 Nail. Perkins, Feb. 14, 1799. Reed, Feb. 22, 1807. Sawin & Skinner, Feb. 8, 1811. Nos. 78,644; 90,902; 92,355; 164,889.
 Nailing Machine. 38,924; 155,962; 163,474; 184,281.
 Necktie. 159,921.
 Necktie Shield. 207,673.
 Needles, Grinding. 172,639.
 Needles. See, also, Knitting.
 Nitro-glycerine. 50,617.
 Nuts. 8427.
 Nut Machine. 21,551.
 Nut Manufacture. 13,118.
 Nut and Washer Machine. 8322.
 Oil. 38,015; 63,229; 90,284; 102,662; 174,506.
 Oil-stone Holder. 102,218.
 Oil Well. 45,647.
 Oil Well, Increasing Capacity of. 59,936.
 Oil Well. See Drill; Packing; Pump.
 Oleaginous Seed, Treating. 168,164.
 Omnibus Step. 8119.

TABLE 3.—TOPICAL LIST OF PATENTS.

Ordnance. 13,927; 32,983; 32,984; 32,985.
 Ore Crusher.† Reissue held invalid for covering more than original, on comparison made with original drawing only. *Hendy v. Golden State & Miners' Iron Works*, 17 Fed. Rep., 515.
 Ore Washer. 188,691; 194,059; 198,432.
 Ostrich Feather Trimming. 252,374.
 Oven. 15,753; 28,130; 252,054.
 Overshoe. 131,201; 166,669.
 Packing Case. 62,378.
 Packing Candy. 230,778.
 Packing (Baling) Hay. 68,282.
 Packing (Baling) Plastering Hair. 152,560.
 Packing Kindling Wood. 93,775.
 Packing, etc., Powders. 41,097.
 Packing Thread. Langdon. June 20, 1821.
 Packings, Elastic. 54,554.
 Packings for Oil Well. 46,217; 49,903; 51,167; 59,319.
 Packings for Pistons. 29,576.
 Packings, Steam Packing.† *Allen v. Deacon*, 21 Fed. Rep., 122.
 Packings for Steam-engine, Metallic. 6491.
 Packings, Steam Packing. 17,855.
 Packings, Stuffing Box. 13,145.
 Padlock. 1243; 35,030; 240,586.
 Pail-graining Machine. 45,590.
 Paint. 66,773.
 Paint for Ships' Bottoms. 40,515.
 Palm Leaf, Preparing. *Smith*, April 3, 1835. *Smith*, March 3, 1833.
 Pan. See Biscuit; Cake; Sauce.
 Pantaloons. 139,121; 178,287; 178,428.
 Paper Bag. 48,036; 123,811; 134,244.
 Paper Bag Machine. 17,184; 24,734; 30,191; 37,726; 38,452; 49,951; 62,342.
 Paper Board Cutting Machine. 142,154.
 Paper Board Lining Machine. 87,359.
 Paper Board Manufacture. 210,714.
 Paper Box. 124,319; 132,368; 152,636.
 Paper and Cloth, Uniting. 134,105.
 Paper Collar. 38,664; 45,998; 47,107.
 Paper Collar.† Nine patents. *Merserole v. Union Paper Collar Co.*, 6 Blatch., 356.
 Paper Cuffs. 56,737.
 Paper Folding. 21,172.
 Paper Holder. 217,909.
 Paper Manufacture. 158,249.
 Paper Perforator. 32,370.
 Paper Pulp. 17,387.
 Paper Pulp Manufacture. 11,343; 21,161.
 Paper Pulp Boiler. 25,418; 38,901.
 Paper, Sizing Paper. 127,858.
 Paper for Twine, Machine for Cutting. 44,249.
 Paper, Waxing. 193,867; 209,393.
 Pasteboard Manufacture. 184,896.
 Paste. 52,779.
 Pavement. 11,491; 72,110; 74,862; 85,814; 88,765; 94,062; 94,063; 101,590; 105,599; 121,544; 134,404.
 Peat Machine. 53,011.
 Peg-cutting Machine. 2725.
 Pen. 8641; 73,255.
 Pen, Stylographic. 191,798; 199,621; 227,416.
 Pencil. 36,854.
 Pencil Case. 11,820.
 Pencil and Eraser. 19,783; 66,938.
 Pendulum Levels. 17,023.
 Peptone-pepsin.† *Jensen*. Held patentable, and not anticipated by prior publications giving mere suggestions and scientific speculations. *Jensen v. Keasbey*, 24 Fed. Rep., 144.
 Percolator. 256,504.
 Petroleum, Distilling Apparatus. 68,426.

PATENTS.

- Petroleum Car. See Car.
- Photography. 179,316.
- Photograph Printing Process.† Lilienthal v. Washburn, 8 Fed. Rep., 707.
- Photographic Shield. 21,829.
- Piano-key Manufacture. 210,780.
- Pianoforte Pedals. 169,931.
- Picks. 146,597.
- Pier for Bridges. 36,512.
- Pill Manufacture. 110,630.
- Pin. 2275; 2970.
- Pin for Braid. 220,126.
- Pin for Neck Wear. 220,610.
- Pipe Reamer and Squeezer. 91,201.
- Pipe Tongs. 22,157.
- Piston. 53,630.
- Pitching Barrels. 42,580.
- Plaiting Machine. 192,098.
- Plane. Isaacs. Nov. 17, 1819.
- Plane, Bench Plane. 67,398.
- Planing Machine. 32,904; 111,632; 138,463.
- Planing Mill. Woodworth. Dec. 27, 1828.
- Plaque.† Deplanque. Patentability doubted; held not infringed, Deplanque v. Ripka, 32 O. G., 1012.
- Plastic Compound for Vegetable Fibre. 65,267.
- Plates of Tin, Decorating. 43,463.
- Plow. Ogle, 1818. Wood & Brundage, Nov. 9, 1820. Davis, Oct. 1, 1825. Prouty & Mears, March 4, 1836. Nos. 14,287; 25,098; 25,843; 30,357; 55,630; 61,796; 71,560; 110,722; 158,482; 176,642.
- Plow.† Hall v. Speer, 6 Pitts. L. J., 403.
- Plow.† Reissue construed to be for a combination and held not infringed. Matteson v. Caine, 17 Fed. Rep., 525.
- Plow, Gang. 58,612; 83,283; 88,413.
- Plow Jointer. 147,629.
- Plow, Sulky. 201,670.
- Pocket-book Clasp. 165,110; 163,794.
- Pocket Lighter. 50,860.
- Postoffice Box. 119,212.
- Postage Stamp. 91,108.
- Preserving Animal Substances. 36,107.
- Preserving Animal and Vegetable Substances. 121,569.
- Preserving Corn. 34,928; 35,274; 35,346; 36,336.
- Preserving Fish. 31,736; 90,334.
- Preserving Fish (Curing).† Boneless Fish Co. v. Roberts, 12 Fed. Rep., 627.
- Preserving Fruit. 31,734.
- Preserving Meat. 12,530; 43,516; 78,932; 149,276; 197,314.
- Preserving Shrimp. 178,916.
- Press. See Baling; Cheese; Cotton; Printing.
- Pressing Machine for Tailors. 20,519.
- Pressure Gauge. 145,726.
- Printer's Galley. 60,151.
- Printing, Bank Note. See Bank Note.
- Printing Press. 9721; 16,263; 22,611; 38,200; 70,773; 73,943; 87,950; 98,087; 131,217; 238,720.
- Printing Press Sheet Deliverer. 146,085.
- Printing Press Feed. 229,998.
- Privy Cleaning Apparatus. 73,938; 115,565.
- Processing Apparatus. 251,456.
- Projectile. 26,904; 32,986; 34,059.
- Propeller. 9810; 10,124.
- Puddle Balls, Rolling. 1890.
- Pulley. 67,470.
- Pulvulent Acid. 14,722.
- Pump. Perkins, March 23, 1813. Reed, Aug. 5, 1831. Reed, Nov. 19, 1833. Nos. 42,126; 78,854; 90,143; 90,930; 110,205; 155,670; 188,879; 191,656.

TABLE 3.—TOPICAL LIST OF PATENTS.

Pump.† Reissue claim sustained, being a substantial repetition of the original claim. National
 Pump Cylinder Co. v. Gunnison, 17 Fed. Rep., 812.
 Pump.† Adair v. Thayer, 7 Fed. Rep., 920.
 Pump, Bucket for Chain. 116,138.
 Pump Filter. 51,145.
 Pump for Fire-engine. 42,920.
 Pump for Gas. 117,925.
 Pump for Oil Well. 47,133; 50,919.
 Pump, Steam Pump. 5352.
 Pump Valve. 141,587.
 Purifying Coal Oil. 45,502.
 Pyroxeline. 105,338.
 Pyroxeline Dental Plate. 113,055.
 Quilting Machine. 118,404; 190,184.
 Rake. 7813; 14,350; 21,712; 65,573; 69,713; 76,760; 105,833.
 Rake and Reel for Harvester. 46,300.
 Rails for Railroads. Stimpson. Aug. 23, 1831. Nos. 3889; 9703.
 Railroad Curves. Stimpson. Sept. 26, 1835.
 Railroad Draw. 13,258.
 Railroad Frog. 215,548.
 Railroad Switches. 121,158.
 Railroad Track Cleaner. 125,547; 190,563.
 Railway, Elevated. 89,233.
 Reed Organ. 87,241.
 Reel for Dyeing. Barrett. June 27, 1809.
 Reel for Harvester. See Rake and Reel.
 Reflector. 27,898.
 Reflecting Pictures for Slides.† Richardson v. Croft, 11 Fed. Rep., 800.
 Refrigerator. 13,802; 44,731.
 Register. See Billiard; Conductor; Coupon; Fare; Hotel.
 Registering Steam Gauge. 101,583.
 Rendering Lard, Apparatus for. 81,743.
 Retort for Gas. 36,065.
 Revenue Stamp. 93,391.
 Rice Cleaning.† Ager, W. Black's Opinion, 9 Att'y Gen., 403.
 Ring Supporter. 118,622.
 Rollers, Casting Chilled. Harley. March 3, 1835.
 Rollers, Elastic; Manufacture of. 101,994.
 Rollers, Spring. 11,638.
 Rollers for Trunks. 108,300.
 Rolling Coulters. 67,222; 76,343.
 Rolling Mill. 130,529.
 Roof for Burial Vault, 244,224.
 Roofing Composition, 46,495; 76,773.
 Roofing Fabric.† Ready Roofing Co. v. Taylor, 15 Blatch., 94.
 Roofing, Preparing Paper for. 91,133; 95,689.
 Rope Clamp. 208,157.
 Ruffles. 28,244; 42,403.
 Ruffler. 37,550.
 Ruffle Machine. 46,424.
 Running Gear for Vehicles. 148,497; 180,886.
 Saddle. Dixon. July 16, 1819. Nos. 4860; 5476.
 Saddle for Harness. 170,910.
 Saddle Pad for Harness. 86,112.
 Saddle Tree. 144,164; 151,730; 166,907; 195,415.
 Saddle Tree for Harness. 180,676.
 Saddle Tree, Side-Saddle. 97,236.
 Safe. Scott. Nov. 12, 1830. Nos. 3117; 273,585; 281,640; 283,136.
 Safe Door. 67,046.
 Sand Blast. 108,408.
 Sand Box for Axles. See Axles.
 Sand Paper Holder. 100,229.
 Sand Paper for Finishing Shoes. 178,994.
 Sand and Gravel Separator. 126,968.

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Sand Washer. 206,514.
 Saucepan. 225,492.
 Saw. 9807; 37,835.
 Saw.† American Saw Co. v. Emerson, 8 Fed. Rep., 806.
 Saw, Circular. Eastman & Jaquith. March 6, 1820. No. 70,728.
 Saw Dog. 134,653; 233,409.
 Saw Guide. 35,390; 78,880.
 Saw Mill. Crosby. March 27, 1835. No. 51,310.
 Saw Mill, Circular. 2174; 7027.
 Saw Mill Dog. 122,215.
 Saw Set. Aiken. May 24, 1830.
 Saw, Setting Teeth in. 32,270.
 Saw Dust, Machine for Burning.† Smith v. Sands, 32 O. G., 1467.
 Scarfs. 222,264.
 Scoops. 84,803.
 Screw. 110,839; 116,922.
 Screw Machine. 79; 1411; 9688; 37,433.
 Screw Peg for Boots and Shoes. 85,374.
 Scythe Snathes. 114.
 Seats. 12,017; 125,329; 134,486; 163,537.
 Seed Drill. 5522; 30,685; 31,819.
 Seed Planter. 9893; 12,231; 26,410; 46,615.
 Seed Steaming Apparatus. 129,018.
 Seeder. 18,083; 216,025; 88,971.
 Separator. See Grain: Sand.
 Sewing Machine. 4750; 6099; 6439; 7776; 7931; 8282; 8294; 8876; 10,597; 10,965; 10,974; 10,975; 11,971; 12,015; 12,116; 13,499; 16,030; 20,775; 21,659; 28,139; 29,785; 30,112; 36,163; 38,807; 42,292; 45,412; 53,927; 77,715; 83,909; 83,910; 101,140; 120,949; 214,513.
 Sewing Machine.† Singer Sewing Machine Co. v. Union Button-hole, etc., Co., 1 Holmes, 253.
 Sewing Machine.† Macaulay v. White Sewing Machine Co., 21 O. G., 496; Same v. Same, 9 Fed. Rep., 698.
 Sewing Machine.† Hicks, W. C. Webber v. Virginia, 103 U. S., 344.
 Sewing Machine Attachment. 108,827; 148,765.
 Sewing Machine Bobbin. 123,625.
 Sewing Machine, Button-hole Attachment. 192,008.
 Sewing Machine for Button-hole. 236,350.
 Sewing Machine, Cloth Marker. 28,633; 40,084.
 Sewing Machine, Cutting Attachment. 156,267.
 Sewing Machine, Feed Mechanism.† Wickersham. Held abandoned by two years' prior public use with inventor's consent. Wickersham v. Singer, 1 MacA. Pat. Cases, 645.
 Sewing Machine, Presser Foot. 177,296.
 Sewing Machine, Tuck Marker. 46,871.
 Sewing Machine, Tuck Creaser. 64,404; 80,269.
 Sewing Silk. 19,283.
 Sewing Silk Manufacture. 42,153.
 Shawl Strap. 82,606.
 Shears. 1092.
 Shearing Sheep. 42,572.
 Sheet Metal Moulding Machine. 74,068.
 Sheet Metal Moulding, Tool for Attaching. 178,436.
 Sheet Metal, Pressing and Stamping. 114,068.
 Sheet Metal Vessel. 189,250.
 Shell, Explosive. 14,133.
 Shingle Machine. Earle. Dec. 28, 1822. Nos. 11,858; 216,344.
 Ships, Securing from Decay. Mellus. Aug. 3, 1822.
 Shoe. See Boot and Shoe.
 Shoe Buckle. 157,395.
 Shoe Buttoner. 68,361.
 Shoe for Car Brake. See Car Brake.
 Shoe and Gaiters. 205,129.
 Shoe Last. 36,495.
 Shoe Pegging Machine. 9947; 23,361; 36,292.
 Shoe Shank Machine. 159,577.
 Shoe Tip. 190,655.

TABLE 3.—TOPICAL LIST OF PATENTS.

Show Card.† Steiger v. Heidelberger, 18 Blatch., 426.
 Show Case Socket. 117,831.
 Shower Bath. 5993.
 Shutter Fastener. 166,819.
 Shutter Hinge. 10,477; 156,277.
 Sieve. 106,597; 130,514.
 Signaling Device for Street Cars. 161,586.
 Silver, Apparatus for Recovering. 35,842.
 Sirups and Mineral Water. 193,476.
 Skate. 28,495; 55,901; 66,316; 116,935; 248,272.
 Skirt. 24,720.
 Skirt Binding. 61,172.
 Skirt Machine. 34,026; 37,124.
 Skirt Protector. 155,534; 161,012.
 Sky-light. 100,143; 106,157; 112,594; 143,149; 143,153.
 Slate Frame. 14,624.
 Sleeve Supporter. 156,429; 202,735.
 Sluice Fork.† Teese & Teese. Teese v. Huntingdon, 23 How., 2.
 Sluice Gate. 1517.
 Smut Mill. 8861.
 Snap-hook. 47,764.
 Snap-hook.† Fitch v. Bragg & Co., 16 Fed. Rep., 243.
 Soap. 65,186; 118,440.
 Soap Manufacture. 47,385; 56,259.
 Soda Fountain. 50,255; 128,411; 137,702; 179,583.
 Soda Water Apparatus. 22,697; 40,811.
 Soda Water Apparatus.† Matthews v. Lalance & Grosjean Mfg. Co., 18 Blatch., 43.
 Soldering. 191,405.
 Soldering Iron. 103,125; 104,412; 115,760.
 Soldering Tool. 194,519.
 Soles. See Boot and Shoe.
 Spark Arrester. 120,638.
 Spectacle Case Catch. 26,891.
 Speeder for Cotton. Moody. April 3, 1819. No. 3089.
 Spike or Hook. Burden. Dec. 2, 1834.
 Spike Manufacture. 1757.
 Spindles. See Bobbins and Spindles.
 Spinning Frame. 89,025.
 Spinning Ring Holder, 108,270.
 Spirit Meter. Tice, I. P. Nusbaum v. Emery, 3 Biss., 469.
 Spittoon. 106,094; 119,705.
 Spool Winding Machine. 26,415.
 Spoon Manufacture. Gale. Dec. 7, 1826.
 Spoon and Fork. 34,252; 220,002; 220,003.
 Spring. 10,280; 152,864; 238,703. See, also, Bed Bottom; Carriage; Corset; Furniture; Hoop-skirt; Tempering.
 Spring Fixture for Shades. 44,624.
 Spring Harrow Teeth.† Carver. Claims of the second reissue construed to be broader than the original. Tuttle v. Loomis, 30 O. G., 344.
 Square, Graduating, Carpenter's. 93,449.
 Square, Try Square. 215,024; 229,283.
 Squib for Blasting. 134,128; 143,396.
 Starch Manufacture. 65,664; 73,259.
 Starch Manufacture, Apparatus for. 137,911.
 Starch Separator. 81,888.
 Starch Tray. 78,320.
 Stave Cutting Machine. 21,856; 33,370.
 Steam Boiler. See Boiler.
 Steamboat. Fulton. Feb. 11, 1809.
 Steamboat.† Two patents. Livingston v. Van Ingen, 1 Paine, 45.
 Steamboat Staging. 31,147.
 Steam-engine. Emerson. March 8, 1834. Nos. 2872; 4199; 21,059; 26,901.
 Steam Gauge. 18,526.
 Steam Gauge Cock. 13,563.

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Steam Generator. 12,682.
 Steam Heater. 64,347.
 Steam Tow-boat. Sullivan. Dec. 4, 1816.
 Steam Trap. 207,484; 123,670; 142,323; 179,581.
 Steel Manufacture. 72,061.
 Step Cover. 62,406; 90,584.
 Stereoscope. 156,311.
 Stock for Bit. 62,232.
 Stone Crusher. 20,542; 68,248; 88,216.
 Stone Channeling Machine. 40,584.
 Stop Cock. Morris. May 15, 1822.
 Stove. Wilson, Oct. 10, 1834. Stanley, Dec. 17, 1832. Orr, Jan. 20, 1836. Nos. 505; 1157; 2636; 3876; 6086; 8047; 10,448; 19,956; 22,787; 28,482; 32,257; 39,535; 41,897; 45,957; 49,469; 51,085; 51,292; 53,251; 56,686; 67,283; 89,304; 100,335; 131,936; 142,933; 142,934; 177,334; 180,001; 183,545; 236,425.
 Stove, Oil Stove. 45,957; 156,149.
 Stove Door. 246,606.
 Stove, Gas Stove. 49,469; 79,989.
 Stove Guard-plate. 80,235.
 Stove Fire-pot. 283,602.
 Straw Cutter. 3431.
 Sugar Purifying. 37,548.
 Sulphate of Alumina Manufacture. 239,089.
 Surface-sizing Fibrous Matter. 41,214.
 Suspenders. Dawson. Nov. 6, 1806. No. 69,629.
 Suspender Button Strap. 169,855.
 Suspender End. 94,881.
 Suspension Ring for Business Cards. 77,482.
 Sweat Leather. 218,220.
 Syringe. 16,956; 28,196; 31,626.
 Table Slide, Extension. 44,073.
 Tan Bark, Extracting. 41,782.
 Tan Bark, Extracting Apparatus. 50,626.
 Tank for Asphalt. 147,423.
 Tapes, Device for Arranging. 50,318.
 Teeth, Setting Mineral. 8621.
 Teeth. See Comb; Dentistry; Spring Harrow.
 Telegraph. See Electric.
 Telegraph Wire. See Electric.
 Telephone. See Electric.
 Tempering Springs. 116,266.
 Tempering Wire and Steel. 21,286.
 Tenon of Metal. 76,491.
 Tent. 14,740.
 Theater Appliances. 222,143.
 Thermometer. 222,420.
 Tile Machine Table. 279,259.
 Tiles. See Brick.
 Tiling, Fire-proof. 112,930.
 Tillers, Method of Connecting with Rudder-heads. 3106.
 Timber Framing Machine.† Hockholzer v. Eager, 2 Sawyer, 361.
 Tobacco, Preparing. 152,649.
 Tobacco, Re-sweating Apparatus. 216,293.
 Tobacco, Plug Tobacco. 140,020.
 Tobacco, Plug Tobacco Finishing. 181,512.
 Tobacco, Plug Tobacco Finisher. 185,119.
 Tobacco, Plug Tobacco Label. 158,604.
 Tool. 56,166.
 Tool Grinding. 4204.
 Topsails, Extra Yard for. 11,125.
 Torpedo Envelope Machine. 167,814.
 Torpedo Filling Machine. 159,995.
 Toy, Elastic. 23,001.
 Transom Lifter. 136,801; 148,538.

TABLE 3.—TOPICAL LIST OF PATENTS.

Trap of Soft Metal. 220,767.
 Traveling Bag. 177,020; 56,801.
 Tray. 38,519.
 Treadle. 176,636.
 Tremolo. 48,366.
 Tripod Head for Surveying. 197,369.
 Truck for Locomotive. 34,377.
 Trunk. 72,988; 128,925; 155,601.
 Trunk Fastening. 74,723; 112,937; 188,950.
 Trunk Molding. 59,458.
 Truss Bridge. 4726; 30,577; 34,183.
 Truss and Supporter. 70,324.
 Tub for Distilling Oil. 86,115.
 Tube. 124,011.
 Tube of Leather. Pennock & Sellers. July 6, 1818.
 Tube, Manufacture of Metallic. 96,037.
 Tube, Flexible. 46,507.
 Turbine Wheel. 28,314.
 Type Manufacture. 55,299.
 Type for Printing. 139,365.
 Type Blocks, Forming Letters on. 64,410.
 Umbrella Cases. 149,480.
 Umbrella Rib, Tempering, 39,210.
 Valve. 2631; 3802; 41,471.
 Valve for Governors. 7755.
 Valve Governor for Water Closet. 11,113.
 Valve for Petroleum Packages. 102,187.
 Valve, Safety Valve. 58,294; 58,962; 85,963; 94,747.
 Valve, Steam Valve. 49,414; 236,052.
 Vapor Apparatus. 12,535.
 Vats for Tanning Hides. 7854.
 Vault Cover. 4266; 14,281.
 Velocipede, 46,706; 59,915.
 Veneer cutting by Machinery. Burnap. May 1, 1829.
 Ventilator. 94,203.
 Ventilator for Cars. 110,803.
 Ventilating Louvers. 170,852.
 Ventilation. 14,510.
 Ventilation of Water Closets. 171,926.
 Vessel for containing Gases and Liquids under Pressure. 159,433.
 Wagon. 155,451.
 Wagon Float.† Stanton, H. Held not infringed. Black's Opinion, 9 Att'y Gen., 332, 349.
 Wagon Gearing. 16,648.
 Wagon Reach. 69,789; 83,497.
 Washboard. 6835; 111,585; 171,568.
 Washing Machine. 14,818.
 Washing Shavings. 85,526.
 Watch. 61,207.
 Watch Chain Machine. Keplinger. May 4, 1820.
 Watchman's Time Detector. 48,048.
 Water Closet. 15,474; 21,734; 91,474; 155,814.
 Water Closet Receiver. 106,089.
 Water Dam. 80,492; 85,598.
 Water Meter. 109,372.
 Water Motor. 146,120.
 Water Supply Regulator. 87,413.
 Water Tank for Railroad. 63,418.
 Water Wheel. Parker. Oct. 19, 1829. Nos. 1658; 2708.
 Water Wheel and Sewing Machine, Combined. 131,616.
 Weaver's Harness. 12,175.
 Weaver's Temple. 8368.
 Weighing Scales. 14,119; 24,162; 25,148; 35,348.
 Weighing Scales.† Weeks v. Buffalo Scale Co., 11 Fed. Rep., 901.
 Well-forming Machine. 49,349.

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Well Reservoir. 53,584.
 Well, Sinking. 50,614.
 Well Tube. 65,648; 130,871.
 Wheels, Cast Iron. 640; 5112; 5531.
 Wheels for Cars.† Trescott. Sizer v. Many, 16 How., 98.
 Wheels for Cars, Casting. 110,779.
 Wheels for Cars, Wrought Iron. 6767
 Wheels for Carriages. 17,520.
 Wheels for Locomotives. 58,447.
 Wheels, Removing Truck. 4213.
 Whip. 60,606.
 Whip Socket. 43,858; 52,439; 70,075; 70,627; 150,195; 221,482; 231,510.
 Whip-socket Manufacture. 132,909.
 Whip Tip. 74,435.
 Whistle for Speaking Tube. 103,406.
 White Oxide of Zinc Manufacture. 8756; 13,416; 13,806.
 Wind Wheel. 87,628.
 Windmill. 68,674; 93,472; 133,601; 156,195.
 Window Cleaner. 196,006.
 Window Frame, Adjustable. 52,726.
 Window Sash Fastener. 88,318; 212,487; 284,506.
 Window Sash Supporter. 64,910.
 Window Sash Holder. 82,580.
 Winnowing Machine. 6757.
 Wire Bag Fastener. 135,899.
 Wire Cable. See Barbed.
 Wire Cage. 139,784.
 Wire Fence. 6106.
 Wire Fence. See, also, Barbed.
 Wire Grating Manufacture. 5006.
 Wire Staple. 19,747.
 Wood-graining Process. 164,858.
 Wood Gutter, Machine for Making. 117,255.
 Wood-splitting Machine. 12,857.
 Wood-bending Machine. 6951; 14,405.
 Wool-carding Machine. 4023.
 Wool-lubricating Machine. 36,603; 47,938.
 Wool Manufacture. Goulding. Dec. 15, 1826.
 Wrench. 40,590; 45,334; 50,364.
 Wrench. See Bung.
 Xyloidine. 97,454; 101,175.
 Zinc White Manufacture. 8756; 13,416; 13,806.

TABLE 4.

A TABLE OF PARTICULAR PATENTEES, UPON WHOSE PATENTS SUIT HAS BEEN BROUGHT, ARRANGED ALPHABETICALLY,

The patents themselves not occurring in Tables 1, 2 or 3 (owing to the absence of sufficient data by which to identify them), and giving after each patent the suits in which it was involved; the construction of the patent in such suits; the reissue of such patent; the suits in which the reissue or reissues were involved, as also the construction given them in such suits.

Bisbee & Doan. See Doan & Bisbee.
 Buckley. Buckley v. Sawyer Mfg. Co., 2 McCrary, 350.
 Clements & Fowler. Ladd v. Mills, 20 Fed. Rep., 792.
 Detmold. Corrected to date of his prior foreign patent. Nelson's Opinion, 4 Att'y Gen., 335.
 Doan & Bisbee. Claims 1, 2 and 3 infringed. Fay & Co. v. Allen, 32 O. G., 1355.
 Douglass (reissued to Wooster). Held not infringed. Wooster v. Muser, 20 Fed. Rep., 162.
 Fowler & Clements. See Clements & Fowler.
 Goodyear. Bourn v. Goodyear, 9 Wall., 811.
 Graves. Divisional reissue. Phillips' Opinion, 16 Att'y Gen., 560.
 Hayden, I. Hayden v. Oriental Mills, 15 Fed. Rep., 605.
 Hoffman & Spofford. See Spofford & Hoffman.
 Lock. Construed strictly in view of state of art, and of its rejected claims, and held not infringed. Fay & Co. v. Allen, 32 O. G., 1355.
 Putnam (Barb Wire Machine?) Washburn & Moen Mfg. Co. v. Grinnell Wire Co., 24 Fed. Rep., 23.
 Spofford & Hoffman. Goldsmith v. American Paper Collar Co., 18 Blatch., 82.

TABLE 5.

A TABLE OF DESIGN PATENT CASES, GIVING AFTER EACH CASE THE PATENT
SUED ON, AND THE SECTION WHERE THE CASE OCCURS IN THE DIGEST.

- Adams & Westlake Mfg. Co. v. St. Louis Wire Goods Co., 12 O. G., 940; 3 B. & A., 77. No. 4637.
 Bigelow Carpet Co. v. Dobson, 21 O. G., 1200; 10 Fed. Rep., 385. §§ 1921, 1922. See Table 8.
 Booth v. Garely, 1 Blatch., 247; Fish. Pat. Rep., 154. No. 139. §§ 1913, 1918, 1956.
 Burton v. Town of Greenville, 18 O. G., 411; 5 B. & A., 541; 3 Fed. R., 642. No. 10,497. § 1987.
 Collender v. Griffiths, 11 Blatch., 212; 3 O. G., 689. Billiard Tables. §§ 1951, 1960, 1966.
 Collender v. Griffiths, 18 Blatch., 110; 18 O. G., 241; 5 Ban. & Ard., 372. § 1972.
 Cone v. Morgan Envelope Co., 4 Ban. & Ard., 170.
 Dayton v. Wright, 11 O. G., 197; 2 Ban. & Ard., 449.
 Dobson v. Hartford Carpet Co.; v. Bigelow, 31 O. G., 787; 114 U. S., 439. Nos. 10,778; 10,870;
 11,074. §§ 1917, 1919, 1920, 1925, 1985.
 Dobson v. Bigelow; v. Hartford Carpet Co., 31 O. G., 787; 114 U. S., 439. Nos. 10,778; 10,870;
 11,074.
 Dryfoos v. Friedman, 18 Fed. Rep., 824. No. 4802. §§ 1938, 1952, 1953.
 Dryfus v. Schneider, 25 Fed. Rep., 481. No. 14,356. §§ 1947, 1986.
 Foster v. Crossin, 23 Fed. Rep., 400. Nos. 15,049; 15,050. §§ 1939, 1955.
 Gibbs v. Ellithorp, 1 MacA. Pat. Cases, 702. No. 1149. §§ 1976, 1977.
 Gorham Mfg. Co. v. White, 7 Blatch., 315; reversed, 14 Wall., 511. No. 1439. §§ 1941, 1942.
 Gorham Co. v. White, 14 Wall., 511; 2 O. G., 592; 2 Whit., 392; reversing *Ibid.*, 7 Blatch.,
 315. No. 1439. §§ 1910-1912.
 Hartford Carpet Co. v. Dobson, 21 O. G., 1200; 10 Fed. Rep., 385. Nos. 10,778; 10,870; 11,074.
 Jennings v. Kibbe, 22 O. G., 331; 10 Fed. Rep., 669. Nos. 10,388; 10,448. §§ 1935, 1936.
 Jennings v. Kibbe; v. Dolan, 32 O. G., 653; 24 Fed. Rep., 697. No. 10,448.
 Jennings v. Dolan; v. Kibbe, 32 O. G., 653; 24 Fed. Rep., 697. No. 10,448.
 Lehnbeuter v. Holthaus, 105 U. S., 91; 21 O. G., 1783. No. 8814. §§ 1950, 1971, 1990.
 Margot v. Schnelzer, 24 O. G., 101. § 1957.
 Miller v. Smith, 18 O. G., 1047; 5 Fed. Rep., 359. No. 10,045. §§ 1927, 1933, 1934, 1944, 1969,
 1980, 1982, 1984.
 Neidringhaus v. Comm'r of Patents, 2 MacA., 149; 8 O. G., 279. §§ 1931, 1961, 1968, 1973, 1978.
 Northrup v. Adams, 12 O. G., 340; 2 B. & A., 567. Design for Provision Safe. §§ 1915, 1962.
 Perry v. Starrett, 14 O. G., 599; 3 Ban. & Ard., 485. No. 7456. §§ 1932, 1943, 1949, 1975.
 Post v. Richards Hardware Co., 25 Fed. R., 905. Design for Curtain and Loop. §§ 1930, 1954.
 Pratt v. Rosenfeld, 18 Blatch., 234; 21 O. G., 866; 5 Ban. & Ard., 488. No. 7914. § 1963.
 Root v. Ball, 4 McLean, 177. §§ 1940, 1948, 1964, 1989.
 Simpson v. Davis, 12 Fed. Rep., 144. §§ 1916, 1979.
 Simpson v. Davis, 22 Fed. Rep., 444. Design for Newel Posts. §§ 1923, 1924.
 Sparkman v. Higgin, 1 Blatch., 205; Fish. Pat. R., 110. Design for Oil Cloth. §§ 1914, 1928, 1965.
 Sparkman v. Higgin, 2 Blatch., 29; Fish. Pat. R., 135. Design for Oil Cloth. §§ 1958, 1959.
 Theberath v. Rubber & Celluloid Harness Trimming Co., 23 O. G., 1112; 15 Fed. Rep., 246.
 No. 5006. §§ 1981, 1988.
 Theberath v. Rubber & Celluloid Harness Trimming Co., 3 Fed. R., 151; 5 B. & A., 584. No. 5006.
 Tomkinson v. Willets Mfg. Co., 31 O. G., 918; 32 O. G., 382; 23 Fed. Rep., 895. No. 13,295.
 §§ 1926, 1945, 1946.
 Untermeyer v. Jeannot, 20 Fed. Rep., 503. No. 12,485. § 1929.
 Werner v. Reinhardt, 20 O. G., 1163; 10 Fed. Rep., 676. No. 11,186.
 Western Electric Mfg. Co. v. Odell, 18 Fed. Rep., 321. § 1967.
 Wood v. Dalbey, 19 Blatch., 214; 20 O. G., 523. No. 11,409. §§ 1937, 1970, 1983.
 Wooster v. Crane, 5 Blatch., 282. No. 1834. § 1974.

TABLE 6.

A TABLE OF PARTICULAR DESIGN PATENTS UPON WHICH SUIT HAS BEEN BROUGHT, ARRANGED CHRONOLOGICALLY,

And giving under each patent the suits in which it was involved, and the construction, etc., of the patent.

NOTE.—For Design Patents not found in this list look in the Topical list, No. 7.

139. Booth, D. A. July 24, 1847. Buttons. *Booth v. Garely*, 1 Blatch., 248.
1149. Ellithorp, S. B. Sept. 27, 1859. Sewing Machine Frames. Awarded priority on interference. *Gibbs v. Ellithorp*, 1 MacA. Pat. Cases, 702.
1439. Gorham, Thurber & Dexter. July 16, 1861. Handles of Table Spoons and Forks. *Gorham Mfg. Co. v. White*, 5 Fish., 94; 14 Wall., 511.
1834. Wooster, E. C. Oct. 20, 1863. Reel. *Wooster v. Crane*, 5 Blatch., 282.
4637. Mann, R. J. Feb. 7, 1871. Sieve. Not novel. Patentability doubted. *Adams & Westlake Mfg. Co. v. St. Louis Wire Goods Co.*, 3 Ban. & Ard., 77; *Dayton v. Wright & Herring*, 2 Ban. & Ard., 449.
4802. Walton, Wm. H. April 11, 1871. Printed Material for Gored Skirts. Construed, limited, not infringed. *Dryfoos v. Friedman*, 18 Fed. Rep., 824.
5006. Theberath, C. M. June 13, 1871. Harness Trimming. Held infringed. *Theberath v. Rubber & Celluloid Harness Trimming Co.*, 3 Fed. Rep., 151; 15 Fed. Rep., 246.
7456. Perry, Dickey & Williams. May 26, 1874. Stove. *Perry v. Starrett*, 14 O. G., 599.
7914. Farmer, G. P. Dec. 8, 1874. Card of Buttons. *Pratt v. Rosenfeld*, 21 O. G., 866.
8814. Lehnbeuter & Claes. Nov. 30, 1875. Show Case. *Lehnbeuter v. Holthaus*, 21 O. G., 1783.
10045. Miller & Miller. June 5, 1877. Studs and Buttons. *Miller v. Smith*, 18 O. G., 1047.
10388. Jennings, A. G. Jan. 1, 1878. Lace Purling. *Jennings v. Kibbe*, 22 O. G., 331.
10448. Jennings, W. P. Feb. 12, 1878. Fringed Lace. *Ibid.*, 22 O. G., 331. Construed and held not infringed. *Ibid.*, 32 O. G., 653.
10497. Burton, G. D. Feb. 19, 1878. Street Lamp. *Burton v. Town of Greenville*, 18 O. G., 411.
10778. Christie, H. Aug. 13, 1878. Carpets. *Dobson v. Hartford Carpet Co.*, 21 O. G., 1200. Sustained, not invalid for joinder of several claims to design as a whole and to its separate elements. *Ibid.*
10870. MaGee, C. Oct. 15, 1878. Carpet. *Ibid.*, 21 O. G., 1200. Held valid; is not for an aggregation, *Ibid.*
11074. Jacobs, W. L. March 18, 1879. Carpet. *Ibid.*, 21 O. G., 1200. Held valid, notwithstanding joinder of nineteen claims. *Ibid.*
11186. Werner, R. May 6, 1879. Trimming. *Werner v. Reinhardt*, 20 O. G., 1163.
11409. Wood, C. F. Sept. 9, 1879. Jewelry setting. *Wood v. Dalbey*, 20 O. G., 523.
12485. Untermeyer, H. Sept. 20, 1881. Watch Case. *Untermeyer v. Jeannot*, 20 Fed. Rep., 503. Limited and not infringed.
13295. Slater, J. Sept. 12, 1882. Vegetable Dish. *Tomkinson v. Willets Mfg. Co.*, 23 Fed. Rep., 895. Held valid and infringed.
14356. Dryfus, B. Oct. 23, 1883. Pendant. *Dryfus v. Schneider*, 25 Fed. Rep., 481. Held novel and infringed.
15049. Foster, T. W. June 10, 1884. Jewelry-pin. *Foster v. Crossin*, 23 Fed. Rep., 400. Held novel.
15050. Same. *Ibid.*, 23 Fed. Rep., 400. Construed to relate to design of the finished product, and not to method of manufacture.

TABLE 7.

A TABLE OF PARTICULAR DESIGN PATENTS UPON WHICH SUIT HAS BEEN BROUGHT, ARRANGED TOPICALLY,

According to subject-matter, and not occurring in Table 6 (owing to the absence of sufficient data by which to identify them), and giving under each patent the suits in which it was involved, and the construction, etc., of the patent.

Billiard Table. Collender v. Griffith, 3 O. G., 689.

Curtain and Loop. Post v. Richards Hardware Co., 25 Fed. Rep., 905.

Newel Post. Simpson v. Davis, 22 Fed. Rep., 444.

Oil Cloths. Sparkman & Kelsey. July 25, 1846. Sparkman v. Higgins, 1 Blatch., 205; 1 Blatch., 135; 2 Blatch., 29.

Provision Safe. Northrup v. Adams, 12 O. G., 430.

TABLE 8.

A TABLE OF PATENT CASES OVERRULED, MODIFIED OR REVERSED.

NOTE.—The sections given indicate where the cases occur in this volume.

- American Cotton Tie Co. v. Simmons*, 3 Ban. & Ard., 320; 13 O. G., 967. §§ 5935, 5936. Reversed, 106 U. S., 89. §§ 5864, 5865.
- American Nicholson Pavement Co. v. Elizabeth*, 1 Ban. & Ard., 439. §§ 238-240, 1485, 1595-1597, 1625-1627, 1643, 1661, 1662, 1689*k*-1689*m*, 1689*p*, 4184, 4435. Reversed as to accountability for profits, 97 U. S., 126. §§ 6378-6386.
- Atlantic Giant Powder Co. v. California Powder Works*, 3 Saw., 448; 2 Ban. & Ard., 131. §§ 5352, 5545, 5660. Reversed as to reissues 4816 and 4819, 98 U. S., 126. §§ 1229, 4831, 5351, 5455, 5538, 5560, 5561.
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Where numbers and dates of patents are given, consult Table 1, *ante*.

Where only the number of the patent is given, and no reference to the section numbers of the digest, all that is material occurs under the number in Table 1, *ante*.

Where a case has several titles, they will all be found in the table, but the section numbers are grouped under only one. For example, see *Adams v. Baron; v. Bellair Stamping Co.* The section references are under the latter title. See, also, *American Diamond Rock Boring Co. v. Gilson; v. Sheldons; v. Sutherland Falls Co.* The references are under *American Diamond Rock Boring Co. v. Sheldons*.

Abbreviations: B. & A., or Ban. & Ard., Banning & Arden's Patent Reports. Fish., Fisher's Patent Cases. Fish. Pat. Rep., Fisher's Patent Reports. Robb, Robb's Patent Cases. MacA. Pat. Cases, MacArthur's Patent Cases. Whit., Whitman's Patent Cases. O. G., Official Gazette, United States Patent Office. W. & M., Woodbury & Mott.

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D.

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- Fales v. Wentworth,* 1 Holmes, 96; 5 Fish., 302; 2 O. G., 58. Same case as Chipman v. Wentworth. No. 52,835. §§ 2777, 3107.
- Falls Co. See Miller's Falls Co.

- Fanning v. Onderdonk,* 5 B. & A., 431; 2 Fed. Rep., 568.
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- Meyer v. Goodyear's India Rubber Glove Mfg. Co.,* 22 O. G., 681; 11 Fed. Rep., 891; 20 Blatch., 91. No. 111,962. § 5526.
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- Middletown Tool Co. v. Judd,* 3 Fish., 141. No. 21,879. §§ 1250, 4326, 5479, 5563, 6102.
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- Miller v. Androscoggin Pulp Co.,* 1 Holmes, 142; 5 Fish., 340; 1 O. G., 409. No. 21,161. § 3038.
- Miller v. Bridgeport Brass Co.,* 14 Blatch., 282; 12 O. G., 667; 3 B. & A., 20; affirmed, *Ibid.*, 14 Otto, 350. No. 30,381. §§ 5573-5575.
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- Miller v. Liggett & Myers Tobacco Co.,* 19 O. G., 1138; 3 McC., 375; 7 Fed. Rep., 91. No. 185,119. §§ 2240, 2246, 4490, 4491.
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- Milligan & Higgins Glue Co. v. Upton,* 6 O. G., 837; 1 B. & A., 497; 4 Cliff., 237; affirmed, *Ibid.*, 7 Otto, 3. No. 44,528. §§ 410, 2606, 3598, 5564, 5688.
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- Moffitt v. Gaar,* 1 Bond, 315; 1 Fish., 610; affirmed, *Ibid.*, 1 Black, 273. No. 9432. §§ 3773, 5754.
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- Morehead v. Jones,* 3 Wall. Jr., 306. No. 2886. § 217.
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- Slate Co. See Plastic Slate Roofing Co.
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V.

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- Vinton v. Hamilton,* 14 Otto, 485; 21 O. G., 557. No. 143,600.
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- Wayne v. Holmes,* 1 Bond, 27; 2 Fish., 20. §§ 1551, 2424, 4361, 4682, 6014, 6017, 6470, 6639.
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- Webster Loom Co. v. Higgins,* 13 Blatch., 349; 9 O. G., 965. No. 130,961. § 227.
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- Welling v. La Baw,* 12 Fed. Rep., 875; v. Gooth. No. 77,938.
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FEDERAL DECISIONS.

COPYRIGHT AND TRADE-MARKS.*

- A. COPYRIGHT.
- B. TRADE-MARKS.

A. COPYRIGHT.

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| I. IN GENERAL. COMMON LAW RIGHT. PROPERTY IN MANUSCRIPT, §§ 1-96. | IV. ASSIGNMENT, §§ 216-220. |
| II. WHAT PROTECTED BY COPYRIGHT, §§ 97-186. | V. INFRINGEMENT, §§ 221-332. |
| III. SECURING COPYRIGHT, §§ 187-215. | VI. SUITS FOR INFRINGEMENT, §§ 333-385. |
| | VII. SALE ON EXECUTION, §§ 386-389. |

I. IN GENERAL. COMMON LAW RIGHT. PROPERTY IN MANUSCRIPT.

SUMMARY — *Right depends on statute, §§ 1, 3.— Property in manuscript, §§ 2, 4, 5.— Effect of publication of a literary work, § 5.— Representation of a play in public, §§ 5-8.— Property in manuscript continues till publication, § 9.— Unauthorized representation of a play; assent of author not presumed, § 10.— Play written under agreement, § 11.*

§ 1. There is no exclusive right in a published work in its author in the United States, except under the laws of congress relating to copyright. *Wheaton v. Peters*, §§ 12-16.

§ 2. Before publication an author has an exclusive right of property in his manuscript, and the unauthorized publication of the whole or of an essential part will be enjoined, and such right is not abandoned by permitting the manuscript to be copied. *Bartlett v. Crittenden*, §§ 17-21.

§ 3. There was no common law copyright. *Ibid.*; *Boucicault v. Hart*, §§ 22-29.

§ 4. The right of the author of a dramatic composition to retain and use the same without publication for his own exclusive benefit exists at common law, but cannot be protected by the federal courts in an action between citizens of the same state. *Boucicault v. Hart*, §§ 22-29.

§ 5. The author of a dramatic or literary work has at common law the sole property in the manuscript and its contents, and of copies of the same, so long as he does not publish it or part with the right of property therein. And the representation of a play with the consent of the author is not such a publication thereof as deprives the author of such exclusive right; and this is true where such exclusive right is claimed in this country as to a play which has been acted in England, where, by statute, such acting was equivalent to a publication. *Crowe v. Aiken*, §§ 30-34.

§ 6. The author of a dramatic composition does not abandon his right therein, or dedicate it to the public, or publish it, by causing it to be acted for his benefit. *Boucicault v. Hart*, §§ 22-29.

§ 7. The representation of a play is not a dedication thereof to the public, except possibly so far as those who witness the performance can recollect it, and spectators have no right to secure its reproduction by phonographic or other *verbatim* report, independent of memory. *Crowe v. Aiken*, §§ 30-34.

§ 8. The representation of a manuscript and uncopyrighted play at a theater under an arrangement with the author is not an abandonment thereof by the author or a dedication to the public or to the theatrical profession, and does not prevent the subsequent copyrighting thereof. *Boucicault v. Fox*, §§ 35-39.

*The digesting on this subject was done by CHARLES N. BROWN, Esq., of Madison, Wisconsin; the arrangement, and the selection and rejection of cases, by the general editor.

§ 9. The literary property in a manuscript continues in the author so long as he exercises control over it, and, until its publication, no one has a right to use it or its contents without his consent. Any special use thereof, therefore, by him in public, for his own benefit, is a use perfectly consistent with his exclusive right to its control, and is no evidence of abandonment. *Ibid.*

§ 10. The assent of the author of a play to its unauthorized representation will not be inferred from the fact that it was presented nine times consecutively without objection from him, especially when the person presenting it knew that the right of his licensor to dispose of the play was disputed by the author. *Ibid.*

§ 11. A dramatic author agreed to write a play, for a certain compensation, which he was to assist in acting, and which was to be presented at a certain theater so long as it would run. *Held*, that the author was entitled to take a copyright thereof, and, when no longer produced at the theater named, it might be exclusively produced elsewhere by him or his licensees. *Ibid.*

[NOTES.— See §§ 40-96.]

WHEATON *v.* PETERS.

(8 Peters, 591-700. 1834.)

APPEAL from U. S. Circuit Court, District of Pennsylvania.

Opinion by MR. JUSTICE McLEAN.

STATEMENT OF FACTS.— The complainants in their bill state that Henry Wheaton is the author of twelve books, or volumes, of the reports of cases argued and adjudged in the supreme court of the United States, and commonly known as Wheaton's Reports; which contain a connected and complete series of the decisions of said court from the year 1816 until the year 1827. That before the first volume was published, the said Wheaton sold and transferred his copyright in the said volume to Matthew Carey, of Philadelphia; who, before the publication, deposited a printed copy of the title-page of the volume in the clerk's office of the district court of the eastern district of Pennsylvania, where he resided. That the same was recorded by the said clerk according to law, and that a copy of the said record was caused by said Carey to be inserted at full length in the page immediately following the title of said book. And the complainants further state that they have been informed, and believe, that all things which are necessary and requisite to be done in and by the provisions of the acts of congress of the United States, passed the 31st day of May, 1790, and the 29th day of April, 1802 (2 Stats. at Large, 171), for the purpose of securing to authors and proprietors the copyrights of books, and for other purposes, in order to entitle the said Carey to the benefit of the said acts, have been done.

It is further stated that said Carey afterwards conveyed the copyright in the said volume to Matthew Carey, Henry C. Carey, and Isaac Lea, trading under the firm of Matthew Carey & Sons; and that said firm, in the year 1821, transferred the said copyright to the complainant, Robert Donaldson. That this purchase was made by an arrangement with the said Henry Wheaton, with the expectation of a renewal of the right of the said Henry Wheaton under the provisions of the said acts of congress; of which renewal he, the said Robert Donaldson, was to have the benefit, until the first and second editions of the said volume which he, the said Donaldson, was to publish, should be sold. That at the time the purchase was made from Carey & Sons, a purchase was also made of the residue of the first edition of the first volume, which they had on hand; and in the year 1827 he published another edition of said volume, a part of which still remains unsold.

The bill further states that for the purpose of continuing to the said Henry Wheaton the exclusive right, under the provisions of the said acts of congress, to the copy of the said volume for the further term of fourteen years, after the

expiration of the term of fourteen years from the recording of the title of the said volume in the clerk's office as aforesaid, the said Robert Donaldson, as the agent of Wheaton, within six months before the expiration of the said first term of fourteen years, deposited a printed copy of the title of the said volume in the clerk's office of the district court of the southern district of New York, where the said Wheaton then resided; and caused the said title to be a second time recorded in the said clerk's office; and also caused a copy of the said record to be a second time published in a newspaper printed in the said city of New York, for the space of four weeks, and delivered a copy of the said book to the secretary of state of the United States; and that all things were done agreeably to the provisions of the said act of congress of May 31, 1790, and within six months before the expiration of the said term of fourteen years.

The same allegations are made as to all the other volumes which have been published; that the entry was made in the clerk's office and notice given by publication in a newspaper, before the publication of each volume; and that a copy of each volume was deposited in the department of state.

The complainants charge that the defendants have lately published and sold, or caused to be sold, a volume called "Condensed Reports of Cases in the Supreme Court of the United States," containing the whole series of the decisions of the court from its organization to the commencement of Peters' Reports at January term, 1827. That this volume contains, without any material abbreviation or alteration, all the reports of cases in the said first volume of Wheaton's Reports, and that the publication and sale thereof is a direct violation of the complainants' rights, and an injunction, etc., is prayed.

The defendants in their answer deny that their publication was an infringement of the complainants' copyright, if any they had; and further deny that they had any such right, they not having complied with all the requisites to the vesting of such right under the acts of congress.

The bill of the complainants was dismissed by the decree of the circuit court; and they appealed to this court.

Some of the questions which arise in this case are as novel, in this country, as they are interesting. But one case involving similar principles, except a decision by a state court, has occurred; and that was decided by the circuit court of the United States for the district of Pennsylvania, from whose decree no appeal was taken. The right of the complainants must be first examined. If this right shall be sustained as set forth in the bill, and the defendants shall be proved to have violated it, the court will be bound to give the appropriate redress.

The complainants assert their right on two grounds. First, under the common law. Secondly, under the acts of congress.

And they insist, in the first place, that an author was entitled, at common law, to a perpetual property in the copy of his works, and in the profits of their publication; and to recover damages for its injury, by an action on the case, and to the protection of a court of equity. In support of this proposition, the counsel for the complainants have indulged in a wide range of argument, and have shown great industry and ability. The limited time allowed for the preparation of this opinion will not admit of an equally extended consideration of the subject by the court.

Perhaps no topic in England has excited more discussion among literary and talented men than that of the literary property of authors. So engrossing was the subject, for a long time, as to leave few neutrals among those who

were distinguished for their learning and ability. At length the question, whether the copy of a book or literary composition belongs to the author at common law, was brought before the court of king's bench, in the great case of *Miller v. Taylor*, reported in 4 Burr., 2303. This was a case of great expectation, and the four judges, in giving their opinions, *seriatim*, exhausted the argument on both sides. Two of the judges and Lord Mansfield held that, by the common law, an author had a literary property in his works; and they sustained their opinion with very great ability. Mr. Justice Yeates, in an opinion of great length, and with an ability, if equalled, certainly not surpassed, maintained the opposite ground.

Previous to this case, injunctions had issued out of chancery to prevent the publication of certain works, at the instance of those who claimed a property in the copyright, but no decision had been given. And a case had been commenced, at law, between Tonson and Collins, on the same ground, and was argued with great ability, more than once, and the court of king's bench were about to take the opinion of all the judges, when they discovered that the suit had been brought by collusion, to try the question, and it was dismissed.

This question was brought before the house of lords, in the case of *Donaldson v. Beckett* and others, reported in 4 Burr., 2408. Lord Mansfield, being a peer, through feelings of delicacy, declined giving any opinion. The eleven judges gave their opinions on the following points: 1. Whether at common law an author of any book or literary composition had the sole right of first printing, and publishing the same for sale; and might bring an action against any person who printed, published, and sold the same without his consent. On this question there were eight judges in the affirmative, and three in the negative.

2. If the author had such right originally, did the law take it away, upon his printing and publishing such book or literary composition; and might any person afterward reprint and sell, for his own benefit, such book or literary composition against the will of the author? This question was answered in the affirmative by four judges, and in the negative by seven.

3. If such action would have lain, at common law, is it taken away by the statute of 8 Anne; and is an author, by the said statute, precluded from every remedy except on the foundation of the said statute, and on the terms of the conditions prescribed thereby? Six of the judges, to five, decided that the remedy must be under the statute.

4. Whether the author of any literary composition and his assigns had the sole right of printing and publishing the same in perpetuity, by the common law. Which question was decided in favor of the author by seven judges to four.

5. Whether this right is any way impeached, restrained or taken away by the statute of 8 Anne. Six, to five, judges decided that the right is taken away by the statute. And the lord chancellor seconding Lord Camden's motion to reverse, the decree was reversed.

It would appear from the points decided that a majority of the judges were in favor of the common law right of authors, but that the same had been taken away by the statute. The title and preamble of the statute, 8 Anne, ch. 19, is as follows: "An act for the encouragement of learning by vesting the copies of printed books in the authors or purchasers of such copies during the times therein mentioned.

"Whereas, printers, booksellers and other persons have of late frequently

taken the liberty of printing, reprinting and publishing, or causing to be printed, reprinted and published, books and other writings without the consent of the authors or proprietors of such books and writings, to their very great detriment, and too often to the ruin of them and their families," etc.

In 7 Term R., 627, Lord Kenyon says: "All arguments in the support of the rights of learned men in their works must ever be heard with great favor by men of liberal minds to whom they are addressed. It was probably on that account that, when the great question of literary property was discussed, some judges of enlightened understanding went the length of maintaining that the right of publication rested exclusively in the authors and those who claimed under them for all time; but the other opinion finally prevailed, which established that the right was confined to the times limited by the act of parliament. And that, I have no doubt, was the right decision." And in the case of the University of Cambridge *v.* Bryer, 16 East, 319, Lord Ellenborough remarked: "It has been said that the statute of 8 Anne has three objects; but I cannot subdivide the first two; I think it has only two. The counsel for the plaintiffs contended that there was no right at common law; and perhaps there might not be; but of that we have not particularly anything to do."

From the above authorities, and others which might be referred to if time permitted, the law appears to be well settled in England that, since the statute of 8 Anne, the literary property of an author in his works can only be asserted under the statute; and that, notwithstanding the opinion of a majority of the judges in the great case of *Miller v. Taylor*, 4 Burr., 2303, was in favor of the common law right before the statute, it is still considered in England as a question by no means free from doubt.

§ 12. *An author at common law has a property in his manuscript.*

That an author at common law has a property in his manuscript, and may obtain redress against any one who deprives him of it, or, by improperly obtaining a copy, endeavors to realize a profit by its publication, cannot be doubted; but this is a very different right from that which asserts a perpetual and exclusive property in the future publication of the work, after the author shall have published it to the world. The argument that a literary man is as much entitled to the product of his labor as any other member of society cannot be controverted. And the answer is that he realizes this product by the transfer of his manuscripts or in the sale of his works when first published.

A book is valuable on account of the matter it contains, the ideas it communicates, the instruction or entertainment it affords. Does the author hold a perpetual property in these? Is there an implied contract by every purchaser of his book that he may realize whatever instruction or entertainment which the reading of it shall give, but shall not write out or print its contents? In what respect does the right of an author differ from that of an individual who has invented a most useful and valuable machine? In the production of this his mind has been as intensely engaged, as long, and perhaps as usefully to the public as any distinguished author in the composition of his book.

The result of their labors may be equally beneficial to society, and in their respective spheres they may be alike distinguished for mental vigor. Does the common law give a perpetual right to the author, and withhold it from the inventor? And yet it has never been pretended that the latter could hold, by the common law, any property in his invention, after he shall have sold it publicly. It would seem, therefore, that the existence of a principle may

well be doubted, which operates so unequally. This is not a characteristic of the common law. It is said to be founded on principles of justice, and that all its rules must conform to sound reason.

Does not the man who imitates the machine profit as much by the labor of another as he who imitates or republishes a book? Can there be a difference between the types and press with which one is formed, and the instruments used in the construction of the others? That every man is entitled to the fruits of his own labor must be admitted; but he can enjoy them only, except by statutory provision, under the rules of property, which regulate society, and which define the rights of things in general. But, if the common law right of authors were shown to exist in England, does the same right exist, and to the same extent, in this country?

§ 13. *No common law of the United States.*

It is clear there can be no common law of the United States. The federal government is composed of twenty-four sovereign and independent states; each of which may have its local usages, customs and common law. There is no principle which pervades the Union, and has the authority of law, that is not embodied in the constitution or laws of the Union. The common law could be made a part of our federal system, only by legislative adoption. When, therefore, a common law right is asserted, we must look to the state in which the controversy originated. And in the case under consideration, as the copyright was entered in the clerk's office of the district court of Pennsylvania, for the first volume of the book in controversy, and it was published in that state, we may inquire whether the common law, as to copyrights, if any existed, was adopted in Pennsylvania.

It is insisted that our ancestors, when they migrated to this country, brought with them the English common law, as a part of their heritage. That this was the case, to a limited extent, is admitted. No one will contend that the common law, as it existed in England, has ever been in force, in all its provisions, in any state in this Union. It was adopted so far only as its principles were suited to the condition of the colonies; and from this circumstance we see what is common law in one state is not so considered in another. The judicial decisions, the usages and customs of the respective states, must determine how far the common law has been introduced and sanctioned in each.

In the argument, it was insisted that no presumption could be drawn against the existence of the common law, as to copyrights, in Pennsylvania, from the fact of its never having been asserted until the commencement of this suit. It may be true, in general, that the failure to assert any particular right may afford no evidence of the non-existence of such right. But the present case may well form an exception to this rule.

If the common law, in all its provisions, has not been introduced into Pennsylvania, to what extent has it been adopted? Must not this court have some evidence on this subject? If no right, such as is set up by the complainants, has heretofore been asserted, no custom or usage established, no judicial decision been given, can the conclusion be justified, that, by the common law of Pennsylvania, an author has a perpetual property in the copyright of his works? These considerations might well lead the court to doubt the existence of this law in Pennsylvania; but there are others of a more conclusive character.

The question respecting the literary property of authors was not made a subject of judicial investigation in England until 1760; and no decision was

given until the case of *Miller v. Taylor* was decided in 1769. Long before this time, the colony of Pennsylvania was settled. What part of the common law did Penn and his associates bring with them from England? The literary property of authors, as now asserted, was then unknown in that country. Laws had been passed regulating the publication of new works under license. And the king, as the head of the church and the state, claimed the exclusive right of publishing the acts of parliament, the Book of Common Prayer and a few other books. No such right at the common law had been recognized in England when the colony of Penn was organized. Long afterwards, literary property became a subject of controversy, but the question was involved in great doubt and perplexity; and a little more than a century ago it was decided by the highest judicial court in England, that the right of authors could not be asserted at common law, but under the statute. The statute of 8 Anne was passed in 1710.

Can it be contended that this common law right, so involved in doubt as to divide the most learned jurists of England, at a period in her history as much distinguished by learning and talents as any other, was brought into the wilds of Pennsylvania by its first adventurers? Was it suited to their condition?

But there is another view still more conclusive. In the eighth section of the first article of the constitution of the United States it is declared that congress shall have power "to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." And in pursuance of the power thus delegated, congress passed the act of the 31st of May, 1790. This is entitled "An act for the encouragement of learning, by securing the copies of maps, charts and books, to the authors and proprietors of such copies, during the times therein mentioned." In the first section of this act it is provided "that from and after its passage, the author and authors of any map, chart, book or books, already printed within these United States, being a citizen, etc., who hath or have not transferred to any other person the copyright of such map, chart, book or books, etc., shall have the sole right and liberty of printing, reprinting, publishing and vending such map, book or books, for fourteen years."

In behalf of the common law right, an argument has been drawn from the word *secure*, which is used in relation to this right, both in the constitution and in the acts of congress. This word, when used as a verb active, signifies to protect, insure, save, ascertain, etc. The counsel for the complainants insist that the term, as used, clearly indicates an intention, not to originate a right, but to protect one already in existence.

§ 14. *The meaning of a word in a statute must be compared with the words and sentences with which it stands.*

There is no mode by which the meaning affixed to any word or sentence, by a deliberative body, can be so well ascertained as by comparing it with the words and sentences with which it stands connected. By this rule the word *secure*, as used in the constitution, could not mean the protection of an acknowledged legal right. It refers to inventors as well as authors, and it has never been pretended, by any one, either in this country or in England, that an inventor has a perpetual right, at common law, to sell the thing invented. And if the word *secure* is used in the constitution in reference to a future right, was it not so used in the act of congress? But, it is said, that by that part of the first section of the act of congress which has been quoted, a copyright is not only

recognized as existing, but that it may be assigned, as the rights of the assignee are protected, the same as those of the author.

As before stated, an author has, by the common law, a property in his manuscript; and there can be no doubt that the rights of an assignee of such manuscript would be protected by a court of chancery. This is presumed to be the copyright recognized in the act, and which was intended to be protected by its provisions. And this protection was given, as well to books published under such circumstances, as to manuscript copies.

That congress, in passing the act of 1790, did not legislate in reference to existing rights, appears clear from the provision that the author, etc., "shall have the sole right and liberty of printing," etc. Now if this exclusive right existed at common law, and congress were about to adopt legislative provisions for its protection, would they have used this language? Could they have deemed it necessary to vest a right already vested? Such a presumption is refuted by the words above quoted, and their force is not lessened by any other part of the act.

§ 15. *Copyright is created in the United States by statute; has no existence at common law. Steps to secure copyright.*

Congress, then, by this act, instead of sanctioning an existing right, as contended for, created it. This seems to be the clear import of the law, connected with the circumstances under which it was enacted. From these considerations it would seem that, if the right of the complainants can be sustained, it must be sustained under the acts of congress. Such was, probably, the opinion of the counsel who framed the bill, as the right is asserted under the statutes, and no particular reference is made to it as existing at common law. The claim, then, of the complainants must be examined in reference to the statutes under which it is asserted.

There are but two statutes which have a bearing upon this subject; one of them has already been named, and the other was passed the 29th of April, 1802. The first section of the act of 1790 provides that an author, or his assignee, "shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the term of fourteen years from the recording of the title thereof in the clerk's office, as hereinafter directed; and that the author, etc., in books not published, etc., shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the like term of fourteen years from the time of recording the title thereof in the clerk's office, as aforesaid. And at the expiration of the said term, the author, etc., shall have the same exclusive right continued to him, etc., for the further term of fourteen years: provided he or they shall cause the title thereof to be a second time recorded, and published in the same manner as is hereinafter directed, and that within six months before the expiration of the first term of fourteen years."

The third section provides that "no person shall be entitled to the benefit of this act, etc., unless he shall first deposit, etc., a printed copy of the title in the clerk's office," etc. "And such author or proprietor shall, within two months from the date thereof, cause a copy of said record to be published in one or more of the newspapers printed in the United States, for the space of four weeks." And the fourth section enacts that "the author, etc., shall, within six months after the publishing thereof, deliver or cause to be delivered to the secretary of state, a copy of the same, to be preserved in his office."

The first section of the act of 1802 provides that "every person who shall

claim to be the author, etc., before he shall be entitled to the benefit of the act entitled an act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the time therein mentioned, he shall, in addition to the requisites enjoined in the third and fourth sections of said act, if a book or books, give information by causing the copy of the record which by said act he is required to publish, to be inserted in the page of the book next to the title." These are substantially the provisions by which the complainants' right must be tested. They claim under a renewal of the term, but this necessarily involves the validity of the right under the first as well as the second term. In the language of the statute, the "same exclusive right" is continued the second term that existed the first.

It will be observed that a right accrues, under the act of 1790, from the time a copy of the title of the book is deposited in the clerk's office. But the act of 1802 adds another requisite to the accruing of the right, and that is, that the record made by the clerk shall be published in the page next to the title-page of the book. And it is argued with great earnestness and ability, that these are the only requisites to the perfection of the complainants' title. That the requisition of the third section, to give public notice in the newspapers, and that contained in the fourth, to deposit a copy in the department of state, are acts subsequent to the accruing of the right, and, whether they are performed or not, cannot materially affect the title.

The case is compared to a grant with conditions subsequent, which can never operate as a forfeiture of the title. It is said also that the object of the publication in the newspapers, and the deposit of the copy in the department of state, was merely to give notice to the public; and that such acts, not being essential to the title, after so great a lapse of time, may well be presumed. That if neither act had been done, the right of the party having accrued before either was required to be done, it must remain unshaken. This right, as has been shown, does not exist at common law; it originated, if at all, under the acts of congress. No one can deny that when the legislature are about to vest an exclusive right in an author or an inventor, they have the power to prescribe the conditions on which such right shall be enjoyed; and that no one can avail himself of such right who does not substantially comply with the requisitions of the law.

This principle is familiar as it regards patent-rights; and it is the same in relation to the copyright of a book. If any difference shall be made, as it respects a strict conformity to the law, it would seem to be more reasonable to make the requirement of the author rather than the inventor. The papers of the latter are examined in the department of state, and require the sanction of the attorney-general; but the author takes every step on his own responsibility, unchecked by the scrutiny or sanction of any public functionary.

The acts required to be done by an author, to secure his right, are in the order in which they must naturally transpire. First, the title of the book is to be deposited with the clerk, and the record he makes must be inserted in the first or second page; then the public notice in the newspapers is to be given; and within six months after the publication of the book, a copy must be deposited in the department of state. A right undoubtedly accrues on the record being made with the clerk, and the printing of it as required; but what is the nature of that right? Is it perfect? If so, the other two requisites are wholly useless.

How can the author be compelled either to give notice in the newspapers or deposit a copy in the state department? The statute affixes no penalty for a failure to perform either of these acts; and it provides no means by which it may be enforced. But we are told they are unimportant acts. If they are indeed wholly unimportant, congress acted unwisely in requiring them to be done. But whether they are important or not is not for the court to determine, but the legislature; and in what light they were considered by the legislature we can learn only by their official acts. Judging then of these acts by this rule, we are not at liberty to say that they are unimportant, and may be dispensed with. They are acts which the law requires to be done, and may this court dispense with their performance?

But the inquiry is made, shall the non-performance of these subsequent conditions operate as a forfeiture of the right? The answer is that this is not a technical grant of precedent and subsequent conditions. All the conditions are important; the law requires them to be performed; and, consequently, their performance is essential to a perfect title. On the performance of a part of them the right vests; and this was essential to its protection under the statute; but other acts are to be done, unless congress have legislated in vain, to render the right perfect.

The notice could not be published until after the entry with the clerk, nor could the book be deposited with the secretary of state until it was published. But these are acts not less important than those which are required to be done previously. They form a part of the title, and until they are performed the title is not perfect. The deposit of the book in the department of state may be important to identify it at any future period should the copyright be contested or an unfounded claim of authorship asserted. But, if doubts could be entertained whether the notice and deposit of the book in the state department were essential to the title, under the act of 1790, on which act my opinion is principally founded, though I consider it in connection with the other act, there is, in the opinion of three of the judges, no ground for doubt under the act of 1802. The latter act declares that every author, etc., before he shall be entitled to the benefit of the former act, shall, "in addition to the requisitions enjoined in the third and fourth sections of said act, if a book, publish," etc.

Is not this a clear exposition of the first act? Can an author claim the benefit of the act of 1790 without performing "the requisites enjoined in the third and fourth sections of it?" If there be any meaning in language, the act of 1802, the three judges think, requires these requisites to be performed "in addition" to the one required by that act, before an author etc., "shall be entitled to the benefit of the first act." The rule by which conditions precedent and subsequent are construed in a grant can have no application to the case under consideration, as every requisite, in both acts, is essential to the title.

A renewal of the term of fourteen years can only be obtained by having the title-page recorded with the clerk and the record published on the page next to that of the title, and public notice given within six months before the expiration of the first term. In opposition to the construction of the above statutes as now given, the counsel for the complainants referred to several decisions in England on the construction of the statute of 8 Anne and other statutes.

In the case of *Beckford v. Hood*, 7 Term R., 620, the court of king's bench

decided "that an author whose work is pirated before the expiration of twenty-eight years from the first publication of it may maintain an action on the case for damages against the offending party, although the work was not entered at Stationers' Hall." But this entry was necessary only to subject the offender to certain penalties provided in the statute of 8 Anne. The suit brought was not for the penalties, and, consequently, the entry of the work at Stationers' Hall was not made a question in the case. In the case of *Blackwell v. Harper*, 2 Atk., 95, Lord Hardwicke is reported to have said, upon the act of 8 Anne, ch. 19: "The clause of registering with the Stationers' Company is relative to the penalty, and the property cannot vest without such entry;" for the words are, "that nothing in this act shall be construed to subject any bookseller, etc., to the forfeitures, etc., by reason of printing any book, etc., unless the title to the copy of such book hereafter published shall, before such publication, be entered in the register book of the Company of Stationers."

The very language quoted by his lordship shows that the entry was not necessary to an investiture of the title, but to the recovery of the penalties provided in the act against those who pirated the work. His lordship decided in the same case that "under an act of parliament providing that a certain inventor shall have the sole right and liberty of printing and reprinting certain prints for the term of fourteen years, and to commence from the day of first publishing thereof, which shall be truly engraved with the name of the proprietor on each plate, and printed on every such print or prints," the property in the prints vests absolutely in the engraver, though the day of publication is not mentioned." The authority of this case is seriously questioned in the case of *Newton v. Cowie*, 4 Bing., 241. And it would seem, from the decision of Lord Hardwicke, that he had doubts of the correctness of the decision, as he decreed an injunction without by-gone profits. And Lord Alvanly, in the case of *Harrison v. Hogg*, cited in 4 Bing., 242, said "that he was glad he was relieved from deciding on the same act, as he was inclined to differ from Lord Hardwicke."

By a reference to the English authorities in the construction of statutes, somewhat analogous to those under which the complainants set up their right, it will be found that the decisions often conflict with each other; but it is believed that no settled construction has been given to any British statute, in all respects similar to those under consideration, which is at variance with the one now given. If, however, such an instance could be found, it would not lessen the confidence we feel in the correctness of the view which we have taken.

The act of congress under which Mr. Wheaton, one of the complainants, in his capacity of reporter, was required to deliver eighty copies of each volume of his reports to the department of state, and which were, probably, faithfully delivered, does not exonerate him from the deposit of a copy under the act of 1790. The eighty volumes were delivered for a different purpose, and cannot excuse the deposit of the one volume as specially required. The construction of the acts of congress being settled, in the further investigation of the case it would become necessary to look into the evidence and ascertain whether the complainants have not shown a substantial compliance with every legal requisite. But on reading the evidence we entertain doubts which induce us to remand the cause to the circuit court, where the facts can be ascertained by a jury.

And the cause is accordingly remanded to the circuit court, with directions

to that court to order an issue of facts to be examined and tried by a jury, at the bar of said court, upon this point, viz.: whether the said Wheaton as author, or any other person as proprietor, had complied with the requisites prescribed by the third and fourth sections of the said act of congress, passed the 31st day of May, 1790, in regard to the volumes of Wheaton's Reports in the said bill mentioned, or in regard to one or more of them, in the following particulars, viz.: whether the said Wheaton or proprietor did, within two months from the date of the recording thereof in the clerk's office of the district court, cause a copy of the said record to be published in one or more of the newspapers printed in the resident states, for the space of four weeks; and whether the said Wheaton or proprietor, after the publishing thereof, did deliver or cause to be delivered to the secretary of state of the United States, a copy of the same to be preserved in his office, according to the provisions of the said third and fourth sections of the said act. And if the said requisites have not been complied with in regard to all the said volumes, then the jury to find in particular in regard to what volumes they or either of them have been so complied with.

§ 16. *A reporter can have no copyright in the written opinions of the supreme court of the United States.*

It may be proper to remark that the court are unanimously of opinion that no reporter has or can have any copyright in the written opinions delivered by this court; and that the judges thereof cannot confer on any reporter any such right.

Reversed. (a)

(a) MR. JUSTICE THOMPSON dissented, holding, from a review of the authorities, that, "by the common law of England, down, at least, to the decision in the case of *Donaldson v. Beckett*, 4 Burr., 2408, an author was considered as having an exclusive right, in perpetuity, to his literary compositions. That this right, as a branch of the common law, was brought into Pennsylvania with the first settlers as early as the year 1682. That whatever effect and operation the statute of Anne may have been deemed to have had upon the common law in England, that statute never having been in force in Pennsylvania, the common law right remains unaffected by it." After examining the statutes on the subject, he says: "But if the complainants in the court below have not made out a complete right under the acts of congress, there is no ground upon which the common law remedy can be taken from them. If there be a common law right, there certainly must be a common law remedy. The statute contains nothing in terms, having any reference to the common law right; and if such right is considered abrogated, limited, or modified by the acts of congress, it must be by implication; and to so construe these acts is in violation of the established rules of construction, that where a statute gives a remedy in the affirmative, without a negative expressed or implied, for a matter which was actionable at common law, the party may sue at common law, as well as upon the statute. 1 Chitty's Pl., 144. This is a well settled principle, and fully recognized and adopted in the case of *Almy v. Harris*, 5 Johns., 175.

"Whatever effect the statute of Anne may have had in England, as to limiting or abridging the common law right there, no such effect upon any sound rules of interpretation can grow out of our acts of congress. There is a wide difference in the phraseology of the laws. The statute of Anne contains negative words. It declares that the author shall have the sole right and liberty of printing, etc., for the time contained in the statute, and no longer; and these are the words upon which the advocates for the limitation of the common law right mainly rest; and it was, for a long time, considered by the ablest judges in England that even these strong words did not limit or abridge the common law right; and the question, at this day, is not considered free from doubt.

"This act, and the construction which it had received in England, were well known and understood when the act of congress was passed, and no such limitation is inserted or intended, or any matter at all repugnant to the continuance of the common law right, in its full extent. These laws proceed on the ground that the common law remedy was insufficient to protect the right, and provide additional security, by means of penalties, for a violation of it. Congress having before them the statute of Anne, and apprised of the doubt entertained in England as

BARTLETT v. CRITTENDEN.

(Circuit Court for Ohio: 5 McLean, 32-43. 1849.)

Opinion of the Court.

STATEMENT OF FACTS.— This bill is brought to protect the copyright of the complainant, in a manuscript work on book-keeping, of which he claims to be the author; and the defendant is alleged to have published a work on the same subject, which the complainant charges was copied from his manuscript. For twelve years and upwards the complainant has been engaged in teaching the art of keeping books, and has used his work, which is still in manuscript, in his school, with the view of rendering it more perfect, and with the intention of publishing it. The work of the defendant contains two hundred and seven pages, ninety-two of which are alleged to have been taken from the plaintiff's manuscript, with only colorable alterations. The answers deny the allegations in the bill.

A reference was made to a master, with special instructions, who reports "that the book of the respondents contains a portion of plaintiff's manuscript, with only slight alterations; and he says that it is impossible that the book and the manuscript could have been composed by two persons, neither having for his guide the entries of the other. The balance sheets are the same in both. As regards the plan and arrangement, they are the same. The book contains explanations, which are valuable to the learner, that are not in the manuscript. Both works consist of a series of brief sets of mercantile books by double entry."

The master reports that the plan of the work in the manuscript and in print is substantially the same; that in the book there are explanations interspersed through the series of sets, which the manuscript does not contain; that these explanations are of great use to the learner, but that they may be verbally given with equal advantage. The system in the manuscript, the master states, is superior to any he has seen, except that of the book published by the defendant, which is the same in substance; "that, unlike all the systems he had seen, the manuscript is made up of a few brief sets of mercantile books, which show the entire process of ordinary double entry book-keeping, and in a compass of very little magnitude;" and he says, that "he discovers in other treatises nothing bearing a resemblance to the manuscript plan. He therefore concludes that the plan is original."

"The manuscript, in its present state (the master says), contains substantially a system of book-keeping, suitable to be used by a teacher in his school." "As the system, when published, becomes its own teacher, it should be accompanied with such precise explanations as may be necessary to a proper understanding and use of it by the uninitiated. It should also be accompanied with forms of the auxiliary books."

Jonathan Jones, of St. Louis, a witness, states that, in 1841, he opened a school in St. Louis, as the partner of the complainant, for instruction in book-keeping on Bartlett's plan, which consists "of eleven sets of books, with a balance sheet for each set, and an inventory attached, showing property on hand, and that Bartlett was the author of them; that his manuscript contains

to its effect upon the common law right, if it had been intended to limit or abridge that right, some plain and explicit provision to that effect would doubtless have been made; and not having been made, is, to my mind, satisfactory evidence that no such effect was intended."

BALDWIN, J., also dissented.

a perfect system of book-keeping, and differs from all others in arrangement, being composed of short exercises." The defendant, Crittenden, entered the school ignorant of book-keeping; and after completing the course, he took charge of the writing department for a short time.

In 1846, Crittenden called on the witness with a copy of his work, which, on examining, the witness found to be Bartlett's system. And Crittenden then told him that when he was in Bartlett & Co.'s school he took a precise copy of the manuscript, with the view of publishing it; and that he did publish it in 1845. And the witness says, if all of Bartlett's manuscript were struck from Crittenden's book, there would not be enough left for a title-page. A copy of Bartlett's manuscript was used at the St. Louis school, and witness never prohibited any of the learners from copying it. Crittenden knew that it was Bartlett's manuscript, and that he intended to publish it as soon as he could make the necessary arrangements. Witness has heard Bartlett frequently say so. Witness gave Crittenden a letter to Bartlett referring to the published work, that Bartlett might see it.

To Josiah Bliss, a witness, Crittenden said that his system was the same as Bartlett's. Nine other witnesses, who are book-keepers, being sworn, state that Bartlett's system of book-keeping is new; and that its plan and arrangement are preferable to any other. And they say that Crittenden's book is the same in substance.

On the part of the defendant, James T. Annan was sworn, who says that he has been a book-keeper for fifteen years,—has examined Bartlett's system, and finds nothing new or original in it, either in the forms of stating the accounts, or in the arrangement, or in any particular; that the materials are not new in matter or form; nothing could be taught by it without rules and explanations, and auxiliary books; and that it is wholly unfit for publication; that a cash book is essential to a complete system, and that Bartlett substitutes for it a cash account. The individual who conducts the business is not named in the exhibit, and there are no indexes.

Richard Miller, who has been a book-keeper for twenty-five years, agrees with the statement of Annan, and adds that, in Bartlett's plan, there is properly no day-book, only a waste-book, from which to make the day-book entries.

John Gundry has been a book-keeper and teacher for seven years, and he agrees with Annan. He says Bartlett has more sets than usual; but he had used the same, or about the same, number more or less. Bartlett's plan contains no definition of terms, such as drafts, bills of exchange, acceptances, etc.,—no mercantile forms, such as bills receivable and payable, account of sales, account current, etc.,—no forms of calculations, viz.: interest, discount, commission, equation of payments, reduction of currencies. But he says that no work has come to his knowledge wherein the theory has been carried out to so great an extent as in Bartlett's, though many authors have recommended it. He never saw the identical entries until the spring of 1842, when he examined Bartlett's manuscript. In 1845 witness united with Bacon to teach book-keeping, who had been using Bartlett's system, and they continue to use it in the school.

The complainant claims relief on two grounds: 1. At common law. 2. Under the act of congress, 3d February, 1831. In the case of *Wheaton v. Peters*, 8 Pet., 655 (§§ 12-16, *supra*), the supreme court say: "That an author, at common law, has a property in his manuscript, and may obtain redress against any one who deprives him of it, or, by improperly obtaining a copy, endeavors

to realize a profit by its publication, cannot be doubted." And again, page 661: "An author has, by the common law, a property in his manuscript; and there can be no doubt that the rights of an assignee of such manuscript would be protected by a court of chancery."

§ 17. *A writer has property in his own manuscript.*

In combating the argument in the same case, that an author had a common law right to republish his own works, and to prohibit others from doing so, the court showed that, after the statute of Anne, there was no such right in England, and that, if such right were shown to exist there, it did not follow that it exists to the same extent in Pennsylvania. That the common law in this country exists in the different states, as modified by them by statutory enactments and judicial decisions. But the question under consideration is very different from the one decided in the above case. We have to say whether the writer has a right of property in his own manuscript. That he has such a property in his own literary labor, until he shall relinquish it by contract or by some unequivocal act, would seem to be clear. This is laid down in *Maughon on Lit. Property*, 74 and 137; *Webb v. Rose*, 4 Burr., 2330; *Pope v. Curl*, 2 Atk., 342; *Manley v. Owens*, Burr., 2320; *Southey v. Sherwood*, 2 Meriv., 434; 2 Story on Eq., sec. 943.

Lord Mansfield, and some others distinguished for their great learning and ability, have considered the publication of a work not as such a dedication of it to the public by the author, at common law, as to deprive him of an exclusive right to republish it.

§ 18. *A publication of a work is a dedication to the public.*

With the greatest respect for these opinions, we think there is a difference in principle between the right to republish a printed work and the exclusive right of an author to publish his own manuscript. A man may write without any intention to publish. He may treat of principles and characters without restraint — with a view to his mental improvement, or from some other motive, without incurring any responsibility so long as the manuscript remains unpublished. It is, therefore, essential, in all proceedings for a libel, to prove publication. And there is no law which can compel an author to publish. No one can determine this essential matter of publication but the author. His manuscripts, however valuable, cannot, without his consent, be seized by his creditors as property. They are valueless to all the world except to the author and his representatives; or to such persons as he shall transfer them. But the author who publishes his work dedicates it to the public. He voluntarily incurs all the responsibility of a publisher. His object is to instruct or amuse mankind, and the more his work is circulated, the greater is the compliment to his ability as a writer. There is no reason, then, against a republication of the work by any one, except that it may reduce the profits of the author. And, on this ground, he cannot complain, as he has failed to secure the right under the statute.

If the common law protects the rights of an author, as contended for, the statute was useless. An action for damages and an injunction would as effectually protect the rights of an author as any provisions of the statutes. But there is another view, which is still more conclusive, against the exclusive right to republish a printed work. The statute limits the right to a term of years. The common law right, if it exist, is without limitation. To hold, then, that there is a common law right, independently of the statute, is to disregard the statute. Whilst the common law protects the right of the author

to his manuscripts, it cannot be made to extend to the republication of a published work. As well might it be contended that the inventor of a machine, after it has gone into general use, by the acts of the inventor, may, by the common law, claim the exclusive right of making and selling it.

But we think this case is within the act of congress referred to. The section 9 of that act (4 Peters' Stat., 438) provides: "That any person or persons who shall print or publish any manuscript whatever, without the consent of the author or legal proprietor first obtained, shall be liable to suffer, and pay to the author or proprietor, all damages occasioned by such injury, to be recovered by a special action on the case founded on this act." "And the several courts of the United States empowered to grant injunctions to prevent the violation of the rights of authors and inventors are hereby empowered to grant injunctions," etc.

That the complainant is the author of the manuscript in question is proved. And it also appears, from the statement of the experts, and by the reports of the master, that the manuscript contains a new and useful system of book-keeping. The novelty consists in the mode of keeping accounts. It can consist in nothing else. The names and figures used in the items of debit and credit are of no importance, as they are only used to illustrate the mode or principle of the work. The manuscript was contained on different sheets or cards, for the convenience of teaching; but this is immaterial. Its parts were necessarily connected. Three or four of the witnesses state that there is no novelty in the manuscript — nothing that had not been taken from or might not be found in different works on book-keeping. But this is contrary to the views of the witnesses generally, and, especially, to the report of the master.

§ 19. *A manuscript is protected from piracy, though incomplete on account of a lack of explanatory notes.*

The objection that the manuscript does not contain a complete system, as explanatory notes, etc., are necessary and usual in such works, to enable the student to learn the art of book-keeping without an instructor, is not sustainable. A surreptitious publication of an important part of the manuscript is equally within the principle of the statute. But the notes are only explanatory of the system, as contained in the body of the work. They facilitate the progress of the learner, but they add nothing to the system. From the weight of the evidence including the master's report, Bartlett's system may be said to be complete for the purpose of teaching. Was there a publication of the manuscript of the complainant by the defendant? He has denied in his answer, somewhat equivocally, the charge of publication as made in the bill. He confessed to Jones that he took a copy of the manuscript with a view of publishing it, and that he did publish it in 1845. After the publication of his book, he admitted, to other witnesses, that the system of his work was the same as Bartlett's. It seems Crittenden became a student in the school of Bartlett and Jones, conducted by Jones at St. Louis, and in which he acquired his knowledge of book-keeping. The manuscript of Bartlett was used in that school, and it was there that the defendant made out his copy.

Independently of this proof, a comparison of the book with the manuscript will show that at least ninety-two pages of the book were substantially copied from the manuscript. The master says that they could not be the production of two minds. So nearly are they identical, that no one can read them without at once perceiving that one must have been copied from the other. The system is the same in both, and the discrepancies that appear only show the

intent of the copyist. It is believed that there is no case in the books where the piracy is more palpable.

The inconsistency of Jones in giving a letter to Crittenden, recommending him and his book to Bartlett, is explained in his testimony. He gave the letter to bring the fact of publication to Bartlett's notice. This act of the witness, though apparently inconsistent with his statements, does not destroy his credibility. He must have known, as he states, that the book contained Bartlett's system; but it was not for him to say, or to know, whether Crittenden, under the circumstances, was liable to an action for the publication. The facts of the case go strongly to show the probability that Crittenden told Jones, as he swears, that he copied Bartlett's manuscript.

§ 20. *The whole of a manuscript need not be published to constitute a violation of the copyright act.*

It is argued, to bring the case within the ninth section, that the whole of any manuscript must be published; that the principle of law in relation to colorable alterations of a printed book, or a fair abridgment of it, does not apply under this section to a manuscript. If the whole of the manuscript must be published, will the omission of a line or a word evade the statute? That it will, would seem to be the argument of the counsel. Under such a construction, the question might well be asked, of what value to an author is the statute? It purports to protect him against a fraudulent use of his manuscript; but practically it gives him no protection. It has been passed in mockery of his right. He is the sport of every man who has the disposition and the opportunity to pirate his manuscript. No such rule of construction is admissible. Has a substantial part of the manuscript been published? Does the book of the defendant contain Bartlett's system of book-keeping? Of this there can be no doubt. Such a publication is within the above section. It renders the manuscript valueless.

§ 21. *Property in manuscript does not depend upon the intention of the author as to publication.*

Was there an abandonment of the manuscript by Bartlett? This is the only remaining point to be considered, and it is the one most relied on in the defense. It satisfactorily appears from the evidence that Bartlett intended to publish his manuscript. And this is only material on the question of abandonment. His right of property in no way depends on his intention in this respect.

His manuscript was used in the school taught by himself in Cincinnati, and by the partnership school taught by Jones in St. Louis. In both these schools the manuscript was studied by the pupils, and they were required to copy certain parts of it, and were at liberty to copy the whole. These schools, and especially the one at Cincinnati, have been in operation several years. And under these circumstances, it is contended, there was an abandonment of the manuscript.

Bartlett's right of property in his manuscript may be transferred or abandoned, the same as any other right of property. Where the copyright of a published work is secured, under the statute, the author, by using the work in imparting instruction to his pupils, or by disposing of it to a friend, does not thereby transfer his exclusive right to publish it, or incur a suspicion that he intends to abandon it. And how does this differ from the case under consideration? In both cases the law gives a right of property to the author, and a remedy to enforce that right. And in both cases he may transfer or abandon that right. The evidence of a transfer or abandonment must be

as clear and as specific in the one case as in the other. An acquiescence in the publication of his manuscript, or in the republication of his printed book, would authorize the presumption of an assignment or of an abandonment. To make a gift of a copy of the manuscript is no more a transfer of the right, or abandonment of it, than it would be a transfer or an abandonment of an exclusive right to republish, to give the copy of a printed work.

In his treatise on Equity, section 943, Mr. Justice Story says: "In cases of literary, scientific and professional treatises in manuscript, it is obvious that the author must be deemed to possess the original ownership, and be entitled to appropriate them to such uses as he shall please. Nor can he justly be deemed to intend to part with that ownership by depositing them in the possession of a third person, or by allowing a third person to take and hold a copy of them. Such acts must be deemed strictly limited, in point of right, use and effect, to the very occasions expressed or implied, and ought not to be construed as a general gift or authority for any purposes of profit or publication, to which the receiver may choose to devote them." And he says, to prevent the publication of manuscripts, without the consent of the author, an injunction should be issued. Even the publication of private letters by the person to whom they were addressed may be enjoined. This is done upon the ground that the writer has a right of property in his letters, and that they can only be used by the receiver for the purposes for which they were written. So far as this, and in justification or defense, an individual has an interest in letters received by him. *Eden on Inj.*, ch. 13, pp. 275, 276; *Duke of Queensbury v. Shebbeare*, 2 *Eden*, 329; *Southey v. Sherwood*, 2 *Meriv.*, 434, 436; *Macklin v. Richardson*, *Ambl.*, 694; *Pope v. Curl*, 2 *Atk.*, 342; *Lord Perceval v. Phipps*, 2 *Ves. & Beam.*, 19, 24; *Gee v. Prichaid*, 2 *Swanst.*, 403, 415, 422, 425.

"No length of time will authorize the publication of an author's original manuscript without his consent." In 1804, the court of sessions of Scotland interdicted, at the instance of the children, the publication of the manuscript letters of the poet Burns. *Cadell v. Stewart*, 1 *Bell's Com.*, 116*n*. Lectures, oral or written, cannot be published without the consent of the lecturer, though taken down when delivered.

Manuscript reports were copied by the clerk of a gentleman, to whom the author had lent them, and the chancellor granted an injunction to restrain the publication. *Forrester v. Waller*, 2 *Eden*, 328; *Eden on Inj.*, 322. The Earl of Clarendon delivered to defendant's ancestor the manuscript of the second part of his father's *History of the Rebellion*, with liberty to take a copy of it, and make what use of it he thought fit. Complainant, who was Lord Clarendon's representative, obtained an injunction from Lord Northington, who said that it could not have been the donor's intention that the donee should print the work, though he might make every use of it except that. *Duke of Queensbury v. Shebbeare*, 2 *Eden*, 329.

Lord Eldon refused to grant an injunction until the right was tried at law, where the manuscript had been in the hands of a publisher twenty-three years, and had not been called for by the plaintiff. *Southey v. Sherwood*, 2 *Meriv.*, 435. Sparks had procured from the representatives of Washington the right of publishing his letters and other writings, and had done so in twelve volumes. Upham, in his *Life of Washington*, had taken many of these letters from Sparks, they never having been published before. On a bill filed, Mr. Justice Story said: "Unless there be a most unequivocal dedication of private letters

and papers by the author, either to the public or some private person, I hold that the author has a property therein, and that the copyright thereof exclusively belongs to him." And he granted an injunction. *Folsom v. Marsh*, 2 Story, 100 (§§ 249-56, *infra*). The manuscript of Bartlett was used in his school at Cincinnati, and in the school at St. Louis, for the purpose of imparting instruction to the pupils, and it does not appear, from the evidence, that copies were required or permitted to be taken of it for any other purpose. There is nothing in the testimony from which an implication can arise that Bartlett consented to the publication of his manuscript by the defendant, or that he ever abandoned it. It seems he was much excited when he was informed of the publication of Crittenden, and shortly afterwards instituted this suit.

An injunction will be granted to restrain the defendants from a further publication of the first ninety-two pages of the work, or sale of it; and a reference is made to a master to ascertain the number of copies sold, and the number on hand, etc., and that he report at the next term.

BOUCICAULT *v.* HART.

(Circuit Court for New York: 13 Blatchford, 47-60. 1875.)

Opinion by HUNT, J.

STATEMENT OF FACTS.—The facts as alleged in the bill are as follows: The complainant, Dion Boucicault, a citizen of the United States and a resident of the state of New York, before October 26, 1874, composed and wrote a dramatic composition called the "Shaughraun," of which he is sole proprietor. On the 26th of October, 1874, he mailed to the librarian of congress a printed copy of the title of this play, and received from the said librarian the usual certificate setting forth the said filing of the title of said dramatic composition, "the right whereof he" (said Boucicault) "claims as author and proprietor in conformity with the laws of the United States respecting copyrights." He complied in all respects with all the provisions of the Revised Statutes of the United States as to copyrights. On the 24th of November, 1874, Boucicault caused said play to be performed before persons licensed by him to witness the same, at Wallack's Theater, for the especial benefit of said Boucicault, and such performances have continued there for his benefit and profit, and said drama has never been performed otherwise or elsewhere with his consent. Boucicault never printed said play for circulation or publication or sale, and the play is still in manuscript, and has never been published, circulated or sold, or copied, or used in any way, with the permission of Boucicault, unless in the said performance of said play at Wallack's Theater for Boucicault's benefit. The defendant Hart is owner of a theater on Broadway called the Theater Comique. He possessed himself, surreptitiously, without the consent of Boucicault, of the manuscript of the "Shaughraun," thus made himself acquainted with its contents, and printed and published the manuscript, or a material part thereof, under the name of the "Skibbeah," a play which professed to be "arranged" by one G. L. Stout. This play has twelve scenes, and eight of them are copied from Boucicault's play of the "Shaughraun." Defendant has printed and published said "Skibbeah," and publicly announced his intention to sell copies of the same, containing these eight scenes of Boucicault's play, without the license or consent of Boucicault. Defendant did also, on the 26th of January, 1875, and continuously since then, up to the granting

of an injunction in this suit, publicly represent this "Skibbeah" at his Theater Comique on Broadway. Boucicault at that time remonstrated with the defendant, in writing, against his representing this play. The "Skibbeah," as far as these eight scenes are concerned, is merely a copy of Boucicault's "Shaughraun." It is, in plot, situation, stage business, language, costumes, scenery, incidents and series and sequence of events, identical with Boucicault's play of the "Shaughraun." The four scenes which are not taken from the "Shaughraun" are taken from a play of which one Reeve is author, called "Pyke O'Callaghan," and these four scenes are merely introductory and accessory to the other eight scenes, which contain the material part of the said "Skibbeah," and are a mere copy of Boucicault's "Shaughraun." The bill prays for an injunction restraining the defendant from performing and representing the said play, or from printing or publishing any copy of the same, and for other relief.

To this bill the defendant demurs upon the following grounds, viz.: For that it appears, on the face of the bill, that the said drama called "Shaughraun" has been, for a greater period than ten days prior to the commencement of this suit, publicly performed, and caused to be publicly performed, by the complainant, upon the stage of a theater; and it does not appear by said amended bill that two printed copies of said drama, or any copies thereof, were filed in the office of the librarian of congress, or sent by mail to said librarian of congress, at Washington, District of Columbia, within ten days after the public performance thereof, or at any other time; and for that it is alleged, in said amended bill, that the complainant has never published, or caused to be published, the said drama called "Shaughraun;" and for that it does not appear, by said amended bill, that the complainant has ever given any notice that he has complied with the requirements of the acts of congress respecting copyrights; and for that it does not appear, by said amended bill, that the complainant has ever given any notice that the said drama is secured by copyright.

It is admitted, by these pleadings, that the plaintiff is the author of the literary work in question. It is also admitted that the defendant, without the consent and against the remonstrance of the complainant, made use of said work for his own benefit, by performing the same at his theater, and by printing and publishing copies thereof. The defendant insists that, in so doing, he has violated no law of the land; in other words, that the complainant has not taken the measures necessary to secure to himself the exclusive right to the performance or the publication of the drama called the "Shaughraun." The complainant relies upon the deposit of a printed copy of the title with the librarian of congress, as the act upon which the grant of copyright depends, and, having performed the act, insists that his copyright is complete. The defendant takes the position, that, no copies of the work being filed with the librarian, there is no right to sue; and that, to entitle an author to copyright, the author must deposit the book, as well as the title, with the librarian. This is the first question to be considered.

§ 22. *Acts of congress on the subject of copyright. Must be fully complied with.*

There is no common law of copyright which can affect this case. *Wheaton v. Peters*, 8 Pet., 657 (§§ 12-16, *supra*). The rights of the complainant to a copyright, if any he has, are conferred by the constitution and the statutes of the United States. It is there that we must look for them, and, unless there found, they do not exist. If conditions are imposed by statute, as preliminary

to the existence of such rights, their performance must be shown. All the conditions clearly imposed by congress are important, and their performance is essential to a perfect title. *Wheaton v. Peters, supra.* The constitution, in section 8, article 1, gives to congress power "to promote the progress of science and useful arts, by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." The first act of congress upon this subject was passed May 31, 1790. 1 U. S. Stat. at Large, 124. The first section of that act secured to the author the sole right of printing, publishing and vending his map, chart or book for the term of fourteen years "from the recording the title thereof in the clerk's office, as is hereinafter directed." The third section provided that "no person shall be entitled to the benefit of this act," where such book has been already published, "unless he shall first deposit, and in all other cases, unless he shall before publication deposit, a printed copy of the title . . . in the clerk's office," etc. "And such author . . . shall, within two months, . . . cause a copy of the said record to be published in one or more of the newspapers printed in the United States, for the space of four weeks." The fourth section required that, within six months after the publishing thereof, a copy of the book should be delivered to the secretary of state to be preserved in his office. The sixth section provided that any person who shall print or publish any manuscript without the consent of the author, etc., shall be liable to damages.

By a statute passed April 29, 1802 (2 U. S. Stat. at Large, 171), it was enacted that, in addition to the above requisites, the author should give information by causing a copy of the required record to be inserted in the title-page or the page of the book next to the title. This act of 1802 was repealed and the copyright acts were amended in 1831 (Act of February 3, 1831; 4 U. S. Stat. at Large, 436). Section 4 of that act provided that no person should be entitled to the benefit of the act unless he should, before publication, deposit a printed copy of the title of the book, etc., with the clerk of the district court where the author resided. It also provided that the author or proprietor of such book, etc., should, within three months from the publication of said book, etc., deliver a copy of the same to the clerk. The fifth section of that act provided that no person should be entitled to the benefit of the act unless he should give information of copyright being secured, by causing to be inserted in each copy of each edition published the words "Entered according to act of congress," etc. In July, 1870, congress passed an act to revise, consolidate and amend the statutes respecting patents and copyrights (16 U. S. Stat. at Large, 198). By section 90 of that act it was provided "that no person shall be entitled to a copyright unless he shall, before publication, deposit in the mail a printed copy of the title of the book, or other article, or a description of the painting, drawing, etc., for which he desires a copyright, addressed to the librarian of congress, and, within ten days from the publication thereof, deposit in the mail two copies of such copyright book or other article, . . . to be addressed to said librarian of congress, as hereinafter to be provided." The librarian is then directed to make a record of the name of such copyright book in words specifically described, and to give a copy of the same to the proprietor. By section 93 the proprietor of every copyright book is required to mail to the librarian of congress, within ten days after its publication, two complete printed copies thereof, and a copy of every subsequent edition. Section 97 enacts that no person shall maintain an action for the infringement of his copyright unless he shall insert a notice

thereof on the title-page or the page immediately following. The various acts mentioned have been referred to to show to some extent the history and previous condition of the law on the subject under consideration. They are all superseded by the Revised Statutes of the United States, a work undertaken by authority of a statute passed June 27, 1866 (14 U. S. Stat. at Large, 74), and taking effect on the 1st day of December, 1873 (§ 5595). Those statutes provide as follows: Section 4952 provides that the author of any book, map, dramatic composition, etc., on complying with the provisions of the chapter, shall have the sole liberty of publishing and printing the same, and, in the case of a dramatic composition, of publicly representing the same. Section 4953 provides that copyrights shall be granted for the term of twenty-eight years from the time of recording the title thereof in the manner thereafter directed. Section 4956 provides that no person shall be entitled to a copyright unless he shall, before publication, mail to the librarian of congress a printed copy of the title of the book or other article, etc., for which he desires copyright, nor unless, within ten days from publication, he mails two copies of the copyright book or other article to the librarian. Section 4957 provides that, immediately on receipt of the printed copy of the title of the copyright book or other article, the librarian is forthwith to record the same; and that he shall give a copy of the same when required. Section 4959 requires the delivery to the librarian of congress of two copies of the book, within ten days after publication. Section 4960 provides that the proprietor of a copyright book or other article, failing to mail printed copies of the book, etc., is to pay a penalty of \$25. Section 4964, referring to books, provides that if any person, after the recording of the title of any book, shall, without the consent of the proprietor of the copyright first had in writing, print or publish any copy of said book, he shall forfeit the copy, and be liable to an action. Section 4965 makes a similar provision as to maps, charts, etc., and protects them from the time of the recording of the title. Section 4966 provides that any person publicly performing any dramatic composition for which a copyright has been obtained shall be liable to damages. Section 4967 provides that any person who shall print or publish any manuscript without the consent of the author, who is a resident of the United States, shall be liable for all damages occasioned by such publication.

§ 23. *To secure the copyright of a book, etc., two copies must be filed with the librarian of congress within a reasonable time after the printed title of the work has been filed.*

In applying these statutes to the question before us, viz., whether a copyright becomes a perfected right upon the filing of the title of the book or composition with the librarian, or whether a deposit of the book is also necessary to complete that right, two points are apparent. The first is that the letter of the law does not, in any of the statutes cited, former or present, require the book to be filed, to confer a copyright. Under all of the statutes referred to, from that of 1790 to the Revised Statutes, the words of the law refer to filing the title-page and not to the deposit of the book. The second suggestion is, that it seems to be assumed throughout all of the statutes, that a copy of the book will, and must, within a short time after filing the title-page, be filed with the librarian of congress. Of this idea, section 4956 of the Revised Statutes affords an illustration. It had been enacted in the previous sections, that a copyright should be secured to authors, designers and composers; and, in this section, a definition is given, in a negative form, of the persons entitled to the

benefit of the law. "No person shall be entitled to a copyright, unless he shall, before publication, deliver at the office of the librarian of congress, or deposit in the mail, addressed to the librarian of congress, . . . a printed copy of the title of the book, etc., nor unless he shall also, within ten days from the publication thereof, deliver, etc., or deposit, etc., addressed to the librarian, etc., two copies" of the book, etc. Any person shall be entitled to a copyright, who, before publication, first, shall deliver to the librarian a printed copy of the title of the book, and second, shall, within ten days after the publication thereof, deliver to the librarian two copies of the same. The book may not be printed or published when the title-page is filed, and some right (inchoate perhaps) seems intended to be secured as of that date, although an actual printing or publication is not then made. But the expression "before publication" is based upon the idea that a printing or publishing will soon occur. This is put into clear meaning by the next clause of the section, that the author shall not be entitled to copyright, unless, "within ten days from the publication," he shall deliver two copies to the librarian. This means that the author is required to publish his work, and, after he has so published it, and within ten days, he shall deliver two copies to the librarian. It is not a fair interpretation of this section to hold that the filing of the title entitles to a copyright fully and absolutely, and that this may be defeated by a publication and failure to deliver two copies, but, as long as there is no publication, although it continue indefinitely, there is no lapse of the right. This construction is not permitted either by that idea which secures benefits to the author or inventor, upon the theory that the public is to be benefited, as well as himself, by his works, or by the principle pervading all this branch of the laws of patents, trade-marks, and copyrights, that an author or inventor must put his claim into the form of a well defined specification, work or composition, and so place it upon record that he cannot alter it to suit circumstances, and so that other authors and inventors may know precisely what it is that has been written or invented. The idea that an inventor may secure a patent for an invention of which he should not be required to file a specification would not be tolerated. He may file preliminary or precautionary papers until his invention shall be completed, he may amend his specifications, and he may obtain reissues. It was never heard, however, that he could conceal the particulars of his invention, and, by filing a general statement of a discovery or improvement, cut off the rights and claims of others. The principle I conceive to be the same in regard to a copyright, and I hold that, to secure a copyright of a book or a dramatic composition, the work must be published within a reasonable time after the filing of the title-page, and two copies be delivered to the librarian. These two acts are, by the statute, made necessary to be performed, and we can no more take it upon ourselves to say that the latter is not an indispensable requisite to a copyright than we can say it of the former.

§ 24. *All the requisites of the law must be complied with, in order to secure a copyright. Case cited.*

In examining the rights of parties under the statutes of 1790 and of 1802, the court held, in *Wheaton v. Peters*, 8 Pet., 664 (§§ 12-16, *supra*), that, to secure a copyright, all the requisites of the statute must be complied with. "The acts required," say the court, "to be done by an author to secure his right are in the order in which they must naturally transpire. First, the title of the book is to be deposited with the clerk, and the record he makes must be inserted in the first or second page; then the public notice in the newspa-

pers is to be given; and, within six months after the publication of the book, a copy must be deposited in the department of state. A right undoubtedly accrues on the record being made with the clerk and the printing of it, as required; but what is the nature of that right? Is it perfect? If so, the other two requisites are wholly useless. . . . But we are told they are unimportant acts. If they are indeed wholly unimportant, congress acted unwisely in requiring them to be done. But whether they are important or not is not for the court to determine, but the legislature. . . . They are acts which the law requires to be done, and may this court dispense with their performance? . . . The notice could not be published until after the entry with the clerk, nor could the book be deposited with the secretary of state until it was published. But these are acts which are not less important than those which are required to be done previously. They form a part of the title, and, until they are performed, the title is not perfect. The deposit of the book in the department of state may be important to identify it at any future period, should the copyright be contested or an unfounded claim of authorship be asserted."

The language of the Revised Statutes is stronger than that of the act of 1870. By the latter act (16 U. S. Stat. at Large, 213) it was provided that no person should be entitled to a copyright unless he should file the title-page with the librarian, "and, within ten days from the publication thereof, deposit in the mail two copies of such copyright book," etc. In the Revised Statutes two negatives are distinctly specified, and in either case the defect is fatal. He must file his title-page — if he fails in this he fails in all — but he cannot then have his copyright, "unless he shall also" deliver two copies within ten days from publication. In addition to the first he must also perform the second requirement. See the opinion of Sawyer, C. J., in *Parkinson v. Lasalle*, 21 Int. Rev. Rec., 163; *Ewer v. Coxe*, 4 Wash., 490; *Baker v. Taylor*, 2 Blatch., 82.

In this case the title-page was filed on the 26th of October, 1874. The bill, verified in February, 1875, does not allege any publication of the work, or any delivery of copies, or any reason why the same has not been done.

§ 25. *The exclusive right to print and the exclusive right to perform a play depend upon copyright.*

The complainant also insists that this action can be sustained by virtue of section 4966 of the Revised Statutes. That section provides that any person publicly performing any dramatic composition for which a copyright has been obtained, without the consent of the proprietor, shall be liable in damages, as therein stated. If no copyright has been obtained by the complainant for this composition, there has been no violation of a right secured by this section, and he takes nothing under this claim. By the act of August 18, 1856 (11 U. S. Stat. at Large, 138), it was enacted that the granting of a copyright to the author of a dramatic composition should be deemed to confer upon him the sole right to perform and represent the same on any stage during the period for which the copyright was obtained. The same power is found in section 101 of the statutes of 1870 (16 U. S. Stat. at Large, 214). Like the exclusive right to print, the exclusive right to perform, so far as these statutes are concerned, is dependent upon the existence of a copyright.

§ 26. *What is forbidden by section 4967, Revised Statutes.*

The bill alleges, also, that the defendant has, without the consent of the complainant, printed and published eight scenes of his play, and has publicly announced his intention to sell copies of the same. This proceeding is in vio-

lation of section 4967 of the Revised Statutes, which provides that every person who shall print or publish any manuscript without the consent of the author, if such author is a citizen of the United States, or resident therein, shall be liable to the author for all damages occasioned by such injury. The demurrer admits this publication, and the defendant must be restrained from printing or publishing the play.

The defendant seeks to avoid the effect of this allegation by the statement that the bill does not aver that such publication took place after the recording of the title of the complainant's play. This averment is not expressly made, but it must be taken to be the fact, upon the pleadings. It is averred that the complainant composed and wrote the play previously to November 14, 1874; that in October he filed a copy of the title-page, and the librarian recorded the same in the proper book kept for that purpose; that on the 14th of November he caused the same to be performed at Wallack's Theater; that he has never printed the play for circulation; and that the defendant, by means unknown to him, has obtained a knowledge of the contents of the manuscript, and, without his consent, has printed the same. The fair meaning of this is that this action of the defendant took place after the title of the play had been deposited and recorded.

§ 27. *A demurrer does not admit conclusions of law.*

In dealing with this case, I have given no effect to the general allegation of the bill, that the "complainant has complied in all respects with the requirements of the Revised Statutes," that were necessary to enable him to copyright his composition. A demurrer admits allegations of fact only, not allegations or inferences of law. That the allegation in question is not one of fact is well illustrated by this case. Does the allegation include an averment that the complainant has deposited with the librarian printed copies of his work as well as of his title-page? If such deposit is a requirement of the statute, it does include it. If it is not, it does not include it. We are thus directed at once to the solution of a question of law instead of a point of fact. Instead of averring that he has deposited a copy of his title-page, and also two copies of the body of the book, the bill alleges that the complainant has deposited a copy of his title-page, and that he has never published his work, and was, therefore, not required by the statute to deposit copies of the work. This is the legal effect of the averment.

§ 28. *What not a publication or a dedication.*

I am also of the opinion that there has never been a publication by the complainant of this work within the meaning of the statute. The work has not been printed by the author, nor has it been abandoned or dedicated to the public. The author has permitted and procured its representation for his own benefit, and through his selected channels. This does not amount to a publication within the statute, or a dedication to the use of the public. *Coleman v. Wathen*, 5 Term R., 245; *Palmer v. De Witt*, 2 Sweeny, 547; S. C., 47 N. Y., 532; *Bartlette v. Crittenden*, 4 McL., 300; *Roberts v. Myers*, 23 Monthly Law Rep., 396; *Keene v. Kimball*, id., 660. The English decision (*Boucicault v. Delafield*, 9 Law Times, new series, 709), cited to the contrary, is based upon the peculiar language of the English statute, and is not an authority in this case.

§ 29. *A federal court has no right to administer common law relief in a suit between two citizens of the same state. Author's rights at common law.*

I am of the opinion, however, that the defendant has violated the complain-

ant's common law right of ownership in his dramatic composition. The copyright law is intended to preserve to the complainant his exclusive right to multiply copies, to publish, and, in my judgment, only attaches perfectly where a publication is made. The ownership, however, and the right of an author to retain and use his dramatic works, for his personal benefit, without publication, is a common law right. It is recognized and defined by the statutes cited, but it exists independently of the statutes. In *Palmer v. De Witt*, 2 Sweeny, 547, the court says: "Whatever may have been the conflict of judicial opinion upon the effect of copyright laws upon the common law rights of authors, it has never been disputed, that, by the common law, an author has, until publication, a property in his literary work, capable of being held and transmitted, and in the exclusive possession and enjoyment of which he and his assignees will be protected." In the opinion of Monell, justice, in that case, all the authorities are collected and presented. The same case is reported in 47 N. Y., 532. It is there held that the representation of a play on the stage is not such a publication or dedication to the public as authorizes others to print and publish it without the author's permission. The manuscript and the author's right are still within the protection of the law. The common law rights of authors to their literary productions, as they existed at common law, are now recognized. The author has the exclusive right to the first publication of his work, but no exclusive right to multiply copies or control the subsequent issues. This latter right is the creation of the statute of the United States. *Boucicault v. Fox*, 5 Blatch., 97 (§§ 35-39, *infra*); *Boucicault v. Wood*, 7 Am. L. Reg., 550. Assuming this to be so, the difficulty arises that this court has no power to administer common law relief in a suit between citizens of the same state. The courts of the state are the proper, and, usually, the exclusive tribunals for the performance of that duty. The United States have jurisdiction of common law questions when the controversy is between citizens of different states. When the controversy is between citizens of the same state, its jurisdiction is limited to questions arising upon or under the laws or authority of the United States.

The result of my examination is, that the portions of the bill based upon alleged violations of the statute respecting copyright cannot be sustained; that the portions thereof based upon the alleged violation of section 4967 of the Revised Statutes are well laid, and the cause of action therein set forth is a good one; and that the common law right of the complainant to a protection in the performance of his play constitutes a good cause of action, but, by reason of the parties being citizens of the same state, this court has no jurisdiction to enforce the same.

The demurrer must therefore be overruled, and the defendant is allowed to answer within thirty days after service of a copy of the order overruling the demurrer.

CROWE *v.* AIKEN.

(Circuit Court for Illinois: 2 Bissell, 208-215. 1870.)

Opinion by DRUMMOND, J.

STATEMENT OF FACTS.—The bill in this case was filed to prevent the performance in Chicago of a drama called *Mary Warner*, by the defendant, who is manager of a theater. It is based not upon any copyright statutes, but on the principles of the common law and of equity. Mr. Tom Taylor, a subject of the queen of Great Britain, is the author of the drama. The plaintiff is the

husband of an actress of distinction known to the public as Miss Kate J. Bateman. The play, written by Mr. Taylor for Miss Bateman, and the principal character to be personated by her, in pursuance of a contract between the plaintiff and Mr. Taylor made in February, 1869, at London, was not intended for publication, but for representation on the stage. After it was completed the author duly transferred in writing to the plaintiff all his right in the play and in the manuscript thereof, together with the exclusive right to its representation on the stage in the United States for five years from June 1, 1869. The manuscript was accordingly delivered to the plaintiff, and the play was represented at the Haymarket theater, in London, in June, 1869. Afterward the plaintiff and his wife came to the United States, and Mary Warner has been performed at Booth's theater in the city of New York.

The foregoing facts do not appear to be controverted. The bill alleges that the play has always been kept in manuscript; that it has never been printed by Mr. Taylor, by the plaintiff, nor by Miss Bateman, nor with the consent or acquiescence of any one of them, nor published with the consent or acquiescence of any one of them, otherwise than by a representation on the stage, and that the defendant did not produce it at his theater by means of the memory of those who had witnessed its representations on the stage, but by a copy wrongfully and surreptitiously obtained from the manuscript, or from a printed copy wrongfully and fraudulently printed. An injunction was issued by the court, and the performance of Mary Warner by the defendant's company stopped. The defendant now appears and moves to dissolve the injunction.

The motion has been fully argued by the counsel of the defendant upon two grounds: *First*, the law of the case as settled in England and in this country. *Second*, on the facts contained in the affidavits of Robert M. De Witt and Charles J. Clarke, both of New York.

The affidavit of De Witt states that he furnished the defendant with a copy of the play used by him; that he procured it from a person in London, on or about the 29th of July, 1869, who obtained the same only from repeated representations on the stage at the Haymarket theater; that there was no restriction or prohibition against any of the spectators using such play as they saw fit. He also states he is advised that by section 20 of 5 and 6 Victoria, chapter 45, "The first representation or performance of any dramatic piece in England is deemed equivalent to the first publication of a book."

The affidavit of Clarke states that the play of Mary Warner was in print in the city of New York as early as August, 1869; that he bought a printed copy of the play at a public news-stand in New York, where the same was publicly exposed for sale.

The copy furnished to the defendant has been exhibited in court. It is not in the usual form of a published play, but consists of printed slips fastened together in pamphlet form, with plats and stage directions as if for dramatic use only.

Various affidavits have been introduced by the plaintiff, from which it is apparent that the play of Mary Warner has never been printed with the knowledge or consent of Mr. Taylor, the plaintiff, nor Miss Bateman. It is not for sale generally in New York, and not at all in England. It is a fair inference, I think, from all that appears in the case, that the only printed copy in evidence was printed by Mr. De Witt, or under his direction, and is kept for sale at a high price to the theatrical managers. Mr. Clarke's affidavit was made on the 14th of December, and the copy referred to by him

may have been, and probably was, purchased directly or indirectly of De Witt or through his instigation, and as he does not state when, it may have been since this bill was filed.

It would seem, in answer to the allegations of the bill, the defendant ought to show that his copy of the play came from a printed or other copy authorized by the author or his assignee or from the memory of those present when the play was performed. The manner in which the play was procured in London is rather vaguely stated. It was from repeated representations only. But was it from the memory of those who heard it performed, or from phonographic reporters? The statement is entirely consistent with the latter source of information.

§ 30. *The common law right of property of an author in his work previous to publication.*

The author of any literary or dramatic work is the sole proprietor of the manuscript and its contents, and of copies of the same, independently of legislation, so long as he does not publish it, or part with the right of property. This is called a common law right, and exists irrespective of copyright statutes. This right of property he can transfer, and a court of equity will protect him or his assignee, in a proper case, just as it will the owner of any other species of property. Those judges who maintained this common law right in the cases of *Miller v. Taylor*, and in *Donaldson v. Becket*, decided a hundred years ago, it has always been thought, had the strength of the argument on their side in the great discussion to which they gave rise. Subject to the qualification stated, it has been generally admitted in this country.

§ 31. *The representation of a play on the stage is not at common law a publication.*

Mr. Taylor, then, was the proprietor of the drama *Mary Warner* when finished, and when transferred to the plaintiff the latter became the proprietor on the terms of the transfer. Has the right of property been lost?

It is conceded that it would be lost by any general publication of the play by the proprietor which could be regarded as a dedication to the public, but, save this, it is difficult to fix on any rule which shall meet the case. The giving of a copy or of several copies of a manuscript will not necessarily be a publication. The representation of a play on the stage was decided in England, before the statutes of 5 and 6 Victoria, not to be a publication.

There are cases in some of the courts of this country which hold that the representation of a play is a qualified publication, viz.: to the extent in which the memory of the auditors can retain its language, scenery or incidents, and if it is reproduced only in that way the author of the work has no remedy. Of these cases it may perhaps be said that, in some instances, the court has not looked very rigidly into the proofs, considering the intrinsic difficulty of the subject. Indeed, as some of the affidavits in this case show, and as all experience proves, to write out a play from memory alone is well nigh impossible.

None of the cases cited by counsel have gone so far as to decide that a reporter can take down the words of an unpublished play as they are uttered by the actors, and thus make it public against the wishes of the author, while, on the other hand, it has been frequently held that such action of a reporter can be prevented because not warranted by express or implied conditions. In some instances stress has been laid on the fact of representations of a play being had without restriction, and it is claimed *Mary Warner* was so

produced in England. This, however, is denied, and it is asserted public notice was given both in London and in New York of the private property in the play. It is not easy to see, however, how a notice can have any effect upon the rights of the author or of the auditor. If the latter had the right to carry the play away in his memory, or to take it down phonographically, and, in either case, to use or publish it, the notice prohibiting it could not affect or change that right.

§ 32. *The statute of 8 Anne took away the common law property of an author in a published book.*

The principal reason, probably, why courts are so much inclined to construe with great strictness the common law right of an author in a manuscript work, partially imparted to the public, is because the right is perpetual. All claims under copyright statutes are for a limited time only. This reason may have had great weight in the discussion which took place in England in the two cases already referred to, and the result of which was the adoption of the principle that the statute of 8 Anne, chapter 19, took away the common law property of an author in a published work. But this common law right is always under the control of the legislative power, and it has been exercised in England; and even under the qualified publication of a play by representation, there can be no doubt that under the rule now established in the courts it might become public property, in the manner heretofore stated, after repeated representations.

§ 33. *The statute 5 and 6 Victoria does not affect the rights of the author of a play in the United States.*

There was some question whether the author of a play had, at common law, the sole right of representation; but so long as the play existed in manuscript, and was unpublished, and not in some way dedicated to the public, the sole right of representation or performance would seem to follow from the exclusive right of property. But the twentieth section of the statute of 5 and 6 Victoria, chapter 45, put an end to this question, by declaring that the first public representation or performance of any dramatic piece should be deemed equivalent, in the construction of the act, to the first publication of any book; and I understand it has been decided in England that the public performance, even in a foreign country, of a play of which an English subject is the author, defeats his claim to a copyright under the British statutes.

It is insisted that as by this statute representation was publication, the play *Mary Warner*, by performance in England, was published there, and all right of property in the play was consequently lost, as well there as in the United States. This necessarily leads to the conclusion, and that is substantially the position of defendant's counsel, that there is no right of property in this country in the play, except that conferred by the statutes, and particularly that of August 18, 1856. 11 U. S. Statutes at Large, 138. I do not understand that the authorities have gone that far, and it does not follow because his claim under the statutes is gone, that everything is lost. He may still stand on his natural, inherent right as the author and creator of the play, and maintain that right until in some mode, in reason or by statute, it is dedicated to the public. It cannot be true in this country that the lecturer has no rights of property in his unpublished and unprinted lecture; that the clergyman has no rights of property in his unpublished sermon — the work, it may be, in each case, of weeks of thought and labor — merely because he has repeated it to an audience. And I cannot comprehend why, because congress has legislated

about dramatic compositions, the author of a play should occupy different ground. The object of all copyright laws is to protect and regulate property in the product of the brain, not to annihilate it.

There can be no doubt of the authority of congress to legislate on the subject of literary property, and to prescribe the terms upon which copyrights shall be granted, and when it has so legislated it may be truly said to create those rights under the law; and this is the sense of the language of the supreme court in the case of *Wheaton v. Peters*, 8 Pet., 661 (§§ 12–16, *supra*), that congress, instead of sanctioning an existing right, created it, because the court admits the right at common law. Neither, perhaps, can there be any doubt that congress can declare what sort of publications of a literary or dramatic work shall constitute a dedication to the public.

It follows from what has been said that a definition of the word representation by a British statute is not operative as such in this country, and in all the cases which have arisen here recently upon the rights of authors to unpublished plays written by Englishmen, the objection that their rights in this country were destroyed in consequence of the clause already referred to in section 20 of 5 and 6 Victoria, chapter 45, seems not to have been taken either by counsel or the court.

§ 34. *The representation of a play does not dedicate it to public uses.*

I am of opinion that upon principle and authority the author, or his assignee, of an unpublished play, has a right of property in the manuscript and its incorporeal contents; that is, in the words, ideas, sentiments, characters, dialogue, descriptions, and their connection, independent of statutes, and that a court of equity can protect it. I am also of opinion that as the law now exists in this country, the mere representation of a play does not of itself dedicate it to the public, except, possibly, so far as those who witness its performance can recollect it, and that the spectators have not the right to secure its reproduction by phonographic or other *verbatim* report, independent of memory.

These being my conclusions, the only other question is whether the defendant has brought himself within the condition named; and, after what has been said, it necessarily follows that in my judgment he has not. I cannot doubt that De Witt obtained the copy of the play of Mary Warner, which he furnished to the defendant in this case, either in whole or in part, through a short-hand reporter, or in some other unauthorized or wrongful way, and not by memory only. The case will therefore go to proofs in the regular way, and the injunction stand until the hearing.

BOUCICAULT v. FOX.

(Circuit Court for New York: 5 Blatchford, 87–102. 1862.)

Opinion by SHIPMAN, J.

STATEMENT OF FACTS.—The plaintiff, who is an actor and a dramatic author, made an arrangement with one Stuart, then the lessee of the Winter Garden theater in the city of New York, by which the former was to become the stage manager and general director of the theater. The particulars of this arrangement are of no importance here, as the undisputed proof in the case is that it was either never definitely settled in all its terms, or, if it was, that it was abandoned before the production of the play in question. Under that arrangement, however, such as it was, the plaintiff performed the duties of

stage manager for some weeks, during which the theater was at first successful, but, the receipts falling off, a new arrangement was made, under which "The Octoroon" was written and brought out by the plaintiff. It appears incidentally in the evidence that Stuart had, some time before, assigned his interest as lessee of the theater to one Fields, in trust for the benefit of certain of his creditors, although he continued to direct its operations, with the approbation and under the control of his trustee. The agreement under which "The Octoroon" was produced was, therefore, made with the assent of this trustee, and the assignment is here mentioned only for the purpose of explaining that fact, as it has no bearing on the merits of the controversy. By one of the terms of this agreement the plaintiff was to write this play, and he and his wife were to perform in it as long as it would run at the Winter Garden. He wrote it, and it was brought out about the 6th of December, 1859. The plaintiff and his wife took part in performing it until the 13th of the same month, when they withdrew, and the plaintiff declined to continue his own or his wife's services any longer. The play was, however, kept on the stage at this theater for several weeks after, although the plaintiff's connection with the theater had ceased on the 13th of December. On the 12th of December the plaintiff took out a copyright for the play. On the 17th of December he commenced a suit in equity in this court to restrain Stuart and Fields from any further representations of the piece. The performance of the play continued at the Winter Garden until Saturday evening, the 21st of January, 1860, when it was withdrawn, and on the Monday evening following it was brought out by the defendants at the New Bowery theater, where it was performed for nine successive nights. It is for these nine performances at the latter theater that this action was brought.

While the performance of the play was proceeding at the Winter Garden, a negotiation was opened between the defendants through their treasurer and agent, one Tryon, and Stuart, for the purchase of whatever rights the latter had in the manuscript, and also for the purchase of the scenery by which the performance was illustrated, which resulted in a verbal agreement between them, by which the defendants were to have all the rights of Stuart to the manuscript, and in its representation, for \$100. A further sum was agreed on for the scenery. The play was then announced for the New Bowery theater by the defendants in the following card: "To the public: Messrs. Fox and Lingard beg to inform their patrons and the public that they have purchased of W. Stuart, Esq., the proprietor of the 'Winter Garden,' the successful drama of 'The Octoroon,' with all the scenery, properties, music, machinery and everything appertaining to the piece, which will be produced in the," etc. During the negotiations between the defendants' agent and Stuart, the latter informed him that his right to the play was in suit, then pending, but the agent insisted that the right to the manuscript and to the performance of the play was in Stuart, and concluded the alleged purchase and received from Stuart a copy, the original being still in the hands of the plaintiff. This copy had been taken by Stuart (whether with or without the consent of the plaintiff does not appear) before the latter withdrew from the Winter Garden, as Stuart says, "for fear of accidents," and it would seem that it was from this copy, whenever reference to it was needed, that the piece was performed at this theater after the plaintiff withdrew.

On the trial the plaintiff proved the performance of the piece at the defendants' theater for nine nights, from the 23d of January to the 1st of February,

inclusive. On this point there was no opposing proof. The plaintiff also proved, from the record of copyrights in the possession of the clerk of the district court for the southern district of New York, that he obtained a copyright for the play on the 12th of December, 1859. The record of the suit in equity brought by the plaintiff against Stuart and Fields was also offered in evidence for the purpose of fixing the dates of the commencement and termination of that suit, to which the defendants objected. The court admitted the evidence only for the purpose for which it was offered, and the defendants excepted. This exception has not been noticed, on this argument, on the ground, no doubt, that the subsequent facts proved by the defendants' witness, Stuart, that such a suit was pending, and that he communicated the fact to the agent of the defendants when he proposed to purchase the play, renders the dates proved from this record clearly relevant. This exception requires, therefore, no further notice.

§ 35. *The United States courts are not empowered to grant a nonsuit where evidence has been taken in the cause.*

The plaintiff having rested his case, the defendants moved for a nonsuit, on the ground that the declaration did not allege that any copyright of the play had ever been taken out by the plaintiff, and on the further ground that the plaintiff had, by his own showing, by performing the piece for hire, dedicated the right to others, and abandoned his right to play the piece and to a copyright, except as regarded the mere right to print and publish the same. The court overruled this motion, on the ground that the courts of the United States are not empowered to grant nonsuits in cases where evidence has been taken; to which the defendants excepted. This exception, too, has not been mentioned on the argument. The ruling of the court was in conformity to well-settled authority and long practice. *Doe v. Grymes*, 1 Pet., 469; *D'Wolf v. Rabaud*, id., 476, 497 (CONTRACTS, §§ 1772-75).

§ 36. *Whenever matter which is in print or writing is presented to a court or jury for construction, the documents themselves must be produced, or reasons shown for their non-production.*

The defendants then introduced in evidence, among other things, the agreement between Stuart and the defendants, through their agent, for the purchase of the play, which has already been mentioned. They also proved that bills and advertisements announcing the play at the New Bowery theater stated that it was to be performed there by permission of Stuart, and that the plaintiff saw some of the bills and posters making this announcement, and did not object to or forbid the performance. The defendants also called as a witness John S. Dasalle, who stated that he was one of the editors of the Sunday Times newspaper; that he had seen the performance of "The Octoroon;" that he knew a novel called "The Quadroon," written and published by Mayne Reid; that it was published before "The Octoroon" was heard of; and that he was familiar with its contents. The defendants' counsel then put the following question to this witness: "Can you state whether the incidents contained in 'The Quadroon' are the same as those contained in the drama of 'The Octoroon?'" This question was objected to, on the ground that the book itself was not produced, and the question was excluded, and an exception was taken. The witness was then asked if he could state, from recollection, any passages contained in "The Quadroon" which were similar to those in "The Octoroon." This question was objected to, and the court excluded it, to which the defendants excepted. The defendants then offered to prove, by the statements of

the witness, that the play was dramatized from the book, and was not an original play. This evidence, in this form, was objected to and excluded. Finally, the defendants produced the book and asked the witness to take it and say whether the scenery, incidents and language were not substantially the same as those of the play. This question, also, was excluded. As these rulings were excepted to, and have been referred to on the argument, we will notice them here. Of all except the last it needs only to be said that neither the book nor the play had been produced in court. The book was in print and could easily have been obtained. To undertake to prove a part of its contents, or to ask the witness whether such part was identical with or resembled passages in the play, was wholly inadmissible under any known rule of evidence. Whenever matter which is in print or in writing is presented to a court or a jury, for the purposes of construction, or to establish proof of identity, resemblance or dissimilarity, the documents themselves must be presented for the inspection of the triers, or, on proper reason for their non-production being shown, their contents must be proved. The rule is trite, familiar and imperative. Nor was the difficulty removed by producing the book, prior to the last question put to the witness. The witness was asked to take the book and say whether the scenery, incidents and language were not substantially the same as those of the play. The play had not been produced, nor had its contents been proved; nor was the witness called upon to give any passage from it, for comparison with any part of the book. To take the opinion of the witness, under these circumstances, would be to substitute his judgment for that of the triers, and that, too, in the absence of the evidence upon which his judgment was founded. The rulings of the court excluding these questions were therefore correct.

At the close of the evidence the defendants requested the court to charge the jury as follows: 1. That the employment of the plaintiff by Stuart, to write the play, and its production and performance by the plaintiff, for hire, was a dedication to the profession of players, of the right to play the piece; 2. That the writing the play for hire and compensation paid to the author, and its delivery to Stuart, gave not only the title to the play, but a right to its use, as a literary composition; 3. That the voluntary public performance of the play, for hire, is such a publication as to amount to a dedication of the play to the use of the public; 4. That it was the duty of the plaintiff, under the circumstances of this case, to have given notice of his dissent to its performance by the defendants, and his failure to do so estops him from alleging a want of assent. This last request was subsequently modified, and the court was asked to charge that if the jury were satisfied that the plaintiff daily, or during the time, frequently saw one of the defendants at the place at which the piece was being performed, and saw the announcement of it, and knew that it was being played there, it was, as matter of law, his duty to express his dissent from the playing; otherwise the jury have the right, if they think proper, to draw the inference that it was with his assent. The court refused to charge according to the several requests of the defendants, to which refusal they excepted. They also excepted to the charge in the following particulars: 1. That the piece was an original play, and that the plaintiff was the author and entitled to a copyright; 2. That the plaintiff was entitled to the literary property in the play; 3. That the neglect to dissent did not constitute assent; 4. That there was no evidence of the abandonment of the play by the plaintiff; 5. That Stuart had no right that he could sell to the defendants in this suit. The charge of the

court will sufficiently appear, as we proceed to examine the following propositions, which condense the points presented in this controversy. The last of these propositions is not strictly in the case, but, by a liberal arrangement of counsel, it is submitted for our examination. These points are: 1. Was this, on the undisputed evidence in the case, an original play, and the production of the plaintiff? 2. Was the literary property in the composition, and the exclusive right to its representation, in the plaintiff? 3. Is there any evidence that he had abandoned to the public any of his rights? 4. Is there any evidence, except that which was submitted to the jury, that he assented to the performance of the play by the defendants? 5. By a careful comparison of the book called "The Quadroon" with this play, is there any evidence disclosed of a want of originality in the latter, which would be sufficient to support a verdict for the defendants, founded upon that evidence?

The first point we have to consider relates to the authorship of the play. On this, the evidence of Stuart, the defendants' witness, is clear and decisive, at least sufficiently so to establish a *prima facie* case, both as to authorship and originality. He states that the play was written by the plaintiff, under the special arrangement already referred to. It was to be a new play, and as such was put on the stage and had a successful run. Its originality does not appear to have been doubted by Stuart, who was familiar with the current dramatic literature of the day. It was virtually conceded on the trial, that the plaintiff constructed and wrote the play, although it was insisted that he drew his materials from "The Quadroon," to such an extent, and with so little modification, as to destroy his claim to originality. But the evidence offered in support of this latter claim was, we think, properly ruled out for the reasons already given. A clear *prima facie* case on this point having been made out, and nothing having been shown to rebut it, there would have been no error if the charge had assumed the fact as proved. This, however, was not the precise form of the charge. The language used was, that "if it was the original production of the plaintiff, the title was in him." But it is unnecessary to discuss this point at any length. A verdict for the defendants, resting on this feature of the case and on the evidence as it stood, could not be sustained. It would be clearly a verdict against evidence. The question whether or not, in point of fact, the use made of the materials of "The Quadroon," in the construction of the piece, was such as to deny to the latter the claim of originality, will be hereafter considered.

§ 37. *The title to literary property is in the author, and remains in him until transferred by contract to another.*

Our next inquiry is: Was the literary property in the composition, and the exclusive right to its representation, in the plaintiff? The questions under this head relate to the bearing on the plaintiff's title of the fact that he wrote the drama while in the employ of Stuart, and for hire, and also to the proof of his copyright. It is proper here to revert to the agreement under which this play was produced by the author. That agreement was, that he should write this play and, perhaps, some other plays, and that he should contribute his and his wife's services at the Winter Garden theater, as long as the plays would run there, and receive half the profits as a compensation. This cannot be construed into a contract conferring upon Stuart, or any one else, the legal or equitable title to this drama. The title to literary property is in the author whose intellect has given birth to the thoughts and wrought them into the composition, unless he has transferred that title, by contract, to an-

other. In the present case, no such contract is proved. The most that could possibly be said in regard to the right of Stuart, or his trustee, in the play, is that the arrangement entitled them to have it performed at the Winter Garden as long as it would run. There is not the slightest foundation upon which they, or either of them, can rest a claim to the literary property in the manuscript. That property was in the plaintiff, subject, at most, to a license or privilege, in favor of Stuart and Fields, to have the piece performed at the Winter Garden. Whether the plaintiff was guilty of a breach of that part of his agreement which bound him to bestow his own and his wife's services, we need not inquire here. Such a breach, if proved, would not vest the proprietors of the theater with the title to "The Octoroon." A man's intellectual productions are peculiarly his own, and, although they may have been brought forth by the author while in the general employment of another, yet he will not be deemed to have parted with his right and transferred it to his employer, unless a valid agreement to that effect is adduced. Publishers, when they employ authors in particular literary enterprises, of course settle, in the terms of their contracts, the rights of each party and the ownership of the copyright. This was not the case of writing a book for publication and general circulation. The play was to be produced, so far as Stuart and Fields were concerned, for a special purpose, and their rights are co-extensive only with that special purpose, which was that the play should be brought out by the plaintiff at the Winter Garden, and be performed as long as it would run. The contract cannot, by the most liberal construction, be expanded beyond this. Under these circumstances, the plaintiff was entitled to the copyright which he obtained. The proof of the obtaining of such copyright made a clear *prima facie* case, and no countervailing evidence was offered. The evidence in the present case is the same as in the case of *Roberts v. Myers*, 23 Monthly Law Rep., 396.

§ 38. *The public performance of a manuscript play by the author thereof cannot be regarded as any evidence of his abandonment of such manuscript to the public or to the profession of players.*

We come now to the third proposition: Is there any evidence in the case that the plaintiff had abandoned his rights to the public? It appears, in the proof, that the play was performed at the Winter Garden under the agreement, and, of course, with the consent of the plaintiff, for some six nights before the copyright was taken out. This is all the evidence there is of an abandonment to the public. From this the defendants argue that such a public representation for profit, prior to the taking out of a copyright, was a dedication to the public, or at least the theatrical public, including the profession of players, of the right to represent the play on the stage. No printed copy of the play having ever been circulated, it is not seriously contended that the plaintiff deprived himself of the right to print and publish it. This naturally brings us to an examination of the statute upon which the plaintiff rests for protection, and upon which his suit is founded. It is the act of August 18, 1856 (11 U. S. Stat. at Large, 138), and provides that "any copyright hereafter granted under the laws of the United States, to the author of any dramatic composition designed or suited for public representation, shall be deemed and taken to confer upon the said author or proprietor, his heirs or assigns, along with the sole right to print and publish the said composition, the sole right also to act, perform or represent the same, or cause it to be acted, performed or represented, on any stage or public place, during the whole period for which the copyright is obtained."

The object of this statute is apparent, at a glance. It is to secure to the author of a copyrighted play the sole right to its performance in any public place, after it is printed. While it is in manuscript he needs no protection. Manuscripts are protected by the common law, as well as by the ninth section of the act of February 3, 1831 (4 U. S. Stat. at Large, 438). *Wheaton v. Peters*, 8 Pet., 591, 657 (§§ 12-16, *supra*); *Jones v. Thorne*, 1 N. Y. Leg. Obs., 408; *Bartlett v. Crittenden*, 4 McL., 300; 5 McL., 32, 36. Whether a copyright had been taken out by the plaintiff or not, the defendants would have had no right to the use of his manuscript play; and, although they had obtained a copy without the consent of the plaintiff, a court of equity would have promptly restrained them from any use of such copy, beyond what the plaintiff had authorized. The reading of a manuscript lecture or discourse, or the performance of a manuscript play in public, by the author, does not confer upon the hearer any title to the manuscript, or any right to a copy, or to the unauthorized use of a copy, which may surreptitiously, or accidentally, pass into his hands. The jurisdiction of the courts of the United States is, indeed, confined, by the ninth section of the act of February 3, 1831, to cases of threatened or actual printing and publication, and would probably not include the public performance of a manuscript play, unless, indeed, the parties should be citizens of different states. But the jurisdiction of the state courts, in suits to protect the owners of manuscripts, is complete in all other emergencies. The plaintiff, then, being the original author of this play, his performance of it in public, or the performance of it by the company at the Winter Garden, with his consent, for a compensation to him, cannot be regarded as any evidence of his abandonment of the manuscript to the public, or to the profession of players. The copy taken by Stuart, whether with or without the consent of the author, was evidently intended by the latter for no other use than that connected with its performance at the Winter Garden, and Stuart had no right to put it to any other use, and could confer none upon the defendants. The common law protected this play, so long as it was in manuscript, or, at least, it was protected by equitable remedies. *Macklin v. Richardson*, Amb. R., 694; *Curtis on Copyright*, 103. The act of February 3, 1831, protects the right of the author to print and publish it. The act of August 18, 1856, superadds to the rights of the author, the exclusive right to the public representation of the play, after the copyright for printing and publishing it has been granted. The only effect of this act on the rights of the author, while his production is in manuscript, is, that it gives him a remedy at law against a party, after he has taken out his copyright, when, before, he possibly had only a remedy in equity. There can be no evidence of abandonment to the public of any rights growing out of the authorship of a manuscript, drawn from the mere fact that the manuscript has, by the consent and procurement of the author, been read in public by him, or another, or recited, or represented, by the elaborate performances and showy decorations of the stage. If the reading, recitation or performance is conducted by his direction, by his agents, for his benefit and profit, with the sanction of the law, how can it be said to be evidence of his intention to abandon his production to the public? Suppose Mrs. Kemble were to read, in her unrivaled manner, a drama of her own production, would the reading be a dedication to the public, and authorize any elocutionist to read it, who could obtain a copy, against the consent of the author? How would it change the matter, if she should, instead of reading the play, have it brought out by a company at Wallack's or the Winter Garden, with all the

embellishments which the stage can lend? The true doctrine is, that the literary property in the manuscript continues in the author so long as he exercises control over it, or has the right to control it; and, until its publication, no one has a right to its use or that of its contents, without his consent. Therefore, any special use of it by him, in public, for his own benefit, is a use perfectly consistent with his exclusive right to its control, and is no evidence of abandonment. *Roberts v. Myers*, 23 Monthly Law Rep., 396.

As to the fourth proposition very little need be said. It appeared in proof that the plaintiff several times passed the theater of the defendants during the time the play was in progress there, and that it was announced by large bill posters, which he must have seen. Indeed, it is conceded that while the piece was being played there the plaintiff knew it, and did not object, during the nine nights in question. The court was asked to charge the jury that, as matter of law, he ought to have objected, and that his failure to do so would warrant the jury in inferring his assent to the performance. If the defendants had been ignorant of the plaintiff's right, and had gone on under a misapprehension of the facts, or if they had supposed he assented, they might make this claim with a better grace. But the evidence shows conclusively that Stuart distinctly informed the defendants' agent, when he went to purchase the play, that his (Stuart's) right to it was disputed by the plaintiff in a suit then pending. It shows further that, instead of relying on the consent of the plaintiff, they impliedly disclaimed it, by publicly announcing in their cards and bill posters that the piece was purchased exclusively from Stuart, and was played with his consent. The plaintiff would be entitled to have a verdict against him on the ground of his assent, if one had been rendered against him on the evidence in this case, promptly set aside. The defendants knew before their purchase that the plaintiff was contesting, in a court of equity, Stuart's right to the play, even his right to perform it at the Winter Garden, and when they purchased it from him with this knowledge they took with it the most solemn form of dissent known to the law, and a notice that, if they played the piece, relying on Stuart's conveyance, it was at their own peril. But the jury were not directed on this point of assent, although it is conceived they might properly have been, on the ground that the proof of dissent was clear. They were instructed that if the plaintiff assented to the performance by the defendants then he could not recover; and that, in determining whether he did thus assent or not, they could take into consideration his silence when the piece was being performed at the New Bowery theater in connection with the other evidence. There was no error on this point.

§ 39. *Test of originality of literary productions.*

We come now to the last topic in this controversy, which relates to the originality of this drama, when compared with the novel of Mayne Reid, called "The Quadroon." Though, as already remarked, not strictly in the record, yet the question is one little fitted for investigation by a jury, and, for reasons already given, was not submitted to them. The counsel, however, have consented that the court may compare the two works, and, if the play cannot be sustained as an original production, then the verdict is to be set aside and a new trial is to be granted.

It is difficult to lay down any precise rule which can be applied, in all cases, as a test of originality. A work may be original in the eye of the law when it is not in the eye of the critic. Mr. Curtis, in his instructive work on copy-

right, well remarks: "A book may also be original, in the sense of the law, although the materials of which it is composed, the hints and sources from which its matter was derived, can all be traced out in former works, provided the author has exercised selection, arrangement and combination, and has thereby produced anything new." Curtis on Copyright, p. 177. These are just reflections, and a rule fully as liberal as that stated by the writer must be applied to dramatic compositions where the materials on which the author works are often old and well known. Many of the plays of Shakespeare are framed out of materials which existed long before his time, and were gathered by him from ancient chronicles and other dusty receptacles of antiquated literature. But these dry bones of the past the poet combined anew, pouring over them the effulgence of his own genius, until they were quickened with a new life and adorned with a hitherto unknown beauty. Of this, Macbeth is an instance. The original tale, from Hollingshed, whether a fable or a verity, was of very indifferent quality; but Shakspeare, as remarked by Sir Walter Scott, "adorned it with a lustre similar to that with which a level beam of the sun often invests some fragment of glass, which, though shining at a distance with the lustre of a diamond, is, by a near investigation, discovered to be of no worth or estimation."

A thorough comparison of the novel and the play in this case will clearly show that the latter is an original work, in the sense of the law. It is not a copy of "The Quadroon," nor an abridgment of it. The most that can be said in favor of their similarity is, that the *dramatis personæ* of the play are, a portion of them at least, suggested by those that figure in the novel. The prominent characters in each have some features in common, and move in and are acted upon by the same social organization; but there are points of marked contrast, both in the fictitious persons sketched, and the vicissitudes they experience. Some of the actors in the drama are almost wholly dissimilar to their supposed prototypes in the novel; and, were it not for their relation to the central figure, which is a quadroon girl in both the book and the play, their resemblance would hardly have been noticed. The author of "The Quadroon" has no just cause of complaint against this plaintiff. His vested rights have not been invaded by the latter, and the policy of the law is to encourage literary labor, so far as it can be done without infringing upon the rights already granted to others. Plagiarism and servile imitations are not to be encouraged. Those literary thefts which are committed upon copyrighted works, the law promptly suppresses. The mere copyist, or the slavish imitator who reproduces old materials, substantially in their old form, without new combination, is entitled to no protection under the statute. But the law rests upon no code of comparative criticism. It protects alike the humblest efforts at instruction or amusement, the dull productions of plodding mediocrity, and the most original and imposing displays of intellectual power. This law should be liberally construed in favor of authors, and leaving their comparative merits to be settled by critics, at the tribunal of public opinion, it should protect and encourage their labors. The fruits of their literary toils should be secured to them by the highest title, for they keep open the springs of thought which feed the intellectual life of the nation.

We are of the opinion that there is no error in the record, and that the validity of the copyright is fully supported by the originality of the play. A new trial is denied.

§ 40. There is no common law of copyright in the United States. *Stevens v. Gladding*, 17 How., 447 (§§ 387-89).

§ 41. Copyright exists only by virtue of the statute, and is not a common law right. *Clayton v. Stone*,* 2 Paine, 382; 1 Leg. Int. & Rev., 69.

§ 42. Property in manuscript.—Before the publication of a play the author is entitled at common law, and independently of the statute, to the exclusive right of property in the manuscript. He may sell it or authorize its performance by others, but he may, by permitting it to be acted for a long time without license or objection, lose such exclusive privilege. After publication he must rely on the statute for protection. *Boucicault v. Wood*,* 2 Biss., 34; 7 Am. L. Reg. (N. S.), 539.

§ 43. State laws.—An author, or his assignee, is entitled to a copyright under the laws of congress, irrespective of the provisions of a state constitution. *Little v. Gould*,* 2 Blatch., 362.

§ 44. An equitable title to a copyright, standing in the name of another, will be protected by a court of equity by an injunction. *Little v. Gould*, 2 Blatch., 165 (§§ 115-23).

§ 45. Citizenship.—Even under section 86 of the act of July 8, 1870, only the works of artists and authors who are citizens of the United States can be copyrighted. *Yuengling v. Schile*, 12 Fed. R., 97; 2 Blatch., 452 (§§ 141-44).

§ 46. Resident.—A person is a resident of the United States, within the meaning of the copyright acts, if he is here with an existing intention of remaining here, though he is a boarder or lodger and does not reside in his own house. *Boucicault v. Woods*,* 2 Biss., 34; 7 Am. L. Reg. (N. S.), 539.

§ 47. A person who is a mere transient visitor in this country, whose family, business, intentions and relations are all abroad, is not a resident of this country within the meaning of the copyright laws of this country; and the fact of the filing of his intention to become a citizen is immaterial. *Carey v. Collier*,* 56 Niles' Reg., 362.

§ 48. Photographs.—The act of congress providing for the copyright of photographs is not so obviously unconstitutional that it will be so declared by a *nisi prius* court. *Sarony v. Burrow-Giles Lithographic Co.*,* 17 Fed. R., 591.

§ 49. A label cannot properly be copyrighted if used before filed in the patent office. *Marsh v. Warren*,* 14 Blatch., 263.

§ 50. It seems that labels for goods may be copyrighted. *Blackwell v. Armistad*,* 3 Hughes, 163.

§ 51. Laws of New York construed.—Section 22 of article VI of the New York constitution of 1846, relating to the publication of judicial decisions, simply confers on all persons the original right to prepare and print them, but after they have been prepared and printed another may not appropriate the work and reprint it. This section is not therefore repugnant to the constitution of the United States. *Little v. Gould*, 2 Blatch., 165 (§§ 115-23).

§ 52. Section 2 of the act of the New York legislature of April 9, 1850, declaring that the copyright of any notes and references made by any state reporter to the reports of the court of appeals should be vested in the secretary of state for the benefit of the people of the state, is not repugnant to section 22, article VI, of the state constitution of 1846. *Ibid.*

§ 53. The word "notes" in that part of the act of the legislature of New York of April 9, 1850, which provides that the copyright of the notes and references made by the state reporter to the decisions of the court of appeals should be taken by the secretary of state, includes the head-notes stating the points decided, and the reporter's statement of the argument, together with such foot-notes as are prepared by the reporter, so far as they pertain to the business of reporting such decisions, but no further. *Ibid.*

§ 54. Official letters written to the government or a department thereof, so far as the public are concerned, are the private property of the writer. *Folsom v. Marsh*, 2 Story, 100 (§§ 249-56).

§ 55. Private letters.—The author of any letters, and his representatives, whether such letters are literary compositions, or familiar letters, or letters of business, possess the sole and exclusive copyright therein, and no person, either those to whom they are addressed, or other persons, have any right or authority to publish the same upon their own account, or for their own benefit. The only right of publication which the persons to whom they are addressed have in them is to use them upon such occasions as require or justify the publication or public use of them; and third persons not in privity with the writer or receiver have no rights of publication. *Ibid.*

§ 56. The fact that the letters of Washington have been purchased by act of congress, and have become national property, does not give private persons the right to publish them, especially as they were purchased subject to an existing copyright. *Ibid.*

§ 57. Suit by assignee.—The assignee of the exclusive right of acting a certain play in the United States, excepting in five specified cities, for the term of one year, may maintain an

action for an infringement in his own name without joining the author. *Roberts v. Myers*,* 23 Law Rep., 396; 13 Law Rep. (N. S.), 396.

§ 58. No pseudonym can give an author any rights which he would not have under his own name. So a publisher who has collected uncopyrighted published writings of an author may publish them as the work of the author, and may apply the author's pseudonym thereto in the same manner that he might apply the author's name. *Clemens v. Belford*,* 11 Biss., 459; 14 Fed. R., 728; 27 Alb. L. J., 293; 29 Int. Rev. Rec., 53; 15 Rep., 227.

§ 59. An assignment by the foreign author of a play of the right to perform the same in this country is at law inoperative, but in equity it is valid, for this country, for such literary property as could exist in his composition. *Keene v. Wheatley*,* 4 Phila., 157; 9 Am. L. Reg., 33.

§ 60. Contract with owner of theater.—An agreement between an author and the owner of a theater, that the author should write a play which was to be performed at the latter's theater as long as it should draw, does not prevent the author from taking the copyright in his own name. The contract is but a license to use the play at a particular theater, and not an assignment of the right of property in the play. *Roberts v. Myers*,* 23 Law Rep., 396; 13 Law Rep. (N. S.), 396.

§ 61. False imprint of copyright.—Under the act of congress of 1831 forbidding the imprint of a copyright on a work not legally copyrighted, and giving a penalty to the person who shall sue for the same, but one person can sue for and recover the penalty. *Ferrett v. Atwill*, 1 Blatch., 151.

§ 62. Section 4963, Revised Statutes of the United States, imposing a penalty for falsely affixing a notice of copyright upon articles, relates only to such articles as may be copyrighted. *Rosenbach v. Dreyfuss*,* 2 Fed. R., 217; 2 Alb. L. J., 472; 17 O. G., 1153.

§ 63. Ownership.—A copyright is *prima facie* evidence that the copyrighted work is the original production of the person procuring the copyright, and the burden of proof to show the contrary is on the person attacking. *Reed v. Carusi*,* 8 Law Rep., 410.

§ 64. A person who has no literary property in a dramatic composition cannot enjoin another from exhibiting or performing it. *Martinetti v. Maguire*,* Deady, 216; S. C., 1 Abb., 356.

§ 65. A grant of a copyright to a person is *prima facie* evidence that he is the author of the copyrighted production. *Reed v. Carusi*,* Taney, 72.

§ 66. In an action of debt for an infringement of the copyright of a musical composition, the question whether the plaintiff was really the author of the composition is one of fact for the jury. If such composition was borrowed altogether from a former one, or was made up of different parts copied from older musical compositions without any material change, and put together into one tune, with slight and unimportant alterations or additions, then the compiler is not the author within the meaning of the copyright law; but the circumstance of its corresponding with older musical compositions, and belonging to the same style of music, does not constitute it a plagiarism provided the air in question was, in the main design, and in its material and important parts, the effort of his own mind. *Ibid.*

§ 67. Contract—Construed.—G., the author of a medical work, assigned a part of the copyright to M., W. & K., under an agreement that they should sell only in the northern states, and that they should furnish G. with the work at cost, and that he should sell it only in the southern states. G. sold his interest to M., who withdrew from the firm, and the firm sold their interest to B. A disagreement as to the price at which books were to be furnished to M. arose, in which M. claimed that the failure to furnish books at a reasonable price abrogated the contract. M. therefore published G.'s work with some additions, and proceeded to sell it in the territory reserved to M., W. & K. under the original contract. *Held*, that the provisions of the contract as to furnishing the books and the division of the territory were independent, and that even the failure to furnish the books according to the contract did not justify M. in invading the territory reserved to the firm. *Baldwin v. Baird*,* 25 Fed. R., 293.

§ 68. An agreement between an author and his publishers that the latter shall have the copyright, "to them and their assigns forever," conveys to the publishers the right to an additional term afterwards granted by congress. *Paige v. Banks*,* 13 Wall., 608.

§ 69. An author, before publication, entered into a contract with his publishers by which they were to print an edition of a thousand copies, paying him a certain sum therefor, and if a second edition was called for he should correct it and they would print and stereotype it and might print as many as they could sell, paying him a certain sum per copy. The first edition was printed and the copyright taken in the publishers' name. A second edition being called for, was corrected and printed and large sales made. *Held*, that as the copyright had been taken in the name of the publishers with the knowledge and acquiescence of the author, the publishers were the lawful owners thereof, but that they could not transfer it, and that they had a right to hold it and to print copies of the work as long as they could sell them, and that though the publishers could not transfer the copyright they could sell the plates and transfer

all their rights under the contract, accounting to the author pursuant thereto. *Pulte v. Derby*,* 5 McL., 328.

§ 70. **Right of renewal.**—A court reporter entered into a contract with a firm of publishers in 1830 by which he agreed to furnish manuscript which they were to print, taking the copyright in their own names, which was to belong to them and their assigns forever, and were to pay the reporter a certain sum per volume. *Held*, that the reporter had parted with all his interest, and that after the expiration of the copyright in 1858 he could not renew the copyright in his name for fourteen years longer. *Paige v. Banks*,* 7 Blatch., 152.

§ 71. **Principal and agent.**—In an action to recover the penalty prescribed by statute for the copying and publishing of a copyrighted picture, the doctrine of the responsibility of a principal for the act of his agent does not apply, and an employer is not responsible for such copying and publishing done by his agent. *Schreiber v. Sharpless*,* 6 Fed. R., 175.

§ 72. **Employer and employee.**—An engraver employed by the United States to engrave a chart has no copyright in such chart, and may be enjoined from selling copies thereof. Copyright,* 7 Op. Att'y Gen., 656.

§ 73. When an author renders gratuitous services for another in whose name the copyright of the work on which such services were rendered is taken, the title to the work of the author is in the person for whom the services were rendered, and no written assignment from the author is necessary to enable such person to take the copyright in his own name. *Lawrence v. Dana*, 4 Cliff., 1; 2 Am. L. T. (N. S.), 402 (§§ 257-69).

§ 74. An author furnished gratuitously to the widow of the author of a book notes and emendations for two editions of the original work, under an agreement that the notes should belong to him afterwards. The widow having taken the copyright in her name, it was held that equity would compel her to assign to him her interest in the copyright of his notes. *Ibid*.

§ 75. A person was not entitled, under the act of congress of April 29, 1802, to a copyright for a work of art which he has paid another to design and execute. *Binns v. Woodruff*,* 4 Wash., 48.

§ 76. An author and inventor who by a contract agrees to use his ability in producing works and inventions for a stipulated compensation, the title to which should be in his employer, absolutely divests himself by the contract of any rights to his productions and inventions, and even on a breach of the contract by his employer such title does not revert in him. *Mackaye v. Mallory*,* 12 Fed. R., 328.

§ 77. An artist accompanied a government expedition with the express agreement that all sketches and pictures made by him should become the property of the government. After the report of the expedition, including the pictures, was prepared and ordered printed, the artist entered his pictures for copyright. *Held*, that he was not entitled to a copyright therein, as by becoming the property of the government they became the property of the public. *Heine v. Appleton*,* 4 Blatch., 125.

§ 78. An artist cannot enjoin the publication of pictures of his which he was paid for preparing for publication by the persons whom he seeks to enjoin. *Ibid*.

§ 79. Written additions to a manuscript play, made either by the proprietor of the play or by a person in his employ, are accessions whose proprietorship is incidental to that of the play. The relation of employer and employee would prevent the latter from acquiring literary property in such additions. *Keene v. Wheatley*,* 4 Phil., 157; 9 Am. L. Reg., 33.

§ 80. Unwritten additions to a play made by an actor in the employ of the proprietor of the play, and performed by him, are not the property of the owner of the play; but where such actor has communicated such additions to the proprietors of another theater, their use will be enjoined. *Ibid*.

§ 81. **No question of copyright—Jurisdiction.**—Comstock, the reporter of the New York court of appeals, as such reporter, together with the comptroller and secretary of state, entered into a contract with a firm of publishers for the publication of his reports for five years. The contract provided that the copyright should be in the publishers. The law provided that the copyright of the reports of that court should be taken by the secretary of state for the use of the people of the state, and forbade the reporter or any other person to acquire the copyright. Three volumes of Comstock's reports were published when, within the five years, Comstock was succeeded by Selden as reporter. He had in his possession manuscript opinions, which he prepared for publication, and of which he sold the copyright to another firm of publishers. The first publishers sought to enjoin the publication in a federal court, but the court held that they had no property in the manuscript from which the publication was made, and that therefore there was no question arising under the copyright law of the United States, and the court was without jurisdiction. *Little v. Hall*,* 18 How., 165.

§ 82. It is competent for a state officer to take out a copyright on a volume of reports as assignee of the reporter, under a state statute. *Little v. Gould*,* 2 Blatch., 362.

§ 83. A publication of a book will be inferred from a sale thereof, in the absence of proof to the contrary. And, if such sales were made before the deposit of the title-page, the copyright is vitiated. *Baker v. Taylor*,* 2 Blatch., 82.

§ 84. The mere delivery of printed volumes of judicial decisions by the official reporter to the state is not proof of publication of the reports, in the absence of any proof of the distribution of the volumes. *Myers v. Callaghan*,* 10 Biss., 139; 5 Fed. R., 726.

§ 85. Publication abroad.—The fact that an unpublished play, after being entered for copyright in this country, was published in England, will not interfere with the exclusive right of the author unless such publication was by his consent. *Boucicault v. Wood*,* 2 Biss., 34; 7 Am. L. Reg. (N. S.), 539.

§ 86. The author of certain copyrighted articles allowed the same to appear in an encyclopædia published in Great Britain. *Held*, that there was sufficient doubt as to whether such author could use such copyright to prevent the reprint and publication of the encyclopædia in this country, in which he had allowed the article to appear, to deter the court from enjoining the publication of the reprint by preliminary injunction: *Lodge v. Stoddart*,* 9 Rep., 137; 19 Am. L. Reg. (N. S.), 433.

§ 87. *Quære*: Whether the copyright and publication in this country, by a foreigner, of an unpublished work purchased from an American citizen, is valid. *Ibid*.

§ 88. Dedication to public.—Where a drama is an original literary effort, the permitted publication of a novel founded on the incidents of the drama is not such a dedication to the public as will permit an unauthorized representation of the drama. *Shook v. Rankin*,* 3 Cent. L. J., 210.

§ 89. A literary work, as a play, is dedicated to the public by a general publication. Such a publication is general whenever the communication effecting it is unrestricted, both as to the persons to whom and the purpose for which it is made. Such general publication is a dedication to the public for such unlimited uses, including all modes of publishing and republishing, as it may be the means, directly or secondarily, of enabling any person to make. A general performance of a play at a theater is a general publication thereof, and the proprietor of the play cannot restrain a representation thereof, if, by means of such representation, either primarily or secondarily, such unauthorized representation is possible by means of the retention of the words in the memory of persons in the audience. Otherwise if the unauthorized representation has been made by other means. *Keene v. Wheatley*,* 4 Phil., 157; 9 Am. L. Reg., 33.

§ 90. G. and S., the authors of "The Mikado," a comic opera, employed one T., a citizen of the United States, to prepare a pianoforte arrangement of the opera from the original orchestral score, which was copyrighted in the United States, and was sold in England with the vocal score with the consent of T. and G. and S. The orchestral score was never published, but was kept in manuscript by G. and S. D. purchased in England a copy of the libretto, vocal score and pianoforte arrangement, and procured a musician to make an independent orchestration therefrom. He was about to produce the opera in this country with costumes, scenery and stage effect imitated from the representations of G. and S., with the vocal score and the independent orchestration, but without representing or claiming that the orchestration was that of the original. *Held*, that the right of G. and S. to exclusively represent any part of the opera except the original orchestral score was lost by the publication of the libretto and vocal score, and that all right to represent the opera as an entirety, except as to the orchestral score, was dedicated to the public, and that the only right retained by them was that of multiplying copies of their orchestral score. *Held*, also, that the musical arrangement was a musical composition, and not a dramatic composition, and that the only right given by our statutes in the case of musical compositions was the exclusive right to multiply copies, but not the exclusive right to represent, and that therefore the representation by D. would not be enjoined at the suit of the assignee of G. and S. *Carte v. Duff*,* 25 Fed. R., 183.

§ 91. The common law right runs only to the time of the publication of the manuscripts by consent. After that the right of multiplying copies, or of representing, if the work is dramatic, is abandoned to the public, and it is immaterial in what country the publication is made. *Ibid*.

§ 92. *Quære*: Where an author publishes his manuscript in the public newspapers, whether he can afterwards publish it in a different form, and claim a copyright: and whether the deposit of the title-page, before the manuscript is prepared, will be effective. *Miller v. McElroy*,* 1 Am. L. Reg. (O. S.), 198.

§ 93. Plaintiff, an American citizen, was the assignee, from a foreign author, of a comedy, which was never printed, nor published otherwise than by representation on the stage. She took the necessary steps to protect herself by copyright, except the deposit of a copy of the book. Additions and changes were made by an actor in the employ of the plaintiff. The defendants obtained a copy of the play from a party who obtained it abroad, and, after acquiring the aforesaid additions and changes from the said actor, produced the play in their theater.

Held, that the public representation of the play by plaintiff was a publication, and that she could not, under the statutes for the protection of literary property, protect her rights as against persons who might reproduce the play from memory; but further, that equity would afford her relief as against the defendants, who did not rely upon such publication, but upon the copy obtained as above indicated; that the additions and changes by the actor belonged to plaintiff, and would also be protected. *Keene v. Wheatley*,* 9 Am. L. Reg. (O. S.), 33; 4 Phil., 157.

§ 94. The foreign proprietors of a musical and dramatic composition permitted the vocal parts with piano accompaniment to be published in this country, but kept the orchestral score in manuscript for the use of themselves and their assigns. *Held*, that a performance of the production by other parties, with an independent orchestral score composed and arranged from the published score by another person, will not be enjoined, but such person will not be allowed in his advertisements of the performance to lead the public to believe he is using the original orchestration. *Carte v. Ford*,* 15 Fed. R., 439.

§ 95. A drama may be copyrighted though it has been previously acted in a public theater. *Roberts v. Myers*,* 23 Law Rep., 396; 13 Law Rep. (N. S.), 396.

§ 96. The exclusive right of property of an author in an unpublished manuscript is not lost by permitting copies thereof to be taken, nor is the piracy thereof excused by the fact that it was unfinished, or that it was used by a teacher for the instruction of his pupils, who were allowed to take and use copies thereof. *Bartlett v. Crittenden*,* 4 McL., 300.

II. WHAT PROTECTED BY COPYRIGHT.

SUMMARY — *Instructions for cutting clothes*, § 97. — *Judicial decisions*, § 98; *copyright taken for benefit of state*, § 99. — *Compilations*, §§ 100, 101. — *System of book-keeping*, § 102. — *Notes to an existing work*, § 103. — *Title to work*, §§ 104, 105. — *Pictures*, §§ 106-111.

§ 97. A chart with printed instructions intended to be used in cutting ladies' and children's clothing, printed on a single piece of paper, is a *book* within the statutes of the United States relating to copyright. *Drury v. Ewing*, §§ 112-114.

§ 98. The reporters of judicial decisions are entitled to the benefit of the copyright laws of the United States to the extent of their authorship in the composition of their reports. But this does not include the written opinions of the court, because the reporter is not the author thereof. *Little v. Gould*, §§ 115-123.

§ 99. A contract was made between C., the reporter of the court of appeals of New York, the secretary of state, the comptroller, and L., a publisher, by the terms of which L. was to publish the state reports for five years upon certain terms. L. was to have the exclusive benefit of the copyright of all matter furnished by C., and the title thereto was to be taken in the secretary of state pursuant to a law of the state which provided that the copyright of the reporter's notes and references should be taken in the name of the secretary for the benefit of the people of the state. The contract purported to be an assignment of the copyright to L. The statute of the state provided that the reporter should have his salary only, and that neither he nor any other person should have a copyright in the reports. A volume of reports was prepared by C. and printed by L., and the copyright was taken in the name of the secretary of state as required by law. Within five years G. reprinted the volume. *Held*, that G. would be restrained from printing and publishing any volume of C.'s reports containing any of the matter prepared by him, or any colorably altered therefrom. On a motion to dissolve the injunction after answer, it was held that the secretary of state might properly take the copyright in his name, as the statute and contract operated as an assignment thereof to him, and that he also might take the title in trust for the people of the state. *Ibid.*

§ 100. A compilation of information in reference to postoffices, railroad stations and freight and express lines is subject to copyright under the laws of congress. *Bullinger v. Mackey*, §§ 124-126.

§ 101. In order to give an author of a compilation a copyright in the plan, combination and arrangement of his materials, it must appear that his plan is essentially new and original with him. *Ibid.*

§ 102. The exclusive property in a system of book-keeping cannot be claimed under the copyright laws, by means of a book in which that system is explained. *Baker v. Selden*, §§ 127, 128.

§ 103. Notes to an existing work, compiled by the author from various sources, may properly be copyrighted by him, though they are not new, if they have been collected by him from the various original sources; and a copying of such notes by another annotator of the same work is an infringement of his copyright. *Gray v. Russell*, §§ 129-133.

§ 104. The mere title of a copyrighted production is not, as separated from the production itself, protected by such copyright from use by others. *Osgood v. Allen*, §§ 134, 135.

§ 105. In determining whether the title of a periodical infringes the title of another, considered as a trade-mark, the question is as to the liability of the subsequent title to deceive the public. *Ibid.*

§ 106. The word "manuscript," as used in the statutes relating to copyright, does not include a picture, and it may be reproduced as a chromo by the owner without the written assent of the artist, which is required by the statute in case of a manuscript. *Parton v. Prang*, §§ 136-140.

§ 107. An absolute and unconditional sale of a picture by the artist, and a similar sale by the purchaser to another, confers upon the second purchaser the right to reproduce the picture as a chromo, when the artist, after being apprised of the purpose of the second purchaser, did not object. *Ibid.*

§ 108. A chromo having artistic merit is a subject of copyright, though intended to be used for advertising purposes. *Yuengling v. Schile*, §§ 141-144.

§ 109. Chromo lithographs are "prints" within the meaning of section 103 of the act of congress of July 8, 1870, and section 4971, Revised Statutes of the United States. *Ibid.*

§ 110. Photographs of a large picture, of which the photographer is the owner, are not protected by the copyright law of 1831 from being copied by the photographic process by others. *Wood v. Abbott*, § 145.

§ 111. The representation of a copyrighted engraving by means of photography is a copying thereof within the meaning of the copyright laws, and is forbidden. *Rossiter v. Hall*, §§ 146, 147.

[NOTES.— See §§ 148-186.]

DRURY v. EWING.

(Circuit Court for Ohio: 1 Bond, 540-554. 1862.)

Opinion of the COURT.

STATEMENT OF FACTS.—The bill in this case was filed June 28, 1860. The complainants aver that the said Lavinia Drury is the "authoress and proprietress" of a chart entitled "The ladies' chart for cutting dresses and basques for ladies, and coats, jackets, etc., for boys," a copy of which was duly deposited in the office of the clerk of the district court of the United States for the southern district of Ohio, April 25, 1859, by which the exclusive right of publishing, using and vending the same was secured to her, by the act of congress on that subject, for the period of twenty-eight years. The bill further alleges that the said Sarah C. Ewing, in conjunction with her husband and others, has caused to be published and sold a large number of said charts, and was then publishing and selling the same, without any license or authority from the said Jonas and Lavinia Drury, and in violation of their rights and greatly to their injury. The bill prays for an injunction to restrain the defendants from any further publication of said charts, and for other relief. A provisional injunction in accordance with the prayer of the bill was ordered July 2, 1860.

The answer of Ewing and wife was filed September 3, 1860. The answer admits, in substance, the sale of Mrs. Drury's charts, but alleges they were sold or used under an arrangement between the parties, by which Mrs. Ewing was constituted the agent of Mrs. Drury, and as such was authorized to vend and use the charts. And the defendants deny that they have in any way infringed the exclusive right of the complainants by such sale and use.

The case came on for hearing on the bill, answer, exhibits and proofs, January 21, 1861, and resulted in a decree for the complainants, and the award of a perpetual injunction against the defendants.

On May 10, 1862, upon a proper showing by the complainants, a rule was entered against Ewing and wife, requiring them to show cause why they

should not be attached as for a contempt in violating the injunction. This rule was duly served, and the defendants, Ewing and wife, appeared, and in response thereto filed an answer denying that they had violated the injunction, or had intentionally disregarded the order of the court, and praying to be discharged from the rule. In the progress of the investigation growing out of the motion for an attachment, it was made to appear that in September, 1860, Ewing and wife had deposited, in the office of the clerk of the district court of the United States for the eastern district of Missouri, a copy of what is described as "the ladies' guide" for taking the measures and cutting garments for females, of which Mrs. Ewing claimed to be the authoress or inventress, and for which she had thus secured a valid copyright. It was also proved on such hearing, and not controverted by the defendants, that Mrs. Ewing had printed a large edition of her guide, and that she had sold many copies of the same after the service of the injunction upon the defendants. In resisting the application for an attachment, it was assumed by the counsel of the Ewings that the guide which they had copyrighted in Missouri was substantially different from Mrs. Drury's, and that the use and sale of them did not therefore involve a violation of the injunction or any infringement of her rights. This posture of the application for an attachment presented the question of the identity of Mrs. Drury's chart and Mrs. Ewing's guide. And, upon this issue, a great mass of testimony has been taken by these parties, and, after a protracted hearing and very elaborate arguments, the question has been submitted for the action of the court.

In this connection, it should be stated that in addition to the issue of identity, if the court should adjudge it to be established by the testimony, it is strenuously urged by counsel that the motion for an attachment cannot be entertained, and the Ewings held to be guilty of a contempt, for the reason that the copyright of Mrs. Drury is a nullity as not being a legitimate subject of a copyright within the scope and intention of the act of congress.

§ 112. *On a motion for an attachment for violating an injunction the original decree cannot be impeached except for fraud or defect of jurisdiction.*

This point first claims the attention of the court. And in relation to it, it is obvious to remark, that whatever ground there may have been for contesting the validity of the copyright on the hearing of the original case, it is now too late to do so. The defendants are clearly concluded by the admissions of their answer, and by the facts adjudged true by the decree of the court, and which could properly have been contested at the hearing on the merits. The bill, as before noticed, contains the distinct averment that Mrs. Drury is the authoress and proprietress of the chart copyrighted to her, and that the exclusive right to publish, use and vend the same vested in her. These allegations are not controverted or put in issue by the answer. They are, at least by the strongest implication, admitted to be true. The answer does not allege the invalidity of Mrs. Drury's copyright, either on the ground that it is not within the act of congress, or that it was not her original invention. Indeed, these points are conceded in the answer, as in that, the Ewings rest their vindication of the sales of the charts up to that time, on the ground that Mrs. Ewing was the agent of Mrs. Drury. This is wholly inconsistent with the position now taken, that her copyrighted chart is a nullity in law. This point not having been brought to the notice of the court at the hearing, it was clearly not its duty, *sua sponte*, to pass upon it, even if there had been doubts as to the validity of the copyright. The court therefore found the facts

alleged in the bill to be sufficiently verified, and entered a decree to that effect. The decree assumes that Mrs. Drury's copyright was valid, and that she was entitled to protection against its infringement. It also finds that the defendants had so violated that right as to justify an order for an injunction, and the award of damages in favor of the complainants in accordance with the statute.

In this state of the case no proposition can be clearer than that the defendants, upon the pending motion, cannot impeach the decree thus entered. Several entire terms of the court have intervened since its entry, and it would be an unheard of exercise of jurisdiction, in this collateral way, to revise and reverse it. No court will do this in a proceeding looking only to the enforcement of the decree, except on a clear showing of fraud in its rendition, or a want of jurisdiction as to the subject-matter of the suit. There is no pretense or allegation of fraud in the decree, nor is there a doubt of the jurisdiction of the court in the suit. This is given in such express terms by the statute, as to leave no room for controversy. If there was any error in the facts found by the decree, or the legal conclusions of the court, the obvious and only remedy was an appeal to a higher court having ample power to revise and reverse the decree. This principle is so well settled as scarcely to need the citation of authorities for its support. It has been repeatedly affirmed by this court, and distinctly held by the supreme court of the United States. 10 Pet., 474; 14 How., 588.

§ 113. *A chart of a single sheet of paper may be a "book" within the meaning of the copyright laws.*

But it is by no means clear that the objection now urged to the validity of the complainant's copyright could have been sustained, if it had been presented in the proper way and at the proper time. The point made by the defendant's counsel is that the chart copyrighted to Mrs. Drury is neither a *book*, nor a *chart*, nor a *print*, within the terms of the act of congress, and therefore not within its protection. Upon this point no American authorities have been referred to, nor am I aware that it has been decided in this country. In the English courts I know of but one case in which it has been fully considered. This will be presently referred to as having a direct bearing on the question adverted to.

Section 1 of the act of congress of February 3, 1831 (4 Statutes of the United States, 436), secures to the author of any *book* or *books*, map, chart or musical composition, or to any one who shall invent, design, etch, engrave, work, or cause to be engraved, etched or worked, from his own design, the exclusive right of printing, reprinting, publishing and vending the same for the term of twenty-eight years, by complying with certain requirements of the statute. The question presented is, whether the chart for which Mrs. Drury has procured a copyright under the statute falls within any of the foregoing designations. I do not propose to consider this question at any length. As a first impression, from an inspection of the chart, the mind repudiates the conclusion that it is a *book*; and when the point was first suggested, it occurred to me it would require a forced construction of the statute to bring it fairly within the meaning of that term. The chart as printed and published for use is contained on one large sheet, representing a series of diagrams, interspersed with printed instructions as to the mode of using them in taking measurements for and cutting certain parts of ladies' dresses. As necessary to the practical use of the diagrams they are pasted on thick paper or pasteboard, corresponding

with and showing precisely the forms of the diagrams. The exact dimension and form of every part of the garment intended to be cut is indicated by a series of numerals placed along the outer edges of the diagrams thus arranged, and by means of dots or marks at the proper figures the exact size and course of each section of the garment is ascertained with mathematical precision.

Now it may well be conceded that the chart as printed on the sheet, or as pasted in parts for practical use, is not a *book*, according to the more popular sense of the word. But, in giving effect to the statute according to its obvious design and spirit, I can see no necessity for restricting the word to a volume. The origin and derivation of the word *book* does not justify this restricted sense. Without intending to make any show of learning on this subject, or attempting a critical investigation, I may remark what is well known, that the Latin word *liber* — book — had no reference to the collection of writings in a volume, but primarily signifies the bark of a tree. Webster, in his dictionary, says our word *book* is derived from the Saxon, *boc*, meaning a beech-tree; and in other languages of the north of Europe it has the same derivation. The supposition is that either the bark of the beech or, what is more probable, thin polished plates of the wood of that tree, were used for writing. It is a fact well established that the Chinese, before the discovery of the art of making paper, used the latter mode for that purpose. It is also well known to the readers of the Bible and other ancient writings that in referring to books the collection of literary materials in a volume is not intended. The *papyrus* was first used for writing, and at a later period the skins of animals made into parchments; but they are called books, though the manuscripts were in the form of rolls or loose leaves, unbound, and not in volumes according to the modern sense of the term.

But I should certainly have hesitated in adopting this view as a judicial conclusion if it was not sustained by an authority entitled to high respect. The English courts, after the fullest investigation, have decided this question in a case to which I will now refer. The statute of 8 Anne, on the subject of copyrights, enumerating in section 1 the works intended to be protected by it, contains the words *book or books* precisely as in our statute. In the case of *Clementi v. Golding*, 2 Camp., 25, the court held that the form of the publication was not material in determining whether it was or was not a book, within the meaning of the statute. That was a suit for a piracy in reprinting and selling a song, which had been published on a *single sheet*, and in that form copyrighted. The objection was made that it was not a *book* entitled to the protection of the statute. Lord Ellenborough, contrary to his opinion in a previous case, overruled the objection and directed the jury to return a verdict for the plaintiff, with leave to move for a new trial. He is reported to have said: "I do not see at present why a composition printed on a single sheet of paper should not be entitled to the privileges of the statute." . . . He adds: "I was at first startled at a single sheet of paper being called a *book*, but I was afterward disposed to think it might be so considered within the meaning of the act of parliament, and when the matter came before the court, the other judges inclined to the same opinion." After the argument of the motion for a new trial, the reporter adds: "The judges seemed unanimously of opinion that it could not depend on the form of the publication whether it were entitled to the privileges of the statute or not; that a composition on a single sheet might well be a *book* within the meaning of the legislature, and that the verdict of the jury ought not to be disturbed." See same case, 11 East, 244

(new ed., vol. 6, 125); also case of *Hime v. Dale*, decided in 1803, referred to 2 Camp., 27; Curtis on Copyrights, 105 *et seq.*; 2 Wat.; Eden on Injunc., 322.

It will be seen by reference to the case of *Clementi v. Golding*, that the question was very fully and carefully considered by the full court. No case has been referred to, and I am not aware there is any, in which the doctrine then settled has been reconsidered or overruled by the English courts. And the construction of the statute of Anne, on the point under consideration, may be regarded as law in England. And I cannot perceive on what ground the principle can be impugned as against good sense and reason. I am, therefore, inclined to adopt the liberal construction given by the English courts to their statute, and to hold that Mrs. Drury's chart is within the protection of our statute. She could doubtless have given it to the world in a succession of sheets, bound together and constituting a volume, but it is obvious that the chart for practical purposes is more easily understood, and therefore more useful, printed on a single sheet large enough to exhibit all the diagrams at one view. I cannot perceive why her rights as an authoress or inventress should be prejudiced by this form of publication. If the chart, as the court is bound, for reasons before intimated, to presume, is original with her — the product of thought and mental toil — her claim is by no means destitute of merit, and she is justly entitled to all the benefits which the law confers. It is clearly no objection to the validity of her copyright, that her production does not claim a standing as a work of great literary merit. The statute does not make this a necessary element of a legal copyright; and it is well known there are works of great practical utility, having no pretension to literary merit, which are yet within not only the words, but the scope and design of the statute.

Adopting this view of the law, it is not necessary to decide whether Mrs. Drury's copyright can be sustained as a *chart* or *print*. These words are used in the statute as legitimate subjects of a copyright, and it would not imply a very forced construction to hold that the copyrighted work of Mrs. Drury is included in one or both of these terms. The authorities, I think, would fully sustain such a conclusion.

§ 114. *What is a piracy of a copyrighted work.*

The only question which remains is, whether the complainant's chart and Mrs. Ewing's guide are legally identical. If they are so, it follows necessarily that the use and sale of the latter is an infringement of Mrs. Drury's exclusive right and a violation of the injunction. And here the true inquiry undoubtedly is, not whether the one is a *fac-simile* of the other, but whether there is such a substantial identity as fairly to justify the inference that, in getting up the guide, Mrs. Ewing has availed herself of Mrs. Drury's chart and has borrowed from it its essential characteristics. And the decision of this question is in no way affected by the fact — if conceded to be the fact — that the guide is in some respects an improvement of and of superior utility to the chart of the complainants. This would confer no right to appropriate and use the prior invention or discovery of Mrs. Drury. The law on this subject is stated by Judge McLean (4 McL., 308) as follows: "The same rule of decision should be applied to a copyright as to a patent for a machine. The construction of any other machine which acts on the same principle, however its structure may be varied, is an infringement of the patent. The second machine may be recommended by its simplicity and cheapness; still if it act on the same principle of the one first patented, the patent is violated." And in the same case, the learned judge asserts the principle strongly, that in the case of a copy-

right, if the work alleged to be a piracy is of a character to render the original "less valuable by superseding its use in any degree, the right of the author is infringed."

In the case of *Folsom v. Marsh*, 2 Story, 115 (§§ 249-56, *infra*), it is decided that it is "not necessary to constitute an evasion of a copyright, that the whole of a work should be copied, or even a large portion of it, in form or substance. If so much is taken that the value of the original is sensibly diminished, or the labors of the original author substantially, to an injurious extent, appropriated by another, that is sufficient in point of law to constitute a piracy *pro tanto*. The entirety of the copyright is the property of the author, and it is no defense that another has appropriated a part, and not the whole, of any property." To the same effect are the views of Judge Story in the case of *Emerson v. Davies*, 3 Story, 795 (§§ 270-79, *infra*). He says: "To amount to an infringement, it is not necessary that there should be a complete copy or imitation in use throughout, but only that there should be an important and valuable portion, which operates injuriously to the copyright of the plaintiff." In the same case the learned judge, in defining a piracy of a copyright, after a reference to the English authorities, says: "I think it may be laid down as the clear result of the authorities in cases of this nature, that the true test of piracy or not is to ascertain whether the defendant has in fact used the plan, arrangements and illustrations of the plaintiff as the model of his own book, with *colorable* alterations and variations only, to disguise the use thereof."

Judge Woodbury, on this point, says the true inquiry in these cases is, "Whether the book of the defendant, taken as a whole, is substantially a copy of the plaintiff's; whether it has virtually the same plan and character throughout, and is intended to supersede the other in the market with the same class of readers and purchasers by introducing no considerable new matter, or little or nothing new except colorable deviations." *Webb v. Powers*, 2 Woodb. & M., 514 (§§ 280-87, *infra*). To the same effect are the numerous English decisions on this point. 2 Mylne & C., 740; 30 Eng. L. & E., 461; 36 *id.*, 321.

These authorities seem to be decisive of the point under consideration. And the single inquiry in this case therefore is, whether there is a substantial identity as between the chart copyrighted to Mrs. Drury and the guide used and sold by Mrs. Ewing. On this issue, I shall not attempt a critical notice of the mass of testimony introduced on the hearing of the present motion. It is to be regretted that under the impulse of their heated passions and intemperate zeal, these excited females have put themselves to unnecessary trouble and expense in taking depositions on the question of identity. It lies within narrow limits and presents no great difficulty in its solution. It is to be borne in mind that Mrs. Ewing does not allege, and has not proved, that she is the inventress or authoress of the system copyrighted to her; nor does she deny in her original answer, nor does she now deny, that Mrs. Drury's chart is the basis of her guide. Her claim is simply that she has so far varied from and improved the chart as to constitute her guide an original work, and that, therefore, it is no infringement. But it is obvious from inspection that the two embody substantially, if not literally, the same principle. The diagrams in each are essentially the same in form, dimensions, etc., and have the same arrangement of numerals. It is true, the different scales or rules for taking measurements are designated by names differing in the guide from those used in the chart, but this does not destroy the identity of the two. In practice

they produce the same curves or forms for the same identical purpose. The device of Mrs. Ewing in placing on what she calls the back scale one number higher than on the front scale, thus making a seeming difference between her plan and that of Mrs. Drury, cannot affect the question of legal identity. This clearly involves no change of principle. And the same remark applies to the claim of a want of identity, on the ground that Mrs. Ewing's plan as alleged requires five measurements, whereas Mrs. Drury provides for three only. The mere increase of the number of measurements does not constitute an essential difference in the two plans. But it is by no means clear that Mrs. Ewing, in her system as copyrighted, requires more than the three measurements. The weight of evidence well justifies the conclusion that until this controversy arose, in practice three only were used, and that the subsequent addition of the two measurements was an afterthought resorted to for an obvious purpose.

But there is one fact that seems wholly conclusive on this question of identity, and dispenses with the necessity of a minute inquiry into the alleged discrepancies between the two plans. Some nine or ten witnesses, practical and intelligent dressmakers, well acquainted with the theory and practice of taking measurements, and cutting dresses upon the plan of these parties, testify that the two are substantially the same, and in practice produce the same result. Some of these witnesses swear they have cut dresses by both plans, and that when the directions of each are strictly pursued, the results are substantially the same. One witness with great apparent candor and intelligence states that by an actual experiment with the two plans, when he dropped the surplus number on the back scale of Mrs. Ewing, the measurements were precisely identical, and that when that number was used there was but a trifling difference. Such an experiment affords an unerring test of truth, and if the witness is credible, the force of the fact stated by him cannot be overcome by the speculative opinions of any number of witnesses testifying adversely to him.

Without noticing other material discrepancies between the chart of Mrs. Drury and Mrs. Ewing's guide, I am led to the conclusion that they are essentially the same, within the scope of the authorities to which I have referred. Mrs. Ewing has, with some adroitness, so arranged and transposed some parts of Mrs. Drury's diagrams as to present to the unexperienced eye the impression that they are dissimilar, but in doing this she has utterly failed to prove that there is any difference in the principle of the two. There is, also, a substantial identity between the printed directions and instructions accompanying the chart and the guide. True, the words and sentences used by Mrs. Ewing are not the same as those used by Mrs. Drury, but they are of the same import, and intended for the same purpose. In this remark, I do not forget that it is strenuously urged by the counsel for the complainants that what is designated by Mrs. Ewing as her third pupil's instruction is more full and minute than those connected with the chart, and so far unlike them. It is enough to say, in reference to this, that the evidence fully warrants the conclusion that these constituted no part of the rules or instructions as claimed by Mrs. Ewing, and copyrighted to her in Missouri. They have been appended recently with the obvious purpose of negating the identity of the two plans. It is another evidence of the consciousness of Mrs. Ewing, that something was needed to avoid the otherwise inevitable conclusion, that in getting up her guide she was interfering with and pirating on the prior exclusive right of

Mrs. Drury. It cannot be doubted that she has adopted all the essential parts of Mrs. Drury's system, and that so far as there are any apparent alterations they are colorable and evasive. It must be conceded that Mrs. Ewing's course does not commend her to the favorable consideration of a court of equity. She seems to have taken a dishonorable advantage of her position as the agent of Mrs. Drury, with the expectation of pecuniary benefits to which she was neither morally nor legally entitled. Her intelligence and adroitness, as developed throughout this controversy, repel the inference that she acted in ignorance of the fact that she was invading the just rights of the complainants. And when by the decree of this court an injunction was granted to restrain her from the further sale and use of her guide, it was a duty of which she could not have been ignorant to respect and obey it. She has wilfully violated the injunction, and the complainants, as they had a right to do, have asked for and obtained a rule to show cause why she should not be dealt with as for a contempt of court. No sufficient showing against such a judgment has been made, and I cannot do otherwise than find her guilty of the alleged contempt.

The only embarrassment on the part of the court arises from the difficulty of determining what order shall now be made in the case. It is necessary that the supremacy of the law should be vindicated and the rights of the complainants protected as far as practicable. To this end it is unquestionably competent for the court to order the imprisonment of Mrs. Ewing as a punishment for the contempt. But in the case of a female I am exceedingly reluctant to make such an order. And if any assurance can be given that there will be no repetition of the offense, and that the rights of the complainants will hereafter be respected, I will not now adopt that stringent course. For the present, with the intimation that such future action, as circumstances may require, will be taken by the court, it is now ordered that the defendants, Ewing and his wife, surrender to the clerk of this court, within twenty days, all the published copies of the guide in their possession or within their control, together with the plate or plates on which they are printed; and also that within that time they pay the costs of this proceeding.

LITTLE v. GOULD.

(Circuit Court for New York: 2 Blatchford, 165-186. 1851.)

STATEMENT OF FACTS.—The plaintiffs in this case claimed the exclusive right to publish and sell volume 3 of the reports of cases of the court of appeals of New York, and they filed their bill to enjoin the defendants from infringing that right. The plaintiffs claimed their right under a contract made, by virtue of a statute of New York, with Comstock, the official reporter, the secretary of state and the comptroller. The statute, which is set out in the opinion, provided that the copyright of any notes and references made by the reporter should be vested in the secretary of state for the benefit of the people of the state.

Opinion by CONKLING, J.

To maintain the denial by the defendants of the plaintiffs' title, their counsel rely mainly upon a provision contained in the constitution of the state of New York. By the constitution and laws of the United States, authors are invested with the exclusive right and liberty, for a limited period, of printing, reprinting, publishing and vending their books; and this right is extended to

their executors, administrators and assigns. The right is held to belong to the reporters of judicial decisions in common with other authors, to the extent of their authorship in the composition of their works. It does not comprise the written opinions of the judges, because of these the reporter is not the author, and it has been said by the supreme court of the United States that the judges of that court cannot confer on the reporter of its decisions any copyright in the written opinions delivered by them.

Under this well known state of the law of the land, as declared in the constitution and statutes of the United States, and by the authoritative interpretations they had received, the people of the state of New York saw fit, in 1846, by the twenty-second section of the sixth article of the constitution adopted in that year, to ordain as follows: "The legislature shall provide for the speedy publication of all statute laws, and of such judicial decisions as it may deem expedient. And all laws and judicial decisions shall be free for publication by any person." According to the interpretation given by the counsel for the defendants to the second member of this section, its direct and sole design was, so far as judicial decisions are concerned, to secure to all persons the right to do precisely what the court is now called upon to restrain the defendants from doing — the right to reprint and sell, *ad libitum*, any volume of reports published in pursuance of any law of the state enacted in obedience to the injunction contained in the first branch of this section. The counsel insist, therefore, that the act of April 9, 1850, mentioned in the bill of complaint, purporting, to a limited extent, to invest the secretary of state, for the benefit of the people of the state, with the copyright of reports to be prepared by the state reporter, is unconstitutional and void.

§ 115. *The provision of section 22, article VI of the constitution of New York of 1846, is not repugnant to the constitution and laws of the United States.*

One of the answers given to this objection is, that the expression "judicial decisions," occurring in the last member of this section of the constitution, does not admit of being restricted to the sense thus ascribed to it; but that the provision embraces, by its very terms, "all" judicial decisions, whether required by law to be published or not, and would extend, therefore, to the reports which have been, and are likely to continue to be, published of the decisions of other courts of the state of New York, as well as to the reports now in controversy. And it is rightly argued that, if this is the true construction, and if it is true, also, that the absolute common right intended to be secured was that of reprinting reports prepared and published by others, it would follow that this provision of the constitution of the state of New York is repugnant to the constitution and laws of the United States, and therefore void; for it is undeniable that a state cannot in any form interfere in this respect with the rights of private persons. For this reason, unless this interpretation of the language of the state constitution is unavoidable, it ought to be rejected; and, after carefully considering the ingenious argument of the counsel for the defendants, designed to show that the judicial decisions referred to in the last member of the section under consideration are such only as shall be designated by the legislature for publication in obedience to the first part of the section, I am of opinion that this proposition cannot be maintained. It is inconsistent with the phraseology actually used, and with the omission of words which, if such an interpretation had been intended, would naturally have been employed. The words "*all* judicial decisions" must be held to mean what they naturally import — not all *such* judicial decisions only as the legislature

should direct to be published, which is what they do not import. It follows, then, that if the license designed to be secured to all persons extends to the reprinting of all reports prepared and published by others, notwithstanding a copyright may be asserted therein by the author, this provision is obnoxious to the objection that it transcends the limits of state authority, and is consequently invalid. It is necessary, therefore, as already observed, to seek for it some other interpretation, which, while consistent with the language of the provision, and with its spirit, so far as that can be discerned, shall be consistent also with the constitution and laws of the United States; and, in my judgment, there is no serious difficulty in finding such an interpretation, although it may be no easy task to discover the precise nature of the evil against which the provision was designed to guard.

On looking into the proceedings of the convention, I observe that this section was proposed by a member, after the adoption, on the same day, of a resolution to arrest all further debate on the article relating to the judiciary, and having been decided by the president to fall within the scope of this resolution, the vote upon it was taken immediately, without explanation or debate, and it was adopted by a majority of twenty-seven. Its language is mandatory, and it is addressed to the legislature. It directs (1) That provision shall be made by law for the speedy publication of *all* statute laws, and of *such* judicial decisions as the legislature may deem expedient; and (2) that all laws and judicial decisions shall be free for publication by any person. This last direction is obviously intended to promote and extend the design of the first. This design was expressed in the section, as originally proposed and adopted, by the addition, to what now stands as the first sentence, of the words "so as to render the same easy of acquisition by the people;" and then followed, separated only by a semicolon, the words which now stand as the second sentence. The words just quoted were expunged in the process of final revision, doubtless because they were seen to be wholly unnecessary, the object being too apparent to require elucidation, and a period was substituted for the semicolon. I have narrated the history of this section, not because it appears to me to shed much light upon the question under consideration, but because it is relied on by the counsel for the defendants to support the interpretation on which they insist. A deliberate review of their argument on this point has failed to convince me of its soundness. The just view of the subject appears to me to be this: The first part of the section having peremptorily enjoined the speedy publication of the more authoritative and important judicial decisions of which it most concerned the public to be speedily apprised, the rest was left to private enterprise; but, lest some impediment should be thrown in the way (not by the claim on the part of the author to copyright, which was beyond the power of the convention), but by the legislature or the courts, or in some other way not easily divined, it was, by the second part of the section, ordained that no such restriction should be imposed, and it was made the duty of the legislature, if necessary, to see that this should not be done. In other words, it was declared, not that when one person had performed the labor of preparing, and incurred the expense of printing from manuscript, a volume of reports, any other person should be at liberty, in spite of the author or his assignee, to intercept and appropriate, or destroy, the just rewards of the enterprise, by rapaciously seizing upon the book and reprinting it, but that the right to engage in such original enterprises should remain common to all.

Assuming this, as I feel warranted in doing, to be the just interpretation of this constitutional provision, I dismiss it from further consideration.

§ 116. *The act of the legislature of New York of April 9, 1850, is not inconsistent with the constitution of New York.*

But it is further objected by the counsel for the defendants that, conceding the validity of the act of April 9, 1850, in virtue of which the copyright of the book in question is claimed by the plaintiffs, still the defendants are not chargeable with any infringement of this right, because, as they argue, the book does not contain anything which can properly be denominated "notes or references," to which alone a copyright in behalf of the people of the state of New York is asserted by the act. The answer given to this objection by the learned counsel for the plaintiffs is, that the prohibition contained in this act against the securing or taking by any person of a copyright for the reports of cases decided by the court of appeals, with the exception therein mentioned, is in conflict with the provisions of the constitution and laws of the United States securing, absolutely, to authors and their assignees, the exclusive right to the fruits of their intellectual labors. But to this it may be replied that Mr. Comstock, having consented to accept and hold his office, and to prepare the book in question for the press, under a law of the state expressly declaring that he should have no pecuniary interest in the work, and that no copyright should be taken therefor, except to a limited extent by the secretary of state, for the benefit of the people of the state, must be considered as having surrendered his rights as author, and was incompetent to confer them on another; or, it may be said — which, however, would be little else than the assertion of the same principle in a different form — that the rights and disabilities of his office being prescribed by law, are to be regarded as conditions of the tenure by which it was held, which were binding upon him, and which a court of justice ought not to aid him in violating. But it is to be further observed that the enjoyment of the right in question is by law made to depend, except in the case of an unpublished manuscript, upon the condition of taking certain steps demonstrative of the author's intention to insist upon his rights in this respect, and adapted to convey notice to all others of such intention, and that, if he omits this precaution, he is to be deemed to have abandoned his claim to protection. Now, in the present case, the author has not complied with this condition. It is said, indeed, that Mr. Morgan is the assignee of the rights of the author, and, as such, has taken the required measures for their security. But Mr. Morgan acted throughout in a fiduciary and representative character, as the agent of the people of the state of New York, and in execution of a trust imposed upon him by law. And it thence follows, I think, that he could not in that character acquire, and that he was therefore incompetent to convey to the plaintiffs, any rights cognizable in a judicial tribunal, except those of which, according to the terms of the laws under which he acted, he was to become the recipient. To this extent, however, it may be assumed, as I do not understand it to be denied, that he might lawfully act, and that his acts ought to be held valid and effectual by this court, provided the laws under which he acted are, as I hold them to be, not inconsistent with the constitution of the state of New York. It becomes necessary, therefore, in the next place, to ascertain the limits of the authority vested in the secretary of state, in trust for the people, by the act of April 9, 1850; and for this purpose, before proceeding to notice more particularly the provisions of this act, I propose to advert to some antecedent enactments relating to the subject.

§ 117. *New York legislation on the subject of the reporting of judicial decisions.*

At the session of the legislature next after the adoption of the constitution, an act was passed providing for the appointment, by the governor and lieutenant-governor, of a reporter of the decisions of the court of appeals, to be denominated "state reporter," who should hold his office for three years, unless sooner removed by the concurrent vote of both branches of the legislature. This act (Act of May 12, 1847, ch. 280, §§ 73, 74) contains the following enactment: "The reporter shall have no pecuniary interest in such reports, but they shall be published by the secretary of state, under the supervision of the reporter, by contract to be entered into pursuant to the provisions of the act entitled 'An act in relation to the public printing,' passed March 5, 1846. Such contract shall be made with the person who, in addition to furnishing the said secretary sixty-four copies of each volume of said reports, bound in leather, as soon as may be after the same is prepared, shall agree to publish and to sell them at the lowest price by the number and volume, according to the pages therein contained. Such reports shall be published in numbers every second month. And the reporter shall prepare for each volume such digests and tables of contents as are usually prepared for similar reports. If the reporter shall neglect to discharge his duty faithfully, it shall be the duty of the said court to report that fact to the legislature, to the end that he may be removed from office. The reporter shall not practice as an attorney, counselor or solicitor in any court." Of the copies to be delivered to the secretary of state, the act requires one copy to be by him delivered to the clerk of each county of the state. It was under this act that Mr. Comstock, as alleged in the bill, was, on the 27th day of December, 1847, appointed state reporter. By another act, passed on the same day, the salary of this officer had been fixed at the sum of \$2,000.

By an amendatory act passed April 11, 1848, the mode of appointing the state reporter was changed by the association of the attorney-general with the governor and lieutenant-governor for that purpose, and it was again enacted that the reporter should "have no pecuniary interest" in the reports to be prepared by him as such reporter, but that the same should "be published under the supervision of the reporter, by contract to be entered into by the reporter, secretary of state and comptroller, with the person or persons who, in addition to furnishing the said secretary of state with sixty-four copies of each volume, shall agree to publish and sell the said reports on terms the most advantageous to the public, and at a rate not exceeding the price of \$3 for a volume of five hundred pages, regard being had to the proper execution of the work." The third section of this act is as follows: "§ 3. It shall not be lawful for the reporter, or any other person within this state, to secure or obtain any copyright for said reports, notes or references, but the same may be published by any persons." It may not be amiss here also to recite the remaining provisions of this act. They are contained in the fourth section and are as follows: "As often as the reporter shall have prepared for publication sufficient of the said reports, with notes and references, to constitute two hundred and fifty pages of the usual size of law reports, he shall cause the same to be published in pamphlet form, with such headings as will appear in the bound volumes, and shall furnish a copy thereof to each county clerk's office at the expense of the state, and keep the same on sale at contract prices for all persons who may want to purchase; such printing to be done by the

person who shall contract to publish the reports under this act at and in proportion to the prices stipulated in his contract." Act of April 11, 1848, ch. 224.

The only remaining enactments which it is necessary to notice are contained in an act to amend that last cited, the third section of which is thereby declared to be amended so as to read as follows: "§ 3. It shall not be lawful for the reporter, or any other person within this state, to secure or obtain any copyright for said reports of the judicial decisions of the court of appeals, but the same may be published by any person." The act further provides: "§ 2. The copyright of any notes or references made by the state reporter to any of said reports shall be vested in the secretary of state, for the benefit of the people of this state." Act of April 9, 1850, ch. 245.

§ 118. *What are "notes and references" as used in the New York act of April 9, 1850.*

Now, the question is whether, according to the proper construction of the words, "any notes or references made by the state reporter to any of said reports," contained in the last mentioned act, these words comprise any, and, if so, what portion or portions of the volume in controversy. The counsel for the defendants strenuously insist they are referable exclusively to such original notes or references as the state reporter might see fit of his own accord to superadd to what would otherwise be in themselves complete reports of the cases by him reported; and the example of the late Mr. Justice Cowen, while reporter to the supreme court of the state of New York, to whom the profession were so much indebted for the learned essays with which his great industry and love of jurisprudence impelled him to accompany his reports, is adduced as an example.

The words "notes or references," as we have seen, first occur in the act of April 11, 1848, chapter 224. By the third section of that act the state reporter and all other persons are expressly forbidden "to secure or obtain any copyright for said reports, notes or references;" and the fourth section directs the immediate publication of the reports, from time to time, as often as "the said reports, with notes and references," shall be sufficient to make two hundred and fifty pages. Now, it is to be observed that the words in question, in the sense in which they are understood by the counsel for the defendants, import nothing that has ever been supposed to pertain to the business of reporting judicial decisions, and nothing, therefore, which a reporter has ever done except at his own option merely. It is what few reporters have in fact done to any considerable extent, and what others have altogether omitted. There is nothing in either of the statutes relative to the subject, expressive of any design to exact this kind of labor of the reporter, and nothing in any other part of them indicative of any expectation that he would engage in it. It was what the state reporter might, perhaps, lawfully do to a moderate extent if he should see fit, but what he certainly was at liberty to omit at his pleasure, and what it could not therefore reasonably be assumed he was likely to undertake. It was what, if he should perform it, would be the fruits of his extraordinary labor, and that to the pecuniary profits of which, therefore, he would in justice be exclusively entitled. Without stopping, then, to inquire whether the legislature had the power, is it probable that it entertained the design to deprive him of the reward due to his enterprise and learning? And, having done this by the prohibition contained in the third section of the act, is it probable that it would have been assumed, as it seems to have been done

in the next succeeding section, that the reporter would nevertheless gratuitously accompany his reports with such notes or references? I am of opinion that these questions must be answered in the negative; and, unless the words in question are to receive a different interpretation in the act of April 9, 1850, which, to the extent of its provisions, must govern the rights of the plaintiffs, so far as they depend on state legislation, it follows that the rights with which the act invests the secretary of state are not restricted to the narrow limits insisted on by the counsel for the defendants. The two acts being *in pari materia*, the presumption is strong that the words "notes or references" were not designed to be used in different senses. But, in truth, the interpretation which they appear to me, as I have already stated, to require in the act of 1848, is fortified, in its application to them, in the act of 1850. This act declares that the copyright of any notes or references made, etc., shall be vested in the secretary of state for the benefit of the people. Now, bearing in mind the nature of the notes or references of which the words of the act are supposed by the defendants' counsel to be descriptive, and the improbability that the reporter would even take the trouble to make them at all, is it to be imagined that the legislature thought it worth while, to say nothing of the injustice of doing so, solemnly to claim them as the property of the state? I think not, and it follows, therefore, that these words were intended to designate some portion or portions of the reports, constituting an essential ingredient of their integral composition, and which the state reporter, as such, was therefore bound to supply. The next question, then, is, What part or parts of the reports are to be considered as comprised by these words? And herein lies the chief difficulty of determining their true interpretation.

§ 119. *The word "notes," in the act of April 9, 1850, of New York, comprises the summary immediately following the title of the suit, the foot-notes, and the statement of the arguments of counsel.*

The word *note* has many significations. Among the fifteen definitions given of it by Webster, the greatest lexicographer of the English language that has yet appeared, the twelfth is this: "Annotation; commentary; as the *notes* in Scott's Bible; to write *notes* on Homer." This is the definition insisted on by the defendants' counsel, but which, for the reasons already assigned, I hold to be inadmissible. The third definition given by Dr. Webster is this: "A short remark; a passage or explanation in the margin of a book;" and his fourth definition is this: "A minute, memorandum or short writing, intended to assist the memory." These are all the definitions which it is pertinent to notice, and the two last mentioned furnish, in my opinion, the proper guide in determining the scope of the word *note* in the statute. That it comprises the summary of the points decided by the court, which immediately follows the title of the suit in each case reported, and the foot-notes, in the volume in question, is indubitable. Does it embrace, also, the arguments of counsel? The process by which this portion of the report of a case is prepared is well known. The arguments are unwritten, and addressed to the court *ore tenus*, and a minute or memorandum, or short writing, intended to assist the memory of the reporter, is made by him at the time, from which he constructs the arguments which ultimately appear as one of the constituent elements of his report. I am of opinion, therefore, that they ought to be adjudged to fall within the scope of the expression, "any notes made by the reporter."

§ 120. *What are "references."*

The only remaining portions of the matter contained in the book in ques-

tion (which I understand to be, in fact, the *first part* of volume III. of Comstock's Reports, this being all that I have seen, and all that the defendants in their affidavit admit to have been published) that are susceptible of being made the subject of copyright, even independently of the state law, are the abstracts of the pleadings and statements of facts, which form the basis of the decisions reported. These can, in no proper sense, be denominated *notes*, nor am I able to perceive that they fall under the denomination of "references." If the book contains anything embraced by this latter word, it is the table of contents, entitled "cases reported," which consists of the titles of the suits comprised in the book, with *references* to the several particular pages where the cases are to be severally found. This constitutes but a very inconsiderable portion of the work; and, as it would be inapplicable to a reprint, unless its pages corresponded exactly with those of the original, I presume it has not been appropriated by the defendants, though I have not seen their book.

§ 121. *An equitable title in a copyright will authorize an injunction in favor of its owner.*

It appearing, from this review of the course of state legislation, that a copyright in the work in dispute was reserved to the people of the state, and the authority to secure it for their benefit vested in Mr. Morgan, the next question for consideration is, whether, in virtue of the contract with the plaintiffs, set forth in their bill of complaint, they obtained such a title to the subject of the controversy as is requisite to enable them to maintain their suit.

In some of the English cases to which I am referred, it is said that, to entitle a plaintiff to an injunction, in a case of this nature, he must establish a valid legal title to the copyright. Undoubtedly, when he relies upon a legal title, he is bound to set it forth, and it must appear to be at least *prima facie* valid. But it has also been held that there are cases in which an equitable title is sufficient to entitle its possessor to protection in this form. In the present case, an agreement has been entered into between the plaintiffs and certain officers of the state, designated by law for that purpose, the author of the work in question and the secretary of state being of the number, by which it is stipulated that, upon the terms therein mentioned, the plaintiffs shall have the exclusive right to the publication of the decisions of the court of appeals, and to the benefit of the copyright to be taken out in behalf of the state therefor, during the period of five years. By an act of the legislature then recently passed, it was declared that the copyright of certain specified portions of the reports of such decisions should be vested in the secretary of state, for the benefit of the people of the state. With respect to the particular manner in which this right should be made advantageous to the people, the act was not explicit. This was left, therefore, measurably, to the discretion of the secretary. He and his associates were, however, expressly required by law to see that the reports were speedily published and exposed to sale at a price not exceeding \$3 per volume. Perhaps they would have been authorized to contract for their publication and sale at that price, on condition that the publisher would pay a certain sum to the state for the privilege, provided a suitable person could have been found willing to become a party to such a contract. But they saw fit, and in strict accordance with the policy adopted by the legislature, of providing a sufficient supply of the reports at moderate prices, so to use the copyright as to make it conducive to that end, by offering to confer the emoluments arising therefrom, for a portion of the period during which it was to continue, on the publisher who would agree to furnish the required supply

of the reports at the lowest prices. The plaintiffs having, as it is to be presumed, offered the most favorable terms, the contract was made with them, they stipulating to publish and sell the reports at the very low rate of \$2.50 for a volume of five hundred pages.

§ 122. *Validity of copyright taken out by a state.*

It is objected that this contract was entered into before the book in controversy was prepared for the press. But, from the nature of the case, this could not have been otherwise without incurring delays subversive of the policy of the laws under which the agents of the state were acting. It seems clear therefore, without pursuing the subject further, that these gentlemen, in entering into this contract, acted in strict accordance with the laws of the state, and that the plaintiffs are justly entitled to all the benefits arising from it which the state could confer. If it is not valid and effectual to the extent contended for by the plaintiffs, it is altogether nugatory, and the plaintiffs must seek redress, not from a judicial tribunal for the violation of their copyright, but from the state for the breach of its plighted faith. It is true they are not the assignees of the entire privilege reserved by the state, of asserting a copyright to the volumes of the reports to be prepared by the state reporter as they shall be successively issued from the press through all future time; but to the beneficial interest in the copyright of the volumes to be published during the stipulated term of five years, it was designed to give them a perfect title. So far as this could be done by the supreme authority of the state, it has been done; and I am not aware of any grounds on which I should be warranted in deciding that it has not been done effectually. If it has not been, it must be because the subject is not in its nature susceptible of municipal regulation. But, in the compact between the state and the state reporter, by which the latter relinquishes and the former assumes the copyright in the reports, I can discern nothing inconsistent with the constitution and laws of the United States. It may be regarded as an assignment by operation of law. Can it be successfully contended that the exclusive right guarantied by the laws of the Union has in this instance become extinct? If not, it must have vested in the state and passed temporarily to the plaintiffs, who alone at the present time are competent to enforce it. Assuming this to be so, I think it follows that the plaintiffs have shown themselves to be in possession of a title to the work in question, of which this court is bound to take cognizance. Indeed there is no want of precedent in our own courts on this point, if it were necessary to invoke it. Thus, in the case of *Folsom v. Marsh*, 2 Story, 100 (§§ 249-56, *infra*), which was a bill in equity to restrain the infringement of Dr. Sparks' copyright in the writings of Washington, the interest claimed by the plaintiffs was described in the bill to consist in their having "assumed a part of the risk and responsibility of publishing the said work;" and the suit was maintained and a perpetual injunction awarded.

§ 123. *As to the granting of injunctions in case of doubt and uncertainty.*

Under this view of the substantial merits of the controversy, it remains only to determine whether an injunction ought to be withheld for the reasons so earnestly addressed by the learned counsel for the defendants to the discretion of the court. It certainly must be conceded that the case involves questions by no means entirely free from obscurity and doubt; and if, as the counsel seem to suppose, this ingredient of itself always constitutes a conclusive objection to the grant of a provisional injunction to restrain an alleged

piracy of a copyright, the only duty which would remain to me after making this concession would be the simple denial of the motion. But it is for the express purpose of resolving doubts with respect to the rights and responsibilities of parties, that courts are instituted; and, even on a motion of this nature, it is not every kind or degree of doubt that will absolve a judge from the responsibility of deciding questions presented for his consideration, much less from the labor of investigation and reflection. It must at least be a serious doubt which remains after the faithful application of his faculties to its solution. If it were otherwise, this form of redress would be illusory. Doubts affecting a plaintiff's title may arise either from uncertainty with respect to the facts, or with respect to the law on which the title depends. In the present case I do not understand that there is any dispute concerning the facts—certainly none respecting which there is any probability, not to say possibility, that any conflicting evidence could be adduced. There is nothing, therefore, which it would be proper to submit to the decision of a jury. The questions on which the rights of the parties depend are questions of law, arising mainly out of certain provisions contained in the constitution and statutes of the state of New York, and these questions the court is bound, at some stage of the controversy, to decide. But it is objected that they are new, never having been settled by acquiescence, or *by the adjudication of any court*. An injunction in a case of this kind, it is said, has never been granted in England without a trial at law; and it is broadly intimated that to do it in this case would be *iniquitous*. It would, it is argued, be to prejudge the case to decide it, and to award execution before trial. These are grave objections, and, if well founded, certainly ought to be held to be decisive. But it is because these questions have never before been judicially determined that they are now before this court for decision; and, with respect to the practice of English courts of chancery, of sending pure questions of law to be settled in a suit at law, the adoption of this practice by the circuit courts of the United States would, for obvious reasons, be an absurdity. As to the assertion that to allow an injunction now would be to decide the cause without a trial, it is proper to remind the counsel that the case has already been elaborately argued; and it is easy to see that its legal features are not likely to be essentially changed by the substitution of a formal answer for the affidavit of one of the defendants. The parties, therefore, have already had a trial of the only kind they ever can have, while the question is not, as it would be on a final hearing, whether the defendants should be perpetually enjoined, but whether this shall be done temporarily, leaving them at liberty, if they see fit, to re-argue the case on a final hearing.

If any additional reasons were wanting why I should not hold myself at liberty fastidiously to decline the responsibility of giving effect to the conclusions at which I have, however doubtingly, arrived, by granting an injunction, such reasons might easily be found in the demerits of the defendants. There can be no injustice in assuming that they have acted with full knowledge of all the facts detailed in the bill of complaint. Their extraordinary letter, already mentioned, shows this. They are chargeable, therefore, not only with a wilful and apparently very discreditable encroachment upon the rights of the plaintiffs, but with openly arraying themselves against the supreme authority of the state. There may possibly be circumstances, growing out of a spirit of rivalry between the parties, affording some palliation for conduct ap-

parently so unjust and audacious; but of this I know nothing, and it may at least be safely assumed that they can furnish no shadow of justification to the defendants.

I am of opinion, therefore, that the plaintiffs are entitled to an injunction restraining the defendants, their agents, servants and workmen, until the further order of the court, from further printing, publishing, selling, or otherwise disposing of any copy or copies of the reports of cases argued and determined in the court of appeals of the state of New York, already published or to be hereafter published by the plaintiffs in pursuance of their contract with the state set forth in their bill, containing any of the head-notes or summary statements of points decided, or any arguments of counsel, or any foot-notes, copied, taken or colorably altered from any book so published by the plaintiffs.

BULLINGER *v.* MACKEY.

(Circuit Court for New York: 15 Blatchford, 550-562. 1879.)

Opinion by BENEDICT, J.

STATEMENT OF FACTS.—This is a suit in equity for damages and an injunction by reason of an alleged infringement by the defendant of a copyright of the plaintiff. The bill avers that heretofore, and before the 26th day of March, 1870, the plaintiff was the proprietor of a certain book, the title whereof was "Supplement to the Counting House Monitor;" that, in the year 1872, he published his book, revised and amended, under the title "Monitor Post Office, Banking and Shippers' Guide;" that, in 1873, he revised and amended and published his said book under the title "The Monitor Post Office, Telegraph, Express and Shipping Guide for the United States and Canada;" and that, in 1876, he revised and amended and published his said book (designated in this case plaintiff's exhibit H), under the title "The Monitor Guide to Post Office and Railroad Stations in the United States and Canada, with shipping directions by express and freight lines. A supplement to the Counting House Monitor." These books the plaintiff asserts have a value by reason of certain peculiarities of structure and the mode of using arbitrary signs and figures, and he avers that the said plan, combination, arrangement and peculiarity of structure were the original work of the plaintiff, and that the exclusive right thereto belongs to him. In regard to each of said publications, the bill avers due performance of all the acts required by statute to be performed to secure a copyright thereof, as to which there is no controversy. The bill then charges that the defendant, in February, 1877, published a book (designated, in this case, defendant's exhibit J) entitled "Mackey's Shippers' Guide, or Mackey's Guide to all the Express, Telegraph, Money Order and Post Offices in the United States and Canada, with a complete list of all railroads, their length, starting point and terminus, giving each station and by what road it is reached, and, in addition, shows what express and freight lines will deliver goods to all the above points." This book, the plaintiff avers, is copied and printed from the books of the plaintiff described in the bill, and is an infringement on the plaintiff's said copyright, in that it is, in all respects, identical with the plaintiff's books, in the plan, combination, arrangement and method of imparting the same information. The defendant, in his answer, denies that his book was copied from the plaintiff's books. He also denies that the plan, combination, arrangement

and peculiarities of structure displayed in the plaintiff's books are the original work of the plaintiff, or that he is entitled to the exclusive right to use the same. He further avers that, since 1862, he has published periodicals containing information of the same character as that contained in the plaintiff's work; that all the information contained in the plaintiff's books had been given to the public in substantially the same form by other publications, including those of the defendant, prior to the publication of the plaintiff's works, and that the plan, arrangement or combination of matters in the plaintiff's books were not new, nor were the materials contained in them brought together in a new form for the first time by the plaintiff, but the same had been given to the public in substantially the same form in certain prior publications designated in the answer. Testimony having been taken upon the issue thus raised, it was referred to a master to report to the court, among other things, "the identity, if any, and in what particulars, of plan, arrangement, combination of materials and the method of imparting instruction, between complainant's exhibit H, and defendant's exhibit J; also, the identity, if any, and in what particulars, of plan, combination of materials, arrangement and the methods of imparting information, between the complainant's publication set forth in the bill, and such of the publications set forth in the answer as may appear to have been made prior to the date of complainant's copyright, in the respect, if any, where exhibits H and J shall be found to be identical." The master reported, among other things, the following conclusions of fact: "Complainant's exhibit H and defendant's exhibit J are identical in the following particulars of plan, viz.: There are compilations of tables or lists which show how to ship goods from New York to any place that is a railroad station or post-office in the United States or the dominion of Canada, by railroad, express line or freight line. They are identical in the following particulars of arrangement, viz.: They are in two general divisions, covering the United States and the dominion of Canada. In the first general division are title-pages, publisher's notice and explanations, list of railroads in the United States, list of places in the United States, but not arranged in identically the same way. In the second general division are lists of places in the dominion of Canada alphabetically arranged. Shipping directions upon the last leaf of both. They are identical in the following particulars of combination of materials: The lists of railroads in each division are arranged alphabetically, with numbers for reference set against each name, but not the same numbers. In the list of places are combined the name of the place; the county in which it is; the railroad, by reference number, upon which it is; if it be on a railroad, the name or abbreviation thereof; the express company by which it may be reached; the names of postoffices are in roman type; the names of railroad stations, not postoffices, are in italic type; money order postoffices are marked by a star; county seats, in some cases, are marked by letters c. h. These combinations are made in the second division alphabetically for the whole dominion. Upon each page of the body of the work, in both divisions, are given explanations of the signs used and references to other pages of the work. They are identical in the following particulars of their method of imparting information: They give information of the county and state in which any given place is located, the express lines from New York by which it may be reached, and the railroad, by reference numbers, on which it is a station, if it be on a railroad, by arranging the names and numbers in corresponding columns, but not in identically the same form of arrangement. They

give information whether a place is or is not a money-order postoffice by placing a star against the names of places that are such postoffices. They give, in some cases, information whether places are county seats by placing the letters c. h. against their names. They give information whether a place is or is not a railroad station as well as a postoffice by putting the names of such stations as are not also postoffices in italic type. They give generally, but not in all cases, a reference upon each page of list of places to other pages where other directions how to ship goods for those places are given. They give information about freight lines, grouped by states." The master further reported as follows: "All the particulars of plan, arrangement, combination of materials and method of imparting information, as above described by him, are not found in any one of the prior publications set up in the answer. In no one of said prior publications is there the identical plan above described by him and found in the plaintiff's exhibit H and the defendant's exhibit J. In one of said prior publications, viz., Teller's American Shipping Express Guide, there is the same general arrangement as described by him and found in plaintiff's exhibit H and defendant's exhibit J. Many of such prior works contain lists of places arranged alphabetically, as in exhibit H, but in none are there the same lists or the same arrangement of places in the list. Some of said prior works contain lists of railroads alphabetically arranged, with reference numbers; others contain lists of places, combining name of place, county, railroad (but not by reference numbers) and express, but, in some cases, the express line on which it or its nearest railroad station is located is not, as in the plaintiff's book, the express that carries goods from New York. Some of said prior publications convey the same information conveyed by the plaintiff's work, but by a different method. In some of the prior publications money-order postoffices are, as in the plaintiff's work, indicated by a star or some equivalent sign; in some a county seat is indicated by the letters c. h. Many of the prior publications contain list of places, of postoffices, of railroads, of freight lines, alphabetically arranged. Many group their information by states. These prior publications were published for some part or parts of the same general purpose as the complainant's exhibit H and the defendant's exhibit J, and contain some part or parts of the same information, but not in the same form or arrangement or combination of materials in any case."

To this report of the master various exceptions were taken, and the case was brought to a hearing upon such exceptions, and the pleadings and proofs, at the same time. Owing to the restricted form of the order of reference, the master's report does not cover all the questions of fact necessary for a disposal of the case. As far as it goes, however, upon the evidence, it must be deemed conclusive of the facts stated therein. The other questions of fact, and the questions of law applicable thereto, are now to be determined by the court.

In regard to the exceptions it is sufficient, therefore, to say that I see no reason to differ with the master as to any of his conclusions of fact, and none of the exceptions appear to be well taken.

§ 124. *A compilation of information respecting railroads, etc., is a proper subject of a copyright.*

In disposing of the questions raised by the answer it will be convenient to notice, first, the point made by the defendant that the plaintiff's work cannot be a subject of copyright, because not within the scope of the provision of the constitution which grants the power "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclu-

sive right to their respective writings and discoveries." Upon this point it is sufficient to say that I am unable to find a substantial distinction between the plaintiff's works and those works that in other cases have been adjudged to be within the scope of the constitution and the copyright laws, such, for instance, as maps, "The Advertiser's and Collector's Chart," hereafter referred to, "The Ladies' Chart for cutting dresses and basques for ladies." *Drury v. Ewing*, 1 Bond, 541 (§§ 112-14, *supra*).

§ 125. *How the fact that the plan, arrangement and combination of a copyrighted work originated in the brain of the author may be proved.*

I next notice the point made that the plaintiff has not produced proper evidence to show himself the author or proprietor of his works, within the meaning of the copyright laws. The argument here is that no one but the plaintiff himself can legally establish the fact that the plan, arrangement and combination of his works originated in his brain. But there is evidence showing that the plaintiff, by his own labor and that of persons employed by him and working under his direction, gathered together from various original sources the material of his book; that the manuscript in which the matter was arranged was partly in his handwriting; and that from the manuscript the work was printed for him at his expense. It was not necessary that these acts of the plaintiff should be proved by the testimony of the plaintiff. The testimony of any person who saw them done is primary and direct evidence of their having been done, and, in the absence of any testimony to the contrary, established the fact that the plaintiff gathered together the information conveyed by his book, arranged that information as it appears in the book, and caused it to be printed in that form. The acts of the plaintiff thus proved to have been done in preparing his work are those of a compiler. A compiler is an author, within the meaning of the constitution and the copyright laws.

A more important question is raised by the averment in the bill that the defendant's book, exhibit J, was copied from the books of the plaintiff. If this averment has been proved, the defendant has infringed upon the plaintiff's copyright, for it is not to be doubted that the plaintiff acquired the right to prevent any person from appropriating the fruits of his labor by making a transcript of his book, without any other skilled labor or expense than that involved in making and publishing the copy, and it is equally true that a copy so made would infringe upon the plaintiff's copyright, notwithstanding it might appear that colorable alterations had been introduced into the copy for the purpose of disguising the fact that the work was but a transcript. But the evidence wholly fails to support the averment that the defendant's book is copied from the plaintiff's books. Notwithstanding the similarity between the plaintiff's exhibit H and the defendant's exhibit J, which the master has pointed out, it is impossible to find that the only labor expended by the defendant was that of making a transcript of the plaintiff's book. Here the character and object of the works, as well as their subject-matter, must not be overlooked. When these features are considered, it is very easy to see how two works of this character may be as similar as the master has found these to be, and yet the one not a transcript from the other. The points of similarity found by the master may well have arisen from the character of the publication, the object intended to be served, and the nature of the information sought to be conveyed; and there are many points of difference. The master was not required to report the points of difference between the conflicting publications, but many such are obvious from an inspection of the two books,

plaintiff's exhibit H and defendant's exhibit J. Among other differences may be noticed the general appearance of the books and their title-pages. In these respects they are so dissimilar that it would be impossible for any intelligent person to mistake the one for the other. Evidently there was no effort on the part of the defendant to impose upon the public by issuing a book similar in appearance to the plaintiff's books. The two books do not convey the same information. To notice one instance, the defendant's list of railroads, under the letter A, contains twenty-five main lines, while the plaintiff's list, under letter A, gives but fourteen lines. The lists of railroads are not identical in the names given. The defendant, in his table, gives the starting point and termination of each railroad, with its length, while the plaintiff's table gives no such information. The plaintiff arranges his list of postoffices and railroad stations for each division alphabetically, while in the defendant's book, postoffices and railroads are arranged alphabetically by states. This is a very substantial difference, sufficient, I apprehend, in some cases, to determine a choice between the two books. In the plaintiff's books, the information respecting freight lines is given in a place by itself, to which reference is made on each page of the table. In the defendant's book, information of the same character, but not the same information, is conveyed by inserting in the tables a list of reference numbers, by which reference is made to certain freight lines given at the bottom of each page of the tables. The directions for shipping freight are wholly dissimilar in the two books. The method of numbering the railroads is not the same in both books, nor are reference numbers used according to the same system. According to the system of the plaintiff's books, each main line of railroad is given its reference number, and to each line that is a branch of a main line is given the number of its main line, with a "superior" number attached thereto, whereby it is indicated that the line is a branch of such main line. In the defendant's book, both main line and branch lines of said roads are numbered continuously. These are not mere colorable differences, made for the purpose of concealing a literary piracy, but they are substantial, and forbid the conclusion that the defendant has copied the plaintiff's books. Moreover there is direct evidence, uncontradicted, showing that the defendant's book was compiled by him from original sources of information, by the exercise of labor and skill of his own, and the expenditure of his money, and was not made by transcribing from the plaintiff's book the information there collected.

In regard to the defendant's use of reference numbers attached to a list of railroads, and set opposite the names of towns, in the list of towns, to indicate the railroad by which that town can be reached, I think it may properly be inferred, from the facts proved, that the use of this method in the plaintiff's book, exhibit H, suggested to the defendant its use in his book, exhibit J. But it is not sufficient to show that it may have been suggested by the plaintiff's work. *Emerson v. Davies*, 3 Story, 768, 787 (§§ 270-79, *infra*). It must also appear that it was new and original with the plaintiff. Here the contrary appears, for the same system is found in actual use, in connection with a list of railroads, in "The Travelers' Official Guide," published in 1871, defendant's exhibit 10.

§ 126. *A compilation made from original sources is a new work.*

Upon the evidence, therefore, it cannot be held that the defendant's book is a copy of the plaintiff's books, within the meaning of the copyright laws. In such cases, each new compilation, where it is the result of labor devoted to

gathering from original sources, and to arranging in convenient form, facts open to be published by any one, is a new work. The one compiler is as much entitled to the fruit of his labor as the other to the fruit of his, and both are, by the copyright laws, protected in an equal degree against the appropriation of that labor by one who does not compile but only copies.

Works of this character appear to me to stand upon very much the same footing with maps, of which it is said, in *Emerson v. Davies*, 3 Story, 768, 781 (§§ 270-79, *infra*), by Story, J.: "A man has a right to the copyright of a map of a state or county which he has surveyed, or caused to be compiled from existing materials at his own expense of skill or labor or money. Another man may publish another map of the same state or county, by using the like means or materials and the like skill, labor and expense. But then he has no right to publish a map taken substantially and designedly from the map of the other person, without any such exercise of skill or labor or expense." What has been already said disposes of the charge in the bill that the defendant's book is copied from the plaintiff's books.

The remaining charge in the bill, demanding attention, is, that the defendant's book is, in all respects, identical with the plaintiff's books, in the plan, combination, arrangement and method of imparting the same information, and for this reason is an infringement on the plaintiff's copyright. It appears by the master's report that the defendant's book is identical with the plaintiff's books in certain particulars of plan, combination, arrangement and method of imparting information; and it also appears from the proofs, that, in certain other particulars of plan, arrangement and method of imparting information, the books are wholly dissimilar in the information they convey. Now, it may be conceded that there is nothing in the character of the plaintiff's work to make it an exception to the rule that has been declared in cases respecting other compilations, that "every author of a book has a copyright in the plan, arrangement and combination of his materials, if it be new and original in substance." But, before the plaintiff can invoke an application of this rule, he must make it appear that his book exhibits a substantially new and original system of arranging material of that character, which system was his own invention. This he has not been able to do. Not every method of arranging material requires invention. No invention, in the legal sense, would be required to arrange a list of names in the reverse order of the alphabet, or to indicate a relation between two things by placing them in corresponding columns, or to state a fact in a short way, by attaching a star to a name, or adding the letters c. h. thereto, or by using different styles of type. None of the methods of imparting information employed by the plaintiff, which the master has found also employed in the defendant's book, involve invention. Nor are any of them new and original with the plaintiff. In this respect the plaintiff's case very much resembles the case of *Lawrence v. Cupples*, 9 Pat. Off. Gaz., 254, decided by Judge Shepley. There, the plaintiff issued a monthly chart, published each month, and containing information in regard to a certain class of debtors, which information was conveyed by means of a list of the debtors arranged alphabetically, with the address of the debtor, the address of the creditor, the amount of the claim, and, in some instances, the discount at which the claim would be sold for cash, arranged in tabular form. The charge was that the defendant, in a work of similar character, had adopted the plaintiff's plan in arranging the names and residences of debtors and creditors, and in stating the amounts, and in the object and purposes of said arrangement. But the

court held that, although the plan or arrangement of a book may be secured to the author, if it be the product of his own genius, there did not seem to be anything in the plaintiff's work which possessed any such novelty of plan or arrangement as would preclude any other person from making and publishing, from his own independent sources of information, similar lists. I am of the opinion that the same conclusion must be reached in regard to the work of the plaintiff. The plan, arrangement and method adopted by the plaintiff, as well as by the defendant, is such as would naturally, if not necessarily, occur to any intelligent person intending to impart information of this character. These methods spring from the necessities of the case and the character of the information intended to be conveyed; and their use by the defendant is not sufficient to constitute his book a servile imitation of the plaintiff's books. Notwithstanding the similarity of the methods visible in these books, it still remains true that the defendant's book "is the result of his own labor, skill and use of common materials and common sources of knowledge open to all men, and the resemblances are either accidental or arising from the nature of the subject." Story, J., in *Emerson v. Davies*, 3 Story, 768, 793 (§§ 270-79, *infra*).

But it is said that the plaintiff was the first to combine the methods employed by him to convey his information, and is, therefore, the author of a new combination of methods, to which he has the exclusive right. It is true that, in no single prior publication, is there to be found in use all the methods of conveying information employed by the plaintiff in his work, but each of those methods has been used before, and none are original with him. What he has done is to aggregate various methods, which, when aggregated, stand now collected for the first time on a single page. This is not like the case of the arithmetic (*Emerson v. Davies*, 3 Story, 768; §§ 270-79, *infra*), where a plan of lessons, an arrangement of tables to illustrate those lessons, a gradation of examples to precede each table, in such manner as to form, with the table, a peculiar appearance of the page and an illustration of the lessons, by attaching to each example unit marks representing the numbers embraced in the example, were so combined as to constitute, in the aggregate, a new method of illustrating the subject of arithmetic. Here, there is no new combination of material, constituting a new and original work. There is a use, perhaps, a combination, of old methods, but it can scarcely be said that a new method of illustrating the subject has been produced. I say perhaps, because it may be doubtful whether there is any just analogy between the combination of methods made by the plaintiff and a patentable combination of elements in a machine. Besides, in regard to patentable combinations even, it is said that "merely bringing old devices into juxtaposition and then allowing each to work out its own effect, without the production of something novel, is not invention." *Hailes v. Van Wormer*, 20 Wall., 353 (PATENTS, §§ 867-72).

Again, if the use of the old methods selected by the plaintiff makes him the author of a new and original combination of materials, and hence the author of a new book, the defendant's position is the same; for he has not selected the same methods. His combination is, therefore, different from that of the plaintiff, not colorably, but substantially, different, and the result a work new and original with him, to which he acquired as much right as did the plaintiff when he adopted, for instance, several methods used in the prior work of Teller. To hold that, in any such case, an exclusive right can be acquired to the combination of methods employed, would be to prevent any improvement in books of the character.

My conclusion, therefore, is, that, for the reasons above stated, the plaintiff has failed to show any infringement upon his rights by the defendant, and his bill must, accordingly, be dismissed, with costs.

BAKER *v.* SELDEN.

(11 Otto, 99-107. 1879.)

APPEAL from U. S. Circuit Court, Southern District of Ohio.

Opinion by MR. JUSTICE BRADLEY.

STATEMENT OF FACTS.—Charles Selden, the testator of the complainant in this case, in the year 1859 took the requisite steps for obtaining the copyright of a book entitled “Selden’s Condensed Ledger, or Book-keeping Simplified,” the object of which was to exhibit and explain a peculiar system of book-keeping. In 1860 and 1861, he took the copyright of several other books, containing additions to and improvements upon the said system. The bill of complaint was filed against the defendant, Baker, for an alleged infringement of these copyrights. The latter, in his answer, denied that Selden was the author or designer of the books, and denied the infringement charged, and contends on the argument that the matter alleged to be infringed is not a lawful subject of copyright.

The parties went into proofs, and the various books of the complainant, as well as those sold and used by the defendant, were exhibited before the examiner, and witnesses were examined on both sides. A decree was rendered for the complainant, and the defendant appealed.

The book or series of books of which the complainant claims the copyright consists of an introductory essay explaining the system of book-keeping referred to, to which are annexed certain forms or blanks, consisting of ruled lines and headings, illustrating the system and showing how it is to be used and carried out in practice. This system effects the same results as book-keeping by double entry; but, by a peculiar arrangement of columns and headings, presents the entire operation, of a day, a week, or a month, on a single page, or on two pages facing each other, in an account-book. The defendant uses a similar plan so far as results are concerned; but makes a different arrangement of the columns, and uses different headings. If the complainant’s testator had the exclusive right to the use of the system explained in his book, it would be difficult to contend that the defendant does not infringe it, notwithstanding the difference in his form of arrangement; but if it be assumed that the system is open to public use, it seems to be equally difficult to contend that the books made and sold by the defendant are a violation of the copyright of the complainant’s book considered merely as a book explanatory of the system. Where the truths of a science or the methods of an art are the common property of the whole world, any author has the right to express the one, or explain and use the other, in his own way. As an author, Selden explained the system in a particular way. It may be conceded that Baker makes and uses account-books arranged on substantially the same system; but the proof fails to show that he has violated the copyright of Selden’s book, regarding the latter merely as an explanatory work; or that he has infringed Selden’s right in any way, unless the latter became entitled to an exclusive right in the system.

§ 127. *The copyright of a book does not secure the exclusive right of a system of book-keeping, set forth and expounded in that book.*

The evidence of the complainant is principally directed to the object of

showing that Baker uses the same system as that which is explained and illustrated in Selden's books. It becomes important, therefore, to determine whether, in obtaining the copyright of his books, he secured the exclusive right to the use of the system or method of book-keeping which the said books are intended to illustrate and explain. It is contended that he has secured such exclusive right, because no one can use the system without using substantially the same ruled lines and headings which he has appended to his books in illustration of it. In other words, it is contended that the ruled lines and headings, given to illustrate the system, are a part of the book, and, as such, are secured by the copyright; and that no one can make or use similar ruled lines and headings, or ruled lines and headings made and arranged on substantially the same system, without violating the copyright. And this is really the question to be decided in this case. Stated in another form, the question is, whether the exclusive property in a system of book-keeping can be claimed, under the law of copyright, by means of a book in which that system is explained? The complainant's bill, and the case made under it, are based on the hypothesis that it can be.

It cannot be pretended, and indeed it is not seriously urged, that the ruled lines of the complainant's account-book can be claimed under any special class of objects, other than books, named in the law of copyright existing in 1859. The law then in force was that of 1831, and specified only books, maps, charts, musical compositions, prints and engravings. An account-book, consisting of ruled lines and blank columns, cannot be called by any of these names unless by that of a book.

There is no doubt that a work on the subject of book-keeping, though only explanatory of well-known systems, may be the subject of a copyright; but then it is claimed only as a book. Such a book may be explanatory either of old systems, or of an entirely new system; and, considered as a book, as the work of an author, conveying information on the subject of book-keeping, and containing detailed explanations of the art, it may be a very valuable acquisition to the practical knowledge of the community. But there is a clear distinction between the book, as such, and the art which it is intended to illustrate. The mere statement of the proposition is so evident that it requires hardly any argument to support it. The same distinction may be predicated of every other art as well as that of book-keeping. A treatise on the composition and use of medicines, be they old or new; on the construction and use of plows, or watches, or churns; or on the mixture and application of colors for painting or dyeing; or on the mode of drawing lines to produce the effect of perspective, would be the subject of copyright; but no one would contend that the copyright of the treatise would give the exclusive right to the art or manufacture described therein. The copyright of the book, if not pirated from other works, would be valid, without regard to the novelty, or want of novelty, of its subject-matter. The novelty of the art or thing described or explained has nothing to do with the validity of the copyright. To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public. That is the province of letters patent, not of copyright. The claim to an invention or discovery of an art or manufacture must be subjected to the examination of the patent office before an exclusive right therein can be obtained; and it can only be secured by a patent from the government.

§ 128. *The difference between copyright and patent-right.*

The difference between the two things, letters patent and copyright, may be illustrated by reference to the subjects just enumerated. Take the case of medicines. Certain mixtures are found to be of great value in the healing art. If the discoverer writes and publishes a book on the subject (as regular physicians generally do), he gains no exclusive right to the manufacture and sale of the medicine; he gives that to the public. If he desires to acquire such exclusive right, he must obtain a patent for the mixture as a new art, manufacture, or composition of matter. He may copyright his book, if he pleases; but that only secures to him the exclusive right of printing and publishing his book. So of all other inventions or discoveries.

The copyright of a book on perspective, no matter how many drawings and illustrations it may contain, gives no exclusive right to the modes of drawing described, though they may never have been known or used before. By publishing the book, without getting a patent for the art, the latter is given to the public. The fact that the art is described in the book by illustrations of lines and figures which are reproduced in practice in the application of the art makes no difference. Those illustrations are the mere language employed by the author to convey his ideas more clearly. Had he used words of description instead of diagrams (which merely stand in the place of words), there could not be the slightest doubt that others, applying the art to practical use, might lawfully draw the lines and diagrams which were in the author's mind, and which he thus described by words in his book.

The copyright of a work on mathematical science cannot give to the author an exclusive right to the methods of operation which he propounds, or to the diagrams which he employs to explain them, so as to prevent an engineer from using them whenever occasion requires. The very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book. And where the art it teaches cannot be used without employing the methods and diagrams used to illustrate the book, or such as are similar to them, such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public; not given for the purpose of publication in other works explanatory of the art, but for the purpose of practical application.

Of course, these observations are not intended to apply to ornamental designs, or pictorial illustrations addressed to the taste. Of these it may be said that their form is their essence, and their object the production of pleasure in their contemplation. This is their final end. They are as much the product of genius and the result of composition as are the lines of the poet or the historian's periods. On the other hand, the teachings of science and the rules and methods of useful art have their final end in application and use; and this application and use are what the public derive from the publication of a book which teaches them. But as embodied and taught in a literary composition or book, their essence consists only in their statement. This alone is what is secured by the copyright. The use by another of the same methods of statement, whether in words or illustrations, in a book published for teaching the art, would undoubtedly be an infringement of the copyright.

Recurring to the case before us, we observe that Charles Selden, by his books, explained and described a peculiar system of book-keeping, and illus-

trated his method by means of ruled lines and blank columns, with proper headings on a page, or on successive pages. Now, whilst no one has a right to print or publish his book, or any material part thereof, as a book intended to convey instruction in the art, any person may practice and use the art itself which he has described and illustrated therein. The use of the art is a totally different thing from a publication of the book explaining it. The copyright of a book on book-keeping cannot secure the exclusive right to make, sell and use account-books prepared upon the plan set forth in such book. Whether the art might or might not have been patented is a question which is not before us. It was not patented, and is open and free to the use of the public. And, of course, in using the art, the ruled lines and headings of accounts must necessarily be used as incident to it.

The plausibility of the claim put forward by the complainant in this case arises from a confusion of ideas produced by the peculiar nature of the art described in the books which have been made the subject of copyright. In describing the art, the illustrations and diagrams employed happen to correspond more closely than usual with the actual work performed by the operator who uses the art. Those illustrations and diagrams consist of ruled lines and headings of accounts; and it is similar ruled lines and headings of accounts which, in the application of the art, the book-keeper makes with his pen, or the stationer with his press; whilst in most other cases the diagrams and illustrations can only be represented in concrete forms of wood, metal, stone, or some other physical embodiment. But the principle is the same in all. The description of the art in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself. The object of the one is explanation; the object of the other is use. The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters patent.

The remarks of Mr. Justice Thompson in the circuit court in *Clayton v. Stone*, 2 Paine, 392, in which copyright was claimed in a daily price current, are apposite and instructive. He says: "In determining the true construction to be given to the act of congress, it is proper to look at the constitution of the United States to aid us in ascertaining the nature of the property intended to be protected. 'Congress shall have power to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their writings and discoveries.' The act in question was passed in execution of the power here given, and the object, therefore, was the promotion of science; and it would certainly be a pretty extraordinary view of the sciences to consider a daily or weekly publication of the state of the market as falling within any class of them. They are of a more fixed, permanent and durable character. The term 'science' cannot, with any propriety, be applied to a work of so fluctuating and fugitive a form as that of a newspaper or price current, the subject-matter of which is daily changing, and is of mere temporary use. Although great praise may be due to the plaintiffs for their industry and enterprise in publishing this paper, yet the law does not contemplate their being rewarded in this way; it must seek patronage and protection from its utility to the public, and not as a work of science. The title of the act of congress is, 'for the encouragement of learning,' and was not intended for the encouragement of mere industry, unconnected with learning and the sciences. . . . We are, accordingly, of opinion that the

paper in question is not a book the copyright to which can be secured under the act of congress."

The case of *Cobbett v. Woodward*, Law Rep., 14 Eq., 407, was a claim to copyright in a catalogue of furniture which the publisher had on sale in his establishment, illustrated with many drawings of furniture and decorations. The defendants, being dealers in the same business, published a similar book, and copied many of the plaintiff's drawings, though it was shown that they had for sale the articles represented thereby. The court held that these drawings were not subjects of copyright. Lord Romilly, M. R., said: "This is a mere advertisement for the sale of particular articles which any one might imitate and any one might advertise for sale. If a man, not being a vendor of any of the articles in question, were to publish a work for the purpose of informing the public of what was the most convenient species of articles for household furniture, or the most graceful species of decorations for articles of home furniture, what they ought to cost, and where they might be bought, and were to illustrate his work with designs of each article he described, such a work as this could not be pirated with impunity, and the attempt to do so would be stopped by the injunction of the court of chancery; yet if it were done with no such object, but solely for the purpose of advertising particular articles for sale, and promoting the private trade of the publisher by the sale of articles which any other person might sell as well as the first advertiser, and if in fact it contained little more than an illustrated inventory of the contents of a warehouse, I know of no law which, while it would not prevent the second advertiser from selling the same articles, would prevent him from using the same advertisement; provided he did not in such advertisement by any device suggest that he was selling the works and designs of the first advertiser."

Another case, that of *Page v. Wisden*, 20 L. T. (N. S.), 435, which came before Vice-Chancellor Malins in 1869, has some resemblance to the present. There a copyright was claimed in a cricket scoring-sheet, and the vice-chancellor held that it was not a fit subject for copyright, partly because it was not new, but also because "to say that a particular mode of ruling a book constituted an object for a copyright is absurd."

These cases, if not precisely in point, come near to the matter in hand, and, in our view, corroborate the general proposition which we have laid down.

In *Drury v. Ewing*, 1 Bond, 540 (§§ 112-14, *supra*), which is much relied on by the complainant, a copyright was claimed in a chart of patterns for cutting dresses and basques for ladies, and coats, jackets, etc., for boys. It is obvious that such designs could only be printed and published for information, and not for use in themselves. Their practical use could only be exemplified in cloth on the tailor's board and under his shears; in other words, by the application of a mechanical operation to the cutting of cloth in certain patterns and forms. Surely the exclusive right to this practical use was not reserved to the publisher by his copyright of the chart. Without undertaking to say whether we should or should not concur in the decision in that case we think it cannot control the present.

The conclusion to which we have come is, that blank account-books are not the subject of copyright; and that the mere copyright of Selden's book did not confer upon him the exclusive right to make and use account-books, ruled and arranged as designated by him, and described and illustrated in said book.

The decree of the circuit court must be reversed, and the cause remanded with instructions to dismiss the complainant's bill; and it is so ordered.

GRAY v. RUSSELL.

(Circuit Court for Massachusetts: 1 Story, 11-21. 1839.)

STATEMENT OF FACTS.—The complainants in this case alleged that they were the owners of the copyright of a book entitled “Adam’s Latin Grammar,” with notes and additions by Gould. The work complained of was entitled “Adam’s Latin Grammar,” and was edited by Cleveland.

Opinion by STORY, J.

The question now before the court is upon the confirmation of the master’s report. No exception has been taken to the facts and detailed statements in the master’s report; and, therefore, the point is narrowed down to the inquiry, whether the conclusion drawn from these facts by the master is correct. I am of opinion that it is, and that the report ought to be confirmed; and, as consequent thereon, that a perpetual injunction ought to be granted, prohibiting the sale of the edition of Cleveland’s Adam’s Latin Grammar in the pleadings mentioned by the defendant.

§ 129. *Notes, collected from various sources and arranged, may be protected by copyright.*

The argument proceeds mainly upon this ground, that there is nothing substantially new in Mr. Gould’s notes to his addition of Adam’s Latin Grammar; and that all his notes in substance, and many of them in form, may be found in other works antecedently printed. That is not the true question before the court. The true question is, whether these notes are to be found collected and embodied in any former single work. It is admitted that they are not so to be found. The most that is contended for is that Mr. Gould has selected his notes from very various authors, who have written at different periods, and that any other person might, by a diligent examination of the same works, have made a similar selection. It is not pretended that Mr. Cleveland undertook or accomplished such a task by such a selection from the original authors. Indeed, it is too plain for doubt, that he has borrowed the whole of his notes directly from Mr. Gould’s work; and so literal has been his transcription that he has incorporated the very errors thereof.

Now, certainly, the preparation and collection of these notes from these various sources must have been a work of no small labor and intellectual exertion. The plan, the arrangement and the combination of these notes, in the form in which they are collectively exhibited in Gould’s Grammar, belong exclusively to this gentleman. He is, then, justly to be deemed the author of them in their actual form and combination, and entitled to a copyright accordingly. If no work could be considered by our law as entitled to the privilege of copyright which is composed of materials drawn from many different sources, but for the first time brought together in the same plan and arrangement and combination, simply because those materials might be found scattered up and down in a great variety of volumes, perhaps in hundreds, or even thousands, of volumes, and might therefore have been brought together in the same way and by the same researches of another mind, equally skilful and equally diligent,—then, indeed, it would be difficult to say that there could be any copyright in most of the scientific and professional treatises of the present day. What would become of the elaborate commentaries of modern scholars upon the classics, which, for the most part, consist of selections from the works and criticisms of various former authors, arranged in a new form, and combined together by new illustrations, intermixed with them? What would

become of the modern treatises upon astronomy, mathematics, natural philosophy and chemistry? What would become of the treatises in our own profession, the materials of which, if the works be of any real value, must essentially depend upon faithful abstracts from the reports, and from juridical treatises, with illustrations of their bearing? Blackstone's Commentaries is but a compilation of the laws of England, drawn from authentic sources open to the whole profession; and yet it was never dreamed that it was not a work which, in the highest sense, might be deemed an original work; since never before were the same materials so admirably combined and exquisitely wrought out, with a judgment, skill and taste absolutely unrivaled. Take the case of the work on insurance, written by one of the learned counsel in this cause, and to which the whole profession are so much indebted; it is but a compilation, with occasional comments upon all the leading doctrines of that branch of the law, drawn from reported cases, or from former authors, but combined together in a new form, and in a new plan and arrangement; yet, I presume, none of us ever doubted that he was fully entitled to a copyright in the work, as being truly, in a just sense, his own.

§ 130. *In the matter of compilations, each author must investigate for himself; he cannot copy the work of another author.*

There is no foundation in law for the argument that, because the same sources of information are open to all persons, and, by the exercise of their own industry and talents and skill, they could, from all these sources, have produced a similar work, one party may, at second hand, without any exercise of industry, talents or skill, borrow from another all the materials which have been accumulated and combined together by him. Take the case of a map of a county, or of a state, or an empire; it is plain that, in proportion to the accuracy of every such map, must be its similarity to, or even its identity with, every other. Now, suppose a person has bestowed his time and skill and attention, and made a large series of topographical surveys in order to perfect such a map, and has thereby produced one far excelling every existing map of the same sort. It is clear that, notwithstanding this production, he cannot supersede the right of any other person to use the same means, by similar surveys and labors, to accomplish the same end. But it is just as clear that he has no right, without any such surveys and labors, to sit down and copy the whole of the map already produced by the skill and labors of the first party, and thus to rob him of all the fruit of his industry, skill and expenditures. See *Wilkins v. Aiken*, 17 Ves., 424, 425; *Eden on Inj.*, ch. 13, pp. 282, 283; 2 *Story on Eq. Juris.*, secs. 939-942. It would be a downright piracy.

§ 131. *It is not material in what form the works of another author are used.*

Neither is it of any consequence in what form the works of another author are used; whether it be by a simple reprint or by incorporating the whole or a large portion thereof in some larger work. Thus, for example, if in one of the large encyclopædias of the present day the whole or a large portion of a scientific treatise of another author, as, for example, one of Dr. Lardner's, or Sir John Herschel's, or Mrs. Somerville's treatises, should be incorporated, it would be just as much a piracy upon the copyright as if it were published in a single volume.

§ 132. *Abridgments. Extracts for purposes of a review.*

In some cases, indeed, it may be a very nice question what amounts to a piracy of a work or not. Thus, if large extracts are made therefrom in a re-

view, it might be a question whether those extracts were designed *bona fide* for the mere purpose of criticism, or were designed to supersede the original work under the pretense of a review, by giving its substance in a fugitive form. The same difficulty may arise in relation to an abridgment of an original work. The question in such a case must be compounded of various considerations: whether it be a *bona fide* abridgment or only an evasion by the omission of some unimportant parts; whether it will, in its present form, prejudice or supersede the original work; whether it will be adapted to the same class of readers; and many other considerations of the same sort which may enter as elements in ascertaining whether there has been a piracy or not. Although the doctrine is often laid down in the books that an abridgment is not a piracy of the original copyright, yet this proposition must be received with many qualifications. See 2 Story, Eq. Juris., secs. 939-942; Sweet v. Shaw, before the vice-chancellor in 1839, The [English] Jurist for 1839, p. 212.

§ 133. *In deciding whether a copyright has been infringed, it is not only quantity, but value, which is looked to.*

In many cases the question may naturally turn upon the point, not so much of the quantity as of the value of the selected materials. As was significantly said on another occasion, *Non numerantur ponderantur*. The quintessence of a work may be piratically extracted, so as to leave a mere *caput mortuum*, by a selection of all the important passages in a comparatively moderate space. In the recent case of Bramwell v. Halcomb, 3 Mylne & Craig, 737, it was held that the question whether one author has made a piratical use of another's work does not necessarily depend upon the quantity of that work which he has quoted or introduced into his own book. On that occasion Lord Cottenham said: "When it comes to a question of quantity, it must be very vague. One writer might take all the vital part of another's book, though it might be but a small proportion of the book in quantity. It is not only quantity, but value, which is looked to. It is useless to look to any particular cases about quantity." See the lord chancellor's opinion in Bell v. Whitehead, The [English] Jurist, 1839, p. 14; Sweet v. Shaw, before the vice-chancellor, 1839, The [English] Jurist for 1839, p. 212. The same subject was a good deal considered by the same learned judge in Saunders v. Smith, 3 Mylne & Craig, 711, 728, 729, with reference to copyright in reports, and how far another person was at liberty to extract the substance of such reports, or to publish select cases therefrom, even with notes appended. In the case of Wheaton v. Peters, 8 Pet., 591 (§§ 12-16, *supra*), the same subject was considered very much at large. It was not doubted by the court that Mr. Peters' Condensed Reports would have been an infringement of Mr. Wheaton's copyright (supposing that copyright properly secured under the act), if the opinions of the court had been or could be the proper subject of the private copyright by Mr. Wheaton. But it was held that the opinions of the court, being published under the authority of congress, were not the proper subject of private copyright. But it was as little doubted by the court that Mr. Wheaton had a copyright in his own marginal notes, and in the arguments of counsel as prepared and arranged in his work. The cause went back to the circuit court for the purpose of further inquiries as to the fact whether the requisites of the act of congress had been complied with or not by Mr. Wheaton. This would have been wholly useless and nugatory, unless Mr. Wheaton's marginal notes and abstracts of arguments could have been the subject of a copyright (for that was

all the work which could be the subject of copyright); so that if Mr. Peters had violated that right Mr. Wheaton was entitled to redress.

But we are spared from any nice inquiries of this sort in the present case. The master's report finds that the substance of all Mr. Gould's notes are used in Mr. Cleveland's book, and for the most part literally copied. It is, therefore, a clear infringement of Mr. Gould's copyright, not, indeed, in Adam's Latin Grammar (for he has none in that), but in his own notes, first collected together by him in their present form, and in the plan and arrangements (also his own), in which they are actually embodied.

Under these circumstances I shall decree a perpetual injunction. In consideration that the defendants have already struck out of their editions of Mr. Cleveland's book now sold by them all the notes of Mr. Gould, and that the defendants are insolvent, the plaintiffs have waived any decree for an account. I shall therefore pass that over, and only decree costs for the plaintiffs. Decree accordingly.

OSGOOD *v.* ALLEN.

(Circuit Court for Maine: 1 Holmes, 185-195. 1872.)

Opinion by SHEPLEY, J.

STATEMENT OF FACTS.—The complainants are the proprietors and publishers of an illustrated magazine for boys and girls entitled "Our Young Folks," which has been published monthly in the city of Boston, under the same title, since December, 1864. Previous to the publication of the first number, the publishers duly entered the title of their magazine for securing the copyright thereof. The publication and sale have been continued in regular monthly numbers by the firm of Ticknor & Fields and their successors, including the complainants; and the copyright of each number was taken out and secured according to law previous to its publication. Complainants allege that when the copyright of the first number was taken out, the title "Our Young Folks" had not been adopted, and was not in use for any other similar publication, and has not been used for any similar publication since except by the defendant; that they have expended large sums of money in publishing and selling the same; that by reason of their expenditure and the care and skill by them bestowed, the magazine has acquired an extensive and valuable reputation throughout the United States and elsewhere as a publication for young people, under the title of "Our Young Folks," and was a source of profit to complainants.

The defendant, a publisher at Augusta, Me., announced by advertisements and otherwise that he would publish on the first and fifteenth days of each month, commencing October 1, 1871, an illustrated publication for young people, under the title "Our Young Folks' Illustrated Paper." It is admitted that he accordingly did issue a very large edition of his illustrated publication, a copy of which is filed with the proofs in the case; and that, upon demand by the complainants before publication, he refused, and still refuses, to withdraw the announcement of the publication, or to change the title, and has published and sold large numbers under said title.

The complainants claim that they are entitled to a remedy under the law of copyright, and also that they have a right to the exclusive use of the name "Our Young Folks," as indicating a periodical, according to the doctrine of

trade-marks as applied to the protection of literary publications. It is apparent upon inspection, and not disputed, that the publications of the complainants and the defendant are in no respect the same, or even similar, except in the use by both of the words "Our Young Folks" as a part of the title. The title of the one on the title-page is, "Our Young Folks: an Illustrated Magazine for Boys and Girls;" of the other, "Our Young Folks' Illustrated Paper." Both are illustrated periodicals for the young. The reading matter and the illustrations are not the same, or similar.

§ 134. *Laws of congress on the subject of copyright.*

Copyright laws are designed for the encouragement of learning, by securing to authors and their representatives the exclusive right to the publication of their literary compositions, as patent laws secure to inventors certain exclusive rights in their discoveries. The constitution conferred upon congress the power to promote the progress of science and the useful arts "by securing, for limited times, to authors and inventors the exclusive rights to their respective writings and discoveries." Accordingly, in 1790, congress passed an act for the encouragement of learning, by securing the copies of maps, charts and books to the authors and proprietors of such copies, during the times therein mentioned. This act provided that the author and authors of any map, chart, book or books . . . "shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for fourteen years from the time of recording the title thereof." The remedy provided by this statute was a right of action given to the proprietor of the copyright, against any person who, without his consent, should publish, sell or expose to sale, or cause to be published, sold or exposed to sale, any copy of such map, chart, book or books.

The act of 1870, "to revise, consolidate and amend the statutes relating to patents and copyrights," provides that the author . . . or proprietors of any books, etc., shall, upon complying with the provisions of this act, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending the same. The nineteenth section provides that no person shall be entitled to the benefit of the act unless he shall, before publication, deposit in the mail, for the librarian of congress, a printed copy of the title of such book, and shall, within ten days after publication, mail to the librarian two copies of such copyright book. The remedy of the author or proprietor under this statute is against the person who, without the consent in writing of the proprietor of the copyright, shall print, publish or import, or, knowing the same to be so printed, published or imported, shall sell or expose to sale, any copy of such book.

§ 135. *The word "book" defined. Whether the title of a book is protected.*

By the plain terms of the statute, the copyright protected is the copyright in "the book," the word "book" being used to describe any literary composition. Although a printed copy of the title of such book is required, before the publication, to be sent to the librarian of congress, yet this is only as a designation of the book to be copyrighted; and the right is not perfected under the statute until the required copies of such copyright book are, after publication, also sent. It is only as a part of the book, and as the title to that particular literary composition, that the title is embraced within the provision of the act. It may possibly be necessary in some cases, in order to protect the copyrighted literary composition, for courts to secure the title from piracy, as well as the other productions of the mind of the author in the book. The right secured

by the act, however, is the property in the literary composition,—the product of the mind and genius of the author, and not in the name or title given to it. The title does not necessarily involve any literary composition; it may not be, and certainly the statute does not require that it should be, the product of the author's mind. It is not necessary that it should be novel or original. It is a mere appendage, which only identifies, and frequently does not in any way describe, the literary composition itself, or represent its character. By publishing, in accordance with the requirements of the copyright law, a book under the title of the life of any distinguished statesman, jurist or author, the publisher could not prevent any other author from publishing an entirely different and original biography under the same title. When the title itself is original, and the product of the author's own mind, and is appropriated by the infringement, as well as the whole, or a part of, the literary composition itself, in protecting the other portions of the literary composition, courts would probably also protect the title. But no case can be found, either in England or this country, in which, under the law of copyright, courts have protected the title alone, separate from the book which it is used to designate. In *Jollie v. Jaques*, 1 Blatch., 627, Mr. Justice Nelson says: "The title or name is an appendage to the book or piece of music for which the copyright is taken out, and if the latter fails to be protected, the title goes with it as certainly as the principal carries with it the incident." The only doubt expressed by Mr. Justice Nelson in that case is as to how the question might be decided in case of a valid copyright of a book and an infringement of the title by the defendant. While expressing no opinion upon this question, the reasoning by which he arrives at the conclusion that when the book fails to be protected the title goes with it, would seem clearly to point to a similar result in a case of alleged infringement of copyright of the book; namely, that if there was no piracy of the copyrighted book, there could be no remedy under the act for the use of a title which could not be copyrighted independently of the book. The injunction granted in the case of *Hogg v. Kirby*, 8 Ves., 215, was not founded on copyright, but on the power a court of equity has to restrain one person from carrying on a trade, or from publishing a work, under a fraudulent representation that such trade or work is that of another. The chancellor (Lord Eldon), in the opinion in that case, says: "In this case, protesting against the argument that a man is not at liberty to do anything which affects the sale of another work of this kind, and that because the sale is affected therefore there is an injury (for if there is a fair competition by another original work really new, be the loss what it may, there is no damage or injury), I shall state the question to be, not whether this work is the same, but, in a question between these parties, whether the defendant has not represented it to be the same; and whether the injury to the plaintiff is not as great, and the loss accruing ought not to be regarded in equity upon the same principles between them, as if it was in fact the same work. Upon the point whether the work was in fact meant to be represented to the public as the same, I do not say that it is not a question proper for a jury." In the case of *Jollie v. Jaques*, Mr. Justice Nelson declined to consider the question whether the court will interfere to prevent the use of a title in fraud of the plaintiff, upon principles relating to the good-will of trades, because, in the case before him, both parties were residents, and, for aught that appeared in the case, citizens, of New York; and, therefore, independently of copyright, the court had no jurisdiction in the case.

In the case before this court, the bill is filed by complainants as citizens of the commonwealth of Massachusetts against the defendant, a citizen of Maine. Relief is sought not only under the law of copyright, but upon the general ground of equity, as related to the good-will of trades and the doctrine of trade-marks. It becomes necessary for the court to determine, in this case, how far the complainants are entitled to a remedy, upon these grounds of equity jurisdiction, and upon the general principles governing courts of equity jurisdiction. Property in the use of a trade-mark or name has very little analogy to that which exists in copyrights or patents for inventions. In all cases where rights to the exclusive use of a trade-mark are invaded, the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another. It is only when this false representation is directly or indirectly made that the party who appeals to a court of equity can have relief. *Canal Company v. Clark*, 13 Wall., 311, 322 (§§ 453-56, *infra*). Words or devices may be adopted as trade-marks which are not original inventions of the one who adopts and uses them. Words in common use may be adopted, if, at the time of adoption, they were not used to designate the same or similar articles of production. A generic name, or a name merely descriptive of an article of trade, or its qualities or ingredients, cannot be adopted as a trade-mark, so as to give a right to the exclusive use of it. The office of a trade-mark is to point distinctively to the origin or ownership of the article to which it is affixed. Marks which only indicate the names or qualities of products cannot become the subjects of exclusive use, for, from the nature of the case, any other producer may employ, with equal truth and the same right, the same marks for like products. Geographical names, which point out only the place of production, and not the producer, cannot be appropriated exclusively, so as to prevent others from using them and selling articles produced in the districts they describe under these appellations. In the case of *Brooklyn White Lead Company v. Masury*, 25 Barb., 416, the court said that, as both plaintiff and defendant dealt in the same article, and both manufactured it at Brooklyn, each had the same right to describe it as "Brooklyn White Lead." Lord Langdale, master of the rolls, well expresses the whole law of trade-marks by names, in the case of *the Collins Company v. Cowen*, 3 Kay & Johns., 428. He says: "There is no such thing as property in a trade-mark as *an abstract name*. It is the right which a person has to use a certain name for articles which he has manufactured, so that he may prevent another person from using it, because the mark or name denotes that articles so marked were manufactured *by a certain person*, and no one else can have the right to put the same name upon his goods, and then represent them to have been manufactured by the person whose mark it is."

Applying these principles to the case before the court, the question presented on this branch of the case is, whether the defendant has so simulated the mark of the complainant as to deceive the public, so that the public will naturally mistake his publication for that of the complainant.

Complainants aver that defendant, fraudulently designing to procure the custom and trade of persons who are in the habit of buying their magazine, and to induce them and the public to believe that his publication is in fact the complainants', and in order to obtain for himself the benefit of the reputation of complainants' publication, advertises, prints and offers for sale his publication under that title; and allege that the public will be deceived by the title and led to purchase defendant's publication under the belief that it is the

magazine of the complainants. The agreed statement of facts is silent on the question whether the public are deceived, or are in danger of being deceived, as alleged; and whether the customers of the complainants or the public are induced to believe, or are in danger of being induced to believe, that defendant's publication is in fact the complainants', and thereby led to purchase the defendant's magazine under the belief that it is the complainants'.

The case will therefore be referred to a master to ascertain and report the fact upon the foregoing questions to the court; and further proceedings in the case will be stayed until the coming in of the master's report.

PARTON *v.* PRANG.

(Circuit Court for Massachusetts: 3 Clifford, 537-552. 1872.)

STATEMENT OF FACTS.—Parton was an artist of New York, and, among other like productions, painted a landscape which he entitled "A View of Claverack Creek," etc., which he sold in his studio in New York after the usual custom of artists. The purchaser sent or carried the picture to Boston, where it was sold to defendant Prang, who was a publisher of chromos, engravings, etc. Prang caused a chromo of the "Claverack" picture to be prepared and copies of it to be made which he sold. Parton filed this bill claiming a copyright in his picture for copying purposes, although he had sold the picture itself. He prayed for an injunction and an account. The case was heard on bill and answer.

Opinion by CLIFFORD, J.

The case now stands in the same posture as if a demurrer had been filed to the bill, which would admit that everything well pleaded in the answer was fully proved. 2 Danl. Chan. Prac. (3d ed.), 998; *Gettings v. Burch*, 9 Cranch, 372; *Leeds v. Marine Ins. Co.*, 2 Wheat., 380; *Brinckerhoff v. Brown*, 7 Johns. Ch., 217; *Dale v. McEvers*, 2 Cow., 118. Viewed in the light of that well-settled rule of practice, it must be assumed as fully proved that the complainant sold the picture for a valuable consideration to the vendor of the respondent, and that the same was delivered by the complainant to the purchaser unconditionally and without any reservation, and that the purchaser from the complainant in like manner sold the picture for a valuable consideration to the respondent, and that he delivered the same to the respondent unconditionally and without any reservation.

§ 136. *Provisions of the copyright law.*

Copyright may be granted, under the copyright act, to the author of any book, map, chart or musical composition falling within the classes described in section 1 of the act, if the author is a citizen of the United States or permanently resident therein, and the same privilege is also extended by the same section to any such citizen or permanent resident who shall invent, design, etch, engrave, work, or cause to be engraved, etched or worked from his own design, any print or engraving; and section 1 also provides that such persons and their executors, administrators or legal assigns shall have the sole right and liberty of printing, reprinting, publishing and vending such book, map, chart, musical composition, print, cut or engraving for the term of twenty-eight years from the time of recording the title as therein directed. 4 Stat. at Large, 436. Persons printing, publishing or importing any copy of a book so copyrighted, or causing the same to be printed, published or imported without the consent of the person legally entitled to the copyright first

had and obtained in writing, signed in presence of two or more credible witnesses, shall forfeit every copy of such to the person legally entitled at the time to the copyright thereof, and the same penalty is imposed upon any person who, knowing the same to be so printed or imported, shall publish, sell or expose to sale any copy of such book without such consent in writing, and that the offender shall also forfeit and pay fifty cents for every such sheet which may be found in his possession, either printed or printing, published, imported or exposed to sale contrary to the intent of that act. 4 Ibid., 438. Protection is also afforded by section 7 of the act to any cut or engraving, map, chart or musical composition so copyrighted; and the provision is that if any person shall within the term engrave, etch or work, sell or copy, or cause to be engraved, etched, worked or sold, or copied, or shall print or import for sale, or cause to be imprinted or imported for sale, any such map, chart, musical composition, print, cut or engraving, without the consent in writing of the proprietor, signed in the presence of two credible witnesses, or, knowing the same to be so printed or imported without such consent, shall publish, sell or expose to sale any such map, chart, musical composition, engraving, cut or print, shall forfeit to the proprietor the plate or plates on which such map, chart, musical composition, cut or print shall be copied, and also one dollar for every sheet of such map, chart, musical composition, print, cut or engraving which may be found in his possession, printed or published, or exposed to sale contrary to the true intent and meaning of that act. 4 Ibid., 438. Provision is also made by section 9 of the same act that any person or persons who shall print or publish any manuscript whatever, without the consent of the author or legal proprietor first obtained as aforesaid, if a citizen of the United States or resident therein, shall be liable to suffer and pay to the author or proprietor all damages occasioned by such injury, to be recovered by a special action on the case, and the federal courts, empowered to grant injunctions to prevent the violation of the rights of authors and inventors, are thereby empowered to grant injunctions in like manner to restrain such publication of any manuscript. 4 Ibid., 438.

§ 137. *The word "manuscript" in section 9 of the copyright act does not include a picture, and the purchaser of a painting may acquire a title thereto by oral contract with the owner.*

Based upon that section of the copyright act, the proposition of the complainant is that the respondent did not acquire, by the alleged purchase of the picture, any right whatever to reproduce the picture or to make a chromo of the same, as he admits in his answer he has done; that he could not acquire such a right by any oral contract of sale, or of sale and delivery, even though the sale and delivery were for a valuable consideration, and were absolute and unconditional; that he could only acquire such a right by the consent of the author or legal proprietor in writing, signed in the presence of two credible witnesses, as required by that section, in order to acquire the right to print or publish a manuscript, which the pleadings show the respondent in that form never obtained. Manuscripts of every kind are embraced in that section, but pictures are not named in the provision and cannot be regarded as entitled to that special protection, unless it be held that the word manuscript includes pictures, which is affirmed by the complainant and denied by the respondent, and that issue presents the principal question in the case. Standard lexicographers certainly do not concur with the complainant, as, for example, Webster treats the word as derived from Latin, *manus*, the hand, and *scribere*,

scriptum, to write, and as synonymous with *manuscriptum*, meaning literally something written with the hand; a book or paper written with the hand, or a written, as distinguished from a printed, document. On the other hand, the same learned author treats the word picture as derived from Latin *pingere*, *pictum*, to paint, and as synonymous with *pictura*, and defines the word as meaning that which is painted, a likeness drawn in colors, hence any graphic representation, as of a person, a landscape or a building; and he adopts the language of Bacon, in which he says that pictures and shapes are but secondary objects, showing that in his view the picture presents the objects to the observer as a whole, whereas the manuscript only describes the parts or elements of the object, leaving the mind of the reader to aggregate those parts or elements into an entire figure or whole. Worcester's definition of those two words is substantially the same as the definitions given by Webster. He treats the word manuscript as derived from the Latin words *manus*, the hand, and *scriptum*, something written, and defines its meaning as a paper written, a writing of any kind, in contradistinction to printed matter. His definition of the word "picture" also corresponds with that given by the first-named author. He derives it from the Latin word *pictura*, and defines it as a representation or likeness in colors, a painting or drawing. Bouvier also defines manuscript as a writing, a writing which has never been printed, and refers to the right of an author as secured by the copyright act, and as conceded at common law, but adds that these rights will be considered as abandoned, if the author publishes his manuscript without securing the copyright under the act of congress. Mere definitions, however, do not portray the difference between a manuscript and a picture as fully or as strikingly as it is seen when the two things are compared and contrasted as means of instruction, or of imparting an idea or description of the object or subject-matter of the manuscript or picture. Separate description of each element of the object is required in the manuscript describing the several parts of which it is composed, the nature, material, appearance, size, color, dimensions, use and everything essential to enable the reader to form an idea of what the object is which is embraced in the description given in the manuscript; all these must be considered and combined by the reader in order that he may be able to form an ideal picture of the object described or the subject-matter of the entire description. His ideal picture may or may not be in accordance with the object actually described in the manuscript, as the object itself is not presented to the senses of the reader. On the contrary, he is left to portray in his own mind the outlines of the object from the written description, and so to combine the same as to suggest an ideal picture of the object described.

Whatever conclusion the reader of the manuscript may form, it is but an ideal picture, made in his own mind from the written description of the object, and necessarily calls into exercise all the creative faculties of the mind. No such operation of the mind is involved where the picture or painting of the object is presented to the observer, as the object itself in a secondary form, "drawn in colors," is presented externally to the sense of sight. In the latter case, no ideal of the mind is necessary, as the thing itself is presented physically to the natural eye. Briefly stated, the picture is the thing itself, but the manuscript is only the description of it in language, and leaves the mind of the reader to make the picture, or in other words, the picture presents, at a glance, all the characteristics of the object exactly as it exists, but the manuscript only enumerates and describes those characteristics one by one, imposing

upon the mind of the reader the labor of aggregating the same into a whole, and presenting to his perceptions an ideal of the described object. Different communities employ diverse characters for letters and even for phrases, but it can make no difference what the characters are that are employed in describing such an object, not even if they are arbitrary signs, so long as it remains true that the manuscript is a description of the object, and not the presentation of the object itself or its portrait, as the manuscript, while it retains that character, is simply the registry of certain thoughts or ideas about a thing and not the exhibition of the thing itself, as in the case of a picture. Unsupported as the proposition of the complainant is, by any legal adjudication, the argument of the respondent is a forcible one that the construction of section 9 of the copyright act must be controlled by the well-established rule, that the words of a statute, if of common use, are to be taken in their natural, plain, obvious and ordinary signification and import, unless it clearly appears from the context or other parts of the enactment that the words were intended to be applied differently from their ordinary or their legal acceptance. 1 Kent, Com. (11th ed.), 462; *Martin v. Hunter*, 1 Wheat., 326 (APPEALS, §§ 682-729); *Waller v. Harris*, 20 Wend., 561; *Doane v. Phillips*, 12 Pick., 226. Nothing is shown in the context of the enactment to favor the theory of the complainant, and inasmuch as the usual and ordinary signification and import of the two words is opposed to such a theory, it is difficult to see how it can be adopted without doing violence to the most approved canons of construction. Dwarris on Stat. (2d ed.), 573; Smith, Com., §§ 505, 545.

§ 138. *The consent of the author, signed in the presence of two credible witnesses, is not necessary to obtain the right to reproduce or "chromo" a picture.*

Strong support to the opposite view is derived as a legislative expression, from section 86 of the subsequent and recent copyright act, which, in terms, extends the privilege of copyright to the author, inventor, designer or proprietor of a painting, drawing, chromo, statue, statuary, and models and designs intended to be perfected as works of the fine arts, as well as to the author, inventor, designer or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print or photograph or negative thereof, giving to such authors, inventors, designers and proprietors the sole liberty of printing, publishing, completing, copying, executing, finishing and vending the same for the term of years therein mentioned. All persons without the consent of the proprietor of the copyright in writing, signed in the presence of two or more credible witnesses, are forbidden to engrave, etch, work, copy, print, publish or import any copy of such map or other article, and the provision of section 100 is that if any person shall violate the prohibition as therein expressed he shall forfeit to the said proprietor all the plates on which the same shall be copied, and every sheet thereof, and in case of a painting, statue or statuary, he shall also forfeit \$10 for every copy of the same in his possession. Unquestionably the provision, so far as it relates to a picture, is entirely new, and it will be observed that it does not embrace a manuscript; but section 102 is substantially the same as section 9 in the prior act, and that both alike are in terms confined exclusively to the protection of manuscripts. 16 Stats. at Large, 212, 214. Viewed in the light of these suggestions, the court is of the opinion that the word "manuscript," as used in section 9 of the copyright act, does not include a picture, and that a purchaser of a picture, such as the one described in the bill, may acquire a title to the same by an oral contract with the lawful owner; that the consent of the author or proprie-

tor in writing, signed in the presence of two credible witnesses, was not necessary under that act to obtain the right to reproduce or chromo the same, provided such consent was fairly and understandingly obtained, and for a valuable consideration.

§ 139. *Rights at common law of an author or his assigns in his manuscript before publication. Effect of publication on those rights.*

Suppose it is not necessary that the consent of the author or proprietor of a picture should be in writing to render the sale valid, still it is contended by the complainant that neither the sale in this case to the vendor of the respondent, nor the purchase of the same by the respondent from the vendee of the complainant, even though the sale and delivery of the picture in each case was absolute and unconditional, or both combined, had the effect to transfer to the respondent the right to reproduce or chromo the picture, that in selling and delivering the picture, and subsequently suffering his vendee to sell and deliver the same to the respondent, he only parted with the result of his labor as property; that he did not part with the right to reproduce or chromo-lithograph the picture; that the right to multiply copies of the picture was vested in him as the author and proprietor of the same, and that he still retains that right notwithstanding the sale and delivery by himself and the subsequent purchase by the respondent. Undoubtedly, the author of a book or of an unpublished manuscript, or of any work of art, has at common law, and independently of any statute, a property in his work until he publishes it or it is published by his consent or allowance, and that property unquestionably exists in pictures as well as in any other work of art. He has the undisputed right to his manuscript; he may withhold or he may communicate it; and communicating, he may limit the number of persons to whom it shall be imparted, and impose such restrictions as he pleases upon the use of it. He may annex conditions and proceed to enforce them, and for their breach he may claim compensation. *Jeffreys v. Boosey*, 4 H. L. Cas., 815-961; *Millar v. Taylor*, 4 Burr., 2396; *Queensbury v. Shebbeare*, 2 Eden, 329. Numerous other decided cases also affirm the same proposition, that the author of an unpublished manuscript has the exclusive right of property therein, and that he may determine for himself whether the manuscript shall be made public at all; that he may in all cases forbid its publication by another before it has been published by him or by his consent or allowance; that a painter also has at common law the same right before publication to prevent any person from copying it, and that the purchaser and owner of the picture holding the title from the painter or his assigns, has the same right, before publication, to prevent another from multiplying copies of it or reproducing the picture, but the authorities all agree that, after publication, that right is lost. *Turner v. Robinson*, 10 Jr. Ch., 121. Same case on appeal, 10 Jr. Ch., 510; *Fisher v. Fold*, 1 Jones, Exch., 12; *Wheaton v. Peters*, 8 Pet., 591; *Keene v. Wheatley*, 9 Am. L. Reg., 33; *Bartlett v. Crittenden*, 5 McL., 37 (§§ 17-21, *supra*). An author, said Hoar, J., in *Keene v. Kimball*, 16 Gray, 549, has at common law a property in his unpublished works, which he may assign, and in the enjoyment of which equity will protect his assignee as well as himself. This property continues until, by publication, a right to its use has been conferred upon or dedicated to the public.

§ 140. *In communicating the contents of his manuscript, an author may prescribe limitations and impose restrictions on its use.*

Independently of legislation, the sole proprietorship of a manuscript is in the

author and his assigns until he publishes it, but an unqualified publication, such as is made by printing and offering copies for sale, dedicates the contents to the public, unless the sole right and liberty of printing, reprinting, publishing and vending the same is secured to the author or proprietor by copyright. But there may be a limited publication by communication of the contents by reading, representation or restricted private circulation which will not abridge the right of the author any further than necessarily results from the nature and extent of such limited use as he has made or allowed others to make of the manuscript or painting, or, as Lord Brougham said in *Jeffreys v. Boosey*, 4 H. L. Cas., 961, he may withhold or he may communicate it, and, communicating, he may prescribe limitation and impose such restrictions as he please as to the extent of its use, which fully justifies the conclusion in *Keene v. Kimball* that, when a literary proprietor has made a publication in any mode not restricted by any condition, other persons acquire unlimited rights of republishing in any mode in which his publication may enable them to exercise such a right. *Keene v. Kimball*, 16 Gray, 550. Assignments of a manuscript are required to be in writing by the copyright act, but enough has been remarked to show that a picture under that act might be transferred by an oral contract, and it is well settled law that even copyright is an incident to the ownership of a manuscript, and that it passes at common law with the transfer of a work of art. *Turner v. Robinson*, 10 Jr. Ch., 121; *Power v. Walker*, 3 M. & S., 9. Hence the remark of the court in *Turner v. Robinson*, that it was a strange proposition that the transfer of property should destroy and extinguish that which principally constitutes the value of the thing transferred, meaning not that the right to publish did not pass by the sale, but that the exclusive right of publication which attached to the manuscript was not lost by the transfer. Such a transfer of the manuscript or picture is not a publication of the same unless it was so intended by the parties, but if the sale was an absolute and unconditional one, and the article was absolutely and unconditionally delivered to the purchaser, the whole property in the manuscript or picture passes to the purchaser, including the right of publication, unless the same is protected by copyright, in which case the rule is different. *Baker v. Taylor*, 2 Blatch., 82; *Ryan v. Goodwin*, 3 Sum., 518; *Wood v. Zimmer*, Holt, N. P., 60; *Pennock v. Dialogue*, 2 Pet., 14.

Personal property is transferable by sale and delivery, and there is no distinction in that respect, independent of statute, between literary property and property of any other description. Owners of personal property have the right to sell and transfer the same as inseparable incidents of the property, and the author or proprietor of a manuscript or picture possesses that right as fully and to the same extent as the owner of any other personal property, the same being incident to the ownership. Sales may be absolute or conditional, and they may be with or without qualifications, limitations and restrictions, and the rules of law applicable in such cases to other personal property must be applied in determining the real character of a sale of literary property. Proper attention to these considerations will furnish the true explanation of many, if not all the cases referred to by the complainant, which are supposed to support the second proposition for which he contends. *Prince Albert v. Strange*, 1 Hall & Twells., 1; *Queensbury v. Shebbeare*, 2 Eden, 329; *Bishop v. Griffin*, 16 Sum., 196; *Steven v. Cady*, 14 How., 528; *Stevens v. Gladding*, 17 How., 447 (§§ 387-89, *infra*); *Abernethy v. Hutchinson*, 1 Hall & Twells., 28.

Beyond doubt, the right of first publication is vested in the author; but he

may sell and assign the entire property to another, and if he does so his assignee takes the entire property; and it is a great mistake to suppose that any act of congress, at the date of the sales of the picture in this case, required that such an assignment should be in writing; and the pleadings show that the sale and delivery in each case were absolute and unconditional, and without any qualification, limitation, or restriction, showing that the entire property was transferred from the complainant and became vested in the respondent. *Sims v. Marryatt*, 17 Ad. & Ell., 281; *Adderly v. Dixon*, 1 Sim. & S., 607. Confirmation of that view, if any be needed beyond what appears in the express allegations of the answer to that effect, is also found in the further allegation that the respondent called upon the complainant immediately after the sale and delivery to him, and informed the complainant that he intended to publish the picture as a chromo, and that the complainant made no objection to the proposed publication, showing that the complainant as well as the respondent understood that the entire property of the picture was vested in the respondent. It is insisted by the respondent that the acts and declarations of the complainant on that occasion, as more fully set forth in the answer, estop the complainant from making any such claim as that set up in the bill; but it is unnecessary to decide that question, as the court is of the opinion that those acts and declarations amount to a practical affirmance of the contract of sale and delivery of the entire property of the picture, as understood and claimed by the respondent. *Freeman v. Cooke*, 6 D. & L., 187; *Boucicault v. Fox*, 5 Blatch., 100 (§§ 35-39, *supra*); *Bigelow on Estoppel*, 475. Neither a conditional sale nor any unfairness is shown, and as neither exists in the case, it must be held that the complainant parted with the entire property in the picture. *Pope v. Curl*, 2 Atk., 142; *Thompson v. Stanhope*, Amb., 737; *Mayall v. Higbey*, 1 H. & C., 147; *Jones v. Thorne*, 1 N. Y. Obs., 408; *Dalglisch v. Jarvie*, 2 McN. & G., 231; *Martin v. Wright*, 6 Sim., 297; *Read v. Conquest*, 9 C. B. (N. S.), 755. Unfairness is not pretended in this case, and inasmuch as the sale and delivery were in their terms absolute and unconditional and without any reservation, restriction, or qualification of any kind, the court is of the opinion that complainant is not entitled to relief.

YUENGLING *v.* SCHILE.

(Circuit Court for New York: 12 Federal Reporter, 97-108. 1882.)

Opinion by BROWN, J.

STATEMENT OF FACTS.—The plaintiff moves, upon a bill of complaint and affidavits, for a preliminary injunction to restrain an infringement of the plaintiff's rights under a copyright alleged to have been obtained by him on the 23d of August, 1880, upon a "chromo" entitled "Gambrinus and his followers." The moving papers allege that the complainant on that day was a citizen of the United States, and "proprietor of said chromo;" that he filed on that day, before publication, in the office of the librarian of congress, the title or description thereof, and on the same day deposited in his office two copies of the same, and gave notice of his copyright by inscribing on the visible front of such chromo, near the bottom, the words: "Copyrighted 1880, by D. G. Yuengling, Jr., New York;" that he has been at great expense in producing such chromo, and that the same is of great value to him; that he has used it as a gratuitous advertisement in his business as a lager-beer brewer;

and that the defendant is about to issue a piratical imitation of such chromo, in violation of the plaintiff's right in such copyright.

The complainant's chromo is of evident artistic merit. It is designed as a symbolic glorification of lager-beer drinking. In the center is a conspicuous figure of King Gambrinus, his left arm resting upon a keg of lager, and his right holding aloft a foaming glass of that beverage. On either side of him are a dozen figures of persons representing various classes in life, into whose eager hands his page is distributing the drink. This chromo, by its subject, its brilliant coloring, its excellent finish, and the artistic grouping of its figures, forms a striking picture, suitable for hanging in saloons, and well calculated to draw attention to the plaintiff, whose name is printed in large type beneath the figures as a person engaged in the lager-beer business, and constituting, therefore, a valuable mode of advertising. Among the Germans, and in the lager-beer trade, "Gambrinus" is familiarly known as the inventor of lager beer, while king of Flanders, as the legend goes, who used it first as a potion or draught.

The defendant's chromo, claimed to be an infringement, is a few inches smaller than the first, and presents the same general grouping, expression, and coloring of the figures, though having some conspicuous changes. Upon the head of the lager-beer cask the words "Bock Beer" are conspicuously printed; and the figure of a goat, with its forefeet upon the top of the cask, appears prominently in the foreground beside the king. The troubadour, who in the first picture is reclining upon the ground beside a maid drawing beer at the spigot, is omitted in the defendant's chromo, which also contains at the left a prominent typical figure of "Brother Jonathan," who is substituted in the place of a tailor in the first. There are various other minor changes.

Upon the whole it is plain that the defendant's chromo is formed upon the same general design as the first, although with very important variations, and is an infringement of it, if the first was lawfully copyrighted before any publication of it. The defendant's chromo is designed as a card advertising the sale of "bock beer" which is sold mainly in the months of April and May.

From the defendant's affidavits it, however, appears that the complainant's chromo was designed in Europe by G. Bartsch, an alien European artist, whose name is engraved on the face of the print; that in the right-hand corner beneath are printed the words, "Wittemann Bros., Publishers of Art Lithographs, New York;" that the work is strictly a chromo-lithographic print; that all the complainant's copies of it were printed and completed in Europe, whence it was imported to this city by the complainant, who thereupon undertook to take out a copyright by depositing two copies with the librarian of congress, as above stated, and stamping upon the left-hand corner the words added by the complainant, "Copyrighted 1880, by D. G. Yuengling, Jr., New York;" that the defendant has long been a designer, and is also engaged in the lager-beer advertising business; that in the summer of 1880, at the book-printer's establishment of Keely & Bartholom, 22 College place, in this city, where he had previously been accustomed to get work done, he was shown a copy of all the colored portion of this chromo, but without the copyright stamp thereon; that he was informed by them at that time that it was a German work, not copyrighted, and had shortly before been imported and received by them from Europe; that he was then allowed to take this copy away with him, and had retained it ever since, and had made his own chromo therefrom, with the variations above pointed out; that he never saw any copy with any copyright

stamp upon it, and had no knowledge of any such copyright until the commencement of this suit.

§ 141. *A chromo, if really a work of art, is a proper subject of copyright, although gratuitously distributed as an advertisement.*

It is urged on the part of the defendant that the plaintiff's chromo is not the subject of a copyright, because it was designed, used, and circulated by him as a gratuitous advertising card for the benefit of his private business as a lager-beer brewer, and not for the instruction or improvement of the public. The case of *Cobbett v. Woodward*, Law Rep., 14 Eq., 407, relied on by the defendant, was a case where the catalogue of an upholsterer, containing engravings of the articles offered by him for sale and circulated gratuitously, was held not to be the subject of copyright on this ground. A similar decision was made in this court in the case of *Collender v. Griffith*, 11 Blatch., 212, concerning engravings of billiard tables offered for sale; but in that case it was held that the engravings were not works of art, and did not have any value or use as such, and that it was a mere mode of advertising the tables for sale. The case of *Ehret v. Pierce*, 18 Blatch., 302 (S. C., 10 Fed. R., 553), was decided upon the same principle. The case of *Cobbett v. Woodward*, *supra*, has not been followed in England, but was substantially overruled in the subsequent case of *Grace v. Newman*, Law Rep., 19 Eq., 623.

The plaintiff's chromo in the present case is not a mere engraving or print of any article which the complainant offers for sale. It is a work of the imagination, and has such obvious artistic qualities as, in my judgment, render it fairly a subject of copyright, without regard to the use which the plaintiff has made or may intend to make of it. Where the work in question is clearly one of artistic merit, it is not material, in my judgment, whether the person claiming a copyright expects to obtain his reward directly through a sale of the copies, or indirectly through an increase of profits in his business to be obtained through their gratuitous distribution.

§ 142. *Who are entitled to the protection of copyright. Authors directly, proprietors derivatively.*

There are several grounds, however, why the preliminary injunction sought in this case should not, I think, be granted. 1. It being conceded that the complainant is not the author or designer of this chromo, it is incumbent upon him to show how he became entitled to any exclusive copyright of it. In *Green v. Bishop*, 1 Cliff., 186, 198 (§§ 242-48, *infra*), Clifford, J., says: "It is undoubtedly true that when a party comes into a court of law or equity seeking protection of a copyright, he must show that he is the author of the work, or that his title is derived from one sustaining that relation to the publication. *Little v. Gould*, 2 Blatch., 181 (§§ 115-23, *supra*). The plaintiff does not show any such derivative title, and it appears that he is not the author."

The owner or proprietor of a work has not, since the act of 1870, any more than before, in that character alone any right of copyright. It is only to "authors and inventors," or to persons representing the author or inventor, that congress is authorized by the constitution to grant a copyright. Const., art. 1, § 8. The right of any other person than the author or inventor must therefore be a purely secondary and derivative one, and in enforcing any alleged copyright such a person must show an exclusive right lawfully derived from the author or inventor; and this the plaintiff has not done. I find no other averment in the papers save that in the bill that on the 23d of August, 1880, he was "the proprietor of said chromo." This is not enough. It does

not show any exclusive right derived from an original author. It appears, in opposition, that the work was designed and printed in Europe by an alien artist, and that copies of this design were imported into this country and came into defendant's hands independently of the complainant. There is no averment either that the design itself was *new*, or that the lithographic stones for the print were engraved by any person employed by the plaintiff or in his behalf, or that any right of copyright was ever transferred, or intended to be transferred, to the plaintiff by the author or artist. The "chromo" may be a mere copy of an European painting long since published in Europe, and free to be copied by any one. For aught that appears, the whole design may have been common property for an indefinite period, as would seem to be the case with the typical form of King Gambrinus. The complainant may have been the "proprietor" of the chromos which he imported, and may have "produced them at great expense," and yet have no exclusive right whatever, as between himself and the European artist, to the sole use even of the lithographic stones in Europe for the multiplication of any additional copies, much less to the original design. In that case he could acquire no copyright which would exclude the defendant, or any other person, from availing himself, either wholly or in part, of other copies obtained from Europe, either from the same stones or from the common source of the design.

In *Johnson v. Donaldson*, 3 Fed. R., 22 (18 Blatch., 287), in reference to an alleged infringement of the copyright of a chromo, it was held by Wallace, J., that if the plaintiff acquired his copyright by appropriating a sketch from a foreign publication, he would not become a proprietor thereof, and could acquire no exclusive copyright; that even if the plaintiff were the artist and designer of the picture so appropriated, the "defendant would not be liable if he did not avail himself, directly or indirectly, of the plaintiff's production."

In *Rosenbach v. Dreyfuss*, 2 Fed. R., 217, it is said by Choate, J.: "It is not enough that the defendant *may* be liable if the facts stated in the complaint be true. It must appear that he *is* liable if the complaint is true." And judgment was for the defendant on demurrer, because it did not certainly appear that the articles described were articles for which a copyright could be granted under the laws of the United States.

In this case it appears affirmatively, from the defendant's affidavits, that in making his chromo he has not availed himself of any copy of the chromo imported by the plaintiff; while from the want of any averment, either that the design was new, or that the plaintiff had ever acquired the exclusive rights of the foreign artist, in case the artist had any such exclusive right, it is impossible to say that the defendant, in availing himself of parts of a foreign copy, independently imported, violated any right of the author, much less of the plaintiff, who could only claim through the author.

§ 143. *Construction of statute, act of 1870, and Revised Statutes, section 4952 — on copyright. Does not protect "proprietors," except as representatives of authors. The law protects only native talent.*

2. The plaintiff claims that the act of July 8, 1870 (16 St. at Large, § 86; R. S., § 4952), authorizes a citizen or resident of this country, if he be "proprietor" of any book, map, print, chromo, etc., to obtain a copyright therefor, although the author, inventor or designer is an alien. The act of 1870, for the first time, uses the word "proprietor" in connection with the words "author, inventor or designer," as one of the persons to whom a copyright

may be granted, although ever since the act of 1790 a proprietor might obtain a copyright if he were the lawful representative of the exclusive rights of a native or resident author. Thus, though the connection in which the word "proprietor" is used in the act of 1870 is new, the use of the word itself in relation to copyrights is as old as the laws of copyright. 1 St. at Large, p. 125, §§ 2, 3, 4, 6; 2 St. at Large, p. 171, §§ 1, 3; 4 St. at Large, p. 437, § 3; 11 St. at Large, p. 139, § 1; 13 St. at Large, p. 540, § 2; 8 Geo. II., ch. 13, § 1; 17 Geo. III., ch. 57.

The literal reading of the section of the act of 1870, now embodied in section 4952 of the Revised Statutes, does not require that both the "author" and "proprietor" shall be citizens or residents of the United States. It provides that "any citizen of the United States or resident therein, who shall be the author, inventor, designer or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print or photograph, or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators or assigns of any such person," may obtain a copyright; and section 103 of the act of 1870, embodied in section 4971 of the Revised Statutes, provides that "nothing therein shall be construed to prohibit the printing, publishing, importation or sale of any book, map, chart, dramatic or musical composition, print, cut, engraving or photograph, written, composed or made by any person not a citizen of the United States, nor resident therein." By virtue of the latter section an exclusive copyright in the work of any foreign author or artist in the subjects mentioned in that section is prohibited; but this section does not embrace the words "painting, drawing, chromo, statue, statuary and models," which were introduced into the copyright law for the first time in the act of 1870; and on this ground it is urged by the complainant that a "proprietor" may obtain a copyright on the last-mentioned subjects, though the artist or author is an alien, because these are not prohibited by section 4971.

There are three objections to the plaintiff's contention in this respect: *First*, that it involves a reversal of the policy of the government from its foundation to protect American artists and authors only; *second*, that the word "proprietor," as used in the copyright laws, in itself means the representative of an artist or author who might himself obtain a copyright; and, *third*, that chromos are in reality embraced under the description of a "print" in the restrictive section, 4971.

It cannot be doubted that the purpose of the copyright laws from the foundation of the government has been to encourage native talent, and to protect American authors and artists only (Drone, Copyright, 231, 257), as the English acts were designed "to protect only those works which were designed, engraved, etched, or worked in Great Britain." Page v. Townsend, 5 Sim., 395, 404.

In the first act on the subject, that of May 31, 1790, the prohibition against an extension of the copyright to alien authors was as broad as the section authorizing copyright in favor of resident authors. 1 St. at Large, p. 124, §§ 1, 2, 5. With every extension of the subjects of copyrights made by subsequent statutes a corresponding restriction was inserted in the prohibitory section relating to foreign authors or artists until the act of 1870, when the few additional subjects above mentioned were added to the subjects of copyright without any corresponding insertion in the restrictive clause as respects

foreign authors or artists. But even this omission, which was probably accidental, would not of itself have sufficed to admit copyright upon the works of foreign authors or artists, because the section authorizing the granting of copyright has always been limited to authors or artists being citizens or residents of the United States, or to their lawful representatives or assigns. It is only by the introduction of the word "proprietor" into the authorizing clause of the act of 1870, section 86, that any doubt could arise in regard to the new subjects of copyright then first introduced and not expressly restricted as respects foreign artists; and its effect, by a mere literal reading, to allow a copyright on the works of foreign artists, has the appearance of being accidental only. After a policy, so early established and so constantly upheld, in reference to every subject of copyright, through all the extensions of the law up to 1870, to limit its protection to the works of native or resident authors, there is certainly a strong presumption that no change in this policy was intended in respect to a few articles only, added for the first time by the act of 1870, as subjects of copyright. There is nothing apparent in the nature of these new subjects of copyright themselves to distinguish them from the subjects of copyright previously existing which can serve as a probable foundation for any such supposed change of policy.

A copyright here, upon such articles designed and manufactured abroad, would be a double injury to American authors and designers. It would not only encourage the employment of foreign artists to the neglect and detriment of native designers, but it would prevent the use by the latter in this country of the foreign material, which would otherwise find its way here to the education and development of our native artists, and which would serve as models or suggestions for their own work. If all foreign works of this kind can be copyrighted in this country, through a mere transfer to some resident dealer, or agent of the foreign authors, our native artists will be thereby effectually foreclosed and debarred from availing themselves of all such materials for the improvement of their own works. Every intendment and every presumption to be derived from the history of copyright in this country, and from other parts of the act of 1870, seem to me to be against any such intention in that act. The effect of the literal construction contended for by the plaintiff would, moreover, be to make the act of 1870 inaugurate two diverse and conflicting policies in reference to the articles which may be copyrighted under section 86, now section 4952, Revised Statutes; one policy virtually protecting foreign artists by copyright in respect to the few subjects first introduced into the law of 1870, and another policy of excluding them in regard to all the other and much larger number of subjects of copyright named in that act. I cannot believe, in the light of the history of the copyright acts, that, in reference to these few new subjects, congress intended to inaugurate any such change of policy, or to grant an exclusive copyright upon the importation of works wholly designed, manufactured, and completed abroad, upon merely depositing copies of lithographs in the congressional library by some resident owner. Such a construction would in effect confer upon foreign authors and artists, in respect to these subjects of copyright, all the advantages of an international copyright act, without any reciprocal rights or advantages whatever in favor of our own authors and artists.

The argument for the plaintiff rests wholly upon the use of the word "proprietor" in the authorizing clause (section 86) of the act of 1870. But the history of the use of the term "proprietor," ever since the act of 1790, shows that

it has always been used in the copyright laws in the limited and restricted sense of a person who, by purchase or otherwise, has lawfully acquired the exclusive rights of some native or resident author or artist, and in no other manner.

By section 1 of the act of 1790, the right to obtain a copyright is granted to a resident author upon *his* works, or to a resident, or to any other person being *a citizen or resident*, "who has *purchased* and legally acquired the copyright of any *such* work," or the executors, administrators or assigns of such persons. Section 2 imposes a penalty for publishing, etc., "without the consent of the author or proprietor." The same expression, "author or proprietor," is again several times used in sections 2, 3 and 4 of that act. Thus, in this early act, the term "proprietor" is used to embrace all the persons except the original author himself, who, by section 1, might obtain a copyright, viz., the author's executors, administrators or assigns, or any person who had "purchased or legally acquired the copyright." By section 1 it is seen, moreover, that the purchasers referred to are the purchasers of "*such* map, chart, book or books;" *i. e.*, of the works of *resident* authors only. It is the same in all the subsequent statutes above cited.

From the act of 1790 down to 1870 there could be no "proprietor," in the sense of the copyright law, except the owner of the work of a citizen or resident author, including a transfer of such resident's right of copyright.

In the case of *Keene v. Wheatly*, 9 Am. Law Reg., 33, Cadwallader, J., says (page 45): "The other sections concern copyright. They apply only to authors who, if not citizens, must be residents of the United States, and proprietors under derivations of title from *such* authors. No other proprietor can obtain a copyright under the act." A third person may become such an owner or "proprietor" through a transfer or assignment, verbal or written, embracing the right of copyright, after the work is completed, or by virtue of an original employment under a contract with the author, which, by agreement, is to confer upon the employer the complete ownership both of the work itself and of any copyright that may be obtained thereon. Upon such a contract, "the person who remunerates," says the vice-chancellor J. in *Grace v. Newman*, L. R., 19 Eq., 623, "must be taken to be the equitable assignee" of the copyright. *Parton v. Prang*, 3 Cliff., 537, 547, 551 (§§ 136-40, *supra*); *Boucicault v. Fox*, 5 Blatch., 87 (§§ 35-39, *supra*); *Little v. Gould*, 2 Blatch., 362; *Sheldon v. Houghton*, 5 Blatch., 285; *Paige v. Banks*, 7 Blatch., 152; 13 Wall., 608; *Drone*, Copyright, 238, 243-5, 257-9.

To a mere owner of a work as such, to a "proprietor" in that sense only, without any express or implied transfer from the author or inventor of his right to a copyright, congress, as above observed, is not, by the constitution, vested with the power to grant a copyright. Congress is not, indeed, prohibited from protecting foreign authors and artists, if it choose to do so; but, in view of its inflexible refusal to do so up to this time, the phraseology of the statute of 1870, in section 86, is not, to my mind, a sufficient indication of any such change of purpose. When, therefore, in the act of 1870, the word "proprietor" is found used, for the first time, in connection with the words "author, inventor, designer," as a person to whom copyrights may be granted, it must be construed, if possible, in harmony with the inflexible policy and intent of the copyright law up to that date, and be held to be used in the same sense in which the word had always before been used in the copyright law of this country, viz., as meaning the lawful owner and representative, whether by

assignment, employment, death, or other lawful succession, of the exclusive rights of some native or resident author or artist only. It must be construed in harmony with the policy of the copyright law, rather than upon its literal and independent reading. Upon the same principle the supreme court, in the late case of *Wilmot v. Mudge*, 103 U. S., 217, 220, held that the literal reading of an amendment of the section of the bankrupt law, as to the effect of a discharge of a fraudulent debt by a composition, must give way to the manifest general purpose and intent of the act. In that case the court says:

"It is conceded that the defendants in error came within the terms of this provision, and it is insisted that they must be bound by the composition. We admit the apparent force of the logic. But, as we have already said, these several statutes, sections and provisions are to be construed as parts of one entire system of bankrupt law. . . . There is no injustice nor any difficulty in restraining the language of the composition section, as regards its binding force, to persons whose debts are capable of being discharged by the bankrupt law. . . . In this manner both provisions of the bankrupt law can stand and be consistent."

Upon the same principle, the word "proprietor" should be construed so as to produce a harmonious rather than a contradictory policy in the different parts of the copyright law by giving that word the restricted meaning and sense in which it has been used in all the past copyright acts of this country. As respects this chromo, the plaintiff was not a "proprietor" of a native work, and, upon the construction here given, he was not, therefore, a "proprietor" within the meaning of section 4952, even had he shown an exclusive right from the foreign artist, and he is therefore not entitled to the benefits of the copyright law in this chromo.

§ 144. *A chromo is a "print."*

3. The chromo in question is nothing but a lithographic *print* in colors. Lithographs were undoubtedly embraced in the term "print" under the act of 1831, both in the authorizing and the restricting clauses. 4 Stat. at Large, p. 436, §§ 1, 8. The only difference between chromo-lithographic prints and other lithographs is that the former are printed from several stones, namely, one for each color, while the latter are printed from one stone, with ink of some kind. It cannot be contended that a "print" is any the less a "print" because struck off in different colors; and it has been held that playing cards printed in colors are "prints." *Richardson v. Miller*, 3 Law & Eq. Rep. (Am.), 614. A print is "a mark or form made by impression or printing; anything printed; that which, being impressed, leaves its form, as a cut in wood or metal, to be impressed on paper; the impression made; a picture; a stamp; the letters in a printed book; an impression from an engraved plate; a picture impressed from an engraved surface," etc. *Webst. Dict.*; *Worces. Dict.*; *Wood v. Abbott*, 5 Blatch., 325 (§ 145, *infra*). "It means, apparently, a picture; something complete in itself, similar in kind to an engraving, cut or photograph." *Rosenbach v. Dreyfuss*, 2 Fed. R., 217, 221.

Chromo-lithographs were therefore copyrightable as "prints" under the act of 1831, and as such were within the restriction of section 8 of that act. As chromo-lithographs became largely dealt in, and, under the slang name of "chromos," became a considerable article of trade, it was not unnatural that for greater certainty they should be mentioned by name in the revision of the copyright act of 1870. But congress did not thereby abolish the restriction which already existed upon copyrighting them when made by alien artists,

because such chromo-lithographic prints are included in the word "print," which is contained both in section 103 of the act of 1870, and in section 4971 of the Revised Statutes. Under that general designation of "prints," being restricted before, they are restricted still; for in the use of the new and specific word "chromo" in the act of 1870, and in section 4952 of the Revised Statutes, there is nothing incompatible with the restriction under the more general word "print," which both statutes continue in force as before. *U. S. v. Sixty-five Terra Cotta Vases, etc.*, 10 Fed. R., 880.

The preliminary injunction should therefore be denied.

WOOD *v.* ABBOTT.

(Circuit Court for New York: 5 Blatchford, 325-329. 1866.)

Opinion by SHIPMAN, J.

STATEMENT OF FACTS.—The plaintiffs charge the defendants with pirating certain alleged "prints or engravings," the copyrights of which the plaintiffs allege belong to them. The case presented by the proofs is a novel one, at least in this court, and requires a statement of the facts in order to see the precise point which the judgment of the court determines.

The plaintiffs are photographers in the city of New York, and are engaged in business as partners under the name of the New York Photographing Company. One Fish, an artist, drew in crayon two original drawings or designs of the human figure, one called "The Golden Age," and the other "School Days." These pictures he sold to the plaintiffs, and assigned to them, so far as he could legally do so, all the rights which he had to or growing out of the same. The object of this sale and assignment by Fish and purchase by the plaintiffs was to enable the latter to manufacture and copyright photographs of the original drawings. To carry out this object the plaintiffs caused what are known in photography as "negatives" to be taken. From these negatives they produced great numbers of copies of the original designs, but of a very much smaller size. Before the publication and sale of these copies, the plaintiffs deposited in the clerk's office of the United States district court for the southern district of New York, printed titles of the designs, together with photographic copies thereof. They also, before the publication and sale of such copies, impressed on the latter the words "Entered according to act of congress," etc. There is some dispute in the evidence as to whether or not these words were impressed on all of the pictures before they left the hands of the plaintiffs, but, for the purposes of this motion, I shall assume that they were placed on them all. These photographic copies were quite small, and were mounted on cards of nearly the same size, about two and a half inches by four. The pictures themselves were on a piece of thin paper, and these were pasted on the cards. The words "Entered according to act of congress," etc., were not on the thin paper upon which the pictures were taken, but were impressed on the cards upon which they were pasted, just at the foot of the pictures. The defendants insist that inasmuch as the statute requires these words to be "impressed on the face thereof" in order to entitle the party to the benefit of the act, the impression of the words on the card at the foot of the picture was not a compliance with this requirement, and that therefore the alleged copyright furnishes no protection to the publishers. It is not necessary to determine this point in the present case, for there is another one more

prominent and strongly marked which, in the judgment of the court, is decisive of the controversy between these parties.

The defendants having purchased a copy of each of these small photographic pictures made negatives from them, and from such negatives printed and sold in the market copies almost identical with those made and sold by the plaintiffs. The plaintiffs insist that, upon these facts, they have shown valid copyrights for these small photographs, made from the original designs in their possession, and that the defendants have infringed their rights in the premises, and the question is, whether the verdict taken at the trial can be supported by the first section of the act of 1831, upon which the alleged copyrights are founded. That section provides that "any person or persons being a citizen or citizens of the United States, or resident therein, who shall . . . invent, design, etch, engrave, work, or cause to be engraved, etched or worked, from his own design, any print or engraving, and the executors, administrators or legal assigns of such person or persons, shall have the sole right of printing, reprinting, publishing and vending such . . . print, cut or engraving, in whole or in part, for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed." A glance at this section will show that the question in controversy is, whether or not these photographs are prints, cuts or engravings, and, therefore, protected by the statute.

The principal ground upon which the plaintiffs claim the validity of the copyright is that, as they allege, the photographs are "prints." The process by which these photographs are taken is substantially as follows: The original picture is transferred to a prepared glass plate, according to the well-known practice of photographers. This copy of the original is called a negative, and, as seen in the medium of transmitted light, the lights and shadows of the original are reversed. A sheet of prepared paper is then laid upon the plate, both paper and plate are put into a frame of the proper size, in which pressure is applied to the paper by appropriate means, so as to bring the paper into contact with the plate throughout its entire surface, and then the plate is exposed to the light of the sun. The rays of light transmitted through the glass throw the picture on the prepared paper and fix it there in positive light and shadow. By this means reduced copies of the original are extensively multiplied. The pressing of the paper upon the glass plate is to make the contact of their surfaces perfect throughout, in order to prevent the diffusion of the light and the consequent blurring of parts of the picture, which would occur in spots where this contact did not take place. In other words, the pressure is to hold the paper to the glass plate in such a way as to secure a uniform chemical action of the light on the paper, controlled or disturbed in no way except by the shadowy image on the glass itself. The rays of light paint or delineate, by chemical action, the image on the paper, guided by the image on the glass. These rays paint it in just the same way in which they paint the negative on the glass, except that, in the latter case, they are reflected from the original, while in this they pass directly through the transparent plate. This is a new and beautiful art, discovered long after the statute in question was enacted. It is not a development of the art of making prints or engravings which existed at the date of the act. Then a print was defined to be "a mark or form made by impression or printing; anything printed; that which, being impressed, leaves its form, as a butter print; a cut in wood or metal to be impressed on paper; the impression made; a picture; a stamp; the letters in a printed book," etc.

As used in this statute it was synonymous with the term "engraving," with which it is connected in the act, which means, in this relation, "an engraved plate; an impression from an engraved plate." This new art of photography, and all its kindred processes, is an entirely original and independent mode of taking pictures of material objects, and multiplying copies of such pictures at pleasure. That combination of creative or imitative power and mechanical skill by which the artist works out his own conception, or the embodied conception of another, in a fixed form, the fruits of which the law was intended to protect, is not brought into play. No block, plate or stone is engraved. No figure is drawn, etched, raised or worked on any surface from which copies are to be produced by impression or printed. The image thrown by light reflected from the original and passed through a camera produces a negative, and, when the light passes through the transparent negative on to paper held in contact with glass, it produces a positive. The image is no more formed by pressure when the positive is made on the paper held in contact with the glass plate, than when the negative is made on the glass by rays reflected from the original at a distance. In both cases, the only force that contributes to the formation of the image is the chemical force of light, operating on a surface made sensitive to its power. The springs in the pressure frame hold the paper firmly in contact with the glass, and thus prevent the diffusion of the light after it passes through the negative. This position of the paper and plate renders the operation of the light direct and strong, and brings out the lines of the picture clearly and sharply.

§ 145. *Photographic printing cannot be protected by copyrights by force of the effect of any clause or provision of the act of February 3, 1831.*

The manufacture of these positives is called, in the language of this new art, photographic printing. But names are not things. It is not printing in any sense known to the arts at the time this copyright act was passed; nor is it an extension of the old processes, or a new development of the art of printing or the art of engraving, as those arts were then understood. It is an entirely original and independent method of producing and multiplying pictures — an art, not of printing or engraving, but of securing the delineation of pictures by light operating on sensitive surfaces. In no just sense, therefore, can it be said to be within the act of 1831. Congress, proceeding upon this view, by the act of March 3, 1865 (13 U. S. Stat. at Large, 540), extended the protection of the copyright act to this new art of photography. This, however, was not done till after the copyrights in question were taken out, and this suit was brought. These plaintiffs, therefore, have no remedy in the present case. The verdict must, therefore, be set aside.

ROSSITER v. HALL.

(Circuit Court for New York: 5 Blatchford, 362-366. 1866.)

Opinion by BENEDICT, J.

STATEMENT OF FACTS.—This case comes before me upon a motion for an injunction to restrain the defendants from producing and selling photographs of an engraving known as "The Home of Washington." The papers read show that the engraving in question is a duly copyrighted engraving, owned by the plaintiffs, and that the defendant, by the photographic process, has produced a negative representation of this engraving, from which he prints photographs of it in various sizes, and is disposing of the same without the

consent of the plaintiffs. This the defendant claims the right to do, upon the ground that the copyright laws do not forbid the making of photographs of copyrighted engravings.

The act of February 3, 1831 (4 U. S. Stat. at Large, 436), in the first section, declares that any person who shall invent, design, etch, engrave, work, or cause to be engraved, etched or worked, from his own design, any print or engraving, shall have the sole right and liberty of printing, reprinting, publishing and vending such print, cut or engraving, in whole or in part; and in the seventh section it declares that, if any person shall engrave, etch or work, sell or copy, or cause to be engraved, etched, worked or sold, or copied, either on the whole or by varying, adding to or diminishing the main design, with intent to evade the law, such offender shall forfeit the plate on which such engraving, cut or print shall be copied, and shall further forfeit \$1 for every sheet of such print, cut or engraving which may be found in his possession.

§ 146. *A reproduction of a print or picture by photography is a manner of copying, within the meaning of the act of February 3, 1831, and therefore an infringement of a copyright, where such print or picture has been previously copyrighted.*

The argument of the defendant is that the exclusive privilege given by the first section of the act does not include the photographing the copyrighted engraving, because that is not a "printing" or a "reprinting," and that the general words of the seventh section cannot be held to forbid in others what has not been exclusively reserved to the author by the words of the first section; and further, that photographing could not have been within the intent of the law-makers, as the art of photography had not been discovered when the act was passed. In support of such a construction the decision of Judge Shipman in the case of *Wood v. Abbott*, 5 Blatch., 325 (§ 145, *supra*), is cited. I cannot agree to the construction of the act which is contended for. In my opinion, sections 1 and 7 should be read together; and, so taken, the words used disclose a clear intent to protect a copyrighted work from such a mode of duplication as is practiced by the defendant. Section 7 provides that any person who shall engrave, etch or work, sell or copy the engraving, shall be an offender. The word *copy* is a general term, added to the more specific terms before used, for the very purpose of covering methods of reproduction not included in the words engrave, etch or work, and, if it covers anything, should cover the photographic method, which, more nearly than any other, produces a perfect copy. This construction of the American act is sustained by the construction given by the English courts to the British act, which contains the word *copy*, used in a similar connection. Hence, in *Gambart v. Ball*, 14 C. B., new series, 306, where the question was whether the copyright of the engraving of Rosa Bonheur's "Horse Fair" was infringed by photographing it, Erle, C. J., says: "Is a reproduction of the print by photography a manner of copying? To that I answer in the affirmative." And the three other judges express the same opinion. Indeed, to hold otherwise would work a substantial repeal of the copyright laws in many cases. For not only engravings, but books may be reproduced by the photographer, and, under the construction claimed by the defendant, authors and publishers would be in no way protected against such reproduction of their works, while the art has been carried to such perfection that the photographic copies of certain classes of engravings, which can be produced at a trifling cost, are, for the purposes of trade, nearly or quite equal to the orig-

inals. It needs but an allusion to the amendment to the copyright law of 1831, passed in 1865 (Act of March 3, 1865, 13 U. S. Stat. at Large, 540), to dispel any doubt as to the proper construction of the act of 1831. This amendment was passed in order to protect original photographs, which were supposed not to be embraced by the words "print, cut or engraving," used in the act of 1831. In order to accomplish that, it simply provides that the provisions of the act of 1831 "shall extend to and include photographs and the negatives thereof, which shall hereafter be made, and shall inure to the benefit of the authors of the same, in the same manner and to the same extent, and upon the same conditions, as to the authors of prints and engravings." But it does not add the word "photograph" to the words used in the seventh section. If, then, the word *copy* does not cover the photographic process, photographs can with impunity be reproduced by the only method ever likely to be resorted to for the purpose, and the amendment gives them no protection at all. The construction I have given to the act of 1831 is necessary to render of any beneficial effect the amendment of 1865.

This conclusion is entirely consistent with the construction given to the act of 1831 in the decision of Judge Shipman cited by the defendant. What Judge Shipman decided in that case was, that, previous to the amendment of 1865, a photograph could not be the subject of a copyright, as it was not a print, cut or engraving, within the meaning of the first section of the act of 1831. The learned judge did not decide or discuss the question whether the word *copy* in the seventh section includes photographic copies, which is the question here.

§ 147. *Notice to the effect that the print or picture is copyrighted may be placed either on the face of the picture or within the line of a reasonable margin, where it would not be covered if properly framed.*

Another point taken by the defendant should also be noticed, which is, that the plaintiffs' engraving did not have upon it the information that it was a copyright, required, by the fifth section of the act, "to be impressed on the face thereof." It appears that the usual legal memorandum of copyright was, in this case, in engraved letters, placed some three inches below the picture itself, and printed with the picture from the plate. The affidavit of Mr. Knoedler shows that the notice would be seen in the margin of the print when properly framed, and that it was placed in the usual position. The defendant claims that the words of the act, "impressed on the face thereof," require the notice to be placed on the picture itself instead of on the margin. But I think, that, when the required notice is plainly engraved on the plate from which the print is taken, within the line of a reasonable margin, and where it would not be covered when properly framed, it is impressed on the face, within the meaning of the act.

It seems, therefore, quite clear, that the defendant is infringing upon the plaintiffs' copyright, and I must grant the motion for an injunction to restrain him.

§ 148. **Book, not printed.**—A book may be the subject of copyright when composed, though it is not printed. *Roberts v. Myers*,* 23 Law Rep., 396; 13 Law Rep. (N. S.), 396.

§ 149. **A book**, within the meaning of the acts of congress relating to copyright, need not be a book in the ordinary acceptation of the term, but may consist of only one sheet, as a song with accompanying music. *Clayton v. Stone*,* 2 Paine, 382; 1 Leg. Int. & Rev., 69.

§ 150. **Translations.**—A translator of a play from a foreign language may obtain a copyright therefor, and all persons will be enjoined from acting the play as thus translated without the assent of the translator or his assigns, though they may use other translations if they

do not use the whole or any part of the translation belonging to the complainant. *Shook v. Rankin*,* 6 Biss., 477; 2 L. & Eq. Rep., 236; 8 Ch. Leg. N., 345.

§ 151. **Foreign works.**—No exclusive right to republish the published works of a foreign author can be acquired in this country. New matter and illustrations may be included, and they may be protected by copyright, but the protection of the copyright laws can extend no further. *Sheldon v. Houghton*, 5 Blatch., 285.

§ 152. **Engraving of patented article.**—A person who manufactures a patented article of a given form cannot, by copyrighting an engraving of the article manufactured by him, prevent another person having the right to manufacture such articles in the same form from publishing a picture of them as a means of advertising them. *Collender v. Griffith*, 11 Blatch., 212.

§ 153. **Photographs.**—So far as a photograph is an original work of art and the product of intellectual invention, it may lawfully be the subject of copyright under the eighth section of article 1 of the constitution. *Lithographic Co. v. Sarony*,* 111 U. S., 53.

§ 154. **A second edition** of a work may be published in a less number of volumes than the first and still be protected by the original copyright if notice thereof is properly published. *Dwight v. Appleton*,* 1 N. Y. Leg. Obs., 195.

§ 155. A copyright affords no protection to what was not in existence when it was granted, and notes and additions incorporated in a subsequent edition of a work are not protected by the original copyright. *Lawrence v. Dana*, 4 Cliff., 1 (§§ 257-69).

§ 156. **A daily price current** is not within the protection of the acts of congress of May 31, 1790, and April 29, 1802, relating to copyrights. *Clayton v. Stone*,* 2 Paine, 382; 1 Leg. Int. & Rev., 69.

§ 157. **A map** is not the subject of copyright except so far as it is based upon original labor, and the right therein is violated only when another person by copying therefrom avails himself of the skill and labor of the first; but merely colorable alterations are insufficient to protect the infringer. *Blunt v. Patten*,* 2 Paine, 397.

§ 158. A new edition of a map is protected by a copyright of the former edition, where the title is unchanged, even though there is a change in the date and on the face of the map in some particulars. *Farmer v. Calvert Lithographing, etc., Co.*, 1 Flip., 228 (§§ 288-97).

§ 159. **Private letters.**—Unless there is a most unequivocal dedication of private letters and papers by the author to the public, or to some private person, the author has a property therein and the copyright thereof belongs exclusively to him. *Folsom v. Marsh*, 2 Story, 100 (§§ 249-56).

§ 160. **A label** of medicine setting forth its name and valuable qualities is not a book within the meaning of the copyright law, and is not the subject of copyright. *Scoville v. Toland*,* 6 West. L. J., 84.

§ 161. **Paintings.**—The president of a corporation made a design from a wood cut belonging to the corporation, and a painting was made therefrom by an artist employed by the corporation. *Held*, that the corporation might copyright the painting, though it was of a size such that lithographic copies were adapted for labels. *Schumacher v. Schwencke*,* 25 Fed. R., 466.

§ 162. **Chart.**—A folded sheet of paper exhibiting tabulated and methodically arranged information is not a "chart" within the meaning of the copyright law. *Taylor v. Gilman*,* 24 Fed. R., 632.

§ 163. **Old materials.**—An author who has compiled and written a new work upon a new and original plan, arrangement and combination of materials, and who has not servilely copied or evasively imitated another, is entitled to a copyright of his work even though all the materials employed by him are old. *Greene v. Bishop*, 1 Cliff., 186 (§§ 242-48).

§ 164. A new plan, arrangement and combination of materials by an author entitles him to a copyright whether the materials are new or old. The author cannot thereby appropriate to himself materials which were common to all persons before him, but he has the exclusive right to use such materials with his improvements added, whether they consist in plan, illustrations, arrangement or combinations. *Emerson v. Davies*, 3 Story, 768; 8 Law Rep., 294; 4 West. L. J., 261 (§§ 270-79).

§ 165. A play may be original and entitled to the protection of a copyright though it is to some extent formed out of existing materials, provided that it is not merely copied or slavishly imitated. *Boucicault v. Fox*, 5 Blatch., 87 (§§ 35-39).

§ 166. Copyright may be justly claimed by an author who has taken existing materials from sources common to all writers and arranged and combined them in a new form, and given them an application before unknown. Others may use the old materials for a different purpose, but they cannot copy and use his improvement, which includes his plan, arrangement and combination of materials, as well as the materials themselves. *Lawrence v. Dana*, 4 Cliff., 1; 2 Am. L. T. (N. S.), 402 (§§ 257-269).

§ 167. An author may have a copyright in his notes to an older work, though the materials collected are not new, if they have never before been collected and embodied. *Ibid.*

§ 168. **Judicial opinions.**—In the absence of a state statute making them the subject of copyright, the written opinions of the judges of the state supreme court, together with the head-notes and statements of fact by them, are not the subject of copyright, though the work of the official reporter is, and that only is protected by the copyright of the volume of reports. *Banks v. Manchester*,* 23 Fed. R., 143.

§ 169. The reporter of the supreme court of New Hampshire has no copyright in the opinions of the court and of the head-notes prepared by the judges writing the opinion. *Chase v. Sanborn*,* 4 Cliff., 306; 6 O. G., 932.

§ 170. A state reporter of judicial decisions is an author within the meaning of the constitution and the copyright laws of the United States. *Little v. Gould*,* 2 Blatch., 362.

§ 171. In the absence of any express legislation by the state indicating a contrary principle, the state reporter of judicial decisions is entitled to a copyright in his volumes of reports for what is the work of his mind and hand, notwithstanding he may have no copyright in the opinions of the court. *Myers v. Callaghan*,* 10 Biss., 139; 5 Fed. R., 726.

§ 172. The reporter of the supreme court of the United States has no copyright in the written opinions thereof. *Wheaton v. Peters*, 8 Pet., 591 (§§ 12-16).

§ 173. **Ownership of a title of a work.**—The person who deposits for copyright the title of a drama, which title is not original with him, cannot thereby secure such title to himself to the exclusion of others who, before such title was deposited, have applied the same title to a dramatic composition founded on the same story. *Benn v. Leclercq*,* 18 Int. Rev. Rec., 94.

§ 174. A dramatic author by copyrighting his production secures only what is his own in it. He cannot prevent others from composing and publishing a similar book on the same subject, provided they do not pirate from his copyrighted book, but rely on their own intellects and mental powers. *Ibid.*

§ 175. A suit for infringement may be maintained by the author of a dramatic composition after the title of his work has been filed but before publication, under the act of congress of August 18, 1856. *Boucicault v. Wood*,* 2 Biss., 34; 7 Am. L. Reg. (N. S.), 539.

§ 176. In order to entitle a dramatic composition to the benefit of the copyright laws it must be fit to be acted,—it must not be immoral or indecent. *Martinetti v. Maguire*,* Deady, 216; S. C., 1 Abb., 356.

§ 177. A mere spectacle, such as *Black Crook*, in which the dialogue is scant and meaningless, and is a mere accessory to the action of the piece, is not a dramatic composition, and is not entitled to protection under the copyright laws. *Ibid.*

§ 178. **Musical compositions.**—If a given musical composition was borrowed from a former one, or was made up of different parts copied from older musical compositions without any material change, and put together into one tune, with only slight and unimportant alterations or additions, then the compiler is not the author within the meaning of the law. But the circumstances of its corresponding with older musical compositions, and belonging to the same style of music, does not constitute it a plagiarism, provided the air in question, in its main design, and in its material and important parts, is the effort of his own mind. *Reed v. Carusi*,* 8 Law Rep., 410.

§ 179. An original arrangement of an existing piece of music is the subject of copyright, though it is not entirely an original composition, and a publication of a piece of music substantially like such adaptation is an infringement. *Schuberth v. Shaw*,* 19 Am. L. Reg. (N. S.), 248.

§ 180. It seems that a person is not entitled to a copyright in a musical production which has been altered and improved by his procurement, but by other persons. *Atwill v. Ferritt*, 2 Blatch., 39.

§ 181. If a piece of music is not protected by copyright, its title is not, and others may use it. *Jollie v. Jaques*,* 1 Blatch., 618; 9 N. Y. Leg. Obs., 10.

§ 182. A musical composition which is merely a copy of an imported piece differently arranged and adapted, or transposed, is not entitled to copyright. *Ibid.*

§ 183. A dedication to the public by a composer of an oratorio of a score for the piano, with marginal notes showing the instruments employed in orchestration, does not permit an unauthorized person to reproduce or copy the orchestral score, and the production of such oratorio by an unauthorized person with orchestral score will be enjoined at the suit of the assignee of the right to produce it, even though the orchestration is by another person than the composer, and the full score is not attempted to be reproduced. *Thomas v. Lennon*,* 14 Fed. R., 849; 16 Cent. L. J., 108; 15 Rep., 258.

§ 184. **Instances.**—A print of a balloon or of a hanging basket with printing for embroidery and cutting lines is not a copyrightable article. *Rosenbach v. Dreyfuss*,* 2 Fed. R., 217; 2 Alb. L. J., 472; 17 O. G., 1153.

§ 185. A card upon which are exhibited specimens of paint is not subject to copyright under the act of congress of February 3, 1831. *Ehret v. Pierce*,* 18 Blatch., 302; 10 Fed. R., 553.

§ 186. A claim to an exclusive method of advertising, as by exhibiting different colors of paint in squares upon a card, cannot be acquired under the copyright laws. *Ibid.*

III. SECURING COPYRIGHT.

SUMMARY — *Deposit of copies of work*, §§ 187, 188.

§ 187. The owner of a copyright cannot recover for an infringement thereof unless he shows by competent evidence that, within ten days after publication, he deposited two copies in the office of the librarian of congress, or deposited them in the mail, properly addressed to such officer. *Merrell v. Tice*, §§ 189-91.

§ 188. An unsigned memorandum appended to the signed and sealed certificate of the librarian of congress of the proper deposit of a copy of the title-page of a book, that two copies of the publication were deposited, is not admissible evidence of such deposit in an action against an infringer of the copyright. *Ibid.*

[NOTES.— See §§ 192-215.]

MERRELL v. TICE.

(14 Otto, 557-562. 1881.)

ERROR to U. S. Circuit Court, Eastern District of Missouri.

Opinion by MR. JUSTICE BRADLEY.

STATEMENT OF FACTS.— This was an action at law to recover damages for the infringement of a copyright. Tice, the plaintiff below, is the author of an almanac known as “Professor Tice’s Almanac.” The copyright alleged to be infringed was that of the almanac for 1877. The declaration contained the proper averments, and the answer a general denial. On the trial the plaintiff produced a copy of his almanac, having on its title-page the words required by the act, “Entered according to act of congress,” etc.; and then, to show that he had complied with the law of copyright, produced a certificate of the librarian of congress, under his seal of office, in the words following:

“ {	LIBRARY OF CONGRESS, COPY-	LIBRARY OF CONGRESS,
{	RIGHT OFFICE, UNITED STATES	COPYRIGHT OFFICE,
{	OF AMERICA.	WASHINGTON.

No. 12,579 G.

“To wit: Be it remembered that on the 13th day of November, anno Domini 1876, John H. Tice, of St. Louis, Mo., has deposited in this office the title of a book, the title or description of which is in the following words, to wit:

“*Professor Tice’s Almanac for the year 1877, etc.*

“The right whereof he claims as proprietor in conformity with the laws of the United States respecting copyrights.

“ {	LIBRARIAN OF CONGRESS, COPY-	(Signed)
{	RIGHT OFFICE, UNITED STATES	A. R. SPOFFORD,
{	OF AMERICA.	Librarian of Congress.

“I, A. R. Spofford, Librarian of Congress, hereby certify that the foregoing is a true copy of the original record of copyright in the Library of Congress.

“In witness whereof I have hereunto set my hand and affixed the seal of my office, this 11th day of May, 1878.

“A. R. SPOFFORD,
“Librarian of Congress.

“Two copies of the above publication deposited December 6, 1876.”

To the introduction of that portion of said paper in the words "two copies of the above publication deposited December 6, 1876," the defendant objected, on the ground that it was no part of the certificate, but a mere anonymous statement, when and by whom made not appearing, and incompetent; which objection the court overruled and permitted the statement to go to the jury; to which ruling the defendant excepted. No other evidence was given to show that any copy or copies of the book had been deposited with the librarian or in the mail. The infringement was proved to the satisfaction of the jury, who, under the charge of the court, rendered a verdict for the plaintiff. Other exceptions to evidence appear in the bill of exceptions, but it is unnecessary to consider them. The questions to which we have given attention, and which are decisive of the case, are:

First, Whether the plaintiff was bound to prove that two copies of the book had been deposited with the librarian or in a postoffice, according to the requirements of the law?

Secondly, If he was, whether the proof adduced was competent for that purpose?

These questions will be considered together.

§ 189. *To secure a copyright the party must, within ten days after publication, deliver or deposit in the mail addressed to the librarian of congress two copies of the work sought to be copyrighted.*

The acts of congress relating to the subject are found in sections 4956 to 4961 of the Revised Statutes.

Section 4956 declares that no person shall be entitled to a copyright unless he shall, before publication, deliver at the office of the librarian of congress, or deposit in the mail addressed to the librarian, at Washington, a printed copy of the title of the book or other article, etc.; nor unless he shall also, within ten days from the publication thereof, deliver at the office of the librarian, or deposit in the mail addressed to him, at Washington, two copies of such copyright book or other article, etc.

Section 4957 requires the librarian to record the name of the book or other article in a book to be kept for that purpose in the words following: "Library of congress, to wit: Be it remembered that on the — day of —, A. B. of — hath deposited in this office the title of a book (map, chart or otherwise, as the case may be, or description of the article), the title or description of which is in the following words, to-wit: (here insert the title or description), the right whereof he claims as author, etc., in conformity with the laws of the United States respecting copyrights. C. D., Librarian of Congress." The librarian is required to give a copy of the title or description, under the seal of the librarian of congress, to the proprietor whenever he shall require it.

Section 4958 prescribes the librarian's fees: "First, for recording the title or description of any copyright book or other article, fifty cents; second, for every copy under seal of such record actually given to the person claiming the copyright, or his assigns, fifty cents," etc.

Section 4959 declares that the proprietor of every copyright book, etc., shall deliver at the office of the librarian of congress, or deposit in the mail addressed to him, within ten days after its publication, two complete printed copies thereof, of the best edition issued, and a copy of every subsequent edition wherein any substantial changes are made.

Section 4960 imposes a penalty of \$25 for failure to deposit the published copies as required in the previous sections.

Section 4961 declares as follows: "The postmaster to whom such copyright book, title or other article is delivered shall, if requested, give a receipt therefor; and when so delivered he shall mail it to its destination."

On a mere inspection of these enactments it is very obvious that the deposit of two copies of the book, after its publication, either with the librarian of congress or in the mail addressed to him, is an essential condition of the proprietor's right, and must, in some way, be proved in an action for infringement. The words of the law are: "No person shall be entitled to a copyright unless he shall also within ten days, etc., deliver at the office of the librarian of congress, or deposit in the mail, etc., two copies of such copyright book." Nothing can be plainer than this.

Then what is competent proof of such a deposit? If, after complying with all the requisite conditions, the law had authorized letters patent for the copyright to be issued to the proprietor, such letters would be competent, if not conclusive, evidence that the conditions had been complied with. But no such letters are issued in the case of copyrights. It is contended, indeed, that the librarian's certificate answers the same purpose. But it is plain that this certificate was only an exemplification of the record required to be made on the filing of the title before publication. Its form, as prescribed by the law, and its contents as shown by the copy produced in evidence, show that it relates to nothing else. The publication of the book, and the deposit of copies thereof, may not take place until the lapse of months afterward. The certificate, therefore, has no relation to the deposit of the books. The record of which it is an exemplification is made without reference to any such deposit.

§ 190. *Quære: Whether the certificate of the librarian of congress that two copies of the book had been deposited would be proof of the fact.*

Whether, after the deposit has been made, the certificate of the librarian, under his official seal, that the books were deposited on such a day, would be competent evidence of the fact, is not now the question; and it may admit of considerable doubt. Perhaps a certificate of the librarian attached to a copy of the book, certifying that two copies of the same book, or of which that is a true copy, were deposited in his office on such a day, would be competent evidence, inasmuch as the librarian's office is a public one; the copyright books deposited with him are quasi-records, kept in his custody for public examination,—one object no doubt being to enable other authors to inspect them in order to ascertain precisely what was the subject of copyright. But we express no opinion whether such a certificate would be competent or not. In the present case no such certified copy of the books deposited, nor a certificate of the fact that they were deposited, was adduced in evidence.

§ 191. *An unsigned memorandum under a certificate is no part of the certificate and not evidence of the fact stated.*

The memorandum under the certificate had no validity as evidence. It might have been put there by any person. It would be unsafe to hold that a memorandum under a certificate, or indorsed upon it, is part of the certificate. A certificate under seal, when invested with legal force and effect, is a solemn instrument, and ought to be complete, certain, and final in itself, without any collateral addition or commentary. Its very form and character as a certificate presuppose that it has the verification and protection of the authenticating signature and seal. Any matter extraneous, that is, not contained in the body of the instrument, has not this verification and protection. Such extraneous matter may be added by other persons, or may be erased or altered, without

involving the offense of forgery or alteration of the certificate. Memoranda of various kinds are frequently indorsed on instruments of this sort for the convenience of the possessors, either to indicate their contents, or to furnish other information with regard to their subject-matter. To hold that such memoranda are evidence, except as against the party making them, would be wholly inadmissible.

We are satisfied that the evidence offered and objected to was incompetent for any purpose in the cause. The judgment must be reversed, and the cause remanded to the circuit court with directions to award a new trial; and it is so ordered.

§ 192. **Strict compliance required.**—Under the acts of congress of May 31, 1790, and of April 29, 1802, relating to copyrights, there must be a strict compliance with the requirements of the law relating to the publication of the record of the entry, and the deposit of a copy in the department of state, in order to entitle a copyright to judicial protection. *Wheaton v. Peters*, 8 Pet., 591 (§§ 12-16).

§ 193. In order to entitle a publication to the protection of the copyright laws it must not only appear that the printed title-page was deposited with the clerk of court, but that it was deposited before publication, and in addition it must not only appear that the copies required by law were deposited as required, but deposited within the time limited after publication. *Chase v. Sanborn*,* 4 Cliff., 306; 6 O. G., 932.

§ 194. In order to entitle a person to maintain an action for an infringement of a copyright he must show a full compliance on his part with the requirements of the act of congress relating to copyrights. In this case a demurrer to the bill was sustained because it did not allege the delivery of copies to the librarian of congress. *Parkinson v. Laselle*,* 3 Saw., 330.

§ 195. The first and third sections of the act of congress of May 31, 1790, and the act of April 29, 1802, relating to copyrights, are mandatory and not directory, and the publication of the record of the entry is essential to acquiring a copyright. *Ewer v. Coxe*,* 4 Wash., 487.

§ 196. **Deposit of title.**—In order to entitle a person to a copyright of a book under the copyright act of 1831, the title must be deposited with the clerk of the proper court before publication, and a copy of the printed work within three months after publication. *Struve v. Schwedler*,* 4 Blatch., 23.

§ 197. Under the copyright law of 1831 the record of the clerk made in the form prescribed by the act is *prima facie* evidence that the title deposited was such as the statute requires. *Roberts v. Myers*,* 23 Law Rep., 296; 13 Law Rep. (N. S.), 396.

§ 198. When it appears that the title-page of a book was deposited in the clerk's office on the same day that the printed volume was deposited, it will be presumed, in the absence of evidence to the contrary, that the deposit of the title-page preceded that of the printed volume. *Myers v. Callaghan*,* 10 Biss., 139; 5 Fed. R., 726.

§ 199. The title of a book was deposited in the office of the librarian of congress as follows: "Over One Thousand Receipts. The Lake-Side Cook-Book. A Complete Manual of Practical, Economical, Palatable and Healthful Cookery. Chicago: Donnelley, Lloyd & Co." The title-page of the book as printed was, "The Lake-Side Cook-Book, No. 1. A Complete Manual of Practical, Economical and Palatable and Healthful Cookery. By N. A. D."—with the place of publication, name of publishers and notice of copyright. *Held*, that the variance between the title deposited and the title-page was immaterial; that the name of the book was substantially the same in each, and that there had been such a substantial compliance with the requirements of the copyright act as entitled the publishers to the copyright. *Donnelley v. Ivers*,* 20 Blatch., 381; 18 Fed. R., 592; 13 Rep., 389.

§ 200. The printed copy of the title of a publication sought to be copyrighted, which is required by section 4956, Revised Statutes of the United States, may be printed with a pen with or without the aid of tracing paper. The result and not the means is what the law provides for. *Chapman v. Ferry*,* 9 Saw., 395; 18 Fed. R., 539.

§ 201. **Deposit of printed copies.**—In order to entitle an author to a copyright, he must publish the work within a reasonable time after filing the title, and within the time limited after publication deposit two copies of the work with the librarian of congress. And if it simply appears that the title has been deposited, and does not appear that a deposit of printed copies has been made as required by law, an action for an infringement cannot be sustained. *Boucicault v. Hart*, 13 Blatch., 47; 4 Am. L. Rec., 726; 8 Ch. Leg. N., 257 (§§ 22-29).

§ 202. In order to recover the penalty prescribed by section 4966, Revised Statutes of the United States, for the unauthorized performance of a dramatic composition, it must appear that the composition is copyrighted. *Ibid.*

§ 203. The act of congress requiring copies of every work sought to be copyrighted to be deposited in the mail for the librarian of congress within ten days after publication is complied with by making such deposit after the work is printed and before it is offered for sale. *Chapman v. Ferry*,* 9 Saw., 395.

§ 204. The provision of the tenth section of the act of congress of August 10, 1846, establishing the Smithsonian Institution, that every author of a copyrighted work should within three months after publication deliver a copy to the Smithsonian library, is directory merely, and a copyright otherwise valid is not void for want of such deposit. *Jollie v. Jaques*,* 1 Blatch., 618; 9 N. Y. Leg. Obs., 10.

§ 205. A copy of a work sought to be copyrighted may be deposited with the secretary of state under the fourth section of the act of May 31, 1790, after six months after publication, where it has been published by no one else, and such deposit will avail from the time it is made. *Copyrights*,* 1 Op. Att'y Gen., 532.

§ 206. The delivery of the first volume of a copyrighted work to the secretary of state within six months after publication, and the rest of the volumes before an infringement, is such a compliance with the copyright law as will enable the owner of the copyright to recover for the infringement. *Dwight v. Appleton*,* 1 N. Y. Leg. Obs., 195.

§ 207. Notice.—The various provisions of the law in relation to copyright should have a liberal construction in order to give effect to what may be considered the inherent right of an author to his own work. So where a person has in good faith attempted to comply with the copyright act of 1831, the fact that the notice of copyright stated that the book was entered in 1866, when in fact it was entered in 1867, was held not to vitiate the copyright. *Myers v. Callaghan*,* 10 Biss., 139; 5 Fed. R., 726.

§ 208. The author and proprietor of a map who has neglected to impress the notice of copyright upon the face of his map, as required by the acts of congress relating to copyrights, has no right to any benefit under such acts. *King v. Force*,* 2 Cr. C. C., 208.

§ 209. Under the copyright laws of the United States a copyright title is not perfected until there is a strict compliance with the provisions of the statutes; and the publication of the notice of the entry of the title-page in a wrong year by a mistake is fatal. *Baker v. Taylor*,* 2 Blatch., 82.

§ 210. In 1871 the rules of practice in the courts of New York were published with annotations and copyrighted. In 1874 new rules were adopted, which were annotated, published and copyrighted by the same publishers. *Held*, that the edition of 1874 was a new work, and not a new edition of the work of 1871, and that it was necessary that a notice of the copyright of the edition of 1871 should be inserted therein. *Banks v. McDivitt*,* 13 Blatch., 163.

§ 211. Where a work is published in several volumes appearing successively, it is sufficient to insert the notice of copyright in the proper place in the first volume. *Dwight v. Appleton*,* 1 N. Y. Leg. Obs., 195.

§ 212. It is a sufficient compliance with the act of congress requiring the name of the party procuring a copyright to be inscribed on the copyrighted article, to indicate the given name by its initial. *Sarony v. Burrow-Giles Lithographic Co.*,* 17 Fed. R., 591.

§ 213. The requirement of the copyright act of June 18, 1874, as to inscribing notice of copyright on all copyrighted articles, is complied with by inscribing thereon the word "copyright," with the date and the name of the person; and such name may properly consist of the surname and the initial of the given name. *Lithographic Co. v. Sarony*,* 111 U. S., 53.

§ 214. The notice of the copyright of an engraving required by act of congress may be presented on the picture itself, or within the margin that would not be covered when the picture was properly framed. *Rossiter v. Hall*, 5 Blatch., 362 (§§ 146, 147).

§ 215. The original notice of the entry of a copyrighted book need not be reprinted in copies of subsequently copyrighted editions of the same book within the term of the original copyright. It is sufficient if the time of the original is stated. *Lawrence v. Dana*, 4 Cliff., 1 (§§ 257-69).

IV. ASSIGNMENT.

§ 216. In general.—Upon the testimony it was decided that transactions between the parties did not amount to an assignment of a copyright. *Hubbard v. Thompson*,* 25 Fed. R., 188.

§ 217. Right to renewal.—An assignment of a copyright, during the first fourteen years, confers on the assignee no right to the renewed copyright; and this notwithstanding a usage among book sellers to the contrary, provided such usage was not known to the owner of the copyright. *Pierpont v. Fowle*,* 2 Woodb. & M., 22.

§ 218. Assignment not in writing.—A person who acquires from the holder of a copyright of an annotated work the right to republish the work with knowledge of the equitable title of

the annotator to his notes is liable to the annotator for an infringement if his notes are republished, though there is no written assignment. *Lawrence v. Dana*, 4 Cliff., 1 (§§ 257-69).

§ 219. **Estoppel.**—The testimony of the author of a copyrighted work in an action brought by his assignees against a third party for an infringement, and in which the question of ownership of the copyright was in issue, that he had parted with his whole interest, will estop his legal representatives from claiming that he only parted with the right to the copyright for the first term of fourteen years, especially where such testimony was given after the expiration of such term as to a portion of the work. *Cowen v. Banks*,* 24 How. Pr., 72.

§ 220. **Assignment not recorded.**—In a suit for an infringement of a copyright brought by assignees of the original owner against persons not claiming under the complainant's assignor, it is immaterial that the assignment to the complainant was not recorded. *Webb v. Powers*, 2 Woodb. & M., 497; 10 Law Rep., 152 (§§ 497-524).

V. INFRINGEMENT.

SUMMARY—*Abridgment*, §§ 221, 233, 234.—*Not necessary that the whole or a larger part of a work be taken*, §§ 222, 224, 226.—*Copying*, §§ 223, 226.—*Test of infringement*, §§ 223, 224, 227.—*Internal evidence of copying*, §§ 226, 229.—*Extraneous evidence*, § 227.—*Use of a part enjoined*, § 228.—*Intent not material*, § 230.—*Privileges of a subsequent writer*, § 231.—*Burden of proof*, § 232.—*As to dictionaries and other similar works*, §§ 235, 237.—*Compilations*, §§ 236-238.—*Maps*, § 238.—*Dramatic compositions*, §§ 239-241.

§ 221. The mere copying of a portion of the materials of a copyrighted work, without any essential condensation of the same, cannot bring the later work within the legal description of an abridgment. *Greene v. Bishop*, §§ 242-248.

§ 222. It is not necessary that the whole or even a larger portion of a work should be taken in order to constitute an invasion of a copyright. It is sufficient that so much is taken that the value of the original is sensibly and materially diminished, or the labors of the original author are substantially, to an injurious extent, appropriated by another. *Ibid.*

§ 223. In questions of the infringement of a copyright, the main inquiry is whether the author of the work alleged to be a piracy has resorted to the original sources alike open to him and to all other writers, or whether he has adopted and used the plan and materials of the work which it is alleged he has infringed without resorting to the sources from which he had a right to borrow. Copying is not confined to literal repetition, but includes also the various modes in which the matter of any publication may be adopted, imitated or transferred, with more or less colorable alterations to disguise the piracy. *Ibid.*

§ 224. The true test of whether there is an infringement of a copyrighted work is to ascertain whether there is a servile or evasive imitation of the former author's work, or whether there is a *bona fide* original compilation made up from common sources or common materials, with resemblances which are purely accidental, or result from the nature of the subject. *Daly v. Palmer*, §§ 298-302.

§ 225. It is not necessary, in order to constitute an invasion of a copyright, that the whole of the work should be copied, or even a large portion thereof, in form and substance. If so much is taken that the value of the original is sensibly diminished, or the labors of the original author are substantially, to an injurious extent, appropriated by another, that is sufficient in point of law to constitute an infringement *pro tanto*. *Folsom v. Marsh*, §§ 249-256.

§ 226. Copying is essential to constitute an infringement of a copyright, but identity of contents, arrangement and combination is strong evidence that the second book was borrowed from the first. Copying is not confined to literal repetition, but includes also the various modes in which the matter of any publication may be adopted, imitated or transferred, with more or less colorable alterations to disguise the source from which the material was derived. Nor is it necessary that the whole or even a larger part of a work should be taken to constitute an infringement. *Lawrence v. Dana*, §§ 257-269.

§ 227. To constitute a violation of a copyright, the copyrighted work must be copied or the differences between it and the infringing work be merely colorable; and where the differences are not apparent on inspection, extraneous testimony is admissible. *Emerson v. Davies*, §§ 270-279.

§ 228. A person will be enjoined from using an important and valuable part of a copyrighted book, though the whole is not copied, if such copying is to the injury of the owner of the copyright. *Ibid.*

§ 229. In cases of an alleged infringement of a copyright, the fact that the respondent's book contains the same errors and peculiarities as the complainant's, in corresponding similar portions, is strong proof of copying. *Lawrence v. Dana*, §§ 257-269.

§ 230. Evidence of innocent intention is immaterial when it appears that there has been an infringement of a copyright. *Ibid.*

§ 231. The privilege of a copyrighted work accorded by law to a subsequent writer is such, and such only, as will not cause substantial injury to the proprietor of the original work. *Ibid.*

§ 232. The burden of proving an infringement of a copyright is upon the party making the charge. *Ibid.*

§ 233. A *bona fide* abridgment or digest of a published literary work is no infringement of the original; but a mere selection or different arrangement of parts of the original work in a smaller compass is not such an abridgment. *Ibid.*

§ 234. An abridgment is not an infringement of the copyright of the larger work if the true design is to abridge and cheapen the price, and that is done by mental labor faithfully performed, though it is otherwise if the abridgment is colorable merely. *Webb v. Powers*, §§ 280-287.

§ 235. In determining the question of infringement of copyright in the case of dictionaries and similar works, some similarities and some use of prior works, even to the copying of small parts, are tolerated, if the main design and execution are in reality novel, and not a mere cover for important piracies from others. *Ibid.*

§ 236. While, in the cases of compilations, a prior compiler is not permitted to monopolize what was not original in himself, and what must be nearly identical in all such works on a like subject, yet he who uses it subsequently to another must not employ so much of the prior arrangement and materials as to show that the last work is a substantial invasion of the other, and is not characterized by enough new matter to indicate new toil and talent. *Ibid.*

§ 237. In cases of an alleged violation of a compiled work of a lexicographical character, the material inquiry is, whether the book of the defendants, taken as a whole, is substantially a copy of the plaintiff's; whether it has virtually the same plan and character throughout, and is intended to supersede the other in the market with the same class of readers and purchasers, by introducing no considerable new matter, or little or nothing new, except colorable deviations. *Ibid.*

§ 238. The compiler of a map is entitled, without exposing himself to a charge of piracy, to make use of preceding maps, where he bestows such mental labor upon what he has taken, and subjects it to such revision and correction as to produce an original result, provided that he does not deny the use made of such preceding works, and the alterations are not merely colorable. So the copying to any considerable extent of the boundaries of a series of towns, without change except as to scale, is an invasion of the copyright of the map copied. *Farmer v. Calvert Lithographing, etc., Co.*, §§ 288-297.

§ 239. A dramatic composition is a written or literary work in which the narrative is not related, but is represented by dialogue and action by persons who represent it as real by countenance, voice or gesture. A written work consisting wholly of directions set in order for conveying the ideas of the author on a stage or public place by means of characters who represent the narrative wholly by action, is as much a dramatic composition as if dialogue was used to convey the same ideas. *Daly v. Palmer*, §§ 298-302.

§ 240. A dramatic author whose composition is copyrighted is protected against the infringement of a single scene in his composition. *Ibid.*

§ 241. The sale of an infringing dramatic composition renders the seller liable for a representation thereof by the vendee, and such sale will be enjoined. *Ibid.*

[NOTES.—See §§ 303-332.]

GREENE v. BISHOP.

(Circuit Court for Massachusetts: 1 Clifford, 186-203. 1858.)

STATEMENT OF FACTS.—This bill was filed to enjoin the sale of a book entitled "Covell's Digest of English Grammar," on the ground that it infringed the copyrights of plaintiff's books, entitled "Greene's Analysis," and "Greene's First Lessons in Grammar." The matter was referred to a master, the material part of whose finding, for an understanding of the points decided, was as follows:

"2d. That the plan of the defendant's book, taken as a whole, is not similar to the plan of either of the plaintiff's books, but that, in that part of the defendant's book which treats of analysis, and which is contained between sections 138 and 181 inclusive, the system on which the materials are arranged,

the logical order in which the subject is displayed, and the mode by which it is set forth, and illustrated by copious models and examples, are similar to those of the plaintiff's entire book entitled 'Greene's Analysis.'"

Opinion by CLIFFORD, J.

[After considering and overruling certain exceptions to the master's report, the court proceeded with the merits as follows:]

At this stage of the case the complainant moves for an injunction, and that the respondent may be ordered to render an account in pursuance of the prayer in the bill of complaint. That motion must be considered and determined on the basis that the report of the master is correct, and wholly irrespective of any matters alleged in the exceptions. Any argument founded upon such matters cannot now avail, as the exceptions have been overruled, and the report of the master confirmed. For the purposes of any further examination of the case, and especially in determining the question under consideration, it must be assumed that the facts are as they have been found to be in the report of the master. Matters not included in the findings, and not embraced in the order of reference, if any, will depend upon the evidence, and must be heard and determined by the court, as in other cases, upon final hearing. All the matters found by the master, and embraced in the order of reference, must now be taken to be true. These findings show in effect that the system on which the materials are arranged in that part of the respondent's book which treats of analysis, as well as in the logical order in which the subject is displayed, and the mode by which it is set forth and illustrated, are similar to those of the entire book of the complainant, entitled "Greene's Analysis;" that the parts and matters of the respondent's book specified in the schedule are similar to the parts and matters in the complainant's book, which are also specified in the opposite schedule; and that the parts and matters thus specified in the logical connection in which they stand, and in which they are used by the respondent, form an original part of an original system of grammar set forth in the complainant's book; and they also show that the use of those parts and matters by the defendant tends to prejudice the sale of so many copies of the same as there are sold copies of the respondent's book. On that state of the case the counsel for the respondent contend:

1. That the system of analysis and classification of sentences set forth in the complainant's book is not original with the complainant.

2. That the respondent, or those he represents, did not copy from the complainant's book what in judgment of law was exclusively secured to the complainant.

3. That the use made by Covell of the analysis of the complainant, if any, was in the fair exercise of his powers as an author engaged in good faith in composing an original work, and fairly availing himself of ideas and terms found in other scientific treatises upon the same subject; and that he did not servilely copy from the complainant's work so much thereof in quantity and value as amounts to an infringement of his copyright.

4. That the complainant is not entitled to an injunction or to an account, under the circumstances of this case.

§ 242. *One claiming protection of the copyright law must show that he is the author of the work, or that he derives title from the author.*

Some additional observations upon the objection embraced in the first proposition may be useful and necessary, notwithstanding it is identical in principle with the third exception, which has already been considered and overruled.

By the first section of the act of the 3d of February, 1831, it is provided that the author of any book "shall have the sole right and liberty of printing, reprinting, publishing and vending such book;" but it is undoubtedly true, as contended by the counsel for the respondent, that when a party comes into a court of law or equity, seeking protection to a copyright, he must show that he is the author of the work, or that his title is derived from one sustaining that relation to the publication. Curtis on C., ch. 5, p. 169. An author, as was remarked by Grier, J., in *Stowe v. Thomas*, 2 Wall. Jr., 564, may be said to be the inventor or creator of the ideas contained in his book, and the combination of words to express them. But when he has published his book, and given his thoughts to the world, he can no longer have their exclusive possession, for the reason that such an appropriation then becomes impossible, and inconsistent with the object of the publication; and he accordingly held to the effect that, when an author has published and sold his book, he ceases to have any exclusive claim to the ideas, sentiments or thoughts therein expressed, considered merely as abstractions, and dissevered from the language, idiom, style or the outward semblance or exhibition of them to the eyes of another; and that the only property which he reserves to himself, and which the law gives him under such circumstances, is the exclusive right to multiply the copies of that particular combination of characters which exhibits to others the ideas intended to be conveyed.

§ 243. *The author of a compilation of old materials is entitled to a copyright.*

Assuming the doctrine there laid down to be correct, of which, as a general proposition, or as one applicable to that case, there can be no doubt, it by no means follows, as seems to be supposed, that an author who has compiled and written a new work upon a new and original plan, arrangement and combination of materials, not servilely copied or evasively imitated from another, is not entitled to a copyright for the work, even though all the materials employed by him were old. Elementary writers and jurists concur that the law does not require that the subject of a book should be new, or the materials original, in order to entitle the author to a copyright; and all appear to admit that there may be a valid copyright in the plan of a book, as connected with the arrangement and combination of the materials, and the mode of displaying and illustrating the subject, although all the materials employed and the subject of the work may be common to all other writers. Reference to two or three decided cases upon the point will be sufficient at the present time, although there are several others which assert the same doctrine; and it will be observed that one of the examples put by Mr. Curtis, in his valuable work on copyright, to illustrate the doctrine, is that of a scientific treatise written and published for the purposes of instruction. Speaking of the question under consideration, he says, in effect, that the author of a book who takes existing materials from sources common to all writers, and arranges and combines them in a new form, and gives them an application unknown before, is protected in the exclusive enjoyment of what he has thus collected and produced, for the reason that he has exercised selection, arrangement and combination, and thereby has produced something that is new and valuable. Curtis on C., pp. 179, 180; *Gray v. Russell*, 1 Story, 17 (§§ 129-33, *supra*); *Emerson v. Davies*, 3 Story, 768 (§§ 270-79, *infra*); *Lewis v. Fullerton*, 2 Beav., 6; *Story v. Holcombe*, 4 McL., 309. Judge Story held, in *Emerson v. Davies*, that every author of a book has a copyright in the plan, arrangement and combination

of his materials, and in his mode of illustrating his subject, if it be new and original in its substance; and remarked that if no book could be the subject of copyright which was not new and original in the elements of which it is composed, then there could be no ground for any copyright in modern times. All the well considered cases upon the subject show that the state of facts found by the master is sufficient to entitle the books of the complainant to protection under his respective copyrights; and, as before remarked, the evidence in the case fully warrants the findings of the master.

§ 244. *Copying, what constitutes.*

Little more need be remarked respecting the second proposition than to refer to the findings of the master, and what has already been said in determining the one which precedes it, and which involves the same general considerations. Copying is not confined to literal repetition, but includes also the various modes in which the matter of any publication may be adopted, imitated or transferred, with more or less colorable alterations to disguise the piracy. In all such cases, says Mr. Curtis (Curtis on C., 253), the main question is whether the author of the work alleged to be a piracy has resorted to the original sources alike open to him and to all writers, or whether he has adopted and used the plan of the work which it is alleged he has infringed, without resorting to the other sources from which he had a right to borrow. Within these principles both the report of the master and the evidence on which it is founded show that the respondent has copied what, in judgment of law, was exclusively secured to the complainant, under and by virtue of his respective copyrights.

§ 245. *To what extent one author may copy from another. Right of quotation. Abridgment.*

Great difficulties oftentimes surround the inquiry whether an alleged act of copying from an original author amounts to piracy, or whether it may or may not be justified on the ground of fair quotation, or that the use made of the book or its contents does not exceed what the law permits to another engaged in composing a new work upon the same subject. None of those difficulties, however, arise in the present case, as all the authorities agree that it is not necessary that the whole, or even the larger portion, of a work should be taken in order to constitute an invasion of a copyright; and they affirm the doctrine that if so much is taken that the value of the original is sensibly and materially diminished, or the labors of the original author are substantially, to an injurious extent, appropriated by another, that such taking or appropriation is sufficient in point of law to maintain the suit. *Folsom v. Marsh*, 2 Story, 100 (§§ 249-56, *infra*); *Wilkins v. Aiken*, 17 Ves., 424; *Mawman v. Tegg*, 2 Russ., 385; *Roworth v. Wilkes*, 1 Camp., 94; *Saunders v. Smith*, 3 My. & Cr., 711; *Lewis v. Chapman*, 13 Beav., 8; *Webb v. Powers*, 2 Wood. & M., 514 (§§ 280-87, *infra*).

Whatever doubts may have been formerly entertained, says McLean, J., in *Story v. Holcombe*, 4 McL., 315, it is now clear that a book may in one part of it infringe the copyright of another book, and in other parts be no infringement; and, in such a case, the remedy will not be extended beyond the injury; and the same learned judge held that extracts made for the purpose of a review, or for a compilation, are governed by the same rule; but that they cannot be so extended in either case as to convey the same knowledge as the original work, nor can the privilege be so exercised as to supersede the original book. *Bramwell v. Halcomb*, 3 My. & Cr., 738. Apply these principles

to the facts stated in the last finding of the master, and it is clear that this proposition cannot be sustained. Whether a fair and *bona fide* abridgment of an original work is, or is not, an invasion of the copyright of the original author, is not a question at the present time, nor is it necessary on the facts of this case to determine, or even consider, what constitutes such an abridgment in the sense of the law. It is clear that the mere copying a portion of the materials, without any essential condensation of the same, cannot be held to bring the work within the legal description of such a publication; and it will not change the rule of law if the new publication also contains the system on which the materials are arranged, the logical order in which the subject is displayed, and the mode by which it is set forth and illustrated in the prior work. One other suggestion of the counsel for the respondent deserves to be considered before leaving this branch of the case. They also contend, in effect, that the respondent is an original author, without having copied or had access to the complainant's books. On this point it will be sufficient to remark, that the weight of the evidence is greatly otherwise, as appears from the testimony of the witnesses, as well as from the inspection of the book and the colorable alterations made in the second edition.

§ 246. *Delay in prosecuting for infringement of copyright.*

Two grounds are assumed in support of the fourth proposition, which will now be briefly considered. First, that the complainant is not entitled to relief on account of the delay in instituting the suit, and because it is prosecuted against the vendor of the book, and not against the author or publishers. Second, because it is brought merely for a technical violation of the legal right, and because the facts show that the complainant has suffered injury only to a nominal amount. A few remarks respecting each of these suggestions will be sufficient at the present time. Both the bill and the answer disclose the fact that the first edition of the respondent's book was published in 1852, in another state; and the second, in 1853, by the same publishers, while the complainant was residing in this district, and this bill was filed during the following year. At what time the complainant became possessed of the knowledge of these publications does not appear; and there is no evidence tending to show that he ever in any manner acquiesced in the claim of the respondent, or recognized the validity of his acts, except what may be inferred from the omission to prosecute. No other laches appears on the face of the bill, and no such defense is set up in the answer. Attention is drawn to two cases, decided in this court, to show that it is incumbent upon the complainant to set forth in the bill the circumstances, if any, which explain the delay to institute the suit. One is the case of *Stearns v. Page*, 1 Story, 204, in which the bill prayed for an account of an intestate's estate after a lapse of more than twenty years; and the other is the case of *Fisher v. Boody*, 1 Curt., 218 (EQUITY, §§ 765-71), which prayed to set aside a conveyance of land, after an acquiescence in the validity of the sale for a period of nine years. Without entering into any further examination of the numerous authorities bearing upon the question, or attempting at this time to lay down any general rule upon the subject, it will be sufficient to say that the cases cited are not applicable to the facts of this case, and that the point cannot avail the respondent as a defense to this suit. *Wagner v. Baird*, 7 How., 234; *De Lane v. Moore*, 14 How., 268 (DOM. REL., §§ 352-55).

§ 247. *Vendor of infringing book liable.*

Vendors are liable for the sale of a book which invades the copyright of

another, on the same principle, and for the same reasons, that the vendor of a machine or other mechanical structure, in the case of patent-rights, is held liable for selling the manufactured article without the license or consent of the patentee; and no reason is perceived for withholding from the complainant the common remedies for the injuries he has suffered by the acts of the respondent, merely because he has elected to seek redress in this district instead of going into another circuit to pursue it against the publishers.

§ 248. *Relief in equity refused where injury is slight.*

Decided cases have been cited by the counsel for the respondent, which show that, when the invasion of a copyright is slight, and the copying consists of indefinite or small parts, so scattered through the work that it is difficult or nearly impossible to estimate either the amount of the injury to the complainant or the profit to the respondent, relief in equity has sometimes been refused, and the party turned over to his remedy at law. Those decisions were doubtless correct as applied to the facts and circumstances under which they were made; but it is clear, both from the finding of the master and all the evidence on which it is based, that no such difficulty can arise in this case; and consequently I hold that the complainant is entitled to an injunction, to be limited according to the second finding of the master, and also to an account.

FOLSOM v. MARSH.

(Circuit Court for Massachusetts: 2 Story, 100-119. 1841.)

§ 249. *Infringement of copyright. Copying. Privileges of a reviewer. Abridgments.*

Opinion by STORY, J.

This is one of those intricate and embarrassing questions arising in the administration of civil justice in which it is not, from the peculiar nature and character of the controversy, easy to arrive at any satisfactory conclusion, or to lay down any general principles applicable to all cases. Patents and copyrights approach nearer than any other class of cases, belonging to forensic discussions, to what may be called the metaphysics of the law, where the distinctions are, or at least may be, very subtle and refined, and sometimes almost evanescent. In many cases, indeed, what constitutes an infringement of a patented invention is sufficiently clear and obvious, and stands upon broad and general agreements and differences; but, in other cases, the lines approach very near to each other, and sometimes become almost evanescent, or melt into each other. So, in cases of copyright, it is often exceedingly obvious that the whole substance of one work has been copied from another, with slight omissions and formal differences only, which can be treated in no other way than as studied evasions; whereas, in other cases, the identity of the two works in substance, and the question of piracy, often depend upon a nice balance of the comparative use made in one of the materials of the other; the nature, extent and value of the materials thus used; the objects of each work; and the degree to which each writer may be fairly presumed to have resorted to the same common sources of information, or to have exercised the same common diligence in the selection and arrangement of the materials. Thus, for example, no one can doubt that a reviewer may fairly cite largely from the original work, if his design be really and truly to use the passages for the purposes of fair and reasonable criticism. On the other hand, it is as clear that, if he thus cites the most important parts of the work with a view not to criticise, but to supersede the use

of the original work and substitute the review for it, such a use will be deemed in law a piracy. A wide interval might, of course, exist between these two extremes, calling for great caution and involving great difficulty, where the court is approaching the dividing middle line which separates the one from the other. So, it has been decided that a fair and *bona fide* abridgment of an original work is not a piracy of the copyright of the author. See *Dodsley v. Kinnersley*, Ambler, 403; *Whittingham v. Wooler*, 2 Swanst., 428, 430, 431, note; *Tonson v. Walker*, 3 Swanst., 672 to 679; *id.*, 681. But, then, what constitutes a fair and *bona fide* abridgment, in the sense of the law, is one of the most difficult points, under particular circumstances, which can well arise for judicial discussion. It is clear that a mere selection, or different arrangement of parts of the original work, so as to bring the work into a smaller compass, will not be held to be such an abridgment. There must be real, substantial condensation of the materials, and intellectual labor and judgment bestowed thereon; and not merely the facile use of the scissors; or extracts of the essential parts, constituting the chief value of the original work. See *Tyler v. Wilcox*, 2 Atk., 141.

STATEMENT OF FACTS.—In the present case, the work alleged to be pirated is the Writings of President Washington, in twelve volumes, royal octavo, containing nearly seven thousand pages, of which the first volume contains a Life of Washington, by the learned editor, Mr. Sparks, in respect to which no piracy is asserted or proved. The other eleven volumes consist of the Letters of Washington, private and official, and his messages and other public acts, with explanatory notes and occasional illustrations by the editor. That the original work is of very great, and, I may almost say, of inestimable value, as the repository of the thoughts and opinions of that great man, no one pretends to doubt. The work of the defendants is in two volumes, duodecimo, containing eight hundred and sixty-six pages. It consists of a Life of Washington, written by the learned defendant (the Rev. Charles W. Upham), which is formed upon a plan different from that of Mr. Sparks, and in which Washington is made mainly to tell the story of his own life, by inserting therein his letters and his messages, and other written documents, with such connecting lines in the narrative as may illustrate and explain the times and circumstances, and occasions of writing them. Now, as I have already said, there is no complaint that Mr. Upham has taken his narrative part, substantially, from the Life by Mr. Sparks. The *gravamen* is, that he has used the Letters of Washington, and inserted, *verbatim*, copies thereof from the collection of Mr. Sparks. The master finds, by his report, that the whole number of pages in Mr. Upham's work, corresponding and identical with the passages in Mr. Sparks' work, are three hundred and fifty-three pages out of eight hundred and sixty-six, a fraction more than one-third of the two volumes of the defendants. Of these three hundred and fifty-three pages, the report finds that three hundred and nineteen pages consist of Letters of Washington, which have been taken from Mr. Sparks' work, and have never been published before; namely, sixty-four pages are official letters and documents, and two hundred and fifty-five pages are private letters of Washington. The question, therefore, upon this admitted state of the facts, resolves itself into the point whether such a use, in the defendants' work, of the letters of Washington, constitutes a piracy of the work of Mr. Sparks.

It is objected, in the first place, on behalf of the defendants, that the letters of Washington are not, in the sense of the law, proper subjects of copyright,

for several reasons; (1) because they are the manuscripts of a deceased person, not injured by the publication thereof; (2) because they are not literary compositions, and, therefore, not susceptible of being literary property, nor esteemed of value by the author; (3) because they are, in their nature and character, either public or official letters, or private letters of business; and (4) because they were designed by the author for public use, and not for copyright or private property.

§ 250. *The writer of private letters has a property therein, and the copyright belongs to him.*

Now, in relation to the last objection, it is most manifest that President Washington deemed them his own private property, and bequeathed them to his nephew, the late Mr. Justice Washington, through whom the late Mr. Chief Justice Marshall and Mr. Sparks acquired an interest therein; and, as appears from the contract between these gentlemen, annexed to the report, the publication of these writings was undertaken by Mr. Sparks, as editor, for their joint benefit; and the work itself has been accomplished at great expense and labor, and after great intellectual efforts, and very patient and comprehensive researches, both at home and abroad. The publication of the defendants, therefore, to some extent must be injurious to the rights of property of the representatives and assignees of President Washington. Indeed, as we shall presently see, congress have actually purchased these very letters and manuscripts, at a great price, for the benefit of the nation, from their owner and possessor under the will of Mr. Justice Washington, as private and most valuable property. That President Washington, therefore, intended them exclusively for public use, as a donation to the public, or did not esteem them of value as his own private property, appears to me to be a proposition completely disproved by the evidence. Unless, indeed, there be a most unequivocal dedication of private letters and papers by the author, either to the public or to some private person, I hold that the author has a property therein and that the copyright thereof exclusively belongs to him.

§ 251. — *as to the distinction between private or business letters, and those which may be treated as literary compositions.*

Then as to the supposed distinction between letters of business, or of a mere private or domestic character, and letters which, from their character and contents, are to be treated as literary compositions, I am not prepared to admit its soundness or propriety. It is extremely difficult to say what letters are or are not literary compositions. In one sense all letters are literary, for they consist of the thoughts and language of the writer reduced to written characters, and show his style and his mode of constructing sentences and his habits of composition. Many letters of business also embrace critical remarks and expressions of opinion on various subjects, moral, religious, political and literary. What is to be done in such cases? Even in compositions confessedly literary the author may not intend, nay, often does not intend them for publication; and yet no one on that account doubts his right of property therein, as a subject of value to himself and to his posterity. If subsequently published by his representatives, would they not have a copyright therein? It is highly probable that neither Lord Chesterfield, nor Lord Orford, nor the poet Gray, nor Cowper, nor Lady Russell, nor Lady Montague ever intended their letters for publication as literary compositions, although they abound with striking remarks and elegant sketches, and sometimes with the most profound as well as affecting exhibitions of close reflection, and various knowl-

edge and experience, mixed up with matters of business, personal anecdote, and family gossip.

§ 252. *The author of letters of every description has the sole copyright therein.*

There is no small confusion in the books, in reference to the question of copyright in letters. Some of the *dicta* seem to suppose that no copyright can exist except in letters which are professedly literary; while others again recognize a much more enlarged and liberal doctrine. See Godson on Patents and Copyright, p. 327 to 332 (ed. 1840, London); *Gee v. Pritchard*, 2 Swanst., 403, 405, 426, 427; *Perceval v. Phipps*, 2 Ves. & Beam., 19, 24, 25, 28. Without attempting to reconcile or even to comment upon the language of the authorities on this head, I wish to state what I conceive to be the true doctrine upon the whole subject. In the first place, I hold that the author of any letter or letters (and his representatives), whether they are literary compositions or familiar letters or letters of business, possess the sole and exclusive copyright therein; and that no persons, neither those to whom they are addressed nor other persons, have any right or authority to publish the same upon their own account or for their own benefit.

§ 253. — *rights of persons to whom letters are addressed.*

But, consistently with this right, the persons to whom they are addressed, may have, nay, must, by implication, possess the right to publish any letter or letters addressed to them upon such occasions, as require or justify the publication or public use of them; but this right is strictly limited to such occasions. *Gee v. Pritchard*, 2 Swanst., 415, 419. Thus, a person may justifiably use and publish, in a suit at law or in equity, such letter or letters as are necessary and proper to establish his right to maintain the suit or defend the same. So, if he be aspersed or misrepresented by the writer, or accused of improper conduct in a public manner, he may publish such parts of such letter or letters, but no more, as may be necessary to vindicate his character and reputation, or free him from unjust obloquy and reproach. If he attempt to publish such letter or letters on other occasions not justifiable, a court of equity will prevent the publication by an injunction, as a breach of private confidence or contract, or of the rights of the author; and *a fortiori*, if he attempt to publish them for profit; for then it is not a mere breach of confidence or contract, but it is a violation of the exclusive copyright of the writer. In short, the person to whom letters are addressed has but a limited right or special property (if I may so call it) in such letters as a trustee or bailee, for particular purposes, either of information or of protection, or of support of his own rights and character. The general property, and the general rights incident to property, belong to the writer, whether the letters are literary compositions or familiar letters, or details of facts, or letters of business. The general property in the manuscripts remains in the writer and his representatives, as well as the general copyright. *A fortiori*, third persons standing in no privity with either party are not entitled to publish them to subserve their own private purposes of interest, or curiosity or passion. If the case of *Perceval v. Phipps*, 2 Ves. & Beam., 21, 28, before the then vice-chancellor (Sir Thomas Plumer), contains a different doctrine, all I can say is, that I do not accede to its authority; and I fall back upon the more intelligible and reasonable doctrine of Lord Hardwicke in *Pope v. Curl*, 2 Atk., 342, and Lord Apsley in the case of *Thompson v. Stanhope*, Amb., 737, and of Lord Keeper Henley in the case of *The Duke of Queensbury v. Shelburn*, 2 Eden, 329; 4 Burr., 2330, which Lord Eldon has not scrupled to hold to be binding authorities upon

the point in *Gee v. Pritchard*, 2 Swanst., 403, 414, 415, 419, 426, 427. But I do not understand that Sir Thomas Plumer did, in *Perceval v. Phipps*, deny the right of property of the writer in his own letters; and so he was understood by Lord Eldon in *Gee v. Pritchard*; who, however, said that that case admitted of much remark.

Indeed, if the doctrine were otherwise, that no person or his representatives could have a copyright in his own private or familiar letters, written to friends upon interesting political and other occasions, or containing details of facts and occurrences passing before the writer, it would operate as a great discouragement upon the collection and preservation thereof; and the materials of history would become far more scanty than they otherwise would be. What descendant or representative of the deceased author would undertake to publish, at his own risk and expense, any such papers; and what editor would be willing to employ his own learning and judgment, and researches, in illustrating such works, if, the moment they were successful, and possessed the substantial patronage of the public, a rival book-seller might republish them, either in the same or in a cheaper form, and thus either share with him or take from him the whole profits? It is the supposed exclusive copyright in such writings which now encourages their publication thereof from time to time, after the author has passed to the grave. To this we owe, not merely the publication of the writings of Washington, but of Franklin and Jay, and Jefferson and Madison, and other distinguished statesmen of our own country. It appears to me that the copyright act of 1831 (ch. 16, § 9) fully recognizes the doctrine for which I contend. It gives, by implication, to the author or legal proprietor of any manuscript whatever, the sole right to print and publish the same, and expressly authorizes the courts of equity of the United States to grant injunctions to restrain the publication thereof by any person or persons without his consent.

§ 254. — *as to official letters addressed to the government.*

In respect to official letters addressed to the government, or any of its departments, by public officers, so far as the right of the government extends, from principles of public policy, to withhold them from publication or to give them publicity, there may be a just ground of distinction. It may be doubtful whether any public officer is at liberty to publish them, at least in the same age, when secrecy may be required by the public exigencies, without the sanction of the government. On the other hand, from the nature of the public service or the character of the documents, embracing historical, military or diplomatic information, it may be the right and even the duty of the government to give them publicity, even against the will of the writers. But this is an exception in favor of the government, and stands upon principles allied to or nearly similar to the rights of private individuals to whom letters are addressed by their agents, to use them and publish them upon fit and justifiable occasions. But assuming the right of the government to publish such official letters and papers under its own sanction, and for public purposes, I am not prepared to admit that any private persons have a right to publish the same letters and papers without the sanction of the government, for their own private profit and advantage. Recently the Duke of Wellington's dispatches have (I believe) been published by an able editor, with the consent of the noble duke and under the sanction of the government. It would be a strange thing to say that a compilation involving so much expense and so much labor to the editor, in collecting and arranging the materials, might be pirated and repub-

lished by another book-seller, perhaps to the ruin of the original publisher and editor. Before my mind arrives at such a conclusion, I must have clear and positive lights to guide my judgment or to bind me in point of authority. However, it is not necessary in this case to dispose of this point, because, of the letters and documents published by the defendants, not more than one-fifth part are of an official character.

§ 255. *The letters of Washington were sold to the government subject to the existing copyright.*

Another and distinct objection urged on behalf of the defendants is that congress have purchased the manuscripts of these letters and documents and they have become public property, and may be published by any one. An answer, in part, has been already given to this objection. Congress have, indeed, authorized the purchase of these manuscripts from the owner and possessor thereof, and paid the liberal price of \$25,000 therefor; and they have thus become national property. But it is an entirely inadmissible conclusion that, therefore, every private person has a right to use them and publish them. It might be contended with as much force and correctness that every private person had an equal right to use any other national property at his pleasure, such as the arms, the ammunition, the ships, or the custom-houses belonging to the government. But a reason which is entirely conclusive upon this point is that the government purchased the manuscripts subject to the copyright already acquired by the plaintiffs in the publication thereof. The vendor took them subject to that copyright, and could convey no title which he did not himself possess, or beyond what he possessed. Nor is there any pretense to say that he either did convey or intended to convey to the government the property in these manuscripts, except subject to the copyright already acquired.

§ 256. *The copying of a part of a work may constitute an infringement.*

The next and leading objection is, that the defendants had a right to abridge and select and use the materials which they have taken for their work, which, though it embraces the number of letters above stated, is an original and new work, and that it constitutes, in no just sense, a piracy of the work of the plaintiffs. This, in truth, is the real hinge of the whole controversy, and involves the entire merits of the suit. It is certainly true that the defendants' work cannot properly be treated as an abridgment of that of the plaintiffs; neither is it strictly and wholly a mere compilation from the latter. So far as the narrative goes, it is either original, or derived (at least as far as the matter has been brought before the court) from common sources of information, open to all authors. It is not even of the nature of a collection of beauties of an author; for it does not profess to give fugitive extracts, or brilliant passages from particular letters. It is a selection of the entire contents of particular letters, from the whole collection or mass of letters of the work of the plaintiffs. From the known taste and ability of Mr. Upham, it cannot be doubted that these letters are the most instructive, useful and interesting to be found in that large collection.

The question then is, whether this is a justifiable use of the original materials, such as the law recognizes as no infringement of the copyright of the plaintiffs. It is said that the defendant has selected only such materials as suited his own limited purpose as a biographer. That is doubtless true; and he has produced an exceedingly valuable book. But that is no answer to the difficulty. It is certainly not necessary, to constitute an invasion of copy-

right, that the whole of a work should be copied, or even a large portion of it, in form or in substance. If so much is taken that the value of the original is sensibly diminished, or the labors of the original author are substantially, to an injurious extent, appropriated by another, that is sufficient, in point of law, to constitute a piracy *pro tanto*. The entirety of the copyright is the property of the author; and it is no defense that another person has appropriated a part, and not the whole, of any property. Neither does it necessarily depend upon the quantity taken, whether it is an infringement of the copyright or not. It is often affected by other considerations, the value of the materials taken, and the importance of it to the sale of the original work. Lord Cottenham, in the recent cases of *Bromhall v. Halcombe*, 3 Mylne & C., 737, 738, and *Saunders v. Smith*, 3 Mylne & C., 711, 736, 737, adverting to this point, said: "When it comes to a question of quantity, it must be very vague. One writer might take all the vital part of another's book, though it might be but a small proportion of the book in quantity. It is not only quantity, but value, that is always looked to. It is useless to refer to any particular cases as to quantity." In short, we must often, in deciding questions of this sort, look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects of the original work. Many mixed ingredients enter into the discussion of such questions. In some cases, a considerable portion of the materials of the original work may be fused, if I may use such an expression, into another work, so as to be undistinguishable in the mass of the latter, which has other professed and obvious objects, and cannot fairly be treated as a piracy; or they may be inserted as a sort of distinct and mosaic work, into the general texture of the second work, and constitute the peculiar excellence thereof, and then it may be a clear piracy. If a person should, under color of publishing "Elegant Extracts" of poetry, include all the best pieces at large of a favorite poet, whose volume was secured by a copyright, it would be difficult to say why it was not an invasion of that right, since it might constitute the entire value of the volume. The case of *Mawman v. Tegg*, 2 Russ., 383, is to this purpose. There was no pretense in that case that all the articles of the encyclopædia of the plaintiffs had been copied into that of the defendants; but large portions of the materials of the plaintiffs' work had been copied. Lord Eldon, upon that occasion, held that there might be a piracy of part of a work, which would entitle the plaintiffs to a full remedy and relief in equity. In prior cases he had affirmed the like doctrine. In *Wilkins v. Aikin*, 17 Ves., 422, 424, he said: "There is no doubt that a man cannot, under the pretense of quotation, publish either the whole or a part of another's book, though he may use, what in all cases it is difficult to define, fair quotation." In *Roworth v. Wilkes*, 1 Camp., 94, Lord Ellenborough said: "A review will not, in general, serve as a substitute for the book reviewed; and even there, if so much is extracted that it communicates the same knowledge with the original work, it is an actionable violation of literary property. The intention to pirate is not necessary in an action of this sort; it is enough that the publication complained of is, in substance, a copy whereby a work vested in another is prejudiced. A compilation of this kind (an encyclopædia) may differ from a treatise published by itself; but there must be certain limits fixed to its transcripts; it must not be allowed to sweep up all modern works, or an encyclopædia would be a recipe for completely breaking down literary property." The vice-chancellor (Sir L. Shadwell), in *Sweet v. Shaw* (The

Jurist [London], vol. I, p. 212), referring to the remarks of Lord Ellenborough, cited by counsel, said: "That does not mean a substitute for the whole work. From what you state, suppose a book to contain one hundred articles, and ninety-nine were taken, still it would not be a substitute." And in this very case he granted an injunction, being of opinion that there was *prima facie*, at law, an invasion of the plaintiffs' right; not only an injury, but also a damage to the plaintiffs in copying from several volumes of reports published by the plaintiffs, although eleven only had been copied *verbatim*, but a considerable number of what were called abridged cases were, in truth, copies of the plaintiffs' volumes, with little, or trifling, alterations. It is manifest, also, from what fell from Lord Chancellor Cottenham, in *Saunders v. Smith*, 3 Mylne & Cr., 711, that he entertained no doubt (although he did not decide the point) that there might be a violation of the copyright of volumes of reports by copying *verbatim* a part only of the cases reported. Much must, in such cases, depend upon the nature of the new work, the value and extent of the copies, and the degree in which the original authors may be injured thereby. In *Lewis v. Fullarton* (The Jurist [English], vol. II, p. 127; S. C., 2 Beav., 6), Lord Langdale, in the case of a topographical dictionary, held that largely copying from the work in another book having a similar object was a violation of that copyright, although the same information might have been (but, in fact, was not) obtained from common sources, open to all persons. On that occasion he said: "None are entitled to save themselves trouble and expense by availing themselves, for their own profit, of other men's works, still entitled to the protection of copyright;" and, accordingly, in that case, he granted an injunction as to the parts pirated, although it was admitted, on all hands, that there was much which was original in the new work.

In the present case I have no doubt whatever that there is an invasion of the plaintiffs' copyright; I do not say designedly, or from bad intentions; on the contrary, I entertain no doubt that it was deemed a perfectly lawful and justifiable use of the plaintiffs' work. But if the defendants may take three hundred and nineteen letters, included in the plaintiffs' copyright, and exclusively belonging to them, there is no reason why another bookseller may not take other five hundred letters, and a third, one thousand letters, and so on, and thereby the plaintiffs' copyright be totally destroyed. Besides, every one must see that the work of the defendants is mainly founded upon these letters, constituting more than one-third of their work, and imparting to it its greatest, nay, its essential value. Without those letters in its present form the work must fall to the ground. It is not a case where abbreviated or selected passages are taken from particular letters; but the entire letters are taken, and those of most interest and value to the public, as illustrating the life, the acts and the character of Washington. It seems to me, therefore, that it is a clear invasion of the right of property of the plaintiffs, if the copying of parts of a work, not constituting a major part, can ever be a violation thereof; as upon principle and authority I have no doubt it may be. If it had been the case of a fair and *bona fide* abridgment of the work of the plaintiffs, it might have admitted of a very different consideration.

I have come to this conclusion, not without some regret, that it may interfere, in some measure, with the very meritorious labors of the defendants in their great undertaking of a series of works adapted to school libraries. But a judge is entitled in this case, as in others, only to know and to act upon his

duty. I hope, however, that some means may be found to produce an amicable settlement of this unhappy controversy.

The report of the master must stand confirmed, and a perpetual injunction be awarded, restraining the defendants, their agents, servants and salesmen, from further printing, publishing, selling or disposing of any copy or copies of the work complained of, the "Life of Washington," by the Rev. Charles W. Upham, containing any of the three hundred and nineteen letters of Washington, stated in the report of the master, and never before published; and that it be referred to a master to take an account of the profits made by the defendants in the premises, with leave for either party to apply to the court for further directions.

LAWRENCE *v.* DANA.

(Circuit Court for Massachusetts: 4 Clifford, 1-88. 1869.)

STATEMENT OF FACTS.—The complainant in this case alleged that in 1853, under an arrangement with Catharine Wheaton, widow of Henry Wheaton, deceased, he prepared for publication a new edition of Wheaton's Elements of International Law, appending such notes as to him seemed fit, and writing an appendix and an introduction, and a life of the author. It was also alleged by complainant in his bill that by virtue of the agreement only a limited interest in the copyright passed to the said Catharine, and that beyond such interest he retained all right and interest in his annotations and additions. The ground of complaint is that the owners of the original work and the publishers caused a new edition of the work to be prepared by Dana, which they had published and publicly sold.

Opinion by CLIFFORD, J.

[After devoting several pages to a consideration of the agreement between the complainant and Mrs. Wheaton, and the interest which the former had in the notes, etc., prepared by him, the court proceeded with the question of infringement.]

. . . Before proceeding to examine the question of infringement, it will be necessary to reproduce, as concisely as possible, some of the principal issues upon the subject as presented in the pleadings.

The statement of the complainant is that, prior to the last edition annotated by him, there was no book of international law in which all the authorities bearing upon the different questions discussed or referred to in the original work of the author, or in his antecedent annotations, were collected and presented in a convenient form for reference. Such authorities, as he represents, consisted of judicial decisions, diplomatic discussions by distinguished diplomatists, and dissertations, treatises and lectures of learned publicists and writers upon the law of nations; that he undertook to collect and present, and by a considerable amount of labor and intellectual exertion did collect and present, in his notes and in a convenient form, with reference to each question so discussed, the discussions and opinions as aforesaid, translating such as were in any foreign language, and giving them in full where they seemed sufficiently important to be so presented, and in other cases referring to them, giving the name of the book and the page where the passage could be found; that many of the authorities so collected, and particularly those relating to diplomatic discussions and negotiations, and those showing the way

in which cases involving principles of international law have arisen between different nations and been determined, are to be found in newspapers, gazettes, legislative debates, the series of books such as the Annual Register, and others named or referred to in the bill of complaint, not treatises on international law; that there is no book which can serve as an index or digest to assist an author in any material respect, in collecting such authorities; that the number of books and papers of that nature examined by him in searching for the authorities and matters cited by him is so great, that it is only possible to make such collection by devoting much attention to the subject for many years, and by making and preserving memoranda of such matters bearing upon the subject, as from time to time they come to the knowledge of a person giving a large share of his attention to such matters, and reading all such books as relate to the subject, and availing himself of much intercourse with persons conversant with such matters. The corresponding statement of the respondent is, that the plan of work he adopted was to take the text of the author of the book with his notes, and annotate the same with original notes of his own, in the same manner as if they had never before been annotated; that it was no part of his plan to revise, reduce or alter the complainant's notes, even in such manner as the law of copyright would have permitted if the complainant had had a copyright therein; but that his course was, after reading a topic in the text, if he thought it required annotation, to examine all the works to which he had access bearing upon the topic, and, among others, but not more or differently than others, the contributions of the complainant. When he had made all the examination he thought necessary, the allegation is that he then gave the subject the best reflection he could, and subsequently wrote out a new and original note in every instance, in manuscript throughout, in his own hand or that of an amanuensis, and without other reference to, or assistance from, any notes of the complainant than as above stated.

The complainant also alleges that in preparing the text of his edition he exercised a considerable amount of skill and judgment in the arrangement of his annotations, and in combining and connecting them with the text, and that he prepared a complete index to the same; and he charges that the respondents in their book have copied, conformed to and pirated the said annotated book and the annotations of the same which he prepared; and that they have used and availed themselves of the said book and annotations and the said labors of the complainant. Responsive to the charge that his notes are in a great part taken and copied from those of the complainant, and that he has pirated and unduly used the contributions of the complainant, the respondent totally denies the same and every part thereof. Evidence to show that the notes in the two annotated editions of Wheaton's Elements of International Law, as prepared by the complainant, involved great research and labor beyond what appears in those two works, is unnecessary, especially as the allegations in the bill of complaint to that effect are not directly denied in the answer; and it is equally obvious and clear that the results of the research and labor there exhibited could not well have been accomplished by any person other than one of great learning, reading and experience in such studies and investigations. Such a comprehensive collection of authorities, explanations and well-considered suggestions is nowhere, in the judgment of the court, to be found in our language, unless it be in the text and notes of the author of the original work. Uncontradicted as these propositions are, it is unnecessary to add anything further in their support. Much, also, has been

accomplished by the last editor of the work in the same direction, and in the collection and presentation of similar matters wholly distinct and separate from what was antecedently collected and presented by the complainant. But the review and comparison of the merits of the respective books are not matters within the province of the court, except so far as the same become necessary in order to decide the issues involved in the pleadings. Stripped of all mere form, the charge against the respondent is that he has infringed the rights of the complainant; and that question is the only one of much importance which remains to be considered.

Apart from the testimony of the parties themselves, and the comparison of the books, the evidence in the case consists mainly of the testimony of the two experts, and the result of the respective comparisons made by them of the notes and citations of authorities contained in one of the books, with those of a corresponding character contained in the other, together with the opinion of each expert witness whether the several notes and citations so examined and compared are, or are not, of the same character. Though admissible in all such cases, the opinions of experts are nevertheless in their nature secondary evidence; but the comparisons made by them in this case have very much facilitated the investigations made by the court. Considerable aid has been derived from that source, and from the testimony of the parties; but the court has found it necessary to re-examine the comparisons made by the witnesses, and to make others for themselves, in order to come to a satisfactory conclusion. Regarded as a basis to enable the court to compare one book with the other, the results given by the experts, as exhibited in their depositions, have proved to be of great service to the court in estimating the weight to be given to their respective opinions. Complicated as the facts are, the examination of the case has imposed much labor upon the judges; but the investigation has been made with care, and continued from time to time until both are satisfied that the court is prepared to render a just decision.

Like other controversies of a similar character, the issue upon the merits presents two questions, one of fact and the other of law. Stated in brief terms, the question of fact is, what use did the respondent who edited the edition in question make of the complainant's notes? And the question of law presented, inasmuch as it is conceded that he used the same to some extent, is, was that use allowable, or was it of a character and to such an extent that it infringed the complainant's rights?

§ 257. *The burden of proving infringement is on the party alleging it.*

Direct evidence upon the subject is unattainable, because the respondent states that he cannot remember nor undertake to give the authors from whom he derived any particular class of citations. Difficult though it be to make proof, still the complainant is not entitled to any decree unless he proves infringement, as alleged, to the satisfaction of the court, as the burden in that issue is always upon the party making the charge. Except that the burden is upon the complainant, the same difficulty is experienced by the respondents in their efforts to prove the affirmative allegations of the answer, and consequently both parties are obliged to rely chiefly upon a comparison of the contents of the respective books, as the best evidence which either party is able to produce. Examination of the notes contained in the respective books will show that the description given of them by one of the respondents' witnesses is quite accurate. He states to the effect that they are either statements of historical events, accounts of legislative debates, narratives of diplomatic discussions,

negotiations or correspondence, abstracts of cases in the courts or judicial tribunals of different countries, or summaries of other text-writers or essayists on international law, and other kindred topics, accompanied with references to the books and documents where the matters are to be found. Such authorities and references of the kind mentioned are very numerous in the edition containing the notes of the complainant, and he contends that the respondent has made a much larger use of such notes, references and authorities, including those collected and presented by him to illustrate particular topics of international law, than the law of copyright or the agreement between him and Mrs. Wheaton, as expressed in the memorandum, will permit. Numerous instances are given where the same topics are illustrated in the two works by reference to the same historical facts or diplomatic negotiations, and where the views expressed are supported by the citation of the same books, pamphlets, debates and newspapers; and the complainant contends that these coincidences occur in instances so numerous that it is past belief that they could be accidental; and he insists that the just inferences to be drawn from these coincidences, when taken in connection with the admission of the respondent that he did make some use of the complainant's book, for the purposes of reference, fully sustain the burden of proof on his part, and justify the conclusion that, in each particular instance in which the citations and authorities are the same, they were in fact taken from his book, unless the respondent can explain these coincidences, or show that the citations and authorities were derived from some other quarter. Weighed as required by the rules of circumstantial evidence, the complainant contends that these coincidences of fact, as exhibited in the two books, are not only consistent with the charge of infringement, but that they, taken as a whole, are absolutely inconsistent with any other theory, which is the test usually applied in cases where proof is required beyond any reasonable doubt.

§ 258. *Latitude allowed in the reception of indirect evidence.*

Great latitude is justly allowed by the law to the reception of indirect or circumstantial evidence; the aid of which is constantly required in the administration of justice; and whenever the necessity for a resort to such evidence arises, either from the nature of the inquiry or the failure of direct proof, objections to testimony on the ground of irrelevancy, even in common-law suits, are not favored, for the reason that the force and effect of circumstantial facts usually and almost necessarily depend upon their connection with each other. Circumstances altogether inconclusive, if separately considered, may, by their number and joint operation, especially if corroborated by moral coincidences, be sufficient to constitute full and conclusive proof. *Castle v. Bullard*, 23 How., 187; 1 Stark. Ev., 58, 862.

§ 259. *Coincidence of errors as evidence of copying.*

Instances quite numerous are also given where clerical and typographical errors and peculiarities, including special translations, are reproduced in the edition prepared by the respondent; and the court is reminded in argument that cases have arisen where the strongest proof of copying consisted "in the coincidence of errors." *Jeremy*, Eq. Jur., 322. Where the question is whether the defendant, in preparing his book, had before him and copied or imitated the book of the plaintiff, it is manifest, says Mr. Curtis, that this kind of evidence is the strongest proof, short of direct evidence, of which the fact is capable. *Curtis on Copyright*, 255; *Murray v. Bogue*, 1 Drewry, 367; *Spiers v. Brown*, 6 W. R., 353. Other authorities may be cited where the presumptions arising from the identity of inaccuracies is carried much further, and where it is held

that when a considerable number of passages are proved to have been copied by the copying of the blunders in them, other passages which are the same with passages in the original book must be presumed, *prima facie*, to be likewise copied, though no blunders occur in them. *Mawman v. Tegg*, 2 Russ., 394; *Longman v. Winchester*, 16 Ves. Jr., 269.

§ 260. — *or coincidence of citation.*

Coincidence of citation is also invoked by the complainant as evidence of copying; and the instances given as examples are many where the authorities are cited in the same way; that is, by volume and page, or by chapter and section, as the case may be, and from the same edition of the work, and from the same place.

Identity in the plan and arrangement of the notes, and in the mode of combining and connecting the same with the text, is also invoked by the complainant, as strongly supporting the charge of infringement; and it is quite apparent, on a comparison of the two books, that the instances of identity in that respect are numerous and pervading.

§ 261. *Copyright on a new arrangement of materials common to all writers.*

Copyright may justly be claimed by an author of a book who has taken existing materials from sources common to all writers, and arranged and combined them in a new form, and given them an application unknown before, for the reason that, in so doing, he has exercised skill and discretion in making the selections, arrangement and combination, and, having presented something that is new and useful, he is entitled to the exclusive enjoyment of his improvement, as provided in the copyright act. *Gray v. Russell*, 1 Story, 11 (§§ 129–33, *supra*); *Lewis v. Fullarton*, 2 Beav., 6; *Greene v. Bishop*, 1 Cliff., 199 (§§ 242–48, *supra*); *Emerson v. Davies*, 3 Story, 768 (§§ 270–79, *infra*); *Story v. Holcombe*, 4 McL., 309. Books “made and composed” in that manner are the proper subjects of copyright; and the author of such a book has as much right in his plan, arrangement and combination of the materials collected and presented, as he has in his thoughts, sentiments, reflections and opinions, or in the modes in which they are therein expressed and illustrated; but he cannot prevent others from using the old material for a different purpose. All he acquires by virtue of the copyright is “the sole right and liberty of printing, reprinting, publishing and vending such book” for the period prescribed by law. Others may use the old materials for a different purpose, but they cannot copy and use his improvement, which includes his plan, arrangement and combination of the materials, as well as the materials themselves, of which the book is made and composed. *Emerson v. Davies*, 3 Story, 768 (§§ 270–79, *infra*); *Curtis on Copyright*, 180; *Gray v. Russell*, 1 Story, 17 (§§ 129–33, *supra*).

Many other facts and circumstances are adduced by the complainant in support of the charge of infringement; but the classes mentioned will be sufficient for the present investigation, as it is not the purpose of the court to enter into the details of the evidence. Infringement in any and every form, as alleged in the bill of complaint, is denied in the answer; and the respondent, in addition to such denials, has presented in proof and in argument very elaborate and minute explanations of all the principal facts and instances adduced by the complainant in support of the charge of infringement. Separate examination at this time of each one of the explanations so given would be impracticable, and any partial review of them in the opinion would necessarily be unsatisfactory, as it would afford ground for inference that the resi-

due had been overlooked, or that they had not been duly considered. Suffice it to say, that they have all been read, studied, and made the subject of careful comparison with the facts and circumstances adduced by the complainant; but the conclusion of the court is, that they are not of a character, speaking generally, to rebut the particular proofs of the complainant, to which it was intended they should be applied. But the respondent contends that, even if it be true that matters of fact, citations and authorities have been borrowed to a considerable extent, he had a right to take them, as the use he made of them was substantially new, and different from that made by the complainant in the two prior annotated editions of the work, because they were used by him in illustration of new and original propositions. Secondly, he contends that the complainant is not entitled to any decree on account of any use he has made of the matters of fact, citations and authorities exhibited in those editions, because, as he insists, the use he so made amounts to no more than a fair and original abridgment of the former editions.

§ 262. *As to the doctrine of a new and different use of old materials collected and arranged by another.*

The doctrine of new and different use in the law of copyright applies more particularly to the old materials, and not the materials of a work like that of the last annotated edition of the complainant, where the materials collected are much abridged, and sometimes paraphrased and newly arranged, and combined with the text of the original work. Beyond all doubt, he might take the old materials, as found in the sources from which the matters of fact, citations and authorities of the complainant were drawn, and use them as he pleased, in illustration of new and original propositions, or for any other purpose not substantially the same as that to which they are applied in the annotated editions edited by the complainant; but he could not borrow the materials as therein collected and furnished, nor could he rightfully use the plan and arrangement, or the mode by which they are combined with the text, beyond the extent falling within the definition of fair use, which rule is only applicable to the materials, and not to the plan, arrangement and mode of operation. Proper attention to the nature of the charge in the bill of complainant will show that the doctrine of new and different use is wholly inapplicable to the matter in issue between the parties, because the charge is that the respondent has borrowed the matters of fact, citations and authorities, collected and presented in the notes of the complainant, and not that he has made the same use of the old materials. On the contrary, the charge is, that he has not consulted the old materials at all, but that he has borrowed the matters of fact, citations and authorities exhibited in his book, from the matters of fact, citations and authorities as collected, arranged and combined with the text in those two annotated editions. Even supposing the rule to be otherwise, and that a second writer may take bodily the matters of fact, citations and authorities collected, arranged and combined, as in the two annotated editions before the court, if the use he makes of the materials is substantially new and different, still the concession will not benefit the respondent, as his edition of the work, except the new materials collected and presented, occupies the same field and was designed for the same class of readers, and was "made and composed" for the same general purpose. Unsupported by the evidence, as the theory of fact involved in the proposition is, it is quite clear that it cannot furnish any defense for the respondent, even if the principle is correct. Argument to show that an author may have a copyright in his notes to an older

work, though the materials collected are not new, is unnecessary, as the proposition is elementary, if it appear that they have never before been collected and embodied. *Gray v. Russell*, 1 Story, 11 (§§ 129-33, *supra*).

§ 263. *Right of abridgment of a work.*

The respondent's second proposition deserves more consideration, as it presents a defense applicable to the main issue involved in the pleadings. Concisely stated, the proposition is, that, even conceding that he borrowed materials from the prior annotated editions to a considerable extent, still the quantity so taken and used did not amount to more than a fair and original abridgment of the former annotated editions. Third persons cannot make any use of a patented invention, without the consent or license of the patentee, because he acquires, by virtue of his letters patent issued under the patent act, the full and exclusive right and liberty of making and using his invention, as well as of vending it to others to be used, for the term allowed by law; but the right secured to the author or proprietor of a book is only "the sole right and liberty of printing, reprinting, publishing and vending such book," which, as construed by the courts, means the exclusive right to multiply copies for the benefit of the author or his assigns. *Stephens v. Cady*, 14 How., 529; *Reade v. Lacy*, 1 Johns. & H., 526; *Millar v. Taylor*, 4 Burr., 2311. Courts have sometimes supposed that the same rule of decision should be applied to a copyright as to a patent for a machine, and consequently that an abridgment of an original work, made and condensed by another person without the consent of the author of the original work, ought to be regarded as an infringement; but the language of the respective acts of congress making provision for the protection of such rights is different; and the opposite doctrine has been too long established to be considered at the present time as open to controversy. *Story v. Holcombe*, 4 McL., 309. Whatever might be thought if the question was an open one, it is too late to agitate it at the present time, as the rule is settled that the publication of an unauthorized but *bona fide* abridgment or digest of a published literary copyright, in a certain class of cases at least, is no infringement of the original. *Phillips on C.*, 171; *Newbery's Case*, Loft, 775; *Dodsley v. Kinnersley*, Amb., 403; *Whittingham v. Wooler*, 2 Swanst., 428; *Gyles v. Wilcox*, 2 Atk., 342.

§ 264. — *a bona fide abridgment is allowable.*

Strong doubts are expressed by Mr. Curtis, whether the definition of an allowable abridgment, as given in the earlier cases, can be sustained, except as applied to such works as histories, or works composed of translations, and others of like kind; but it was decided in this court in the case of *Folsom v. Marsh*, 2 Story, 105 (§§ 249-56, *supra*), that an abridgment in which there is a substantial condensation of the materials of the original work, and which required intellectual labor and judgment to make the same, does not constitute an infringement of the copyright of the original author; and the court, as now constituted, is inclined to adopt that rule in cases where it also appears that the abridgment was made *bona fide* as such, and that it is not of a character to supersede the copyrighted publication. Unless it be denied that a legal copyright secures to the author "the sole right and liberty of printing, reprinting, publishing and vending the book" copyrighted, it cannot be held that an abridgment or digest of any kind of the contents of the copyrighted publication, which is of a character to supersede the original work, is not an infringement of the franchise secured by the copyright. What constitutes a fair and *bona fide* abridgment in the sense of the law is, or may be, under particular

circumstances, one of the most difficult questions which can well arise for judicial consideration; but it is well settled that a mere selection or different arrangement of parts of the original work into a smaller compass will not be held to be such an abridgment. *Campbell v. Scott*, 11 Sim., 38, and note; *Gyles v. Wilcox*, 2 Atk., 342; *Folsom v. Marsh*, 2 Story, 107 (§§ 249-56, *supra*). Substantially the same views are expressed in the case of *Tinsley v. Lacy*, 1 Hem. & M., 753; and the vice-chancellor in that case, in speaking of the authorities by which fair abridgments have been sustained, goes on to say that the courts have gone far enough in that direction, and adds that it is difficult to acquiesce in the reason sometimes given that the compiler of an abridgment is a benefactor to mankind, by assisting in the diffusion of knowledge.

§ 265. *What will amount to copying. Literal repetition not necessary.*

Viewed in the light of these principles it is quite clear that the 'book of the respondent, even if it could be regarded as an abridgment of the prior editions, must still be held to be an infringement of the same; but the court is of the opinion that it is not an abridgment of those editions in any sense known to the law of copyright. Instead of being an abridgment of the prior editions it is precisely what it purports to be, a reprint of the text of the author, with notes by a new editor; and the proofs are full to the point that he was employed to edit a new edition of the work to supersede the antecedent editions annotated by the complainant. Instructed as he was to make no use of the complainant's notes, his principal defense still is that he complied with those instructions, and that he did not make any use of the notes in his edition beyond what is allowable as fair quotations from the published work of a prior author treating upon the same subject. Copying is not confined to literal repetition, but includes also the various modes in which the matter of any publication may be adopted, imitated or transferred, with more or less colorable alterations to disguise the source from which the material was derived; nor is it necessary that the whole or even the larger portion of the work should be taken in order to constitute an invasion of a copyright. Some use may be made by a subsequent writer of the contents of a book or treatise antecedently made, composed and copyrighted by another person, in making and composing a new book upon the same subject, whether the contents of the antecedent book or treatise were wholly original, or were partly original and partly made up of selections from other authors. Copyright differs in this respect from patent-right, which admits of no use of the patented thing without the consent or license of the patentee. Persons making, using, or vending to others to be used, the patented article, are guilty of infringing the letters patent, even though they may have subsequently invented the same thing without any knowledge of the existence of the letters patent; but the re-composition of the same book without copying, though not likely to occur, would not be an infringement. Coincidence, if perfect, is sufficient to prove the infringement of a patent, as the charge is that the defendant, if it be a machine, has made machines in the similitude of the patented machine and with the same mode of operation. Copying is essential to constitute an infringement of copyright, but identity of contents, arrangement and combination is strong evidence that the second book was borrowed from the first, because it is highly improbable that two authors would express their thoughts and sentiments in the same language, throughout a book or treatise of any considerable

size, or adopt the same arrangement or combination in their publication. *Reade v. Lacy*, 1 Johns. & H., 526.

§ 266. *Evidence of innocent intention on the question of infringement.*

Great difficulty attends every attempt to define in precise terms the privilege allowed by law to a subsequent writer to use without consent or license the contents of a book or treatise antecedently made, composed and copyrighted by another author; or to mark the boundaries of the privilege of such subsequent writer to borrow the materials in a book like the annotated editions of the complainant, where the materials have been selected from such a variety of sources, and where the materials so selected are arranged and combined with certain chosen passages of the text of the original work, and in a manner showing the exercise of discretion, skill, learning, experience and judgment. Decided cases are referred to where the principal criterion of determination is held to be the intent with which the person acted who is charged with infringement. Remarks to that effect are to be found in the opinion of the court in the case of *Cary v. Kearsley*, 4 Esp., 170, and the decision in the case of *Spiers v. Brown*, 6 W. R., 353, refusing the application for an injunction, turned to some extent upon the same consideration; but the vice-chancellor (now chancellor) refused to apply that doctrine in the subsequent case of *Scott v. Stanford*, L. R., 3 Eq., 722, and explained the grounds of his ruling in the former case, which show that he would not sanction that rule in any case unless it appeared that the defendant had bestowed such mental labor upon what he had taken as to produce an original result. Evidence of innocent intention may have a bearing upon the question of "fair use;" and where it appeared that the amount taken was small, it would doubtless have some probative force in a court of equity in determining whether an application for an injunction should be granted or refused; but it cannot be admitted that it is a legal defense where it appears that the party setting it up has invaded a copyright. *Cary v. Faden*, 5 Ves., 23; *Reade v. Lacy*, 1 Johns. & H., 526; *Bramwell v. Halcomb*, 3 Myl. & Cr., 738.

§ 267. *Limits within which subsequent writers are restricted.*

Few judges have devised safer rules upon the subject than Judge Story. He held that, to constitute an invasion of copyright, it was not necessary that the whole of a work should be copied, nor even a large portion of it, in form or substance; that if so much is taken that the value of the original is sensibly diminished, or the labors of the original author are substantially, to an injurious extent, appropriated by another, that is sufficient in point of law to constitute an infringement; that, in deciding questions of this sort, courts must "look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale or diminish the profits, or supersede the objects of the original work." *Folsom v. Marsh*, 2 Story, 116 (§§ 249-56, *supra*). Mere honest intention on the part of the appropriator will not suffice, said Vice-Chancellor Wood, as the court can only look at the result, and not at the intention in the man's mind at the time of doing the act complained of, and he must be presumed to intend all that the publication of his work effects. *Scott v. Stanford*, L. R., 3 Eq., 723; *Hodges v. Welsh*, 2 Ir. Eq., 266. Twenty years before that decision was made, Mr. Curtis, in his valuable work on the law of copyright, expressed the same views, and this court entertains no doubt they are correct. *Curtis on Copyright*, 240. Recent decisions afford more ample protection to copyright

than those of an earlier date, and they also restrict the privilege of the subsequent writer or compiler in respect to the use of the matter protected by the copyright, within narrower limits. The decision in *Kelley v. Morris*, L. R., 1 Eq., 697, is, that in the case of a map, guide-book or directory, or the like, where there are certain common objects of information which must, if described correctly, be described in the same words, a subsequent compiler is bound to do for himself that which was done by the first compiler; that he is not entitled to take one word of the information published without independently working out the matter for himself, so as to arrive at the same result from the same common sources of information, and that the only use he can make of a previous publication of that kind is to verify his own calculations and results when obtained. Rights secured by copyright are property within the meaning of the law of copyright, and whoever invades that property beyond the privilege conceded to subsequent authors commits a tort, and is liable to an action. None of these rules of decision are inconsistent with the privilege of a subsequent writer to make what is called a fair use of a prior publication; but their effect undoubtedly is, to limit that privilege so that it shall not be exercised to an extent to work substantial injury to the property which is under the legal protection of copyright.

§ 268. *Privileges of reviewers.*

Reviewers may make extracts sufficient to show the merits or demerits of the work, but they cannot so exercise the privilege as to supersede the original book. Sufficient may be taken to give a correct view of the whole; but the privilege of making extracts is limited to those objects, and cannot be exercised to such an extent that the review shall become a substitute for the book reviewed. *Story v. Holcombe*, 4 McL., 309.

Examined as a question of strict law, apart from exceptional cases, the privilege of fair use accorded to a subsequent writer must be such, and such only, as will not cause substantial injury to the proprietor of the first publication; but cases frequently arise in which, though there is some injury, yet equity will not interpose by injunction to prevent the further use, as where the amount copied is small and of little value, if there is no proof of bad motive, or where there is a well-founded doubt as to the legal title, or where there has been long acquiescence in the infringement, or culpable laches and negligence in seeking redress, especially if it appear that the delay has misled the respondent. *Sweet v. Cater*, 11 Sim., 580; *Tinsley v. Lacy*, 1 Hem. & M., 752; *Spiers v. Brown*, 6 W. R., 353; *Strahan v. Graham*, 15 W. R., 487; *Bramwell v. Halcomb*, 3 Myl. & Cr., 738; *Reade v. Lacy*, 1 Johns. & H., 527; *Jarrold v. Houlston*, 3 Kay & J., 717; *Lewis v. Fullarton*, 2 Beav., 6; *Bell v. Whitehead*, 17 L. T., 141; *Curtis on Copyright*, 326; *Saunders v. Smith*, 3 Myl. & Cr., 711.

Guided by the rules of law, as already explained, the court, after having examined the whole case with care, is of the opinion that many of the notes presented in the edition edited by the respondent whose case is under consideration do infringe the corresponding notes in the two editions edited and annotated by the complainant, and that the respondent borrowed very largely the arrangement of the antecedent edition, as well as the mode in which the notes in that edition are combined and connected with the text. Judge Story held, in the case of *Emerson v. Davies*, 3 Story, 780 (§§ 270-79, *infra*), that every author had a copyright in the plan, arrangement and combination of his materials, and in his mode of illustrating his subject, if it be new and original; and it was also held, in *Greene v. Bishop*, 1 Cliff., 199 (§§ 242-48, *supra*), that

there may be a valid copyright in the plan of a book, as connected with the arrangement and combination of the materials; and no doubt is entertained that both those decisions were correct; but it is a mistake to suppose that a subsequent writer can be held to have infringed a book where he has not borrowed any of the materials of which the book is composed. New materials are certainly the proper objects of copyright; and old materials, when subsequently collected, arranged and combined in a new and original form, are equally so; and in either case, the plan, arrangement and combination of the materials are as fully protected by the copyright as the materials embodied in the plan, arrangement and combination. Damages may be recovered in either of the supposed cases for the infringement of the property protected by the copyright; but the property in the latter case consists chiefly, if not entirely, in the plan, arrangement and combination of the materials collected and presented in the book, as any other person may collect from the original sources the same materials, and arrange and combine them in any other manner not substantially the same as that of the antecedent author. *Barfield v. Nicholson*, 2 Sim. & S., 6.

§ 269. *Difficult and complex cases will be referred to a master.*

A detailed specification of the instances of infringement, as shown by a comparison of the two books, would be impracticable, and will not be attempted; as the settled practice in equity is, where the works are voluminous and of a complex character, containing, as in this case, much original matter mixed with common property, the cause will, at some stage of the case, be referred to a master, to state the facts, together with his opinion, for the consideration of the court. It is a better course to make the reference before the final hearing; but the parties in this case waived any reference at that stage of the cause, and elected to proceed to final hearing without any such report. Cases arise where the court, under such circumstances, would not order a reference, but would proceed to compare the books and ascertain the details of the infringement; but the case before the court is far too complex to admit of that course of action. *Curtis on Copyright*, 325; *Mawman v. Tegg*, 2 Russ., 400; 2 Story, Eq. Jur., § 941. Details have been examined as far as practicable, consistent with the claims of other official duties, but the judges are of the opinion that they should be further examined, and the results classified, before the court proceeds to determine the extent of the infringement, as the danger of injustice cannot well be avoided in any other way. New matter of value has been collected and presented by the respondent, and he has added much that is valuable in his references to events which have occurred since the publication of the last preceding annotated edition. Whatever may have been the rule in the earlier history of equity jurisprudence, it is now settled law in this court, that a book may in one part of it infringe the copyright of another, while in other parts it may be entirely original and the proper object of a copyright; and in such a case, it was held, in *Greene v. Bishop*, 1 Cliff., 201 (§§ 242-48, *supra*), that the remedy will not be extended beyond the injury. Preceding that decision, the same rule had been adopted in *Story v. Halcombe*, 4 McL., 315, in which the opinion was given by the late Mr. Justice McLean. The modern practice in the chancery courts of England is the same as appears in the case of *Jarrold v. Houlston*, 3 Kay & J., 721, in which the opinion was given by Vice-Chancellor Wood, since promoted to the office of chancellor. *Kelly v. Morris*, L. R., 1 Eq., 701; *Carnan v. Bowles*, 2 Bro. Ch. C., 80; *Curtis on Copyright*, 325. It is suggested that it will be impossible to separate that

which is original from that which was borrowed, and to some extent the suggestion may be of weight; but the court is of the opinion that the difficulties in that behalf, when the matters pass under the searching examination of a master, will be much less than is apprehended by the parties. Should the difficulty in any instance or class prove to be insurmountable, then the rule in equity is, that if the parts which have been copied cannot be separated from those which are original without destroying the use of the original matter, he who made the improper use of that which did not belong to him must suffer the consequences of so doing. If a second writer mixes the literary matter of another, which is under the protection of a copyright, with his own, without the license or consent of the proprietor, he must nevertheless be restrained from publishing what does not belong to him, and if the parts of the work cannot be separated, so that the injunction prevents also the publication of his own literary production, so mixed with that of another, he has only himself to blame. *Mawman v. Tegg*, 2 Russ., 390; *Lewis v. Fullarton*, 2 Beav., 11. It is believed that an extended application of that rule will not be required, in view of the proofs exhibited in the record, and of the facilities afforded by the comparison of the notes in the respective editions, to separate what is original from that which has been copied.

Attention is called by the respondent to the fact that some of the notes in the edition edited by him are entirely original, that in others the material copied is much condensed, or the notes reduced to a mere reproduction of the authorities cited in the prior edition, and that other notes have been enlarged and improved by the addition of new matter; and in view of those circumstances, he contends that the edition edited by him should be regarded as a new and original work; but the decisive answer to the first and last suggestion is, that no man is entitled to avail himself of the previous labors of another for the purpose of conveying to the public the same information, even though he may append additional information to that already published. *Scott v. Stanford*, L. R., 3 Eq., 724; 2 Story, Eq. Jur., § 940; 2 Kent, Com., 382, 383; *Cary v. Faden*, 5 Ves., 25, and note; *Wheaton v. Peters*, 8 Pet., 591 (§§ 12-16, *supra*); *Bramwell v. Halcomb*, 3 Myl. & Cr., 737.

Additional remarks in respect to the alleged fact that the contents of the notes copied were condensed is unnecessary, as it is quite clear, as before explained, that the change made in that behalf is not of a character to afford the respondent any defense.

Supported by these reasons, the conclusions of the court are as follows:

1. That the complainant in a court of equity is the equitable owner of the notes in the two annotated editions described in the pleadings as arranged, and the mode in which they are combined and connected with the text.

2. That the title to the entire text, together with the title to the memoir and indices, is in the proprietor of the book, and not in the complainant as alleged in the bill of complaint.

3. That there are notes in the edition edited by the respondent, of substantial importance in point of number, and the value of the materials, which do infringe the equitable rights of the complainant, as explained and defined by the court.

4. That all the respondents had notice of the claim of the complainant, as explained and defined by the court.

5. That there are notes in that edition of substantial importance in point of

number, and the value of the materials, which do not infringe any rights of the complainant.

6. That the notes in that edition consisting wholly of citations found in the corresponding notes of the complainant do infringe his rights, as explained and defined by the court, though many of them are unaccompanied by the extracts collected and presented in the next preceding edition.

7. That notes consisting of authorities or collections of authorities copied in like manner as described in the preceding proposition, and without remarks or comments, do also infringe the complainant's rights, though they are found inserted in or prefixed or appended to notes otherwise not objectionable.

8. That notes of which the whole or some substantial and material part is condensed from the corresponding notes in the preceding edition, or from the extracts therein printed and published, without any marks of original labor, or of any such labor except the study of the note copied and adopted, do also infringe the complainant's rights, as explained and defined.

9. That notes wholly original do not infringe.

10. That notes partly original and partly copied from the preceding edition do not infringe, except for the matter copied, if it be practicable to ascertain and define the separate proportions and make the separation of the same; but if not, still the respondent at the proper stage of the case must be restrained from using the part copied.

11. That the cause must be referred to a master to examine the pleadings and proofs, and report the extent of the infringement as adjudged by the court in this investigation, and also to examine and ascertain what, if any, other instances of the alleged infringements within the principles here explained are proved; and if any, to classify the same and report the details, together with the reasons for his conclusions, for the consideration of the court.

12. That all other matters in the cause will be reserved until the coming in of the master's report.

13. That the cause is referred to Henry W. Paine as master, for his examination and report in the premises, in conformity to the opinion and directions of the court.

Equity suits for the infringement of a copyright are usually referred to a master before the final hearing, to ascertain whether the charge is proved, and if so, for a report as to the nature and extent of the infringement; and in such cases the general rule is that the complainant, if he prevails in the suit, is entitled, if at all, to an injunction at the time the decretal order is entered, to restrain the respondent from any further violation of his rights, as the whole case is then before the court. Even when the case is heard before any such reference and report, if the charges of infringement are few and of a character that the extent of the infringement can be conveniently determined by the court without sending the case to a master, the court, if the case be one where an injunction is the proper remedy, will order it at the same time that the decision is announced upon the merits. But where the cause comes to a final hearing without any such report, the court, if the charges of infringement are numerous and of a character to require extended examination before the extent of the infringement can be ascertained, will ordinarily send the case to a master for further examination and report in respect to all matters not previously adjudged by the court; and the general rule in such cases is that the injunction will not be granted until the nature and extent of the in-

fringement are fully ascertained and determined, as its effect and operation might work great injustice. Obviously the present case falls within the latter rule, and therefore an injunction will not be ordered until the court shall have acted finally upon the report of the master.

EMERSON v. DAVIES.

(Circuit Court for Massachusetts: 3 Story, 768-799. 1845.)

Bill in equity for the infringement of a copyright of a work entitled Emerson's North American Arithmetic. The work complained of was an arithmetic by Davies. The facts are stated in the opinion.

Opinion by STORY, J.

This cause has been argued with great ability, and with great fullness of the examination of the evidence. The merits of the case, however, seem to me to depend mainly, if not altogether, upon two points. First, whether the plaintiff's book contains anything new and original, entitling him to a copyright. Secondly, whether, if the plaintiff has a title by copyright, the defendants have infringed that copyright by the book published by them, or, as it is technically expressed, whether they have printed the work of the plaintiff.

§ 270. *New plan, arrangement, or employment of old materials will entitle the author to a copyright of his book.*

Upon the first question, at least, upon the evidence in the case, there does not appear to me to be any reasonable ground of doubt. The book of the plaintiff is, in my judgment, new and original, in the sense in which those words are to be understood in cases of copyright. The question is not whether the materials which are used are entirely new, and have never been used before; or even that they have never been used before for the same purpose. The true question is, whether the same plan, arrangement and combination of materials have been used before for the same purpose or for any other purpose. If they have not, then the plaintiff is entitled to a copyright, although he may have gathered hints for his plan and arrangement, or parts of his plan and arrangement, from existing and known sources. He may have borrowed much of his materials from others, but if they are combined in a different manner from what was in use before, and *a fortiori*, if his plan and arrangement are real improvements upon the existing modes, he is entitled to a copyright in the book embodying such improvements. See *Lewis v. Fullerton*, 2 Beav., 6. It is true that he does not thereby acquire the right to appropriate to himself the materials which were common to all persons before, so as to exclude those persons from a future use of such materials; but then they have no right to use such materials with his improvements superadded, whether they consist in plan, arrangement, or illustrations or combinations; for these are strictly his own. A man who constructs a new machine is entitled to a patent therefor, if the combination and arrangements thereof are new and his own invention, although he uses old materials and old mechanical apparatus and powers in constructing such machine. He may use wheels, or levers, or screws, or toggle-joints, or cranks, or any other known modes of accomplishing given mechanical ends, if he combines them in a new manner, and thus produces a beneficial result. The steam-engine, the steamboat, the cut-nail machine, the carding machine, the grooving machine, are all but new combinations of old materials, old processes, and old mechanical powers and apparatus.

In truth in literature, in science and in art there are, and can be, few, if any,

things which, in an abstract sense, are strictly new and original throughout. Every book in literature, science and art borrows, and must necessarily borrow and use, much which was well known and used before. No man creates a new language for himself, at least, if he be a wise man, in writing a book. He contents himself with the use of language already known and used and understood by others. No man writes exclusively from his own thoughts, unaided and uninstructed by the thoughts of others. The thoughts of every man are, more or less, a combination of what other men have thought and expressed, although they may be modified, exalted or improved by his own genius or reflection. If no book could be the subject of copyright which was not new and original in the elements of which it is composed, there could be no ground for any copyright in modern times, and we should be obliged to ascend very high, even in antiquity, to find a work entitled to such eminence. Virgil borrowed much from Homer; Bacon drew from earlier as well as contemporary minds; Coke exhausted all the known learning of his profession; and even Shakspeare and Milton, so justly and proudly our boast as the brightest originals, would be found to have gathered much from the abundant stores of current knowledge and classical studies in their days. What is La Place's great work but the combination of the processes and discoveries of the great mathematicians before his day with his own extraordinary genius? What are all modern law-books but new combinations and arrangements of old materials, in which the skill and judgment of the author in the selection and exposition and accurate use of those materials constitute the basis of his reputation as well as of his copyright? Blackstone's Commentaries and Kent's Commentaries are but splendid examples of the merit and value of such achievements.

§ 271. *An author has a copyright in the plan, arrangement and combination of his materials, and in his mode of illustrating his subject. Translations, maps, etc.*

In truth, every author of a book has a copyright in the plan, arrangement and combination of his materials and in his mode of illustrating his subject, if it be new and original in its substance. Sir John Leach, in *Barfield v. Nicholson*, 2 Sim. & Stu., 1, 6, recognized this doctrine in its fullest extent; and there stated that a copyright might well be taken where the composition is either new or there is a new arrangement thereof. Nay, the right to a copyright goes much further. A man has a right to a copyright in a translation upon which he has bestowed his time and labor. To be sure, another man has an equal right to translate the original work and to publish his translation; but then it must be his own translation, by his own skill and labor, and not the mere use and publication of the translation already made by another. *Wyatt v. Barnard*, 3 Ves. & Beam., 77. A man has a right to the copyright of a map of a state or country, which he has surveyed or caused to be compiled from existing materials at his own expense, or skill, or labor, or money. Another man may publish another map of the same state or country, by using the like means or materials, and the like skill, labor and expense. But then he has no right to publish a map taken substantially and designedly from the map of the other person, without any such exercise of skill, or labor, or expense. If he copies substantially from the map of the other, it is a downright piracy; although it is plain that both maps must, the more accurate they are, approach nearer in design and execution to each other. *Mathewson v. Stockdale*, 12 Ves., 270; *Wilkins v. Aiken*, 17 Ves., 422.

§ 272. *One who, by his own skill, labor and judgment, writes a new work, and does not merely copy from another, is entitled to a copyright therein.*

He, in short, who, by his own skill, judgment and labor, writes a new work, and does not merely copy that of another, is entitled to a copyright therein; if the variations are not merely formal and shadowy from existing works. He who constructs by a new plan and arrangement, and combination of old materials, in a book designed for instruction either of the young or the old, has a title to a copyright, which cannot be displaced by showing that some part of his plan or arrangement or combination has been used before.

The case of *Gray v. Russell*, 1 Story, 11 (§§ 129-33, *supra*), affords a strong illustration of the doctrine, as that was a case confessedly of a mere improvement of an old work, Adams' Latin Grammar, a subject that had been discussed and treated in many hundred works, and in which little more could be done than to arrange the materials upon a new plan, or in a new combination, with additional illustrations and initial remarks. Yet the court held it clearly to be the subject of a copyright; and from the doctrine therein stated, I feel not the slightest inclination to depart. It was upon the like ground that an action has been held to lie for the recovery of damages for pirating the new corrections and additions to an old work (*The Itinerancy of England*). Upon that occasion, Lord Kenyon said: "The courts of justice have been long laboring under an error, if an author have no copyright in any part of a book, unless he have an exclusive right to the whole book." See, also, *Trusler v. Murray* and *Tonson v. Walker*, cited in 1 East, 360, 361, and notes. Another illustration may be found in the cases of histories and dictionaries, as stated by Lord Mansfield in *Sayre v. Moore*, 1 East, R., 361, note. "In the first, a man may give a relation of the same facts, and in the same order of time; in the latter an interpretation is given of the identical same words. But he must not servilely copy the words of another on either subject. An author has as much right in his plan, and in his arrangements, and in the combination of his materials, as he has in his thoughts, sentiments, opinions, and in his modes of expressing them. The former, as well as the latter, may be more useful or less useful than those of another author; but that, although it may diminish or increase the relative values of their works in the market, is no ground to entitle either to appropriate to himself the labor or skill of the other, as embodied in his own work."

§ 273. *Where the plan, arrangement and illustration of a school book are new, the taking of them is a violation of copyright.*

It is a great mistake to suppose, because all the materials of a work, or some parts of its plan and arrangements, and modes of illustration, may be found separately or in a different form, or in a different arrangement in other distinct works, that therefore, if the plan or arrangement or combination of these materials in another work is new, or for the first time made, the author or compiler, or framer of it (call him which you please), is not entitled to a copyright. The reverse is the truth in law, and, as I think, in common sense also. It is not, for example, in the present case, of any importance that the illustrating of lessons in arithmetic by attaching unit marks representing the numbers embraced in the example may be formed by dots in Wallis' *Opera Mathematica* (p. 28); or in Colburn's *Arithmetic* in the form of upright linear marks, in a pamphlet detached from the main work. That is not what the plaintiff purports to found his copyright upon. He does not claim the first use or invention of unit marks for the purpose above mentioned. The use of these is a

part of and included in his plan, but it is not the whole of his plan. What he does claim is, 1. The plan of the lessons in his book; 2. The execution of that plan in a certain arrangement of a set of tables in the form of lessons to illustrate those lessons; 3. The gradation of examples to precede each table in such manner as to form with the table a peculiar and symmetrical appearance of each page; 4. The illustration of his lessons by attaching to each example unit marks representing the numbers embraced in the example. It is, therefore, this method of illustration in the aggregate that he claims as his invention, each page constituting of itself a complete lesson; and he alleges that the defendants have adopted the same plan, arrangement, tables, gradation of examples and illustrations by unit marks, in the same page, in imitation of the plaintiff's book, and in infringement of his copyright, and in confirmation of this statement he refers to divers pages of his own book in comparison with divers pages of the book of the defendants. Now I say that it is wholly immaterial whether each of these particulars, the arrangement of the tables and forms of the lessons, the gradation of the examples to precede the tables, the illustration of the examples by unit marks, had each existed in a separate form in different and separate works before the plaintiff's work, if they had never been before united in one combination or in one work, or on one page, in the manner in which the plaintiff has united and connected them. No person had a right to borrow the same plan, and arrangement, and illustrations, and servilely to copy them into any other work. The same materials were certainly open to be used by any other author, and he would be at liberty to use unit marks and gradations of examples and tables and illustrations of the lessons, and to place them in the same page. But he could not be at liberty to transcribe the very lessons and pages and examples and illustrations of the plaintiff, and thus to rob him of the fruits of his industry, his skill, and his expenditures of time and money.

I have dwelt the more upon this point because it seems to me that some of the learned witnesses whose evidence is in the case have entirely misunderstood the law upon this subject; and some portions of the argument at the bar seem to me to have proceeded upon an equally inadmissible ground, that if none of the materials of the plaintiff's book were new, or invented by him, that new combinations or arrangements or illustrations of the old materials would give a title to a copyright. My judgment is far otherwise; and as far as the evidence in this case goes, it is clear to my mind that the plaintiff has a good copyright in his book; that, taking his plan, arrangements, lessons, examples and illustrations as a whole, they are not to be found combined in any former work. I must confess that it strikes me that the plaintiff's method is a real and substantial improvement upon all the works which had preceded his and which have been relied on in the evidence; but whether to be better or worse is not a material inquiry in this case. If worse, his work will not be used by the community at large; if better, it is very likely to be so used. But either way he is entitled to his copyright, *Valere quantum valere potest*.

§ 274. *To constitute piracy of copyright it must appear that the original work was either copied or so imitated as to be a mere evasion of the copyright.*

The second question is the real and important question in the cause; and certainly it is not without its difficulties. It falls within that class of cases where the differences between different works are of such a nature that one is somewhat at a loss to say whether the differences are formal or substantial; whether they indicate a resort to the same common sources to compile and

compose them, or one is (as it were) *uno flatu* borrowed from the other, without the employment of any research or skill, with the disguised but still apparent intention to appropriate to one what in truth belongs exclusively to the other, and with no other labor than that of mere transcription, with such omissions or additions as may serve merely to veil the piracy. It is like the case of patented inventions in art or machinery, where the resemblances or diversities between the known and the unknown, and between invention and imitation, are so various or complicated, or minute or shadowy, that it is exceedingly difficult to say what is new or not, or what has been pirated and what is substantially different. The approaches on either side may be almost infinitely varied, and the identity or diversity sometimes becomes almost evanescent. In many cases the mere inspection of a work may at once betray the fact that it is borrowed from another author with merely formal or colorable omissions or alterations. In others, again, we cannot affirm that identity in the appearance or use of the materials is a sufficient and conclusive test of piracy, or that the one has been fraudulently or designedly borrowed from the other. Take the case, for example (already referred to), of two maps of a city, a county, or a country. We cannot predicate that the one is a piracy from the other, simply because their external appearance is in nearly all respects the same, with or without some additions or alterations or omissions. Take the case of two engravings copied from the same picture, or two pictures of natural objects by different artists;—it would not be practicable, in many cases, from the mere inspection of them and their apparent identity, to say that the one was a transcript of the other. It would be necessary to resort to auxiliary and supplementary evidence to establish the fact either way.

And this leads me to remark that the bill directly charges “that the said work of the defendant Davies is copied and pirated from that” of the plaintiff, and is an infringement of his copyright in the particulars set forth in the bill. These particulars we shall have occasion hereafter to consider. The defendant Davies, in his answer, alleges from his own knowledge, and the other defendant Barnes alleges from information and belief, “that neither the said work composed by the defendant Davies, nor any part thereof, is copied, adopted or taken from the said book of the said complainant, or any part thereof.” Now this part of the answer, being directly responsive to the charge made in the bill, is positive evidence of the fact for the defendants, unless it is overcome by the clear testimony of two witnesses, or of one witness and equivalent circumstances. In short, the true exposition of this rule in equity is, that where the answer is responsive to the charge in the bill, it is to be taken as true, unless its credibility is impeached in such a manner as renders it unsafe and improper to place confidence in it; and this may be by direct testimony, or by circumstantial evidence sufficient to overthrow its credibility.

It has been suggested at the bar, and it is a suggestion not without weight, that the answer of the defendants nowhere denies that Davies had seen the plaintiff's book before his own was compiled and published. The omission of such denial would have been more stringent if the bill had contained any interrogatory pointed directly to the fact that Davies had seen it. Not containing any such interrogatory, the attention of the defendants may not have been drawn to the importance of such a denial, if it could be correctly made. Still, as the book of Emerson was published in 1829, and had a wide circulation, and that of Davies was not published until 1840, the natural inference certainly is, that composing a book on the same subject, for the same professed

object, the instruction of beginners in arithmetic, he should, considering his local position in New York, have examined all the existing works published and on sale in the neighboring states upon the same subject. I rather incline, therefore, to think that, under all the circumstances, it must be taken as a fact by the court that Davies, when he compiled his work, had seen and read that of Emerson. But then this circumstance does not necessarily displace the substance of the answer to the charge in the bill. It may be true that Davies had seen and read Emerson's book, and yet that he may not have copied or adopted or taken any part of it from that of Emerson, but from common sources open to all authors and compilers. It should be added that the answer expressly alleges that the similarity of appearance between certain pages of the two books alleged in the bill, "if such similarity of appearance do exist, which the defendants deny, was purely accidental and was not intended, expected or desired by this defendant, Davies." There is some evidence that the arrangement of the whole matter of one lesson on one and the same page was the act of the stereotyper, and was afterwards adopted by Davies. But the stereotyper did not change the arrangement by Davies of the matter of each lesson; and if that matter had been on different pages, and yet it had been a mere transcript from Emerson's book, it would have been a clear invasion of his copyright. The question is not in what part of one or more pages the matter is found, but whether it is borrowed or pirated from the plaintiff, without any substantial alteration or difference. In truth, however, the placing each lesson in one and the same page, having been finally accepted and acted upon by Davies, binds him just as much as if he had originally authorized or directed it.

§ 275. *Distinction between a copy of a work and an imitation or resemblance.*

The case, therefore, comes back at last to the naked consideration, whether the book of Davies, in the parts complained of, has been copied substantially from that of Emerson, or not. It is not sufficient to show that it may have been suggested by Emerson's, or that some parts and pages of it have resemblances, in method and details and illustrations, to Emerson's. It must be further shown that the resemblances in those parts and pages are so close, so full, so uniform, so striking, as fairly to lead to the conclusion that the one is a substantial copy of the other, or mainly borrowed from it. In short, that there is substantial identity between them. A copy is one thing, an imitation or resemblance another. There are many imitations of Homer in the *Æneid*; but no one would say the one was a copy from the other. There may be a strong likeness without an identity; and as was aptly said by the learned counsel for the plaintiff in the close of his argument, *Facies non omnibus una, non diversa tamen, qualem debet esse sororum*. The question is, therefore, in many cases, a very nice one, what degree of imitation constitutes an infringement of the copyright in a particular work. It is very clear that any use of materials, whether they are figures or drawings, or other things which are well known and in common use, is not the subject of a copyright, unless there be some new arrangement thereof. Still, even here, it may not always follow, that any person has a right to copy the figures, drawings or other things, made by another, availing himself solely of his skill and industry, without any resort to such common source. A striking case to illustrate the first part of this proposition is *Barfield v. Nicholson*, 2 Sim. & Stu., 1, 6. There the question was whether a work called *The Practical Builder* was an improvement upon *The Architectural Dictionary*, both works having been compiled by the same

gentleman, Mr. Nicholson, and both being, plainly, on the same subject, the science of architecture and the art of building. On that occasion, Sir John Leach (the vice-chancellor) said: "The Architectural Dictionary, and The Practical Builder, are plainly both works upon the same subjects, namely, the science of architecture and the art of building. The question is, whether the latter work is a piracy upon any part of the former work, which the author of that work had a right to claim as his own property, in respect that it was his own composition.

"Composition is either in new matter or new arrangement. The arrangement in the two works is altogether different. In The Architectural Dictionary, the information is scattered through the whole work, under the head of each particular term of science or art, arranged in alphabetical order; in the Practical Builder, the information is conveyed in the connected form of a treatise. If there be piracy here, it must be piracy of the matter of The Architectural Dictionary. The general answer of the defendant is, that The Practical Builder was conceived and planned by him as a speculation on his own account, and that he employed various artists in the execution of this work, and, among others, Nicholson and his son; and especially in the plates; and that he paid for everything as original design; and that, if it be a piracy, he is himself imposed upon.

"The Practical Builder, as far as published, consists of forty-six plates; and the affidavits allege that thirteen of these plates contain one, two, three or four figures, which are imitations of figures contained in The Architectural Dictionary; and the particular figures are pointed out in the affidavits. The entire resemblance of these figures, though in some instances denied, is generally admitted; but it is said this resemblance is no proof of imitation. The figures of geometry must necessarily resemble each other in all works; and, in a great degree, this applies to the figures of architecture or building, where they are descriptions of things in use, as, for instance, in one of the articles, roofs. Where two works describe the figures of roofs in use, they must necessarily produce resembling figures. And the defendant then proceeds to show that the figures used in his plates, supplied by the Nicholsons, are not, in fact, piratical copies of the plaintiff's works. The defendant does not deny (what could not be denied) that if the Nicholsons, whom he employed, piratically copied these figures from the plaintiff's work, that he is bound by their acts, as the acts of his agents, and that piracy in the Nicholsons is piracy in him.

"As to those figures in which he admits resemblance, he says there is not one of them which was not given to the public in some or many works prior to The Architectural Dictionary; that some of these prior works were the works of Nicholson himself, as the articles of architecture in Rees' Cyclopaedia, and the same articles in Brewster's Encyclopedia, and The Carpenter's Guide, published in 1792. And he says further, that not only were these figures extant prior to The Architectural Dictionary, but that the Nicholsons had not, in fact, recourse to The Architectural Dictionary for them, nor to any materials collected for The Architectural Dictionary. Upon reference to the prior publications, it is proved to be indisputably true, that there is not one of these figures which had not been given to the world prior to The Architectural Dictionary; and the matter not being new, the author of The Architectural Dictionary could acquire no property in these figures except by a new arrangement; but there is clearly no novelty in his arrangement. The figures of The

Architectural Dictionary are introduced to illustrate the letter-press; and so are all figures in prior works, as well as in The Practical Builder.

"If, therefore, the figures furnished by Nicholson for The Practical Builder had in fact been copied from The Architectural Dictionary, this would have been no piracy, because the author of The Architectural Dictionary had no property in these figures. But the Nicholsons, both father and son, positively swear that these figures were not copied from The Architectural Dictionary, nor from any materials collected for The Architectural Dictionary.

"With respect to the letter-press, the affidavits filed by the plaintiff do not point out particular instances of invasion; but upon the motion, I was referred to the article Roofs, which is nearly a *verbatim* copy of the same article in The Architectural Dictionary. The defendant's answer here is the same as to the figures. This article was published *verbatim* in the Encyclopedia prior to The Architectural Dictionary, and is not therefore the property of the plaintiff."

The other part of the proposition may be illustrated by the case, already stated, of maps and engravings borrowed from copyright maps and engravings, without any resort to the originals or to any common sources. *Wilkins v. Aiken*, 17 Ves., 422, 424, 425; *Mathewson v. Stockdale*, 12 Ves., 270; *Longman v. Winchester*, 19 Ves., 269. In *Roworth v. Wilkes*, 1 Crompt., 94, which was, among other things, an action for pirating certain prints in a work on fencing, it appeared in evidence that three of the engravings of the defendant represented figures in exactly the same attitudes as the plaintiff's, but disguised by a different costume. Lord Ellenborough, on that occasion, said: "But it is still to be considered whether there be such a similitude and conformity between the prints that the person who executed the one set must have used the others as a model. In that case, he is a copyist of the main design. But if the similitude can be supposed to have arisen from accident, or necessarily from the nature of the subject, or from the artist having sketched designs merely from reading the letter-press of the plaintiff's work, the defendant is not answerable. It is remarkable, however, that he has given no evidence to explain the similitude, or to repel the presumption which that necessarily causes." And the verdict was for the plaintiff. Now, it is quite as remarkable that the defendant Davies has not (as far as I recollect) given any evidence as to what sources he examined in the compilation of his own work; and this coupled with the fact that he has offered no denial, or proof that he had not seen or read the plaintiff's book before his own compilation was made, is certainly a circumstance of some significance. It is in the highest degree probable that he had seen and read some of the works on arithmetic, referred to by the witnesses, before his compilation was made, such as Colburn's Arithmetic, Leslie's Philosophy of Arithmetic, Adams' Arithmetic, Develey's Arithmetique d'Emile, for they are all to be found in the library at West Point, where he was a professor. But it is far from being certain that he had ever seen Francoeur's Cours complet de Mathematique Pures, or Jonaune's Arithmetique Elementaire; and there is no pretense to say that he had seen or used Wallis' Arithmetic. But neither of these works embraces in itself the same plan, method, arrangement, tables and examples, in the same connection, or for the same purposes, or in the same progressive order of lessons, as the plaintiff's. Adams' Arithmetic is wholly different. Colburn's Arithmetic approaches the nearest to the plaintiff in its use of unit marks. But it differs from the plaintiff's in this material respect: that in Colburn's, the unit marks

are in a separate pamphlet from the text, and need, of course, the aid of an instructor. In the plaintiff's, they are united, and the child instructs himself.

Now, it is by no means clear that the defendant Davies, without consulting the plaintiff's work, was in fact led to the same course of lessons, examples, and illustrations, and tables, which he has used in the first twenty pages of his work on Addition, and which bears so close a resemblance to the first eighteen pages of the plaintiff's work. And the question then comes to this: whether he has, in substance, copied these pages in plan, method, arrangement, illustrations and tables, from the plaintiff's work, with merely colorable alterations and devices to disguise the copy, or whether the resemblances are merely accidental, and naturally or necessarily grew out of the objects and scheme of the defendant Davies' work, without any use of the plaintiff's. If the defendant Davies had before him, at the time, the work of the plaintiff, and used it as a model for his own plan, arrangements, examples and tables, then I should say, following the doctrine of Lord Ellenborough in *Roworth v. Wilkes*, that it was an infringement of the plaintiff's copyright, notwithstanding the alterations and disguises in the forms of the examples and unit marks. Lord Mansfield, in *Sayre v. Moore* (cited 1 East, 361, 362), said: "In all these cases the question of fact to come to a jury is, whether the alteration be colorable or not. There must be such a similitude as to make it probable and reasonable to suppose that one is a transcript of the other, and nothing more than a transcript. So in the case of prints; no doubt different men may take engravings from the same picture. The same principle holds in regard to charts: that a man who has it in his intention to publish a chart may take advantage of all prior publications. There is no monopoly in the subject here, any more than in the other instances. But upon a question of this nature the jury will decide whether it be a servile imitation or not." Observe, his lordship does not say a mere literal copy, but a servile imitation. In *Trusler v. Murray*, 1 East, 362, note, Lord Kenyon put the point in the same light, and said: "The main question here was, whether, in substance, the one work is a copy and imitation of the other; for, undoubtedly, in a chronological work (the case before the court was of that nature), the same facts must be related." The same doctrine was recognized by the court of king's bench, in *Cary v. Longman & Rees*, 1 East, 358; and it was fully acted on in *Mathewson v. Stockdale*, 12 Ves., 270, and *Longman v. Winchester*, 16 Ves., 269, and *Wilkins v. Aiken*, 17 Ves., 422, 424, 425, in the court of chancery.

§ 276. *True test of piracy.*

I think it may be laid down as the clear result of the authorities in cases of this nature, that the true test of piracy or not is to ascertain whether the defendant has, in fact, used the plan, arrangements, and illustrations of the plaintiff, as the model of his own book, with colorable alterations and variations only to disguise the use thereof; or whether his work is the result of his own labor, skill, and use of common materials and common sources of knowledge, open to all men, and the resemblances are either accidental or arising from the nature of the subject. In other words, whether the defendant's book is, *quoad hoc*, a servile or evasive imitation of the plaintiff's work, or a *bona fide* original compilation from other common or independent sources.

§ 277. *As to the use in a book of old tables.*

In respect to the Abacus, I throw it, at once, out of the case. The controversy is not, here, in respect to a patent for a machine, embodying the Abacus, but in respect to the copyright of a book, instructing by lessons in an entirely

different form and method. The Abacus may have suggested means of instruction by signs; but it is not a book, and has not the same identical objects, uses, and methods of instruction. In comparing the book of the plaintiff with that of the defendant Davies, in the first eighteen to twenty pages, the tables appear to be identical. It is said that there is nothing new in these tables. That they are well known, and were in common use, long before the plaintiff's work was published. Be it so. The question is not whether such tables existed before, but whether the use and arrangement of them as a part of plaintiff's book is new and has not been borrowed by the defendant from the plaintiff. In each book they stand at the bottom of the page or lesson, and are used for the same purpose, to fix in the memory what has been previously taught in the lesson which precedes it. Then again, the mode of illustration by progressive lessons, and visible unit marks, is the same in each, and is used for precisely the same purpose. Take, for example, pages 10 and 11 of Davies and compare them with pages 8 and 9 of Emerson; each puts the question in the same form, and each suggests the answer by visible unit marks. The unit marks in Davies are, uniformly, a star; the unit marks in Emerson are various — trees, apples, horses, chairs, etc. But will it be contended, that, if in all other respects these twenty pages were identical, the substitution of a star for other figures, or of one figure for another, would have made these pages substantially different? I presume not. The change of costume of the fencing figures, in the case before Lord Ellenborough, was treated as a mere evasion.

The two principal differences between the book of the defendant Davies and that of the plaintiff, in the pages in Addition, already referred to, seem to be, first, that Davies uniformly uses stars as unit marks, and the plaintiff a great variety of different figures to illustrate the questions; and secondly, that Davies there omits all the different modes of illustrating the questions by putting cases which the plaintiff uniformly uses. Thus Davies puts the question, "One and two are how many," merely, and then places a star under one, and two stars under two; whereas the plaintiff puts the case thus: "Tell me how many trees are one and two trees," placing the figure of a tree by itself, and then the figures of two trees together, and then comes the question in the abstract, "One and two are how many." Davies, however, puts divers illustrative examples (see pages 20, 21), but they are placed in a subsequent page, and are not a part of the original lesson, nor put in juxtaposition. In each book (as has been already remarked), tables exactly alike follow at the bottom of the page, to be committed to memory as the result of the lesson. The resemblances in the title or section of Subtraction in Davies are not so striking. The questions there put, and the tables there given, are of a similar nature; but the stars are omitted. But it is principally in the title or section of Addition that the resemblances are so close and exact as directly to raise the question whether the title or section of the one book was borrowed, with colorable alterations only, from the other.

§ 278. *The injunction may go to a part of an infringing work.*

If it was, then, *quoad* this title or section, the injunction ought to be granted, although the rest of the work of Davies may not infringe any part of that of the plaintiff; for, to amount to an infringement, it is not necessary that there should be a complete copy or imitation in use throughout; but only that there should be an important and valuable portion, which operates injuriously to the copyright of the plaintiff. The case of *Wilkins v. Aiken*, 17 Ves., 422, and *Bram-*

hall v. Holcomb, 3 Mylne & C., 737, 738, and Campbell v. Scott, 11 Simons, 31, fully establish this position. See, also, Mawman v. Tegg, 2 Russ., 385, 397-400. Nor is it any objection to the injunction, that if it goes to part of a work it may render the other part, which is original, wholly without value, or injuriously diminish its value. The answer to this suggestion, if made, is to be found in the language of Lord Eldon, in Mawman v. Tegg, 2 Russ., 388, 390. His lordship there said: "As to the hard consequences which would follow from granting an injunction, when a very large proportion of the work is unquestionably original, I can only say, that, if the parts which have been copied cannot be separated from those which are original, without destroying the use and value of the original matter, he who has made an improper use of that which did not belong to him must suffer the consequences of so doing. If a man mixes what belongs to him with what belongs to me, and the mixture be forbidden by the law, he must again separate them, and he must bear all the mischief and loss which the separation may occasion. If an individual chooses in any work to mix my literary matter with his own, he must be restrained from publishing the literary matter which belongs to me; and if the parts of the work cannot be separated, and if by that means the injunction, which restrained the publication of my literary matter, prevents also the publication of his own literary matter, he has only himself to blame."

§ 279. *An imitation may amount to an infringement.*

It has been truly said that the subject of both of these works is of such a nature that there must be close resemblances between them. But the real question on this point is not whether such resemblances exist, but whether these resemblances are purely accidental, and undesigned, and unborrowed, because arising from common sources accessible to both the authors, and the use of materials open equally to both; whether, in fact, the defendant Davies used the plaintiff's work as his model, and imitated and copied that, and did not draw from such common sources or common materials. Then, again, it has been said that, to amount to piracy, the work must be a copy and not an imitation. That, as a general proposition, cannot be admitted. It is true the imitation may be very slight and shadowy. But, on the other hand, it may be very close, and so close as to be a mere evasion of the copyright, although not an exact and literal copy. And again, it is said that the plan of the work of the defendant Davies is different from that of the plaintiff's. The volume is but the commencement of a course of mathematics. It may be true (but into this I do not inquire) that, taking the entire volume, the other parts may not be executed upon the same plan as the plaintiff's. But, then, if it substantially includes the essential parts of the plaintiff's plan, of his arrangement, examples and tables, so as to supersede the work of the plaintiff, it is a violation of his copyright. It is like the case of publishing the substance of an article of an author in an encyclopedia; or the substance of a volume of poems of an author in a work purporting to contain extracts from his works and those of other authors. Yet in each of these cases the copyright of the author is violated. The cases of Mawman v. Tegg, 2 Russ., 388, and Campbell v. Scott, 11 Simon, 31, abundantly establish this. The plaintiff's volume consists but of forty-eight pages; and if it turns out that twenty or more of them have been so closely imitated by the defendant Davies, and that it superseded that of the plaintiff, it will be difficult to say that it is not an infringement of his copyright.

I have bestowed a good deal of reflection upon this case; and, at last, I

feel constrained to say that I am unable to divest myself of the impression that, in point of fact, the defendant Davies had before him, when he composed his own work, the work of the plaintiff, and that he made it his model, and imitated it closely in his title or section of Addition, and, in a great measure, in that of Subtraction also. The coincidences in plan, arrangement, modes of illustration and tables appear to me to be too exact and various to have been wholly accidental and without resort to the plaintiff's work. Both of the works appear to me to be highly meritorious; which is the most useful and convenient in practice it is no part of my duty to consider or decide. That properly belongs to another tribunal—the public. Nor do I mean to suggest that the defendants have not acted with entire good faith; although I cannot but think they have acted under a mistake of the law. I strongly incline to the opinion, although I admit the case is not free from all difficulty, that it is my duty to order an injunction as to all the book of the defendant Davies, from the tenth to the nineteenth pages inclusive, and from the twenty-fifth to the thirty-fourth pages inclusive.

My only doubt has been whether, under all the circumstances of the case, I ought not to direct an issue to try the question of the violation of the copyright as was done in *Bramhall v. Holcomb*, 3 Mylne & C., 737. If such an issue were directed I should order it to be tried by a jury at the bar of this court, in the following form, and confined to that: the jury to find whether the defendant Davies, in his book entitled *First Lessons in Arithmetic*, stated in the case, in the pages thereof from the tenth to the nineteenth pages inclusive, and from the twenty-fifth to the thirty-fourth pages inclusive, and from the thirty-seventh to the forty-fourth pages inclusive, did use the work of the plaintiff entitled *The North American Arithmetic, Part First*, stated in the case, as a model, and copy or imitate the plan, arrangement, mode of illustration, and tables thereof, or whether the same pages of the work of the said Davies were prepared without knowledge or use of or reference to the said work of the plaintiff, and the coincidences therein arose from the use of common sources of information and common materials, open to both, and were accidental and undesigned. If the defendants shall elect the trial of such an issue, I shall be willing to grant it upon the terms that they pay the ordinary taxable costs of the suit to the plaintiff up to the present time, the expense of the printing of the record being divided between the plaintiff and the defendants; and the future costs to abide the result of the verdict and decree of the court.

In case such an issue shall be elected, no other evidence is to be laid before the jury except that contained in the record and the works therein referred to—with this qualification and enlargement, that the defendants shall be at liberty to offer evidence (if they choose) to show what were, in point of fact, the original sources and works to which the defendant Davies resorted, or which he used in compiling his work; and the plaintiff shall also be at liberty to offer evidence (if he chooses) that the defendant Davies had before, or in compiling his work, seen, known and used the plaintiff's work; and for this, and for no other purpose, the plaintiff shall be at liberty to require the defendant Davies to answer upon oath such written interrogatories as to his having seen, known or used the plaintiff's work before or in compiling his own work, as he shall be advised.

The defendants are to elect whether they will take an issue or not, on or before the 1st day of September.

WEBB v. POWERS.

(Circuit Court for Massachusetts: 2 Woodbury & Minot, 497-524. 1847.)

STATEMENT OF FACTS.—Plaintiffs claimed to be the owners by assignment of the copyright of a work called “Flora’s Interpreter,” prepared by Mrs. S. J. Hale. The work complained of, as an infringement of their copyright, was “The Flower Vase,” by Miss S. C. Edgerton. The answer denied plaintiffs’ title, the validity of their alleged copyright, or that defendants had infringed. The master, to whom a reference was made, found that there was no infringement.

§ 280. *Assignment of copyright. Validity as between the parties without recording.*

Opinion by WOODBURY, J.

Several objections are urged in this case against a recovery by the plaintiffs, which are formal rather than substantial. One is, that the assignments, under which they claim, do not appear to have been recorded. But they are still valid as between the parties, and as to all persons like the defendants, not claiming under the assignors. See cases in *Leland v. The Medora*, Mass. Dist., October, 1846, 2 Woodb. & Min., 92.

§ 281. *An allegation of citizenship not denied in the answer is taken to be true.*

Another is, that the plaintiffs are not proved to be citizens of the United States. But that being averred in the bill, and not denied by the answer, must be considered as admitted. There are some other objections which have either been removed by evidence, or probably may be; and hence, if the case can be decided on the merits, without delay and expense as to any formal objection, it will be better for both parties that this should be done.

§ 282. *A master’s report in chancery, though presumably correct, may be re-examined.*

Passing by, then, the other preliminary exceptions, how does this case stand on the merits? The report of the master is in favor of the defendants. From the care evinced in the examination and the high character of the gentleman who made it, much weight must be given to its conclusions. But the parties are entitled to a revision of it here, and, though the presumptions are in its favor at the outset of the examination, yet if it cannot stand the scrutiny to which it has been subjected in argument, and which the court is bound to bestow on it, the plaintiffs ought to succeed.

§ 283. *In some kinds of books, such as dictionaries, etc., the copying of small parts and other like similarities are tolerated.*

It may conduce to a more lucid exposition of the merits between these parties, as to the originality of their respective books, to ascertain first what each claims as novel or peculiar. Neither of the parties makes any pretense to be inventors of dictionaries of flowers. Whether arranging them alphabetically or scientifically, and whether describing and defining them in prose or poetry, according to their classes and orders, or their medical virtues, or the sentiments they are accustomed to inspire, and whether illustrated by engravings of them, or the opinions of those most experienced in the beautiful hues and figurative language of flowers,—all this had been done before the first of these publications. It had been done, too, not only abroad, but in this country, and more especially in the “Flora’s Dictionary,” published in Baltimore in 1830, and republished in 1831, with the reputation of having been compiled by Mrs.

Wirt. In the preface to the plaintiffs' book Mrs. Hale acknowledges her obligations to other writers on this subject, and more especially to the author of *Flora's Dictionary*, just described. And in the preface to the book of the defendants, Miss Edgerton also expresses her indebtedness to others who had labored in this garden before her, and especially to the "*Flora's Interpreter*" of the plaintiffs. Again, there is much discrimination to be used, in inquiries of this character, between different kinds of books, some of which, from their nature, cannot be expected to be entirely new. Thus, dictionaries of all descriptions when on like subjects, philological, lexicographical, professional or scientific, must contain many definitions and descriptions almost identical; as must gazetteers, grammars, maps, arithmetics, almanacs, concordances, cyclopædias, itineraries, guide books and similar publications. In these, if great errors have not previously existed, or unusual ignorance to be corrected, no great novelty is practicable or useful; unless it be to add new discoveries or inventions, new names, or words, or decisions, so as to post up the subject to more recent periods, or unless it be to abridge and omit details and condense a more voluminous work into a smaller and cheaper form, so as to bring its purchase and use within the reach of new and less wealthy classes in society. Some similarities and some use of prior works, even to copying of small parts, are in such cases tolerated, if the main design and execution are in reality novel or improved, and not a mere cover for important piracies from others. *Trusler v. Murray*, 1 East, 362, note; *Gray v. Russell*, 1 Story, 11 (§§ 129-33, *supra*); 12 Ves., 270; 16 id., 269; 17 id., 422.

What was there novel then in the combination and materials of the plaintiffs' book which the defendants have copied? Nothing in the arrangement, except that the "class and order and description of the flower" are placed on the same page with its name and interpretation, instead of being in notes at the end, as in the second edition of *Flora's Dictionary*. In the materials there is also a novelty in the special designation of the sentiment in the plaintiffs' book, which is not in *Flora's Dictionary*. But the defendants have not imitated that, and hence it becomes unimportant. All, then, which the defendants have copied in the arrangement which did not exist in other books than the plaintiffs', and to which the plaintiffs of course have no exclusive claim, is the mere transfer of the notes to the same page with the flower to which they relate,—a closer juxtaposition; and all in the materials of the plaintiffs which are original, and have been copied *verbatim*, are a few "poetic significations" or definitions, being about twenty in one hundred and forty-eight, and consisting of only one hundred and fifty-six words out of the whole volume. In three or four other instances some of the significations are varied in form slightly, but not in substance; and, in nineteen cases, parts of the descriptions of flowers, and their localities, in prose, are used by the defendants, which were employed by the plaintiffs. The defendants offered to prove, in explanation of this, that the plaintiffs had copied in this way still more extensively from others; and it is difficult to conceive of different works, describing the appearance and locality of the same plants, not using like language, and often in some particulars the same, if the plant or flower has been long known; and the notices of them are as in these cases very brief, being embodied frequently in a single line.

§ 284. *Rights of compilers of old materials.*

In compiling dictionaries of all kinds, gazetteers and similar works, the materials of all must, to a considerable extent, be the same, and to such an

extent are allowable; and the novelty or improvement, as before remarked, can be substantial in scarcely any case, unless the matter is usefully abridged in bulk and price, or a material change is made in arrangement, or more modern information is added in valuable quantities, or important errors are corrected, or important omissions are supplied. While, on the one hand, a prior compiler is not permitted to monopolize what was not original in himself, and what must be nearly identical in all such works on a like subject, yet he who uses it subsequently to another must not employ so much of the prior arrangement and materials as to show that the last work is a substantial invasion on the other, and is not characterized by enough new or improved to indicate new toil and talent, and new property and rights in the last compiler. That is the cardinal distinction.

Thus a material addition is made to a common dictionary which shall, like Webster's, add definitions of a large number of words before omitted; or quotations from the authors who have employed the words in the sense adopted, like Johnson's; or rules for the proper pronunciation of each word, like Walker's; or the roots from which the word has been derived, like several others. And no one would complain of a new dictionary as an infringement on former ones if it contained any of these important additions, and had not in other respects servilely copied but a few definitions of old words from any one former author. Now, was the defendants' book of this character or otherwise? A little further scrutiny into this case will show whether the change here by the defendants was real or only colorable. They followed, to be sure, the arrangement of the plaintiffs, but that arrangement was not novel with them, except putting on the same page one part of the account of the flowers which before had been placed in notes at the end. This could hardly be deemed of sufficient importance to justify a prosecution, unless connected with other infringements as to materials and design, or unless this was a change more essential in some other respects than a mere transfer of similar matter from one page to another. But of this more hereafter. Besides this, however, it is contended that the defendant has copied materials, and design also, to such an extent as to be convicted of a substantial infringement.

§ 285. *Leading inquiry in this case on the question of infringement.*

The leading inquiry then arises, which is decisive of the general equities between these parties, whether the book of the defendants, taken as a whole, is substantially a copy of the plaintiffs'? whether it has virtually the same plan and character throughout, and is intended to supersede the other in the market with the same class of readers and purchasers, by introducing no considerable new matter, or little or nothing new, except colorable deviations?

We have already stated the quantity of materials literally copied, amounting to only about one hundred and fifty-six words. Perhaps half as many more may be considered substantial uses of the plaintiffs' book. But what are the differences? numerous or not? essential or trivial? To illustrate the differences in these two works, in order to see whether they are substantial or otherwise, it will be necessary to compare first their prefaces. They of course profess to relate to like subjects, as do all modern Floras of this character, and must therefore, as before remarked, contain something of the same matter. But do they really and materially in any respects differ? Their claims and pretensions, in the prefaces, are certainly not the same. The book of the plaintiffs claims merely some novelty in its arrangement, and the use of American poetry to illustrate what is there called the sentiment of flowers. The

novelty in arrangement, as before shown, does exist, but is very trifling so far as regards anything imitated by the defendants. But there was another novelty, perhaps more material, which was not imitated by them, in giving first some European or anonymous poetry on the signification of each flower, and then separately some remarks by American authors, illustrative of the sentiment inspired by each flower. This last, and this substitution of American sentiments and authors for foreign ones, seem to me to constitute the great novelty and attraction of the plaintiffs' book, in its matter, over others on this subject, which had preceded it. In this way quotations are introduced from sixty to seventy different American poets, and twenty to forty pieces from some of them, besides the many beautiful extracts given from foreign poets under the other head of illustrating the "signification of flowers." In this way the authoress of the plaintiffs' book was original, in these important particulars, but not in giving a poetical language to flowers, or discussing a sentiment in them, a symbol of affection, as these had existed here before and in Europe, and in the East for ages, if not since Paradise. This authoress also attempted to unite some botanical instruction with poetry; but that was not a new union or combination, nor did she, however highly gifted and favorably known, in other respects, pretend to furnish any scientific information beyond what is contained in Linnæus, Jussieu, Eaton and other botanists, nor even to emulate Darwin's "Loves of the Plants."

On the other hand, what novelty did the authoress of the defendants' book aim at? the same? or none? She claimed none in the arrangement, and that of other writers on flowers, and that especially in the plaintiffs' book, where original, was in some degree followed, as before shown, in transposing notes from the end to the page to which they apply. But even in arrangement the last was not like the plaintiffs' in a few important particulars. There is not one piece of poetry cited to show the signification, and another piece to show the sentiment, as in the plaintiffs', but generally only a single piece for each flower, and that to illustrate merely what she calls the sentiment. But in materials, the defendants' book furnishes, and professes to furnish, a striking difference. The poetry, instead of being quoted from American authors of celebrity, like the plaintiffs', claims to be chiefly original by Miss Edgerton herself, and her title to it is not denied in the answer or the argument. The substance, the staple of the book, is then truly original, and not colorably so; as much as if she had undertaken to publish a volume of poetry, chiefly original, on the subject of flowers.

Again, Mrs. Hale's book, belonging to the plaintiffs, is one in several respects of higher and more ambitious pretensions than the defendants'; pretensions, too, well sustained. It is an octavo volume. It consists of some two hundred and twenty-four pages. It has two colored engravings; has a double index, one to the flowers and one to their interpretations, and double pieces of poetry to each flower, usually extracted for one purpose from distinguished foreign poets, and for the other from distinguished Americans; and has five pages of instruction and explanations in botanical science as an introduction; and has been sold per copy at \$1 or \$1.25. While, on the other hand, the defendants, in the preface, claim only the merit of a book on the subject much less expensive, and chiefly original in all its poetry instead of extracts from eminent writers; and it is only a small duodecimo instead of an octavo, with but one hundred and fifty-one pages of that reduced size instead of two hundred and twenty-four, and of larger size; and it has no scientific intro-

duction on botany, has no plates or engravings, and only one index to the flowers; has no double illustrations of the signification and sentiments, and sells for merely twenty-five cents a copy, or less than one-fourth of the price of the other.

On a computation it will be found that the plaintiffs' book is on so different a scale as to contain near three times more matter than the defendants', besides being so different in the substance and originality of it; and that it illustrates many more flowers, being two hundred and thirty, while the defendants' illustrates only one hundred and forty-eight. The stock used in each per volume differs in a still greater ratio; and in the defendants', from its smaller type as well as less matter, is probably not one-fourth of that in the plaintiffs'.

For a further illustration, using their own favorite language and symbols, both of these works are flowers, and not destitute of charms; but one is more like the magnolia grandiflora or japonica in size and attraction, and the other like the wayside violet or anemone. They both come from females, with loveliness peculiar to their sex, but they still essentially differ; as one develops matronly experience and more ripened graces, while the other is just opening her buds and blossoms.

It will thus be seen that the book of the defendants is much less complete and useful than that of the plaintiffs; is suited for a different and humbler class of readers; and would, in truth, be little more than an abridgment if its poetry was not chiefly original and some of its other features so different. See the case of Johnson's *Rasselas*, in *Dodsley v. Kinnersley*, Amb., 403; *Bell v. Walker*, 1 Bro. Ch. C., 451; *Godson on Pat.*, 339.

Considering then its form and substance, its design and use, my mind strongly inclines to the conclusion that the aim of Miss Edgerton in preparing the defendants' book was in truth what she describes it to be in her preface—to furnish original poetry on the sentiment of flowers, and to do it in such a form as to be much less expensive, and to circulate in hands which could not so well afford to purchase the existing and larger and more expensive treatises on that subject. In effecting this object she did not aspire to novelty in arrangement or discoveries in science as to botany, but in some respects copied from others, and among them from Mrs. Hale, as she had a right to do in some degree and to some extent, if it was not her main design to compile a like treatise with only colorable but not real differences. The copying of errors or mistakes in such cases is therefore not unusual, and only shows the fact more clearly of the actual copying in those particulars, but cannot affect the question whether they are enough in quantity and value to characterize the whole work or its main design to be a piracy. 12 Ves., 270; 17 id., 422; 1 East, 363; *Mawman v. Tegg*, 2 Russ., 385. That depends on other considerations.

Believing then the main design in the defendants' book to have been different in important respects from that of the plaintiffs', in regard to the production and publication of original rather than extracted poetry to illustrate the sentiment of flowers, and in several things varying in material details from the plaintiffs', with a view to make it less expensive and to circulate among a different class of readers rather than be a substitute with the same class, I see in this no infringement on the copyright of the plaintiffs, and do not consider this design and the execution of it to be void, because in carrying it out a use is made in its botanical descriptions of former works to some extent and their arrangements in part copied. *Wilkins v. Aiken*, 17 Ves., 422; *Godson on Patents*, 215; *Cary v. Kearsley*, 4 Es. C., 168.

More especially the plaintiffs cannot complain of this, when they have done the same as extensively in respect to others. The nature and value of the parts copied, being chiefly definitions and descriptive epithets, indicate no appropriation of much mental toil in others, any more than does the small quantity. White flowers must in all such books be described as "white," and red as of a "red hue," and those from India as belonging to the East; and it is so in like cases and of like character in several of the similarities here. 3 Mylne & Cr., 740; 4 Es. C., 168. They could not be described in any other way if described naturally and truly. But when these copyings or close resemblances have gone further, and beside the few lines of description and the few parts of others have encroached on one feature in the arrangement, new or peculiar in the plaintiffs' book, they do, thus combined, probably constitute a legal infringement of their copyright; but they hardly seem to furnish a sufficient ground for the extraordinary interposition of this court by a permanent injunction. I say, both combined; for in a work of this character, partaking so much of the nature of a dictionary, these copies of definitions, so few and unimportant in number and value compared with the whole work, are not, independent of following the plaintiffs' plan, to be regarded as a violation of the plaintiffs' copyright when the main design is of a new and different character. They are nothing compared with what is ordinary and almost inevitable in all new works on such a subject. Nothing compared with what is usual in reviews of a work, and is there allowable as being neither a rival nor substitute. *Bramwell v. Halcomb*, 3 Mylne & Cr., 738.

§ 286. *As to abridgments.*

Nothing improper in an abridgment. If the leading design is truly to abridge and cheapen the price, and that by mental labor is faithfully done, it is no ground for prosecution by the owner of a copyright of the principal work. *Godson on Pat.*, 238; 1 Story, R., 19. But it is otherwise, if the abridgment or similar work be colorable and a mere substitute. *Butterworth v. Robinson*, 5 Ves., 709.

One test of this is the quantity and value of the matter extracted. In 1 Camp. N. P., 97, a case is stated of seventy-five pages copied out of one hundred and eighteen. In 2 Rus., 388, the close imitation of copying was twenty pages out of forty-eight, or nearly one-half, and hence vitiated the work. 11 Lew., 31. And in 1 East, 363, twenty pages were copied *literatim et verbatim*. Here it is but parts of twenty or thirty lines out of near seven thousand. The former, so great a quantity, indicates theft, *animus furandi*. The latter, so small a quantity, indicates rather illustration, and comports with the preface acknowledging aid from the plaintiffs' work, but having some different and material purposes to accomplish, and not being a mere substitute with no essential changes. *Godson on Pat.*, 216; *Eden on Injunction*, 381, n.; *Roworth v. Wilkes*, 1 Camp. N. P., 97; 2 Kent's C., 382; 8 Ves., 225. Where nine-tenths were copied an injunction was clearly proper (1 East, 358), but not where only one-tenth was copied. *Ambler*, 403. See, also, *Folsom v. Marsh*, 2 Story, 100 (§§ 249-56, *supra*). Or, as here, not one two-hundredth.

§ 287. *Where the novelty in the arrangement of complainant's book has been copied, though only in part, an injunction will issue as against such part. But if the matter cannot be easily separated, the party will be left to his action at law.*

But the aspect of this case becomes somewhat different and more favorable to the complainant when we add to this the other circumstance that a small

part of the novelty in the arrangement has been imitated. Though small in value, such an imitation or appropriation of another's invention may be actionable; and the subject of an injunction, perhaps, if easily separated from the rest of the book. *Emerson v. Davies*, 3 Story, R., 768 (§§ 270-79, *supra*); *Lewis v. Fullarton*, 2 Beav., 6; *Barfield v. Nicholson*, 1 Sim. & Stuart, 1, 6; 16 Ves., 270; *Wilkins v. Aikin*, 17 Ves., 424; *Stockdale's Case*, 12 Ves., 270; *Gray v. Russell*, 1 Story, R., 11 (§§ 129-33, *supra*).

But it is doubtful whether this small transfer of matter to a new place is sufficient alone to sustain a copyright without some new and additional materials; and more doubtful still whether an injunction ought to issue, when the whole is pervaded or leavened by it, and the whole destroyed on account of it, rather than damages given only to the extent or value of the encroachment. But here the adoption of the new feature in the arrangement, however small it be, pervades the whole work, and no permanent injunction can issue against it without destroying the whole work as now compiled.

I think, therefore, that such a remedy, applied to a case situated like this, would be disproportionate, unsuited to the case, and hence unjust. Whatever damages the plaintiffs have thus sustained may, however, be obtained by a suit at law, without destroying the whole work; and that is therefore the more equitable relief in a state of facts like these. *Drewry on Inj.*, 199; *Bell v. Whitehead*, 17 Law Journal, 441; 9 *id.*, 323; 1 East, 385.

On the contrary, where the violation is clear, and the part copied can readily be separated, then an injunction is usually proper against that part. *London Lat. Comp. v. Bedells*, *Webster on Patents*, 140; 13 Rep. of Arts, 167; *Emerson v. Davies*, 3 Story, 768 (§§ 270-279, *supra*). So, where a party wilfully mixes or interweaves the property of another with his own with a bad motive, and so as not to be easily separated, he may be required at times to lose the whole. 2 Russ., 385; 2 Bro. Ch. C., 85. But here the motive does not seem to have been culpable, the plan cannot be separated from the work, and the plaintiffs can obtain ample redress at law in damages without destroying the whole.

Both parties have relied upon the opinion of the district judge in this case, being in their favor, when refusing a temporary injunction, but ordering an account of sales to be kept and the plates not sold. He thought more light would be flung on the case at the final hearing by the testimony of Miss Edgerton being particular as to the extent she used and meant to use the plaintiffs' book. But neither party has asked leave to offer it, and the inclination of his mind seems to have been that the part of the arrangement claimed to be original by the plaintiffs, and followed by the defendants, was hardly sufficient to justify an injunction. A novelty in arrangement, especially so trifling as this, without any new material connected with it, seemed to him, and still seems to him to be, of questionable sufficiency to be protected by a copyright.

The master seemed to be of the same opinion on the ground *de minimis non curat lex*. Slight changes, like the use of chapters and verses, where none existed before, as some hundreds of years ago in the Bible, or the introduction of punctuation, which is said not now to exist generally in acts of parliament, or the use of sections instead of pages, which in modern times is reviving only an ancient practice, would all have higher claims to novelty and usefulness than merely transferring the same material from one page at the end to another in the central part of a book, as here.

Some machines have been changed merely by inverting their position; but they are not deemed entitled to protection. But, however this may be suffi-

cient or not to claim legal protection (and I am inclined to think it is), my opinion, as before intimated, is that the use of it should not be enjoined against, when it runs through the whole book, and cannot be separated from the rest. It would generally be equitable and just to let the party, under such circumstances, seek redress for it by damages in a suit at law. It is not a suitable case for the exercise of a peremptory injunction, which is chiefly to aid legal rights, and in cases of copyrights runs against specific parts copied. It is usually done to work substantial justice between the parties rather than destroy the whole book of the defendants, for the small infringement in the arrangement, if otherwise it was novel and unexceptionable and useful to the community. See cases where a part may be enjoined against: 17 Ves., 422; 11 Sim., 31; 2 Russ., 385; 3 Mylne & Cr., 737.

This conclusion renders it unnecessary to decide on the point how far the conduct of the plaintiffs, in the purchase and sale of the work of the defendants, and in some delay to prosecute, should bar this application, though redress might perhaps be still had at law. On this, see Eden on Inj., 207; 7 Ves., 1; 19 id., 447; 3 Mylne & Cr., 711; *Rundell v. Murray*, Jacobs, 311; *Lewis v. Chapman*, 3 Vern., 133; 8 Ves., 224, n. And for the same reason the motion by the defendants to file a supplemental answer, in order to allege that matter more specifically, need not be acted on. On the necessity for this, see 2 Daniel's Ch. P., 814; 3 Story, R., 456, 700. Delay in this bill is also urged against it; but length of time so as to bar, by any statute of limitation, must be pleaded. 19 Ves., 447; 2 Jacobs, 311; cases cited in *Hunter v. Marlborough*, 2 Woodb. & M., 168; *Taylor v. Benham*, 5 How., 233. And if to bar, independent of the statute, a change of circumstances and injury by the delay must appear.

Another point made was the master's refusal to go into an inquiry as to the extent of colorable imitations. Though in the master's situation I should have been disposed to make the inquiry, there was some ground for his refusal, after the hearing was over, it not having been pressed before. It is pretty decisive, however, that such instances were not frequent, or they would earlier have been suggested, or could more readily be pointed out. And there is no pretense that they can exist in the great mass of the defendants' book, as it professes to be original matter, and no exception has been made that it is not truly original.

The intent not to be guilty of piracy, which has likewise been referred to in the argument, would not be material, if much had actually been copied, and the new work was a mere substitute. But if this be doubtful, the intent not to pilfer from another, colorably or otherwise, for the substantial portions of the new work, may be important. In fine, as, from all the evidence in this case, it seems quite clear that the main intent was to make a much cheaper work, and one with original poetry, rather than colorably to republish the plaintiffs' or any similar book, I think the prayer for an injunction must be refused.

FARMER *v.* CALVERT LITHOGRAPHING, ENGRAVING & PUBLISHING COMPANY.

(Circuit Court for Michigan: 1 Flippin, 228-241. 1872.)

Bill to enjoin infringement of copyright and for an account. Motion to dissolve injunction. The facts are stated in the opinion.

§ 288. *Where an injunction has been granted by consent, upon motion to dissolve nothing will be considered but the questions raised by the answer.*

Opinion by LONGYEAR, J.

The preliminary injunction in this case having been issued upon the bill of complaint, by consent the court, in the absence of any pretense of fraud or mistake in the obtaining or giving of the consent, will not, upon the motion to dissolve, consider any questions arising upon the bill alone, or the complainant's right to bring the suit; the parties, the subject-matter, and the writ, appearing as they do to be within the jurisdiction of the court. 16 Statutes at Large, 215, sec. 106. The motion seems in fact to be based upon this idea, it being founded expressly upon the answer and accompanying affidavit. The complainant may, as was argued, have inserted in his bill prayers for specific relief to which he is not entitled in a court of equity. But with that we have nothing to do here, although it is a proper matter for consideration upon the final hearing. The only question now is whether the injunction shall be continued until final hearing and decree. The right of the complainant to have the injunction issue upon the case as made by his bill having been, as we have seen, conceded, the motion to dissolve must be considered solely upon the questions raised by the answer.

On the hearing of the motion, complainant's counsel offered to read affidavits for the purpose of rebutting certain averments of the answer as to complainant's title. Defendant's counsel objected. The court allowed the affidavits to be read subject to the objection, to be finally received or rejected as the court should decide.

The question of the reception of affidavits on motion for or to dissolve an injunction in copyright cases, for the purpose of rebutting averments in the answer as to complainant's title, has undergone much discussion in the courts. In England it seems to be well settled that such affidavits will not be received, the complainant being left to depend upon the affidavits filed with his bill so far as the question of title is concerned. *Norway v. Roe*, 14 Ves. Jr., 144, 151, 156, and cases there cited; *Platt v. Button*, id., 447. In the United States, although a practice seems to have grown up in some localities to receive such affidavits, yet whenever the question has been raised and adjudicated the decisions of the courts, with scarcely an exception, seem to have been quite to the contrary, and in conformity with the English practice.

§ 289. *Affidavits in rebuttal of answer cannot be allowed on motion to dissolve.*

Counsel referred the court to numerous authorities on the question of allowing complainant to read affidavits in rebuttal of the answer in injunction cases generally (see cases cited in Hilliard on Injunctions, at page 107), but they failed to refer the court to any authority or adjudicated case upon this particular question of allowing such affidavits to be read after answer, in support of complainant's title, with perhaps the single exception of the case of *Poor v. Carleton*, 3 Sumn., 70 (EQUITY, §§ 1679-85), which upon the face of it appears to be exceptional. With the limited time I have had to spare amidst the discharge of other duties, I have been able to find but few decisions in this country upon the point.

Justice Grier, in 1850, in a patent case (*Parker v. Sears*, 1 Fish. Pat. Cas., 94), held that the United States circuit courts were bound to follow the settled rules of practice of the English courts of equity in this respect (there being no written rule of court to the contrary), and refused to allow such affidavits

to be read. In 1868, in another case (*Goodyear v. Mullee*, 3 Fish. Pat. Cas., 420), the same learned judge allowed affidavits by way of rebuttal to be read, but they in no manner related to the question of title.

In the case of the *United States v. Parrott*, 1 McAl., 271, 275, 276, the United States circuit court for California, McAllister, J., after an able review and full consideration of the authorities, English and American, including the case of *Poor v. Carleton*, *supra*, held that affidavits as to the title after answer could not be read on a motion for injunction to stay waste.

In *Brooks v. Bicknell*, 3 McL., 250, 255, Justice McLean quotes approvingly the language of the court in *Morphett v. Jones*, 19 Ves., 350, where it is said: "There are many cases of injunction where you may reply to the answer by affidavits, not on the question of title, but on mere facts, as in the instance of waste. On such questions of fact, though not on the title, affidavits in reply to the answer may be read." The learned judge then quotes from 1 Smith's Ch. Pr., where it is said: "If the plaintiff, instead of applying for the injunction upon affidavit, waits until the defendant has answered, he must rest his case upon the disclosures made by the answer, and he is not entitled, either for the purpose of obtaining or continuing an injunction, to read affidavits in support of his motion in opposition to the answer," and says: "But cases of waste, or of mischief analogous to waste, are an exception to this rule where the affidavits do not refer to title." That was a patent case, and, as the affidavits did not refer to title, they were allowed to be read.

§ 290. *Affidavits may be heard on the question of infringement.*

The current of authority seems to be all one way, and opposed to the reception of the affidavits. So far, therefore, as the affidavits offered refer to complainant's title, they must be rejected. They are received, however, and will be used so far as they bear upon the question of infringement. The motion to dissolve the injunction must, therefore, be decided upon the answer and accompanying affidavit, so far as questions relating to complainant's title are concerned.

§ 291. *Action at law not necessary to authorize relief in equity.*

There is a demurrer, by way of answer, to the bill as an injunction bill, which must be first disposed of. It is claimed that complainant is not entitled to an injunction for the reason that it does not appear by the bill that he has settled his right at law, and obtained a verdict of a jury in his favor touching the alleged infringement. Such, no doubt, was formerly the law, and now, in some cases, the court will, no doubt, require that to be done. But it is now well settled that both the right and the infringement may be set up and adjudicated in a court of equity without having been first determined at law. Phillips on Patents, chapters 20 to 24; Hill. on Inj., 391, 392; 2 Story's Eq., pp. 246-248; *Stevens v. Gladding*, 17 How., 447 (§§ 387-89, *infra*); *Motte v. Bennett*, 3 Fish. Pat. Cases, 642; *Ogle v. Ege*, 4 Wash., 584.

Suffice it to say, that under the authorities, and aside from the fact that the injunction was issued by consent, the present case is one in which the court will not send the parties to a court of law before proceeding to adjudicate upon the plaintiff's right to an injunction.

§ 292. *Waiver of penalties not necessary in bill for infringement. Omission of such waiver not good ground for demurrer.*

Another ground of demurrer is that the bill does not waive the forfeiture of the printed copies of defendant's map, and the penalty of \$1 for each copy, as provided by statute in such cases, but on the contrary prays that such for-

feiture and penalty may be inflicted in addition to the relief by injunction and an accounting for profits. The proposition here is, that equity will not grant its assistance by way of injunction and an accounting as to the profits, unless complainant, as a condition of his prayer for such assistance, shall expressly waive the forfeitures and penalty. No reason, based upon principle, is advanced in support of the proposition, neither can I see that any exists. It is claimed, however, that the proposition is supported by authority, and several English cases are cited. Some of the cases by their looseness of expression and generality of statement would seem to do so, especially the case of *Colburn v. Simms*, 2 Hare, 554. But it will be found upon scrutiny that the cases cited are all based upon the decision in the leading case upon this question of *Brand v. Cumming*, cited 22 Vin. Abr., 315, and that the rule deducible from them all goes to the following extent, and no further, viz.: That equity will not compel a discovery by a defendant when such discovery would subject him to forfeitures or penalties, unless such forfeitures or penalties are expressly waived by the bill; *provided*, the defendant takes the objection by demurrer to such discovery, or declines in his answer to make such discovery on that ground. *Brand v. Cumming*, 22 Vin. Abr., 315; *Williams v. Farrington*, 3 Brown's Ch., 38; *Mason v. Murray*, cited in last case, at page 40.

The defendant cannot submit to answer as to the discovery prayed, and at the same time insist upon the objection. In this case he has so submitted to answer. The objection, therefore, comes too late. The further objection that the statutory forfeitures and penalty can be enforced only at law does not concern the present motion, although it will be a proper matter for consideration in another stage of the case.

This brings us directly to the merits of the question upon the bill and answer. The question is, as has been already remarked, does the answer so far disprove the case made by the bill as to entitle the defendant to a dissolution of the injunction?

§ 293. *Denials or allegations on information and belief are not sufficient to dissolve an injunction.*

1st. As to complainant's title. This is set up in the bill with great particularity, and an undisturbed use and enjoyment of the same for a long period of time by complainant and those under whom he claims is alleged. The answer in the first paragraph ignores complainant's proprietorship of the copyrights of the twelve maps, as set up in the bill, and proceeds as follows: "But defendant says, as hereinafter particularly alleged, that complainant and his transferrers were never of right entitled to any such copyrights, and that the same, if existing, are null and void." What is referred to "as hereinafter particularly alleged" is found in paragraphs 50 and 51 of the answer, and consists in allegations wholly on information and belief, to the effect that complainant's maps were not themselves original, but were copies or piracies of the work and labors of other persons. The only other allegation or denial contained in the answer affecting complainant's title or right is the sixteenth paragraph, and is wholly on information and belief.

It is seen, therefore, that all the allegations and denials of the answer in any manner affecting complainant's title or right are founded on information and belief merely; and none of them are supported by affidavits of persons having any knowledge of the facts thus alleged. Denials and allegations merely on information and belief are not sufficient to entitle the defendant to a dissolution of an injunction. They must be upon personal knowledge or

supported by the affidavit of some person or persons having personal knowledge. *Poor v. Carleton*, 3 Sumn., 70, 78 (EQUITY, §§ 1679-85); *Nelson v. Robinson*, Hemp., 464; *United States v. Samperyac*, id., 118; *Conover v. Mers*, 3 Fish. Pat. Cas., 386.

For the purposes of this motion, therefore, the title of complainant must stand as set up in his bill.

2d. As to infringement. The bill sets up copyrights of twelve different maps, and contains a general charge of infringement of them all, and especially of the first six; and also special charges of infringement as to certain of the maps, particularly the first, second and fourth. The map first set up, and with which we have principally to do so far as this motion is concerned, is a map of Wisconsin, embracing parts of Illinois, Michigan and Minnesota, alleged to have been made and published in 1865, and to have been entered for copyright May 11th of the same year. Of this map, it is alleged in an amendment to the bill, editions were published and dated in the years 1866 and 1867. Copies of the said alleged edition of 1867, and of two others of complainant's maps, and of the defendant's map, alleged to be an infringement of the same, are filed with the bill as exhibits.

The answer, in general terms, denies the general charge, and also the special charges of infringement, but admits the taking of the boundaries of all the towns in Wisconsin, containing more than thirty-six square miles, from the complainant's map of 1867.

In addition to what is stated above, the bill contains voluminous references to instances of similarity and identity, gathered from examinations and comparisons, such as errors in complainant's maps, peculiarities of spelling and location of names, etc., as evidence of infringement; and the answer contains equally voluminous statements by way of explanation and avoidance of the same. These are merely matters of evidence. They were as fully before the court by means of the maps made exhibits as they could be by any statements in the bill, and, being made matters of evidence, the statement of them in the bill was not only unnecessary, but in violation of a well settled rule of equity pleading. See *Story's Equity Pleadings*, §§ 28, 252, note 1 to § 265a, and § 266. When it is necessary to bring such matters before the court for the purpose of moving for or of sustaining an injunction, or it is deemed important to call the attention of the court to them in some authentic form, it should be done by affidavit and not by allegations in the bill.

I allude to this subject in this connection, not so much because it is to materially affect the question now under consideration (the defendant having submitted to answer), but to call attention to the pernicious and growing practice of stuffing and overloading pleadings in equity with superfluous allegations and redundant and unnecessary statements; and also, as it is expressed in one of the ordinances of the English court of chancery, "to the end, the ancient brevity and succinctness of bills and other pleadings may be restored and observed."

§ 294. *New editions of maps are included in copyright acts of congress.*

In order to avoid the effect of the admission in the answer of the taking by defendant in the preparation of its map of certain township boundaries from complainant's map of 1867, it is contended, on behalf of defendant, that the said map of 1867 is not covered by the copyright of the map of 1865, as being a new edition thereof, because: 1. The copyright laws of the United States contemplate and cover new editions of books only, and not of maps. Section

4 of the supplemental act of March 3, 1865 (13 Stat. at Large, 540), is referred to in support of this proposition. But that section is definitive merely of the word "book" as used in the act, and in no manner affects maps or any subject of copyright other than books, affirmatively or negatively. It will be seen, however, by an examination of section 5 of the act of February 3, 1831 (4 Stat. at Large, 437), in force at the time, and section 97 of the act of July 8, 1870 (16 Stat. at Large, 214), now in force, that subsequent editions of maps, as well as books, were then, and continue to be, clearly contemplated. 2. It is also contended that the map of 1867 is not entitled to the protection of the copyright of the map of 1865 as a new edition, because it differs from the latter materially in respect to its title, and also in numerous additions and alterations. The title of the map of 1865, as set up in the bill, and that of the map of 1867, as printed upon its face, are identical, so far as they are descriptive of the map. Appended to the descriptive statement are the following words and figures: "Published by S. Farmer & Co., Detroit and Milwaukee, 1865," the figures "1865" being changed to "1867" on the map of that date, and this is the only difference alleged or that can be found in relation to the title. The clause quoted, and in which the difference of date occurs, is no part of the description of the map, and is entirely unnecessary to an understanding of that to which the title relates, and I think it constitutes no part of the title. It could not truthfully constitute a part of the title for the purpose of copyright, because by express enactment the title was, as it still is, required to be entered and recorded before publication. 4 Stat. at Large, 437, sec. 4; 16 id., 213, sec. 90. All that is required in connection with the fact of publication is the depositing of a copy or copies within certain specified times after publication. 4 Stat. at Large, 437, sec. 4; 16 id., 213, sec. 90. There is no time prescribed within which actual publication shall commence. That is left entirely to the option of the proprietor. The map of 1867 has, moreover, printed upon its face in a prominent position, and in plain type, the notice of entry for copyright required by law, showing clearly and plainly that the date of such entry was in the year 1865. I think this sufficiently indicated that the map of 1867 was intended for the map, or an edition of the map, which had been so entered as specified in the notice, so that the date at the bottom of the title, even if it could be considered a part of the title, would, in the light of the notice, indicate to any person of ordinary comprehension a map, or an edition of a map, which had been copyrighted in 1865 and published in 1867. This case is very different from the cases cited by defendant's counsel (*Baker v. Taylor*, 2 Blatch., 82; *King v. Force*, 2 Cr. C. C., 208), in which there had been an omission or erroneous statement of the year in which the copyright was obtained, in the notice; also from the English case cited by him (*Mathieson v. Harrod*, Eng. Ch., 1868, 1 Ch. Leg. N., 99), which arose under an English statute very different from ours, requiring the date of the first publication to be given. Those cases, therefore, have no application. As to the alterations and additions alleged in the answer to have been made to the map of 1865 in the map of 1867, there are none specified except as to the railroad system of Wisconsin, and that is not alleged except inferentially, at least, by reference to the map itself. The edition of 1865, not having been made an exhibit, and not being before me, I am unable to determine whether any and what alterations and additions were made, and, of course, whether such alterations and additions are of such a character in kind and extent as to make the map of 1867 an original map, and

so deprive it of the protection of the copyright of the map of 1865. This can be determined only after the proofs are all in. For the purposes of this motion, the map of 1867 must be deemed an edition of that of 1865, as alleged in the bill, and therefore protected by the copyright of the latter. 3. It is also contended that the notice of copyright is bad, because it describes the court in which the entry was made as "the district court for the eastern district of Michigan," instead of "the district court of the United States for," etc., as is the true title of the court. Suffice it to say that the statute prescribes the form of the notice (4 Stat. at Large, 437, sec. 5), and the notice in this case is in the exact form so prescribed. It must, therefore, be deemed sufficient.

§ 295. *Rights of a compiler, as in case of maps, etc.*

The courts, in the interest of learning and science, have at all times and in all countries recognized the right of subsequent authors, compilers and publishers to use the works of others to a certain extent, but the great difficulty has always been, and always must be, to determine where such use ceases to be legitimate, and becomes an invasion of the rights of others. The difficulty is greatest in cases of maps and the like, in which there is not, and cannot be, any originality in the facts or materials of which they are composed, and which facts and materials are equally open to all. The following rule laid down by Mr. Copinger — Copinger's Law of Copyright, 91 — comes as near to defining this right as anything I have been able to find or can invent. He says: "The rule appears now to be settled that the compiler of a work in which absolute originality is of necessity excluded is entitled, without exposing himself to a charge of piracy, to make use of preceding works upon the subject, where he bestows such mental labor upon what he has taken, and subjects it to such revision and correction, as to produce an original result; *provided*, that he does not deny the use made of such preceding works, and the alterations are not merely colorable."

To apply this rule to the present case: What mental labor did the defendant bestow upon those portions of the complainant's map, admitted to have been taken in the preparation of its own, viz.: the boundaries of the larger townships of Wisconsin? None whatever beyond the mere mechanical operation of reducing them from the larger scale of complainant's to the smaller scale of defendant's map. Neither does it appear that there was any revision whatever to ascertain if there were errors which needed correction, or for any other purpose. There is, in fact, nothing whatever to bring the case within the rule. So far as those boundaries are concerned, it is clearly a case of naked piracy.

§ 296. *Taking boundaries of townships from another map is an infringement of copyright.*

But it is contended that boundaries of townships are not a legitimate subject of copyright — that they are fixed and defined by statute law, and that the marking of them down upon paper is but a transcription in another form of the legal enactment. What is claimed in this regard is true in regard to all original materials from which maps are made, and that is that none of them are subjects of copyright — they are open to all. But no one has the right to avail himself of the enterprise, labor and expense of another in the ascertainment of those materials, and the combining and arrangement of them, and the representing them on paper. The defendant, no doubt, had the right to go to the common source of information, and having ascertained those boundaries,

to have drawn them upon its map, notwithstanding that in this respect it would have been precisely like complainant's map (which of course it would have been if they were both correct). But he had no right to avail himself of this very labor on the part of complainant in order to avoid it himself. As appears by complainant's affidavit, these boundaries were fixed by the boards of supervisors of the respective counties, and not by legislative enactment, thus showing that the labor must have been much greater than it would have been if such boundaries could have been ascertained from the statutes of the state.

§ 297. *Courts look at the value of the matter taken rather than at the quantity.*

It is said the court looks at value more than quantity in these cases, and that in this case the value of what was taken is so small in comparison with the whole that the court will disregard it. The rule of law is correctly stated; but how is it as to the fact? The townships of which the boundaries are admitted to have been taken comprise nearly, if not quite, one-half of the state of Wisconsin. Most of the smaller townships of the state, those comprising no more than thirty-six square miles, are rectangular — nearly all of them square — in form, and therefore easily projected on a map, while the townships in question are nearly all irregular in form, and therefore more difficult to represent correctly on paper, requiring more and a higher degree of mental labor and skill in the operation. Neither can it be said that this portion of the map is of less value because it represented the unsettled, or but sparsely settled, portions of the state. There might be some force in the suggestion if the region in question were a desert waste, uninhabited and uninhabitable, and valueless and unsought after for any purpose whatever. But here the facts are directly the opposite. These lands are among the most valuable in the state for agricultural purposes, for timber, and to some extent for minerals; are largely sought after for actual settlement and for speculation, and are rapidly filling up with a fixed and permanent population. It is to maps that persons desiring to settle or invest go to a very large extent for information as to locality, topography, markets, railroads, etc., and it certainly cannot be said that the part of a map representing this portion of the state is insignificant or of little value; nor, in my opinion, is it of any less value than that part of the map representing the settled portions of the state.

From these views it results that the injunction ought to be continued to the hearing without the necessity of entering into a particular consideration of other evidences of piracy gathered from a comparison of defendant's map with those of complainant, which were laid before me at the hearing. It must not be inferred from this, however, that that branch of the case has not received full consideration at my hands. Suffice it to say, that upon a careful and critical examination and comparison, I find evidence — some of which it has been attempted in the answer to explain and avoid, with what degree of success it is unnecessary to consider here, and all of which is open to such explanation as the defendant may hereafter offer — which strongly confirms me in the belief that defendant's piracy of complainant's copyrights extends far beyond what is admitted in the answer, thus placing it beyond all doubt, in my mind, that justice requires that the injunction should be continued to the hearing. The motion to dissolve is denied.

DALY v. PALMER.

(Circuit Court for New York: 6 Blatchford, 256-271. 1868.)

Opinion by BLATCHFORD, J.

STATEMENT OF FACTS.—The plaintiff is, by profession, a dramatic author, his business being to compose, write and produce on the theatrical stage, dramatic compositions, commonly called plays. The defendants are the managers of a public place of theatrical amusement in the city of New York, called Niblo's Garden. Before the 1st of August, 1867, the plaintiff composed and wrote a dramatic composition called "Under the Gaslight," and on that day he took the proper steps to secure to himself a copyright for the composition, under the provisions of the act of February 3, 1831 (4 U. S. Stat. at Large, 436), by depositing, before publication, a printed copy of the title of the composition, as author and proprietor, in the clerk's office of the district court of the southern district of New York, where he resided at the time. The composition was afterward printed and published, and, within three months from its publication, he caused a copy of it, as printed and published, to be delivered to said clerk. He also gave information of copyright being secured, by causing to be printed and inserted in the several copies published, the words prescribed by the fifth section of the act.

The act of 1831 confers upon the author and proprietor of a dramatic composition, duly copyrighted, the sole right and liberty of printing, reprinting, publishing and vending such composition, in whole or in part, for the term of twenty-eight years from the time of recording the title of such composition in the manner directed by the act. The act of August 18, 1856 (11 U. S. Stat. at Large, 138), provides that any copyright thereafter granted under the laws of the United States, "to the author or proprietor of any dramatic composition, designed or suited for public representation, shall be deemed and taken to confer upon the said author or proprietor, his heirs and assigns, along with the sole right to print and publish the said composition, the sole right also to act, perform, or represent the same, or cause it to be acted, performed or represented, on any stage or public place, during the whole period for which the copyright is obtained."

The bill alleges that the plaintiff's play was designed and suited for public representation; that it was represented for the first time on the 12th of August, 1867, under his direction and for his benefit, at the New York Theater, a public place of theatrical amusement in New York, and was thenceforward represented there for eight consecutive weeks; that it met with great success, attracted crowds of persons, and was pecuniarily profitable to the plaintiff to a large amount; that the particular cause of such success was what was commonly called, after such public performance, the "railroad scene," at the end of the third scene of the fourth act, in which one of the characters is represented as secured by another, and laid helpless upon the rails of a railroad track, in such manner, and with the presumed intent, that the railroad train, momentarily expected, shall run him down and kill him, and, just at the moment when such a fate seems inevitable, another of the characters contrives to reach the intended victim, and to drag him from the track as the train rushes in and passes over the spot; that this incident and scene was entirely novel, and unlike any dramatic incident known to have been theretofore represented on any stage, or invented by any author before the plaintiff so composed, produced and represented the same; that the playing of said com-

position and scene caused the same to become famous in all parts of the United States and Canada, and in England; that the chief value of the composition and its popularity depend upon said "railroad scene;" that it was repeatedly produced and represented by and for the advantage of the plaintiff, in many cities and towns of the United States and Canada, to the profit of the plaintiff; that, before learning of the alleged wrongs mentioned in the bill attempted by the defendants, the plaintiff had made arrangements for representing the play dramatically at New York, and in various places in the United States, during the present winter and the approaching spring; that he accordingly commenced to represent the play at the New York Theater, in the city of New York, on the 4th of November, 1868; that, soon after the production, representation and printing of the play in the United States, one Dion Boucicault, a dramatic author and actor and theatrical manager, a subject of Great Britain, residing in England, procured a copy of said play by some means, and, without the knowledge or consent of the plaintiff, prepared therefrom a play, which he called "After Dark," in which play he introduced several of the scenes and incidents of the plaintiff's play, varying them slightly, but following in them the invention and plan of the plaintiff's play in a manner which was intended to differ from it only slightly, so as colorably to be a different work, while substantially retaining the attractive features of the plaintiff's play, and which contained, with only colorable variations, the said "railroad scene" of the plaintiff's play, substituting for the surface railroad an underground railroad, for the rescuer of the victim to be killed on the railroad a man for a woman, for the railroad station in which the rescuer was confined a cellar, and for the breaking down a door to escape and rescue the victim the breaking down a wall or the door in a wall; that the work of Boucicault is a palpable imitation of the plaintiff's said "railroad scene," and is plagiarized therefrom, and put into the play called "After Dark" by Boucicault for the purpose of obtaining the pecuniary benefit which might otherwise result to the plaintiff from the representation of his play; that the play of "After Dark" was performed in England without the plaintiff's consent, to the great profit of Boucicault, and was indebted for its success and profit to such imitation of said "railroad scene;" that Boucicault has sent copies of his play containing such plagiarism of said "railroad scene" to the defendants in the United States for sale and performance for his own profit, and several copies of it are in the defendants' possession; that the defendants are intending and have announced their purpose to perform such play called "After Dark," publicly on the stage, at Niblo's Garden, in New York, on the 16th of November, 1868, and every night thereafter; till further notice, without the consent of the plaintiff; that such play, and the plagiarism of said "railroad scene," are being rehearsed at Niblo's Garden, under the direction of the defendants, with a view to such public performance thereof; and that the defendant Palmer, acting for Boucicault, is about to sell copies of the play called "After Dark," with said plagiarized scene, to other persons in the United States, to be publicly represented. The bill prays for an injunction to restrain the defendants from the public representation and from the sale for dramatic representation of the said "railroad scene" in "After Dark."

The defense to the application, on the facts, is confined to showing, by affidavits, that the following matters were known prior to the taking out by the plaintiff of his copyright, namely: the representation on a stage of a train of cars drawn by a locomotive engine on a railroad; a like representation wherein

the train appeared to run over a man lying on the track; and a like representation wherein the train appeared to run over a man lying on the track, who had been thrown thereon in a helpless condition by another of the characters, in order that he might be run over and killed. A story called "Captain Tom's Fright," in "The Galaxy" for March 15, 1867, is also adduced to affect the validity of the plaintiff's copyright. There is no answer to the bill, nor is there any denial of the allegations that Boucicault procured a copy of the plaintiff's play and prepared therefrom the "railroad scene" in the play of "After Dark," and intended that the latter should only be colorably different from the "railroad scene" in the plaintiff's play by making the substitutions before mentioned, and that the "railroad scene" in the play of "After Dark" was plagiarized by Boucicault from the "railroad scene" in the plaintiff's play.

In the plaintiff's play there is a surface railroad with a railroad station and a signal-station shed or store-room. A signal-man appears and a woman named Laura. At the request of Laura the signal-man locks her in the shed. There are some axes in it. One Snorkey then appears. The signal-man then goes off. One Byke then enters, with a coil of rope in his hand, and throws it over Snorkey, and tightens it around his arm, and coils it around his legs, and then lays him across the track and fastens him to the rails, and goes off, having, by language, given it to be understood that the intention is that Snorkey shall be run over by the train and killed. Laura, from a window in the shed, sees what is done. The steam whistle of the train is heard. She takes an ax and strikes the door. The whistle is heard again, with the rumble of the approaching train. She gives more blows on the door with the ax; it opens; she runs and unfastens Snorkey; the lights of the engine appear, and she moves Snorkey's head from the track as the train rushes past. This incident occupies the whole of the third scene of the fourth act. There is a good deal of conversation; first between the signal-man and Laura, and then between Snorkey and the signal-man, and then between Byke and Snorkey, and then between Laura and Snorkey. There are stage directions for Laura to go into the shed, for the signal-man to lock her in, for Snorkey to enter, for the signal-man to go off, for Byke to enter with the coil of rope, for Byke to throw the coil over Snorkey and tighten the rope around Snorkey's arm and coil it around his legs, for Byke to lay Snorkey across the track and fasten him to the rails, for Byke to go off, for the steam whistle to be heard, for blows at the door to be heard, for the steam whistle to be heard again with the rumble of the train, for more blows on the door to be heard, for the door to open, for Laura to appear with the ax in her hand, for her to run and unfasten Snorkey, for the lights of the engine to be seen, for Laura to take Snorkey's head from the track, and for the train to rush past. These stage directions are separate and apart from the conversation, and are in italics and in parentheses at the appropriate places in the progress of the scene. The substance and purport of the successive conversations in the scene are that Laura requests the signal-man to lock her in the shed, and he consents; that Snorkey requests the signal-man to stop by signal the expected train, and he refuses; that Byke gives Snorkey to understand that he is to be run over and killed by the train, and that Snorkey requests Laura to break down the door and release him. The idea is also conveyed, by the language in the scene, that Byke is about to commit robbery and murder at Laura's house, and that Snorkey is trying to give information of the fact.

In the play of "After Dark" the "railroad scene" is in the third act. In the first scene of that act one Gordon Chumley is rendered insensible by drugs, and one Old Tom is thrown by force into a wine vault. In the second scene of that act Old Tom is represented as in the vault. There is an orifice in the vault which opens upon the track of an underground railroad. The rumbling of cars is heard, and lights flash through the orifice. Old Tom, through a door into an adjoining vault, sees two of the characters carry Chumley, and break a hole through a wall and pass the body of Chumley through the hole, for concealment, as he supposes, in a well or vault. Old Tom then finds an iron bar and resolves to attempt escape by enlarging the orifice in the wall opening on the railroad. Then follows scene third. The railroad is seen, with a circular orifice which ventilates the cellar in which Old Tom is. The body of Chumley is seen lying across the rails, and the arm of Old Tom, and then his head, are passed through the orifice. For this much of the scene there are only stage directions, without spoken words. The following is a *verbatim* copy of the rest of the scene, the parts in parentheses being stage directions: "*Old Tom.* About four courses of bricks will leave one room to pass. What is that on the line? There is something, surely, there. (A distant telegraph alarm rings. The semaphore levers play, and the lamps revolve.) Great Heaven! 'tis Gordon. I see his pale, upturned face—he lives! Gordon! Gordon! I'm here. He does not answer me. (A whistle is heard, and distant train passes.) Ah! murderers. I see their plan. They have dragged his insensible body to that place, and left him there to be killed by a passing train. Demons! Wretches! (He works madly at the orifice. The bricks fall under his blows. The orifice increases. He tries to struggle through it.) Not yet. Not yet. (The alarm rings again. The levers in the front play. The red light burns, and a white light is turned to L. H. tunnel. The wheels of an approaching train are heard.) Oh, heaven! give me strength—down—down. One moment! (A large piece of wall falls in, and Old Tom comes with it.) See, it comes, the monster comes. (A loud rumbling and crashing sound is heard. He tries to move Gordon, but, seeing the locomotive close on him, he flings himself on the body, and, clasping it in his arms, rolls over with it forward. A locomotive, followed by a train of carriages, rushes over the place, and, as it disappears, Old Tom frees himself from Chumley and gazes after the train.)" The play of "After Dark" has never been published by Boucicault, although printed by him for private use.

§ 298. What is a "dramatic composition" within the terms of the copyright act.

The first inquiry is, what is meant, in the act of 1856, by a "dramatic composition," what is meant by the "public representation" of a dramatic composition, and what is meant by the right to "act, perform or represent" a dramatic composition on a "stage or public place?" The act of 1856 confers on the author or proprietor of a copyrighted "dramatic composition, designed or suited for public representation," the sole right of acting, performing or representing the same on a stage or public place, in addition to the sole right to print and publish such composition. The latter right must be considered as being conferred by the act of 1831, for, although that act only speaks of a copyright for a "book or books, map, chart, musical composition, print, cut or engraving," yet, under the language of the act of 1856, a "dramatic composition, designed or suited for public representation," must be regarded as embraced within the act of 1831.

§ 299. *A written play, consisting of directions for its representation by action only, is a dramatic composition.*

A composition, in the sense in which that word is used in the act of 1856, is a written or literary work invented and set in order. A dramatic composition is such a work in which the narrative is not related, but is represented by dialogue and action. When a dramatic composition is represented, in dialogue and action, by persons who represent it as real, by performing or going through with the various parts or characters assigned to them severally, the composition is acted, performed or represented; and, if the representation is in public, it is a public representation. To act, in the sense of the statute, is to represent as real, by countenance, voice or gesture, that which is not real. A character in a play who goes through with a series of events on the stage without speaking, if such be his part in the play, is none the less an actor in it than one who, in addition to motions and gestures, uses his voice. A pantomime is a species of theatrical entertainment in which the whole action is represented by gesticulation, without the use of words. A written work, consisting wholly of directions, set in order for conveying the ideas of the author on a stage or public place, by means of characters who represent the narrative wholly by action, is as much a dramatic composition designed or suited for public representation as if language or dialogue were used in it to convey some of the ideas. The "railroad scene," in the plaintiff's play, is undoubtedly a dramatic composition. Those parts of it represented by motion or gesture, without language, are quite as much a dramatic composition as those parts of it which are represented by voice. This is true, also, of the "railroad scene" in "After Dark." Indeed, on an analysis of the two scenes in the two plays, it is manifest that the most interesting and attractive dramatic effect in each is produced by what is done by movement and gesture, entirely irrespective of anything that is spoken. The important dramatic effect, in both plays, is produced by the movements and gestures which are prescribed and set in order so as to be read, and which are contained within parentheses. The spoken words in each are of but trifling consequence to the progress of the series of events represented and communicated to the intelligence of the spectator by those parts of the scene which are directed to be represented by movement and gesture. The series of events so represented and communicated by movement and gesture alone to the intelligence of the spectator, according to the directions contained in parentheses, in the two plays in question here, embraces the confinement of A. in a receptacle from which there seems to be no feasible means of egress; a railroad track, with the body of B. placed across it, in such manner as to involve the apparently certain destruction of his life by a passing train; the appearance of A. at an opening in the receptacle from which A. can see the body of B.; audible indications that the train is approaching; successful efforts by A., from within the receptacle, by means of an implement found within it, to obtain egress from it upon the track; and the moving of the body of B. by A. from the impending danger a moment before the train rushes by. In both of the plays the idea is conveyed that B. is placed intentionally on the track with the purpose of having him killed. Such idea is, in the plaintiff's play, conveyed by the joint medium of language uttered and of movements which are the result of prescribed directions, while, in Boucicault's play, it is conveyed solely by language uttered. The action, the narrative, the dramatic effect and impression, and the series of events in the two scenes are identical. Both are dramatic compositions, designed or suited for public

representation. It is true that in one A. is a woman, and in the other A. is a man; that in one A. is confined in a surface railroad station shed, and in the other A. is confined in a cellar abutting on the track; that in one A. uses an ax, and in the other A. uses an iron bar; that in one A. breaks down a door, and in the other A. enlarges a circular hole; that in one B. is conscious and is fastened to the rails by a rope, and in the other B. is insensible and is not fastened; and that in one there is a good deal of dialogue during the scene, and in the other only a soliloquy by A. and no dialogue. But the two scenes are identical in substance, as written dramatic compositions, in the particulars in which the plaintiff alleges that what he has invented and set in order in the scene has been appropriated by Boucicault.

Nor is this a case of first impression. An arrangement of musical notes, forming a tune or air, is a musical composition; and the author who has invented it, and sets it in order, and copyrighted it, is entitled to protection. The extent of that protection has been the subject of judicial interpretation. In the case of *D'Almaine v. Boosey*, 1 *Younge & Collyer's Exch. R.*, 288, the plaintiffs, proprietors of the copyright of an opera of Auber's, and also of another copyright of the overture of the same opera, and also of another copyright of the airs of the same opera, filed a bill in equity to restrain the defendant from infringing such copyrights. The defendant had published several of the airs, with some alterations, in the shape of quadrilles and waltzes. It was claimed, on the part of the defendant, that his work was merely an adaptation of the original, and, therefore, not a piracy. But the court (Lord Chief Baron Lyndhurst) held that if the defendant had published the original air, though with adaptations and harmonies, or for different instruments, it was a piracy, and that it was not like the case of an abridgment of a book, where the purpose of the abridgment was distinct from that of the work from which it was taken. On this subject the court says: "It is admitted that the defendant has published portions of the opera containing the melodious parts of it; that he has also published entire airs; and that, in one of his waltzes, he has introduced seventeen bars in succession, containing the whole of the original air, although he adds fifteen other bars which are not to be found in it. Now, it is said that this is not a piracy, first, because the whole of each air has not been taken; and, secondly, because what the plaintiffs purchased was the entire opera, and the opera consists, not merely of certain airs and melodies, but of the whole score. But, in the first place, piracy may be of part of an air, as well as of the whole; and, in the second place, admitting that the opera consists of the whole score, yet, if the plaintiffs were entitled to the whole, *a fortiori*, they were entitled to publish the melodies which form a part. Again, it is said that the present publication is adapted for dancing only, and that some degree of art is needed for the purpose of so adapting it, and that but a small part of the merit belongs to the original composer. That is a nice question. It is a nice question what shall be deemed such a modification of an original work as shall absorb the merit of the original in the new composition. No doubt such a modification may be allowed in some cases, as in that of an abridgment or a digest. Such publications are, in their nature, original. Their compiler intends to make of them a new use, and not that which the author proposed to make. Digests are of great use to practical men, though not so, comparatively speaking, to students. The same may be said of an abridgment of any study; but it must be a *bona fide* abridgment, because, if it contains many chapters of the original work, or such as made

that work most salable, the maker of the abridgment commits a piracy. Now, it will be said, that one author may treat the subject very differently from another who wrote before him. That observation is true in many cases. A man may write upon morals in a manner quite distinct from that of others who preceded him; but the subject of music is to be regarded upon very different principles. It is the air or melody which is the invention of the author, and which may, in such case, be the subject of piracy; and you commit a piracy, if, by taking, not a single bar, but several, you incorporate in the new work that in which the whole meritorious part of the invention consists. . . . Now, it appears to me, that if you take from the composition of an author all those bars consecutively which form the entire air or melody, without any material alteration, it is a piracy; though, on the other hand, you might take them in a different order, or broken by the intersection of others, like words, in such a manner as should not be a piracy. It must depend on whether the air taken is substantially the same with the original. Now, the most unlettered in music can distinguish one song from another, and the mere adaptation of the air, either by changing it to a dance, or by transferring it from one instrument to another, does not, even to common apprehensions, alter the original subject. The ear tells you that it is the same. The original air requires the aid of genius for its construction, but a mere mechanic in music can make the adaptation or accompaniment. Substantially, the piracy is, where the appropriated music, though adapted to a different purpose from that of the original, may still be recognized by the ear. The adding variations makes no difference in the principle." An injunction was granted. The views of Lord Lyndhurst, in that case, were cited and approved by Mr. Justice Nelson, in this court, in the case of *Jollie v. Jaques*, 1 Blatch., 618, 625. They are eminently sound and just, and are applicable to the case of a dramatic composition designed for public representation. Such a composition, when represented, excites emotions and imparts impressions not merely through the medium of the ear, as music does, but through the medium of the eye as well as the ear. Movement, gesture and facial expression, which address the eye only, are as much a part of the dramatic composition as is the spoken language which addresses the ear only; and that part of the written composition which gives direction for the movement and gesture is as much a part of the composition, and protected by the copyright, as is the language prescribed to be uttered by the characters. And this is entirely irrespective of the set of the stage, or of the machinery or mechanical appliances, or of what is called, in the language of the stage, scenery, or the work of the scene painter.

§ 300. *An author of a dramatic composition is entitled to protection against piracy of any part of his work.*

Now, in consonance with the principles laid down by Lord Lyndhurst, the plaintiff is as much entitled to protection in respect of a substantial and material original part of his "railroad scene" as he is in respect of the whole. Under the act of 1856, construed in connection with the act of 1831, he is entitled to be protected against piracy, in whole or in part, by representation as well as by printing, publishing and vending. Although the act of 1831 in regard to printing, publishing and vending uses the words "in whole or in part," and the act of 1856 in regard to representing does not use those words, yet the act of 1856, by referring, as it does, to the right conferred by the act of 1831 as the "sole right to print and publish" the copyrighted composition, when such right is, on the face of the act of 1831, the sole right to print and

publish "in whole or in part," and by then conferring "the sole right also to act, perform or represent the same, or cause it to be acted, performed or represented, on any stage or public place," must be held to confer the right to represent in whole or in part. All that is substantial and material in the plaintiff's "railroad scene" has been used by Boucicault in the same order and sequence of events, and in a manner to convey the same sensations and impressions to those who see it represented as in the plaintiff's play. Boucicault has, indeed, adapted the plaintiff's series of events to the story of his play, and in doing so has evinced skill and art; but the same use is made in both plays of the same series of events, to excite, by representation, the same emotions in the same sequence. There is no new use, in the sense of the law, in Boucicault's play, of what is found in the plaintiff's "railroad scene." The "railroad scene" in Boucicault's play contains everything which makes the "railroad scene" in the plaintiff's play attractive as a representation on the stage. As, in the case of the musical composition, the air is the invention of the author, and a piracy is committed if that in which the whole meritorious part of the invention consists is incorporated in another work, without any material alteration in sequence of bars, so, in the case of the dramatic composition, designed or suited for representation, the series of events directed in writing by the author, in any particular scene, is his invention, and a piracy is committed if that in which the whole merit of the scene consists is incorporated in another work, without any material alteration in the constituent parts of the series of events, or in the sequence of the events in the series. The adaptation of such series of events to different characters who use different language from the characters and language in the first play is like the adaptation of the musical air to a different instrument, or the addition to it of variations or of an accompaniment. The original subject of invention, that which required genius to construct it and set it in order, remains the same in the adaptation. A mere mechanic in dramatic composition can make such adaptation, and it is a piracy if the appropriated series of events, when represented on the stage, although performed by new and different characters, using different language, is recognized by the spectator through any of the senses to which the representation is addressed, as conveying substantially the same impressions to, and exciting the same emotions in, the mind, in the same sequence or order. Tested by these principles, the "railroad scene" in Boucicault's play is undoubtedly, when acted, performed or represented on a stage or public place, an invasion and infringement of the copyright of the plaintiff in the "railroad scene" in his play.

§ 301. *The test of piracy of a dramatic composition.*

The substantial identity between the two scenes would naturally lead to the conclusion that the later one had been adapted from the earlier one. The charge of actual plagiarism on the part of Boucicault, made in the bill, is not denied. It is hardly possible that the resemblances are accidental, and that the differences are not merely colorable, with a view to disguise the plagiarism. The true test of whether there is piracy or not is to ascertain whether there is a servile or evasive imitation of the plaintiff's work, or whether there is a *bona fide* original compilation, made up from common materials and common sources, with resemblances which are merely accidental, or result from the nature of the subject. *Emerson v. Davies*, 3 Story, 768, 793 (§§ 270-79, *supra*).

Nothing that has been adduced on the part of the defendants affects the

validity of the plaintiff's copyright, on the question of the originality and novelty of the "railroad scene" in his play.

§ 302. *The seller of a pirated work for representation by the vendee is liable for the violation of the copyright by the vendee.*

The sale of Boucicault's play to other persons, with a view to its public representation, makes the seller a participant in causing the play to be publicly represented.

An injunction must, therefore, issue, restraining the defendants from the public performance and representation, and from the sale, for public performance or representation, of the "railroad scene" in the play of "After Dark," or of any scene in substance the same as the "railroad scene" in either of the two plays as such scene is herein defined.

§ 303. **In general.**— In deciding the question of an infringement of a copyright the inquiry is not whether the one publication is a *fac-simile* of the other, but whether there is such a substantial identity as fairly to justify the inference that in preparing his work the subsequent author availed himself of the work of the first and substantially borrowed. *Drury v. Ewing*, 1 Bond, 540 (§§ 112-14).

§ 304. An author's property in his composition or copyright consists only in a right to multiply copies of his book and enjoy the profits therefrom, and he has no such property in his original conceptions that he alone can use them in a new work. *Stowe v. Thomas*,* 2 Wall. Jr., 547; 2 Am. L. Reg., 210.

§ 305. The "sole liberty" secured by the copyright acts of printing and selling a copyrighted work is inconsistent with a right in any other person to print and vend material and valuable portions of such work taken *verbatim* therefrom. So a key to a copyrighted work of instruction in English grammar containing an original system of diagrams, which reproduced the diagrams of the original work, and the lesson sentences of the original work, arranged according to the rules and diagrams of the original work, is an infringement of the copyright. *Reed v. Holliday*,* 19 Fed. R., 325.

§ 306. **Intent.**— Where an infringement of a copyright appears, the motives of the infringer are immaterial. *Ibid.*

§ 307. A party publishing copyrighted music is liable to the penalty therefor, though the publication was made in ignorance of the copyright. *Millett v. Snowden*,* 1 West. L. J., 240.

§ 308. **Limitations.**— Every printing and sale of an infringement of a copyrighted article is a new infringement, and the statute of limitations runs from such printing and sale and not from the time of the engraving from which the infringing article is printed. *Reed v. Carusi*,* Taney, 72.

§ 309. **The statutory penalty** for printing a copyrighted work imposed by the sixth section of the copyright act of February 3, 1831, is incurred only by printing the whole work, and not by printing a part which amounts to an infringement. *Rogers v. Jewett*,* 12 Law Rep. (N. S.), 839.

§ 310. **Books sold by subscription.**— In the absence of notice of the terms of the contract between the publishers of a book sold by subscription and their agents for the sale of such book, by which such agents were bound to sell only to subscribers and only for the full retail price, and in the absence of any solicitations on his part, a book-seller may contract to purchase such books from agents who have lawfully obtained the books from the owner or the publisher, and may advertise such books for sale at such prices as he may see fit. *Clemens v. Estes*,* 22 Fed. R., 899.

§ 311. **Agent.**— Under the copyright law, a principal is not liable to the penalty imposed by section 4965, Revised Statutes, for the infringement of a copyright, where such infringement is made by his agent without his knowledge or authority. *Taylor v. Gilman*,* 24 Fed. R., 632.

§ 312. **Purchase and resale.**— A person who has published a copyrighted work without authority, and who purchases and resells the books he has thus published, is liable to the owner of the copyright for the profits on the resale as well as on the original sale. *Myers v. Callaghan*,* 24 Fed. R., 636.

§ 313. **Abridgment.**— A fair and *bona fide* abridgment of a work, though it may somewhat affect the sale thereof, is not an infringement of the copyright thereof; but where, combined with what is properly an abridgment, there is a considerable part of the original work merely copied, the use of the copied portion will be enjoined. *Story v. Holcombe*,* 4 McL., 306.

§ 314. **Maps.**— Where a map is substantially a copy of a copyrighted map except in scale and color, there is an infringement of the copyright of the former map, and its owner is en-

titled to an injunction and an account of the profits realized from the sale of the infringing map. *Chapman v. Ferry*,* 9 Saw., 395; 18 Fed. R., 539.

§ 315. A copyrighted series of maps of one city is not infringed by the production of a series of maps of another city on the same plan; nor has the holder of the first copyright any exclusive right to the arbitrary signs used by him on his maps. *Perris v. Hexamer*,* 9 Otto, 674.

§ 316. Musical composition.—A person is not liable for an infringement of the copyright of a musical composition unless the composition alleged to be an infringement is the same as the copyrighted composition in its main design and important parts, or was colorably altered from it; nor is he liable though they are the same in some respects, provided it was not taken from the copyrighted composition, but was the effort of his own mind, or was taken from an air composed by some one not a plagiarist from the original author. *Reed v. Carusi*,* 8 Law Rep., 410.

§ 317. Slight omissions or alterations do not prevent a piece of music from being the same as another so far as copyright laws are concerned. *Millett v. Snowden*,* 1 West. L. J., 240.

§ 318. Where the words and music of a copyrighted ballad are republished without authority, the fact that the words are not original with the composer of the music is no defense to an action for infringement of the copyright of the music. *Ibid.*

§ 319. A person is not liable for an infringement of a copyrighted musical composition unless he caused it to be engraved either on the whole or by varying, adding to, or diminishing the main design, with the intent to evade the law, or he caused it to be printed for sale in such manner and for such purpose. But he is not liable unless the musical composition engraved or printed and for sale by him is the same as that which it is said to infringe in the main design, and in its material and important parts altered as above mentioned to evade the law. Nor is he liable although it is in some respects the same, provided it was not taken from the other, but was an effort of his own mind, or was taken from an air composed by some other person, who was not a plagiarist from the copyrighted production. *Reed v. Carusi*,* Taney, 72.

§ 320. Newspaper — Engravings.—It is not an infringement of the copyright of a newspaper to prepare and sell a plate from which a copy of an engraving published in the paper can be produced, where it does not appear that the plate was made or sold for the purpose of violating the rights of the publisher of the paper; and an intention to violate such rights will not be presumed from the making and sale of the plate. *Harper v. Shoppell*,* 26 Fed. R., 519.

§ 321. Pictures.—A person is not liable as for an infringement of a copyrighted picture if, in producing the picture alleged to be an infringement, he did not avail himself, either directly or indirectly, of the plaintiff's production. *Johnson v. Donaldson*,* 18 Blatch., 287; 3 Fed. R., 22; 10 Rep., 233.

§ 322. A person can acquire no exclusive copyright in a chromo of a design found in and copied from a foreign periodical. *Ibid.*

§ 323. Dramatic compositions.—It is a violation of section 4967, Revised Statutes, for a person to print and publish and offer to sell a dramatic composition, a large portion of which is copied without permission from a prior composition. *Boucicault v. Hart*, 13 Blatch., 47; 4 Am. L. Rec., 726; 8 Ch. Leg. N., 257 (§§ 22-29).

§ 324. Alterations in the language of a pirated play will not protect the unauthorized use thereof if there is a substantial use of the play. *Boucicault v. Wood*,* 2 Biss., 34; 7 Am. L. Reg. (N. S.), 539.

§ 325. In a suit to enjoin the unauthorized representation of a dramatic copyrighted composition, it is no defense that the defendants obtained the whole play by the aid of memory, where they so obtained it while engaged as actors of the play. *Shook v. Rankin*,* 3 Cent. L. J., 210.

§ 326. Where two plays, when acted, produce the impression that they are the same, it is fair to presume that one is a piracy of the other, and especially so when the name of one was Black Crook and of the other Black Rook. *Martinetti v. Maguire*,* Deady, 216; S. C., 1 Abb., 356.

§ 327. State reports.—In an action for an infringement of the copyright of certain volumes of the reports of judicial decisions, it was held, on a comparison of the infringing with the copyrighted volumes, and after considering the evidence, that the defendants in preparing the infringing volumes had so used the plaintiff's book as to interfere with his copyright. *Myers v. Callaghan*,* 10 Biss., 139; 5 Fed. R., 726; 20 Fed. R., 441.

§ 328. A translation of a copyrighted work into a foreign language is not an infringement of the copyright of the original. *Stowe v. Thomas*,* 2 Wall. Jr., 547; 2 Am. L. Reg., 210.

§ 329. Compilations.—One compilation does not infringe another, though the information imparted is in some instances almost identical, when each has been compiled by the author from original sources of information by labor and skill of his own, and is not transcribed from the other. *Bullinger v. Mackey*, 15 Blatch., 550 (§§ 124-26).

§ 330. The compiler of a work on a given subject has no monopoly of the subject of which the book treats. Any other person is permitted to make a similar work. But the subsequent author must investigate for himself from the original sources. He cannot use the labors of a previous compiler *animo furandi*, and save his own time by copying the results of the former compiler's labor, although the same results could have been attained by independent labor. *Banks v. McDivitt*,* 13 Blatch., 163.

§ 331. The question whether a compiled work is a violation of a previously copyrighted work of the same character is to be determined by considering whether the publishers of the work alleged to violate the copyright have used the plan, arrangements and illustrations of the complainant as the model of their own book, with colorable alterations and variations only to disguise the use thereof, or whether the work is the result of their own labor, skill and the use of common materials and common sources of knowledge, and whether the resemblances are not either accidental, or arise from the nature of the subject. *Lawrence v. Cupples*,* 9 O. G. 254.

§ 332. It is not sufficient evidence of an infringement of a copyright to show that a later compilation uses the same system of references as a former one. It must also appear that the system was new and original with the author of the first work. *Bullinger v. Mackey*, 15 Blatch., 550 (§§ 124-26).

VI. SUITS FOR INFRINGEMENT.

§ 333. Courts of equity possess jurisdiction to grant full relief in cases of violations of copyrights, though to some extent there may be a remedy at law. *Pierpont v. Fowle*,* 2 Woodb. & M., 22.

§ 334. A court of equity has full jurisdiction in copyright cases, though the title to the copyright is in dispute. *Ibid.*

§ 335. Concurrent remedies.—A suit to enjoin the infringement of a copyright may be maintained, though a *qui tam* action for a penalty is pending. *Schumacher v. Schwencke*,* 25 Fed. R., 466.

§ 336. Pleading.—In an action to recover for the infringement of a copyright, the declaration must aver the taking of the steps necessary to procure a copyright, and when the plaintiff alleges that he is the proprietor, and that the copyrighted work is the work of another person, he must set out his title from such author. *Chicago Music Co. v. J. W. Butler Paper Co.*,* 19 Fed. R., 758.

§ 337. Production of books.—In an action to recover the penalties for a violation of the copyright of a chromo, and to enforce the forfeiture of the plates from which it was printed, a defendant cannot be compelled by a subpoena *duces tecum* to produce his books of account and plates to be used as evidence in behalf of the plaintiff. *Johnson v. Donaldson*,* 18 Blatch., 287; 3 Fed. R., 22; 10 Rep., 233.

§ 338. Trial at law.—In copyright cases both the right and the infringement may be set up and adjudicated in a court of equity without having been first determined at law. *Farmer v. Calvert Lithographing, etc., Co.*, 1 Flip., 228; 5 Am. L. T. (U. S.), 168; 7 Am. L. Rev., 365 (§§ 288-97).

§ 339. Abatement.—A *qui tam* action brought under section 4965, Revised Statutes of the United States, to recover a penalty for the violation of a copyright, abates on the death of the defendant. *Scheiber v. Sharpless*,* 17 Fed. R., 589.

§ 340. Form of action.—An action of trespass is not a proper form of action for damages for an infringement of a copyright. It seems that the proper remedy is an action on the case. *Atwill v. Ferrett*, 2 Blatch., 39.

§ 341. Discovery.—Where a bill in equity claims a forfeiture for an infringement of a copyright, the defendants cannot be compelled to make discoveries in answer to the bill as to the number of their publications, the quantity on hand, or of the amount of the sales. *Ibid.*

§ 342. In a suit for an infringement of a map, the defendants may demur to the part of the complainant's bill which asks for a discovery of the number of copies on hand, because under the statute they would be liable to forfeiture. *Chapman v. Ferry*,* 12 Fed. R., 693; 8 Saw., 191.

§ 343. Penalty under act of 1831.—Under the sixth section of the copyright act of 1831, the penalty of fifty cents per sheet of infringing matter applies only to sheets in the possession of the defendants, and does not include those sold by them. *Backus v. Gould*,* 7 How., 798.

§ 344. Title of plaintiff.—A person cannot maintain a suit for an infringement of a copyright unless he shows an exclusive right derived from the author or inventor. It is not sufficient that he allege in general terms that he is the proprietor of the work in question. *Yuengling v. Schile*, 12 Fed. R., 97; 20 Blatch., 452 (§§ 141-44).

§ 345. A court of equity will not enjoin the publication and sale of a work alleged to be an infringement of a copyright, if it appears that the plaintiff has no copyright in the work of which he is the owner. *Ewer v. Coxe*,* 4 Wash., 487.

§ 346. In an action to recover the statutory penalty for the violation of a copyright, the defendant may show that the copyrighted music was not original, or that it was an alteration or abbreviation. *Millett v. Snowden*,* 1 West. L. J., 240.

§ 347. In cases of an infringement of a copyright, if the title is in the plaintiff, an injunction will be allowed and an accounting decreed. *Pierpont v. Fowle*,* 2 Woodb. & M., 22.

§ 348. **Forfeiture.**—A court of equity cannot decree a forfeiture in copyright cases, not being specially authorized to do so by statute. *Stevens v. Cady*,* 2 Curt., 200; *Chapman v. Ferry*,* 12 Fed. R., 693; 8 Saw., 191; *Stevens v. Gladding*, 17 How., 447 (§§ 387-89).

§ 349. **Evidence.**—The fact that a compilation was made by a person may be proven by other persons cognizant of the facts as well as by the author. *Bullinger v. Mackey*, 15 Blatch., 550 (§§ 124-26).

§ 350. In an action to recover for the infringement of a copyright of a dramatic composition, it is improper to ask a witness whether the incidents of the play are the same as those of a previously published book, where neither the play nor the book is produced, and no reason is shown for their non-production. Nor is it proper, on the production of the book, merely to ask the witness whether its scenes, incidents and language are not substantially those of the play. *Boucicault v. Fox*, 5 Blatch., 87 (§§ 35-39).

§ 351. **Accounting.**—Commissions received by a book-seller from the sales of a map which infringed a copyright must be accounted for as profits to the owner of the copyright. *Stevens v. Gladding*,* 2 Curt., 608.

§ 352. It seems that an accounting may be decreed in suits for the infringement of a copyright, though an injunction will not be allowed. *Blank v. Manufacturing Co.*,* 3 Wall. Jr., 196.

§ 353. Where the infringement of a copyright complained of is the licensing to others, by the defendant, of the right to produce the copyrighted work, the defendant will be compelled to account as the trustee or agent of the complainant. *Pierpont v. Fowle*,* 2 Woodb. & M., 22.

§ 354. After answering, the defendant in a suit for the infringement of a copyright cannot object that the complaint asks for an accounting, and at the same time asks a forfeiture under the statute. *Farmer v. Calvert Lithographing, etc., Co.*, 1 Flip., 228 (§§ 288-97).

§ 355. Where the bill in a suit for the infringement of a copyright prays simply for general relief, an accounting may be decreed, as it is an incident to the allowance of the injunction. *Stevens v. Gladding*, 17 How., 447 (§§ 387-89).

§ 356. Relief by an account, though an incident to an injunction, cannot be granted in a suit for an infringement of a copyright, if not prayed for, either specially or by a prayer for general relief. *Stevens v. Cady*,* 2 Curt., 200.

§ 357. **Damages.**—The measure of damages for the unauthorized production of a manuscript play is to be determined by the jury from the evidence. *Boucicault v. Wood*,* 2 Biss., 34; 7 Am. L. Reg. (N. S.), 539.

§ 358. The damages sustained by the complainants by reason of an infringement of a copyright cannot be recovered in a suit in equity. *Chapman v. Terry*,* 12 Fed. R., 693; 8 Saw., 191.

§ 359. In a *qui tam* action by the owner of a copyright against a book-seller who had imported several copies of a pirated edition, and sold some of them, it was held that the plaintiff might recover fifty cents for each sheet of the whole number of volumes found at any time within the period stated in the declaration to have been in the possession of the defendant. *Dwight v. Appleton*,* 1 N. Y. Leg. Obs., 195.

§ 360. C. republished without authority volumes 39 to 46 inclusive of the Illinois Reports, which were copyrighted by M. C. owned the copyright of volumes 1 to 31 inclusive, and F. the copyright of the volumes above 46. C. sold sets consisting of those copyrighted by him and by F. and pirated copies. He also sold many separate copies of the pirated volumes. *Held*, that the selling price was properly determined on an accounting by finding the mean between the average price of the single volumes sold, and one forty-sixth of the price at which the sets were sold after deducting the price paid F. for the volumes owned by him. *Myers v. Callaghan*,* 24 Fed. R., 636.

§ 361. **Profits.**—On an accounting by the infringer of a copyright for the profits derived from the pirated work, an allowance should be made for the expenses of carrying on the business, and, if the cost of selling the pirated work was only a part of the business, then such a proportion should be deducted from the gross proceeds as the cost of sale of all the works published by them bears to the gross proceeds thereof. *Ibid.*

§ 362. On an accounting by the infringer of a copyright for the profits derived from the sale of the pirated work, the cost of stereotyping should not be allowed as a part of the cost of production. Nor should the salaries of the partners in the infringing firm be included in the

expenses of carrying on the business. Nor will the sum paid for editing the infringing volumes be allowed as a part of the expense of production. *Ibid.*

§ 363. Where defendants, in an action for an infringement of a copyright, after a decision against them on the merits, retain the volumes of the infringing work unsold by them, the cost of the production of the unsold volumes cannot be credited to them and go to diminish the profits on the volumes sold, but the owners of the copyright are entitled to the full profits of the volumes sold, without any reduction by the cost of unsold volumes. *Ibid.*

§ 364. On an accounting by a person who has infringed a copyright, as the defendant has in his hand all the proof relating to the profits derived by him from the infringement, the complainant makes a *prima facie* case when he shows the selling price and the usual cost of manufacturing. *Ibid.*

§ 365. Reference to master.—Motion for a provisional injunction to restrain the publication and sale of a map. The court refused to refer the matter to a master for his opinion on the question of infringement, holding that such a motion must be disposed of on the moving papers of the plaintiff and the affidavits of defendant in opposition. *Smith v. Johnson*,* 4 Blatch., 252.

§ 366. Where the facts upon which the question of an infringement of a copyright is based are voluminous and intricate, the court will refer the matter to a master for a report, and such reference will usually be ordered before the final hearing; though when, by consent, the cause has been heard without it, it may be ordered afterward. *Lawrence v. Dana*, 4 Cliff., 1 (§§ 257-69).

§ 367. In a suit for an infringement of copyright and an injunction the case was referred to a master with special instructions. *Story v. Derby*,* 4 McL., 160.

§ 368. Injunction as to a part.—Where a portion of the novel part of a copyrighted compilation has been copied in a subsequent compilation on the same subject, the publication of such copyrighted portion will be enjoined if it can be readily separated from the rest of the work; but if the portion is small and is woven into all the other work, the injured party will be left to his action at law. *Webb v. Powers*, 2 Woodb. & M., 497 (§§ 280-87).

§ 369. Where, in a literary work, portions of a previously copyrighted work have been incorporated, the publication of the infringing parts will be enjoined; and where such infringing part is so mixed with original matter that it cannot be separated without destroying the whole, then the publication of the whole will be enjoined. *Lawrence v. Dana*, 4 Cliff., 1; 2 Am. L. T. (N. S.), 402 (§§ 257-69).

§ 370. Injunction not granted while there is doubt as to the existence of a copyright. *Miller v. McElroy*,* 1 Am. L. Reg. (O. S.), 198.

§ 371. In a case of doubt as to the infringement of a copyright an injunction will not be granted in the first instance, but the parties will be left to their action at law. *Blunt v. Patten*,* 2 Paine, 397.

§ 372. The granting of a preliminary injunction is within the discretion of the court, but it should issue only when the plaintiff's right and the defendant's violation of that right are clear, and the case exhibits no special facts which would render the use of the process unjust; this rule applies in patent and copyright cases. *Scribner v. Stoddart*,* 19 Am. L. Reg. (N. S.), 433.

§ 373. The rule as to granting injunctions in copyright cases is the same as in other equity cases. The right of the plaintiff must be clear, and the circumstances must be such that the remedy will not be unjust. *Lodge v. Stoddart*,* 9 Rep., 137.

§ 374. Where an infringement of a copyright is palpable, and a provisional injunction will not be attended with serious injury, it is not ordinarily refused as to so much of an infringing work as infringes the prior publication. *Banks v. McDivitt*,* 13 Blatch., 163.

§ 375. Where an infringement of a copyright is shown the court will grant an injunction without proof of actual damage. *Reed v. Holliday*,* 19 Fed. R., 325.

§ 376. A court of equity will not grant a preliminary injunction in a copyright case where it appears that the injury to the complainants will be much less if refused than would be the injury to the defendants if it was granted. *Lodge v. Stoddart*,* 9 Rep., 137.

§ 377. Where a bill in equity by the owner of a copyright seeks a discovery and prays that the further infringement of his copyright be enjoined, the injunction will be granted, if a proper case is made, though the bill fails to make a case for a discovery. *Atwill v. Ferrett*, 2 Blatch., 39.

§ 378. Where the plaintiff, in a suit to enjoin the unauthorized representation of a copyrighted dramatic representation has made out a *prima facie* case, an affidavit that the plaintiff was not the author, but that it was written by two foreigners, and that a play in all particulars like it was performed in London before it was alleged to have been written, in two theatres, is insufficient to prevent the issuing of the injunction, where such play is not produced. *Shook v. Rankin*,* 3 Cent. L. J., 210.

§ 379. It appearing that the plaintiff in a suit for an infringement of a copyright, claimed that he was the owner of the copyright under an assignment from the defendant; and that the defendant claimed that he had never assigned the work in question; that the plaintiff had not performed his part under the contract alleged by him to operate as an assignment; that the contract had been abrogated, and that there was no infringement, the court refused an injunction, but directed that the defendant give bond to answer any damages allowed against him, and to keep an account of books disposed of, and preserve an account of those previously sold which the plaintiff claimed to have infringed his copyright. *Hubbard v. Thompson*,* 14 Fed. R., 689.

§ 380. On an application for an injunction to restrain an infringement of a copyright, it is not necessary to the allowance of the injunction that it should appear that the violation of the copyrighted work is so extensive that the piratical work is a substitute for the original. *Reed v. Holliday*,* 19 Fed. R., 325.

§ 381. The owner of an uncopyrighted opera may have the unauthorized production thereof enjoined on giving proper security, and if such security is insufficient, and the counsel for the defendant was not present when it was given, it seems that the court may, on motion and notice, order additional security to be given as a condition of continuing the injunction. *Goldmark v. Kreling*,* 25 Fed. R., 349.

§ 382. The owner of an uncopyrighted opera obtained an order for an injunction on condition of filing a bond for \$10,000 on a certain day. The bond offered not being satisfactory to the court, the defendants offered to furnish an indemnifying bond in the same amount, on furnishing which the injunction was to be dissolved. Before the security was furnished, the complainants offered to deposit in court a certified check or the coin. *Held*, that they should be permitted to do so. *Ibid*.

§ 383. It seems that in a copyright case an injunction will not be granted against a person who has been led into publication by the encouragement and acquiescence of the author, or where the author suffers time to run on the violation of his right. *Cooper v. Mattheys*,* 8 Law Rep., 413.

§ 384. In copyright cases, affidavits for rebutting the averments of the answer as to the title of the complainants will not be received on motions for or to dissolve an injunction. *Farmer v. Calvert Lithographing, etc., Co.*, 1 Flip., 228; 5 Am. L. T. (U. S.), 168; 7 Am. L. Rev., 365 (§§ 288-97).

§ 385. It appearing that an injunction in a copyright case had been violated by the printing and publication of a chart violating the complainant's copyright, and the offender being a woman, it was ordered that all copies of the chart, within the respondent's control, and the plate from which they were printed, be delivered to the clerk of the court. *Drury v. Ewing*, 1 Bond, 540 (§§ 112-14).

VII. SALE ON EXECUTION.

SUMMARY — *Sale of copper-plate*, § 386.

§ 386. The sale on execution of the plate from which a copyrighted map is printed does not confer on the purchaser the right of printing and selling the map. *Stevens v. Gladding*, §§ 387-89.

STEVENS v. GLADDING.

(17 Howard, 447-455. 1854.)

Opinion by MR. JUSTICE CURTIS.

STATEMENT OF FACTS.—The appellant filed his bill in the circuit court of the United States for the district of Rhode Island, to restrain the defendants from printing and publishing a map of that state, whereof he claimed to be the exclusive proprietor, under the act of congress of February 3, 1831 (4 Stats. at Large, 438), concerning copyrights of maps, etc. The defendants admit that they have sold such maps, but allege that a copper-plate owned by the plaintiff was duly sold on an execution which issued on a judgment recovered against the plaintiff in the court of common pleas for the county of Bristol, in the state of Massachusetts, and that one Isaac H. Cady was the purchaser of the plate under that sale; that Cady has used the plate to print the said maps, and the defendants have sold them; and they insist that by the purchase of

the copper-plate Cady acquired the right to print maps therewith, and to publish and sell them; and that, therefore, the defendants have not infringed on any exclusive right of the complainants.

By reference to the case of *Stevens v. Cady*, reported in 14 How., 528, it will be seen that the same title, now asserted by these defendants, was tried on that case, between the complainant and Cady. But, as is stated in the report of that case, no counsel then appeared or was heard in support of Cady's title; and Mr. Justice Woodbury, who sat in the cause in the circuit court, having deceased, this court was not apprised of the grounds and reasons on which the decree of that court dismissing the bill rested; and when this cause was called, counsel having appeared and desired to be heard, though he frankly avowed that the question passed on in the former case was the only one which could be raised, the court readily assented, and, having now considered the argument of the respondent's counsel, the court directs me to state its opinion in the cause.

The positions assumed by the respondent's counsel are that copy and patent-rights are subject to seizure and sale on execution; and that whenever the owner of a copyright of a map causes a plate to be made which is capable of no beneficial use except to print his map, he thereby annexes to the plate the right to use it for printing that map, and also the right to publish and sell the copies when printed; and that when the plate is sold on execution, these rights pass with the plate, and as incidents or accessories thereto, though no mention is made of them in the sale.

§ 387. *By the sale on execution of a copper-plate of a map the right to print and publish or sell maps from it does not pass, but remains in the owner of the copyright. (a)*

There would certainly be great difficulty in assenting to the proposition that patent and copyrights, held under the laws of the United States, are subject to seizure and sale on execution. Not to repeat what is said on this subject in 14 How., 531, it may be added that these incorporeal rights do not exist in any particular state or district; they are co-extensive with the United States. There is nothing in any act of congress, or in the nature of the rights themselves, to give them locality anywhere, so as to subject them to the process of courts having jurisdiction limited by the lines of states and districts. That an execution out of the court of common pleas for the county of Bristol, in the state of Massachusetts, can be levied on an incorporeal right subsisting in Rhode Island or New York will hardly be pretended. That by the levy of such an execution the entire right could be divided, and so much of it as might be exercised within the county of Bristol sold, would be a position subject to much difficulty.

These are important questions, on which we do not find it necessary to ex-

(a) The copper-plate engraving, like any other tangible personal property, is the subject of seizure and sale on execution, and the title passes to the purchaser the same as if made at a private sale. But the incorporeal right, secured by the statute to the author, to multiply copies of the map by the use of the plate, being intangible, and resting altogether in grant, is not the subject of seizure or sale by means of this process — certainly not at common law. No doubt the property may be reached by a creditor's bill, and be applied to the payment of the debts of the author, the same as stock of the debtor is reached and applied, the court compelling a transfer and sale of the stock for the benefit of the creditors. 20 J. R., 554; 5 J. Ch., 280; S. C., 4 id., 687; 1 Paige, 637. But in case of such remedy, we suppose it would be necessary for the court to compel a transfer to the purchaser, in conformity with the requirements of the copyright act, in order to invest him with a complete title to the property. *Stevens v. Cady*,* 14 How., 528.

press an opinion, because, in this case, neither the copyright as such, nor any part of it, was attempted to be sold. The return of the officer on the execution is that he seized and sold "one copper-plate for the map of the state of Rhode Island." The defendants must, therefore, stand upon the second position assumed by their counsel, that the right to print and publish the map passed by the execution sale with the plate.

There are no special facts in this case to distinguish it from any case of a sale on execution of copper or stereotype plates. It appears that the plaintiff owned the plate; whether he made it, or caused it to be made, or purchased it after it had been made, does not appear.

Nor should the case be confounded with one where the owner of copper or stereotype plates sells them. What rights would pass by such a sale would depend on the intentions of its parties, to be gathered from their contract and its attendant circumstances. In this case, the owner of the copyright made no contract of sale, and necessarily had no intention respecting its subject-matter.

The sole question is whether the mere fact that the plaintiff owned the plate attached to it the right to print and publish the map, so that this right passed with the plate by a sale on execution.

And upon this question of the annexation of the copyright to the plate it is to be observed, first, that there is no necessary connection between them. They are distinct subjects of property, each capable of existing, and being owned and transferred, independent of the other. It was lawful for any one to make, own and sell this copper-plate. The manufacture of stereotype plates is an established business, and the ownership of the plates of a book under copyright may be, and doubtless in practice is, separated from the ownership of the copyright. If an execution against a stereotype founder were levied on such plates, which he had made for an author and not delivered, the title to those plates would be passed by the execution sale, and the purchaser might sell them, but clearly he could not print and publish a book for which they were made. The right to print and publish is therefore not necessarily annexed to the plate, nor parcel of it.

Neither is the plate the principal thing, and the right to print and publish an incident or accessory thereof. It might be more plausibly said that the plate is an incident or accessory of the right; because the sole object of the existence of the plate is as a means to exercise and enjoy the right to print and publish.

Nor does the rule that he who grants a thing grants impliedly what is essential to the beneficial use of that thing apply to this case. A press, and paper and ink, are essential to the beneficial use of a copper-plate. But it would hardly be contended that the sale of a copper-plate passed a press, and paper and ink, as incidents of the plate, because necessary to its enjoyment.

The sale of a copper-plate passes the right to such lawful use thereof as the purchaser can make, by reason of the ownership of the thing he has bought; but not the right to a use thereof, by reason of the ownership of something else which he has not bought, and which belongs to a third person. If he has not acquired a press, or paper, or ink, he cannot use his plate for printing, because each of these kinds of property is necessary to enable him to use it for that purpose. So, if he has not acquired the right to print the map he cannot use his plate for that purpose, because he has not made himself the owner of something as necessary to printing as paper and ink, and as clearly

a distinct species of property as either of those articles. He may make any other use of the plate of which it is susceptible. He may keep it till the expiration of the limited time during which the exclusive right exists, and then use it to print maps. He may sell it to another, who has the right to print and publish, but he can no more use that right of property than he can use a press, or paper, which belongs to a third person.

The cases mentioned at the bar, in which incorporeal rights have been held to pass with corporeal property, do not apply.

By the levy of an execution on a mill, the incorporeal rights actually annexed to the mill, and necessary to its use, pass with the mill. So does what is parcel of the mill, though temporarily removed from it — as a mill-stone, which has been taken from its place to be picked. These, and many other such cases, are collected in Broom's Legal Maxims, 198, 205.

But the right in question is not parcel of the plate levied on, nor a right merely appendant or appurtenant thereto; but a distinct and independent property, subsisting in grant from the government of the United States, not annexed to any other thing, either by the act of its owner or by operation of law.

For these reasons, as well as those stated in 14 How., our conclusion is, that the mere ownership of a copper-plate of a map, by the owner of the copyright, does not attach to the plate the exclusive right of printing and publishing the map, held under the act of congress, or any part thereof; but the incorporeal right subsists wholly separate from and independent of the plate, and does not pass with it by a sale thereof on execution.

The next question is, whether the complainant can have a decree in accordance with the prayer of his bill, for the penalties imposed by the seventh section of the act of February 3, 1831. The bill prays specifically for a decree for these penalties. We speak of the forfeiture of the printed copies, as well as of the sum of \$1 for each sheet unlawfully printed, as penalties; for, under the laws of the United States, it is clear that the complainant can have no title to either of them, except by way of penalty.

There being no common law of copyright in this country, whatever rights are possessed by the proprietor of the copyright must be derived from some grant thereof, in some act of congress, either *nominatim* or by a satisfactory implication; and, looking to the act of congress applicable to this subject-matter, it appears that the rights claimed by this bill are expressly conferred by way of forfeiture. Its language is: "Then such offender shall forfeit the plate or plates on which such map, etc., shall be copied, and also all and every sheet thereof so copied or printed as aforesaid, to the proprietor or proprietors of the copyright thereof; and shall further forfeit \$1 for every sheet of such map, etc., which may be found in his or their possession, printed, etc., contrary to the true intent and meaning of this act; the one moiety thereof to the proprietor or proprietors, and the other moiety to the use of the United States, to be recovered in any court having competent jurisdiction thereof."

In the case of *Colburn v. Simms*, 2 Hare, 554, Mr. Vice-chancellor Wigram came to the conclusion that, since the decision of the house of lords in the case of *Miller v. Taylor*, the right to a decree for the delivery up of copies must be rested by the complainant upon some statute provision; and that inasmuch as courts of equity do not enforce forfeitures by an exercise of their ordinary jurisdiction, such a jurisdiction also must be derived from an act of parliament. And though the eighth section of the act of 1 and 2 Vict., ch. 59, as

well as the preceding act of 54 Geo. III., ch. 156, § 4, allows the forfeited copies to be recovered in "any court of record in which an action at law, or a suit in equity, shall be commenced by such author or authors, or other proprietor or proprietors," etc., yet it was admitted, in *Colburn v. Simms*, that no such order had ever been made, *in invitum*, in a court of equity. It is a significant fact that congress, in legislating on this subject, though manifestly acquainted with the phraseology of the act of Geo. III., and though in some particulars it adopted that phraseology, yet omitted to confer upon courts of equity power to enforce either of the forfeitures provided for, but left them to be recovered "in any court having competent jurisdiction thereof." And the only equitable jurisdiction, as to copyright, conferred upon the courts of the United States, is by the act of February 15, 1819 (3 Stats. at Large, 481), which gives original cognizance to the courts of the United States, as well in equity as at law, of cases arising under any law of the United States granting to authors or inventors the exclusive right to their respective writings, inventions and discoveries; and, upon any bill in equity filed by any party aggrieved in any such case, shall have authority to grant injunctions according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors secured to them by any laws of the United States, on such terms as the said courts may deem fit and reasonable. Though the substance of this enactment is incorporated into the seventeenth section of the patent act of July 4, 1836, so far as it related to inventors, and so far as it related to the subject of patent-rights, is no longer in force, *proprio vigore*, yet, so far as it gave cognizance to the courts of the United States of cases of copyright, it still remains in force, and is the only law conferring equitable jurisdiction on those courts in such cases; for the ninth section of the act of February 3, 1831, protects manuscripts only.

§ 388. *Courts of equity have not power to enforce forfeitures for violation of copyright.*

There is nothing in this act of 1819 which extends the equity powers of the courts to the adjudication of forfeitures; it being manifestly intended that the jurisdiction therein conferred should be the usual and known jurisdiction exercised by courts of equity for the protection of analogous rights. The prayer of this bill for the penalties must therefore be rejected.

The remaining question is, whether there ought to be a decree for an account of the profits. The complainant has not prayed for such an account, nor have the defendants stated one in their answer; but the bill does pray for general relief.

§ 389. *Where a bill states a proper case for an account, one may be ordered under the prayer for general relief.*

The right to an account of profits is incident to the right to an injunction in copy and patent-right cases. *Colburn v. Simms*, 2 Hare, 554; 3 Dan. Ch. Pr., 1797. And this court has held, in *Watts v. Waddle*, 6 Pet., 389, that, where the bill states a case proper for an account, one may be ordered under the prayer for general relief. See, also, 2 Pet., 612; 14 id., 156; 16 id., 195; 9 How., 405.

The decree of the circuit court must be reversed and the cause remanded to the circuit court, with directions to award a perpetual injunction as prayed for in the bill, and to take an account of the profits received by the defendants from the sales of the map.

B. TRADE-MARKS.

I. IN GENERAL, §§ 390-406.	IV. POWERS OF CONGRESS, §§ 528-536.
II. WHAT MAY BE USED AS A TRADE-MARK, §§ 407-520.	V. RIGHT TO USE OF AN ESTABLISHED TRADE-MARK, §§ 537-564.
III. ADOPTION AND REGISTRATION, §§ 521-527.	VI. INFRINGEMENT, §§ 565-605.
	VII. SUITS FOR INFRINGEMENT, §§ 606-631.

I. IN GENERAL.

§ 390. **General principles.**—Trade-marks are protected on the ground of property, and not exclusively on the ground of fraud, and damages will be allowed for an unauthorized, though unintentional, use of a trade-mark. *Oakes v. Tousmierre*,* 4 Woods, 547.

§ 391. Equity gives relief for the infringement of a trade-mark upon the ground that one person is not allowed to offer his goods for sale representing them to be the manufacture of another. *Manhattan Medicine Co. v. Wood*, 4 Cliff., 461; 14 O. G., 519 (§§ 550-51).

§ 392. Where a person has appropriated a particular trade-mark to distinguish his goods from other similar goods, he has a right of property in it which entitles him to its exclusive use which equity will protect. *Hostetter v. Vowinkle*,* 1 Dill., 329.

§ 393. The basis of the action of a court of equity to restrain the infringement of the right to a trade-mark is fraud on the part of the defendant. *Delaware & Hudson Canal Co. v. Clark*,* 7 Blatch., 112.

§ 394. In suits against an infringer of a trade-mark, the question is not whether the complainant was the original inventor or proprietor of the article made by him, and on which he has put his trade-mark, nor whether the article made by the respondent is equal to his own in value or quantity, but the court proceeds on the ground that the complainant has a valuable interest in the good-will of his trade or business, and that, having adopted a particular label, sign or trade-mark, indicating to his customers that the article bearing it is made or sold by him or by his authority, or that he carries on business at a particular place, he is entitled to protection against one who attempts to deprive him of his trade or customers by using such labels, signs or trade-mark without his knowledge or consent. *McLean v. Fleming*, 6 Otto, 245; 10 Ch. Leg. N., 252 (§§ 431-40).

§ 395. **Rights of creditors.**—A court of equity will not direct the sale, for the benefit of creditors, of the interest of a debtor in a trade-mark, consisting of the name of the firm of which he is a member. *Taylor v. Bemis*,* 4 Biss., 406.

§ 396. An assignee of a trade-mark is not affected by a private and secret agreement between the original proprietors of the trade-mark of which he has no notice. *Oakes v. Tousmierre*,* 4 Woods, 547.

§ 397. **Quack medicines.**—A person whose business is imposition cannot invoke the aid of equity against a piracy of his trade-mark. So the unauthorized use of a trade-mark of a quack medicine will not be enjoined. *Fowle v. Spear*,* 7 Pa. L. J., 176; 4 Pa. L. J. Rep., 145; 11 Law Rep., 130; 1 Law Rep. (N. S.), 130.

§ 398. A court of equity will not interfere by injunction to prevent the use of a word as a trade-mark for a patent quack medicine. *Heath v. Wright*,* 3 Wall. Jr., 141.

§ 399. **Evidence of a custom** in England and elsewhere abroad to counterfeit the trade-marks of aliens with impunity is inadmissible as a defense in an action to recover damages for the unauthorized use of a trade-mark. Nor is it admissible to show acquiescence on the part of the plaintiff. *Taylor v. Carpenter*,* 2 Woodb. & M., 1; 10 Law Rep., 35.

§ 400. **Acquiescence** in the unauthorized use of a trade-mark will not bar an action for damages for such use unless continued for the period prescribed by the statute of limitations. *Ibid.*

§ 401. **No defense that others infringe.**—It is no defense to a suit for the infringement of a trade-mark that others are guilty of the same infringement, where there has been no surrender of rights by the plaintiffs to the public, or the infringers. *Taylor v. Carpenter*,* 3 Story, 458; 7 Law Rep., 437; 2 West. L. J., 187.

§ 402. **Aliens.**—The unauthorized use of a trade-mark of thread, and an imitation of spools and labels, will be enjoined even though the plaintiffs are aliens, and their thread is manufactured abroad. *Ibid.*

§ 403. An alien friend may maintain an action in the courts of this country to recover damages for an unauthorized use of his trade-mark, even though such right is not allowed our citizens in the country to which he belongs. *Taylor v. Carpenter*,* 2 Woodb. & M., 1; 10 Law Rep., 35.

§ 404. **Right to make and sell an article.**— A person does not, by the invention of an article not patented, secure to himself the exclusive right to manufacture and sell it. Any other person may make and sell it. *Coffeen v. Brunton*,* 4 McL., 516; 7 West. L. J., 59.

§ 405. **The right to use a trade-mark** depends upon its use. *William Rogers Manuf'g Co. v. Rogers & Spurr Manuf'g Co.*, 11 Fed. R., 495 (§§ 470-72).

§ 406. **A trade-mark will protect** only the particular kind of goods set forth in the statement filed. *Osgood v. Rockwood*,* 11 Blatch., 310.

II. WHAT MAY BE USED AS A TRADE-MARK.

SUMMARY— *Marks and brands*, § 407.— *Labeled packages of a peculiar shape*, § 408.— *Wrapper of a certain size, color and lettering*, § 409.— *Labels*, § 410.— *Barrel of a peculiar size and shape*, § 411.— *Shape and color of an article*, § 412.— *Words*, § 413.— *Name descriptive of article*, § 414.— *Geographical names*, §§ 415, 416, 417.— *Use of the word "Durham" in connection with the figure of a bull*, § 418.— *Expiration of patent*, §§ 419-422.— *Letters denoting quality*, § 423.— *Figures*, § 424.— *Symbols of a certain form, size and color*, § 425.— *Appropriation of good-will of another business*, § 426.— *Names of persons*, § 427.— *Right to use one's own name*, § 428.— *"Parabola," as applied to needles*, § 429.— *"Yankee,"* § 430.

§ 407. Where a person has been in the habit of stamping his goods with a particular mark or brand, so that the purchasers of his goods having that mark or brand know them to be of his manufacture, no other manufacturer has a right to adopt the same stamp. *McLean v. Fleming*, §§ 431-440.

§ 408. Whether a manufacturer has a trade-mark or not, if he was the first to put up his goods for sale in peculiarly shaped and labeled packages adopted by him, and his goods become known to purchasers and are purchased by them as his manufacture by reason of the peculiar shape, color and label of the packages, no person has the right to use the same form of package, color or label, or any imitation thereof, in such a manner as to deceive purchasers into believing that they are purchasing the goods of the original manufacturer, no matter whether they are better or worse in quality. *Sawyer v. Horn*, § 441.

§ 409. A wrapper used on a small bottle containing bluing, divided into compartments, in one of which are the words "Sawyer's Crystal Blue and Safety Box," other words in finer type, commendatory of the article and giving directions for its use, being printed in the other compartments, is infringed by a wrapper of the same size, color, type and general appearance, and containing in one of the compartments the words "Sawin's Soluble Blue and Pepper Box." *Sawyer v. Kellogg*, § 442.

§ 410. The use of a label made in imitation of a label in use for a long time upon an article of the same nature, and which is calculated to deceive purchasers, will be enjoined. *Ibid.*

§ 411. A barrel of peculiar size, shape and construction, without any marks, symbols or devices of any kind impressed upon or connected with it, cannot become a trade-mark or the substantive part of a trade-mark. *Moorman v. Hoge*, §§ 443, 444.

§ 412. The shape and color of an article cannot be claimed and protected as a trade-mark. These may be copied with exactness without inflicting any legal injury, unless the party attributes a false origin to that which he has made. *Fairbanks v. Jacobus*, §§ 461, 462.

§ 413. In order that mere words may be upheld as a trade-mark, they must be merely arbitrary, or they must indicate the origin or ownership of the article to which they are affixed. If they are expressive only of the name or quality of the article, and have acquired that significance in the market, their use cannot be exclusive. *Burton v. Stratton*, §§ 445-452.

§ 414. The question whether a term applied to an article has become so well known as to stand in the public eye as denoting its character and quality, and not its origin or ownership, as it did when first applied, is for the determination of the court from the term itself and the evidence. If manufactured and sold by a number of persons under a particular name, this would be conclusive against the exclusive right to use the name as a trade-mark, as the term would thereby become generic, or indicative of quality. But if the primary object of the trade-mark was to indicate origin or ownership, the mere fact that the article has obtained such a wide sale that the mark has also become indicative of quality is not sufficient of itself to debar the owner of protection. *Ibid.*

§ 415. The use of the words "Lackawanna coal," as applied to coal mined in the Lackawanna valley, will not be enjoined at the suit of the owners of the mine first operated in that locality, who first applied that term to the product of their mine. *Canal Co. v. Clark*, §§ 453-456.

§ 416. The name of a district of country cannot be applied to a well-known article of commerce in such a manner as to prevent others inhabiting the district or dealing in similar articles from truthfully using the same designation. It is only when the adoption or imitation of what is claimed to be a trade-mark amounts to a false representation that there is any title to relief against it. Purchasers may be mistaken, but they are not deceived, by false representations, and equity will not enjoin the telling of the truth. *Ibid.*

§ 417. Tobacco grown in the vicinity of Durham, North Carolina, having special and peculiar characteristics, and having acquired a reputation for special excellence, the use of the word "Durham" by manufacturers at other points would be enjoined as being a fraud on the public. *Blackwell v. Dibrell*, §§ 457-459.

§ 418. *Blackwell & Co.* have the exclusive right to the use of the word "Durham" and the side figure of a bull as a trade-mark for tobacco. *Ibid.*

§ 419. Where a machine has acquired a name which designates a mechanism or a peculiar construction, parts of which are protected by patents, other persons, after the expiration of the patents, have the right to construct the machine and call it by that name, because that only expresses the kind and quality of the machine; but such other persons will not be allowed to place upon their machines marks and devices which would lead the public to think they were made by the original manufacturers. *Singer Manuf'g Co. v. Larsen*, § 460.

§ 420. The words "Singer Sewing Machine" do not constitute a proper trade-mark. *Ibid.*

§ 421. After the expiration of the Fairbanks' scale patents the use of the words "Fairbanks' Patent" upon scales cannot be protected as a trade-mark, especially when the words are so used as to produce the belief that the scales are still protected by patents and there has been acquiescence in such infringement. *Fairbanks v. Jacobus*, §§ 461, 462.

§ 422. When, during the whole existence of a patent, articles embodying the principles of the patented article and called by the same name were manufactured and sold with the acquiescence of the patentee, he cannot claim, as against such manufacturer, an exclusive right to such name as a trade-mark for such articles after the expiration of the patent. *Filley v. Child*, § 463.

§ 423. Letters used by a manufacturer to denote merely the quality of the article to which they are affixed cannot be appropriated by him as an exclusive trade-mark. *Manufacturing Co. v. Trainer*, §§ 464-467.

§ 424. The court being in doubt whether the character $\frac{1}{2}$, stamped upon packages of cigarettes, was used merely as an arbitrary trade-mark, or as calculated in some sort to indicate the idea of half-and-half, refused a general injunction; but held that the complainant had the right to the exclusive use of the symbol in the form, size, color and style in which he had been accustomed to use it. *Kinney v. Allen*, §§ 468, 469.

§ 425. The use of a symbol which indicates but does not express an idea embodied in the articles to which it is attached will not be enjoined; but where such symbol is used in a certain form, size and color, it is a trade-mark in the use of which the owner will be protected. *Ibid.*

§ 426. A person cannot apply his name to articles of his manufacture in such a manner as to appropriate to himself the good-will of a business established by others of that name. *William Rogers Manuf'g Co. v. Rogers & Spurr Manuf'g Co.*, §§ 470-472.

§ 427. The names of persons may be used as a trade-mark by a corporation, and such use will be protected though the persons whose names are used are not connected with the manufacture of the goods upon which their names appear. *Ibid.*

§ 428. A person has not the right to the exclusive use of his name as a trade-mark, as against another person of the same name, unless such other person uses a form of stamp or label so like that used by him as to represent that the goods of the former are of the latter's manufacture. Nor will any other name, merely as such, confer any such exclusive right unless the name is printed in some particular manner in a label of some particular characteristics, so that it becomes to some extent identified with a particular kind of goods, or when the name is used by a person in connection with his place of business, in such a manner that it assumes the character of a trade-mark. *McLean v. Fleming*, §§ 431-440.

§ 429. The word "Parabola" is a proper trade-mark for needles, and its use as applied to needles will be enjoined, even though used in connection with the name of the defendant manufacturer. The claim of the defendant that the word is descriptive of the eyes of the needles is immaterial when no reference is made thereto on the label, and does not appear correctly to describe the shape of the eye. *Roberts v. Sheldon*, § 473.

§ 430. The word "Yankee" may be used as a trade-mark applied to soap. *Williams v. Adams*, §§ 474, 475.

[NOTES.—See §§ 476-520.]

MCLEAN *v.* FLEMING.

(6 Otto, 245-258. 1877.)

APPEAL from U. S. Circuit Court, Eastern District of Missouri.

The facts are stated in the opinion with sufficient fullness for an understanding of the questions decided.

Opinion by MR. JUSTICE CLIFFORD.

STATEMENT OF FACTS.—Protection for lawful trade-marks may be obtained by individuals, firms or corporations entitled to the same, if they comply with the requirements prescribed by the act of congress; and the provision is that a trade-mark, duly registered as required, shall remain in force thirty years from the date of such registration, subject to an exception not necessary to be noticed. 16 Stat., 210; R. S., secs. 4937, 4941.

Exclusive ownership of a certain medicinal manufacture, known as "Dr. C. McLane's Liver Pills," and of the trade-mark used in advertising and vending the same, is claimed by the complainant; and the record shows that he, on the 1st day of June, 1872, filed in the circuit court a bill of complaint against the respondent, charging that the respondent had unlawfully infringed the said trade-mark; and he prayed for a decree that the respondent shall render an account of the gains and profits made by the infringement, and for an injunction.

Service was made, and the respondent appeared and filed an answer. Proofs were taken; and, the parties having been heard, the court entered a decretal order in favor of the complainant, and sent the cause to a master, to compute the amount of the gains and profits. Due report was made by the master, to which the respondent excepted; and the court overruled the exception, confirmed the report of the master, and entered a final decree for the complainant, in the sum of \$7,399.35.

All matters in that court having been finally determined, the respondent appealed to this court, and assigns errors as follows: 1. That the court erred in finding that the labels L and K, or either of them, infringed Exhibit F, as set forth in the decretal order. 2. That the court erred in finding that the complainant was entitled to any damages, and in ordering the assessment thereof, and in allowing him costs. 3. That the court erred in ordering an account of the sales of Exhibits L and K, prior to the 16th of October, 1871, the date of the first use of Exhibit H by the complainant. 4. That the court erred in overruling the respondent's exception to the master's report.

Medicines of the kind described were first prepared and sold by the physician whose name the pills bear, by putting the same in wooden boxes, labeled with the name of the inventor. For ten years, or more, he used the pills in his practice; but the evidence shows that, on the 19th of June, 1844, he sold the right to use the same to Jonathan Kidd, who, for a year or more, prepared and sold the pills under that agreement, when he formed a partnership with John Fleming, under the style of "Jonathan Kidd & Co.;" which firm continued to prepare and sell the pills until March 29, 1853, when the senior partner died.

They (the firm) dealt largely in the business; and, as early as 1847, in order to designate the medicine as an article of their own manufacture, and to prevent imposition and fraud, they commenced putting the pills in wooden boxes, of uniform size, shape and appearance, each box containing twenty-two pills, with the name of the original inventor stamped in red wax under the cover of

each box, around which they placed the red label or wrapper described in the bill of complaint. Beyond doubt, that label, with its devices, and the red seal on the box, constituted the trade-mark by which the firm made known to their customers and the public the genuine pills which they prepared and sold; the firm being at the time the owners of the original recipe, and having the exclusive right to make and vend the pills.

Within a month subsequent to the death of the senior partner of the firm, his executors sold and conveyed all the interest of the decedent in the business to the surviving partner and the complainant, whereby they, under the firm name of "Fleming Brothers," acquired not only the title to the recipe and the right to make and vend the pills, but also the right to use the labels and trade-marks used by the former owners. Possessed of the whole interest, they (the firm, Fleming Brothers) prosecuted the business, with some changes in the individual partners, until July 1, 1865, when the present complainant sold out his whole interest to his brother, John Fleming, who, as sole proprietor of what the firm owned, continued the business until the 2d of November, 1870, when he died, leaving a last will and testament.

When that firm acquired the entire interest, they immediately enlarged the business, and in the year 1855 they adopted the dark label, Exhibit F, which is fully and minutely described in the bill of complaint; and the complainant avers that it has since been used in the business, with no other substantial alterations than what are shown in Exhibit H, mentioned in the decretal order. Both parties agree that the complainant, by the will of his deceased brother, acquired all the rights which the deceased had in the business; and the record shows that he has, since the probate of the will on the 9th of November, 1870, been preparing and vending said pills, and using the labels and trade-marks to designate their genuineness and to commend their value and utility.

Evidence was introduced by the respondent, whose name is James H. McLean, that he commenced in 1849, in St. Louis, to manufacture his own medicines; that in 1851 he began to manufacture and sell liver pills, under the name of "Dr. McLean's Universal Pills," using first a type-printed label in red letters, which was changed, in 1852, to a lithographed red label, called in the decretal order "Exhibit L," which was used down to 1866, except that about 1863 he added to his name the initials "J. H.," so that the label read "Dr. J. H. McLean's Universal Pills;" that in 1866 he changed his label to the one referred to in the decretal order as "Exhibit K," which he continued to use until May 21, 1872, when he adopted a new label, the use of which does not infringe the trade-mark of the complainant.

Governed by these facts as stated, the court will examine the first error assigned; which is, that the court erred in finding that the labels L and K infringed complainant's Exhibit H, as set forth in the decretal order. By the order, the respondent, James H. McLean, his agents, employees and servants, are perpetually enjoined and restrained from using, or causing to be used, the words "Dr. J. H. McLean's Universal Pills or Vegetable Liver Pills," or the words "Dr. McLean's Universal Pills," upon any label or wrapper for boxes or other packages of pills resembling or in imitation of the labels, wrappers or trade-mark of the complainant, described in his bill of complaint as "Exhibit H," whether in style of engraving, printing or lettering; and from vending or exposing for sale, or causing to be vended or exposed for sale, any article of pills having upon the boxes or other packages thereof any such labels or wrap-

pers so made in imitation of or resemblance to the said labels or wrappers of the complainant.

§ 431. *Where a manufacturer stamps his goods with a particular mark no other person has a right to use the same mark.*

Equity gives relief in such a case upon the ground that one man is not allowed to offer his goods for sale, representing them to be the manufacture of another trader in the same commodity. Suppose the latter has obtained celebrity in his manufacture, he is entitled to all the advantages of that celebrity, whether resulting from the greater demand for his goods or from the higher price the public are willing to give for the article, rather than for the goods of the other manufacturer, whose reputation is not so high as a manufacturer. Where, therefore, a party has been in the habit of stamping his goods with a particular mark or brand, so that the purchasers of his goods having that mark or brand know them to be of his manufacture, no other manufacturer has a right to adopt the same stamp; because, by doing so, he would be substantially representing the goods to be the manufacture of the person who first adopted the stamp, and so would or might be depriving him of the profit he might make by the sale of the goods which the purchaser intended to buy. *Seixo v. Provezende*, Law Rep., 1 Ch., 195.

§ 432. *What constitutes infringement.*

What degree of resemblance is necessary to constitute an infringement is incapable of exact definition, as applicable to all cases. All that courts of justice can do, in that regard, is to say that no trader can adopt a trade-mark so resembling that of another trader as that ordinary purchasers buying with ordinary caution are likely to be misled.

§ 433. *Delay as a ground for refusing relief.*

Unreasonable delay in bringing a suit is always a serious objection to relief in equity; but cases arise in litigations of the kind before the court where the complainant may be entitled to an injunction to restrain the future use of a trade-mark, even when it becomes the duty of the court to deny the prayer of the bill of complaint for an account of past gains and profits. *Harrison v. Taylor*, 11 Jur. (N. S.), 408.

§ 434. *The right to a trade-mark is based on the ground that the party has a valuable interest in the good-will of his trade of which the trade-mark is an important accessory.*

In such cases the question is not whether the complainant was the original inventor or proprietor of the article made by him, and on which he puts his trade-mark, nor whether the article made and sold under his trade-mark by the respondent is equal to his own in value or quality, but the court proceeds on the ground that the complainant has a valuable interest in the good-will of his trade or business, and, having adopted a particular label, sign or trade-mark, indicating to his customers that the article bearing it is made or sold by him or by his authority, or that he carries on business at a particular place, he is entitled to protection against one who attempts to deprive him of his trade or customers by using such labels, signs or trade-mark without his knowledge or consent. *Coats v. Holbrook*, 2 Sandf. (N. Y.) Ch., 586; *Partridge v. Menck*, 2 Barb. (N. Y.) Ch., 101.

Everywhere courts of justice proceed upon the ground that a party has a valuable interest in the good-will of his trade and in the labels or trade-mark which he adopts to enlarge and perpetuate it. Hence it is held that he, as proprietor, is entitled to protection as against one who attempts to deprive him

of the benefits resulting from the same by using his labels and trade-mark without his consent and authority. Decided cases to that effect are quite numerous, and it is doubtless correct to say that a person may have a right in his own name as a trade-mark as against a trader or dealer of a different name; but the better opinion is that such a party is not, in general, entitled to the exclusive use of a name, merely as such, without more. *Millington v. Fox*, 3 Myl. & C., 338; *Dent v. Turpin*, 2 J. & H., 139; *Meneely v. Meneely*, 62 N. Y., 427.

Instead of that he cannot have such a right, even in his own name, as against another person of the same name, unless such other person uses a form of stamp or label so like that used by the complaining party as to represent that the goods of the former are of the latter's manufacture. Nor will any other name, merely as such, confer any such exclusive right, unless the name is printed in some particular manner in a label of some peculiar characteristics, so that it becomes, to some extent, identified with a particular kind of goods, or when the name is used by the party, in connection with his place of business, in such a manner that it assumes the character of a trade-mark within the legal meaning of that term, and as such entitles the party to the protection of a court of equity, to prevent others from infringing the proprietor's exclusive right. *Gilman v. Hunnewell*, 122 Mass., 139; *Colladay v. Baird*, 4 Phil. (Pa.), 139; *Sykes v. Sykes*, 3 B. & C., 541; *Croft v. Day*, 7 Beav., 89; *Burgess v. Burgess*, 3 DeG., M. & G., 896; *Holloway v. Holloway*, 13 Beav., 209; *Rogers v. Taintor*, 97 Mass., 291.

§ 435. *What constitutes an infringement of a trade-mark. Positive proof of fraudulent intent is not required.*

Much must depend, in every case, upon the appearance and special characteristics of the entire device; but it is safe to declare, as a general rule, that exact similitude is not required to constitute an infringement or to entitle the complaining party to protection. If the form, marks, contents, words, or the special arrangement of the same, or the general appearance of the alleged infringer's device, is such as would be likely to mislead one in the ordinary course of purchasing the goods, and induce him to suppose that he was purchasing the genuine article, then the similitude is such as entitles the injured party to equitable protection, if he takes seasonable measures to assert his rights, and to prevent their continued invasion. *James v. James*, Law Rep., 13 Eq., 425; *Singleton v. Bolton*, 3 Doug., 293; *Morrison v. Salmon*, 2 Man. & G., 385; *Boardman v. Meriden Britannia Co.*, 35 Conn., 413.

Such a proprietor, if he owns or controls the goods which he exposes to sale, is entitled to the exclusive use of any trade-mark adopted and applied by him to the goods, to distinguish them as being of a particular manufacture and quality, even though he is not the manufacturer, and the name of the real manufacturer is used as part of the device. *Walton v. Crowley*, 3 Blatch., 440; *Emerson v. Badger*, 101 Mass., 82.

Equity courts will not, in general, refuse an injunction on account of delay in seeking relief, where the proof of infringement is clear, even though the delay may be such as to preclude the party from any right to an account for past profits. *Rodgers v. Rodgers*, 31 L. T., 285; *Blackwell v. Crabb*, 45 L. J., Pt. I., 505. Positive proof of fraudulent intent is not required where the proof of infringement is clear, as the liability of the infringer arises from the fact that he is enabled, through the unwarranted use of the trade-mark, to sell a simulated article as and for the one which is genuine. *Wotherspoon v. Currie*, Law Rep., 5 App. Cas., 512.

Nor is it necessary, in order to give a right to an injunction, that a specific trade-mark should be infringed; but it is sufficient that the court is satisfied that there was an intent on the part of the respondent to palm off his goods as the goods of the complainant, and that he persists in so doing after being requested to desist. *Woollam v. Ratcliff*, 1 Hem. & M., 259. Apply these rules to the case, and it is clear that the charge of infringement is satisfactorily proved in this case.

§ 436. *What may be used as a trade-mark.*

Words or devices, or even a name in certain cases, may be adopted as trade-marks which are not the original invention of the party who appropriates the same to that use; and courts of equity will protect the proprietor against any fraudulent use or imitation of the device by other dealers or manufacturers. Property in the use of a trade-mark, however, bears very little analogy to that which exists in copyrights or in patents for new inventions or discoveries, as they are not required to be new, and may not involve the least invention or skill in their discovery or application. Phrases, or even words in common use, may be adopted for the purpose, if, at the time of their adoption, they were not employed by another to designate the same or similar articles of production or sale. Stamps or trade-marks of the kind are employed to point out the origin, ownership, or place of manufacture or sale of the article to which it is affixed, or to give notice to the public who is the producer, or where it may be purchased. *Canal Company v. Clark*, 13 Wall., 311 (§§ 453-56, *infra*).

Subject to the qualification before explained, a trade-mark may consist of a name, symbol, figure, letter, form or device, if adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells to distinguish the same from those manufactured or sold by another, to the end that the goods may be known in the market as his, and to enable him to secure such profits as result from his reputation for skill, industry and fidelity. *Upton*, Trade-marks, 9; *Taylor v. Carpenter*, 2 Sandf. (N. Y.) Ch., 603; *Coddington*, Dig., 9.

Complainant's pills have been in the market as a vendible article for more than forty years, and during that whole period have been sold under trade-marks of the form heretofore sufficiently described, and they are still sold under the trade-mark mentioned in the decretal order.

§ 437. *Colorable imitation of a trade-mark.*

Difficulty frequently arises in determining the question of infringement; but it is clear that exact similarity is not required, as that requirement would always enable the wrong-doer to evade responsibility for his wrongful acts. Colorable imitation, which requires careful inspection to distinguish the spurious trade-mark from the genuine, is sufficient to maintain the issue; but a court of equity will not interfere, when ordinary attention by the purchaser of the article would enable him at once to discriminate the one from the other. Where the similarity is sufficient to convey a false impression to the public mind, and is of a character to mislead and deceive the ordinary purchaser in the exercise of ordinary care and caution in such matters, it is sufficient to give the injured party a right to redress, if he has been guilty of no laches. *Amoskeag Manufacturing Co. v. Spear*, 2 Sandf. S. C., 599; *Coddington*, Dig., 109; *McAndrew v. Bassett*, 4 DeG., J. & S., 380.

Argument to show that the name of the pills, as given in the trade-mark of the respondent, was of a character to mislead and deceive, is scarcely necessary, as they are *idem sonans* in the usual pronunciation; nor can it be doubted

that the form of the box containing the pills, and the general appearance of the wrapper which surrounded it, were calculated to have the same effect. Mention may also be made of the fact that the color of the label, and the wax impression on the top of the box, are well suited to divert the attention of the unsuspecting buyer from any critical examination of the prepared article.

§ 438. *Ground on which a trade-mark is protected.*

Chancery protects trade-marks upon the ground that a party shall not be permitted to sell his own goods as the goods of another; and, therefore, he will not be allowed to use the names, marks, letters or other *indicia* of another, by which he may pass off his own goods to purchasers as the manufacture of another. *Croft v. Day*, 7 Beav., 84; *Perry v. Truefitt*, 6 id., 66; *Newman v. Alford*, 51 N. Y., 192.

Witnesses in great numbers were called by the complainant, who testified that the Exhibits L and K of the respondent were calculated to deceive purchasers; and the reasons given by them in support of the conclusion are both persuasive and convincing. Differences between those exhibits and Exhibits F and H of the complainant undoubtedly exist; and still it is manifest that the general appearance of the package in the respects mentioned, and others which might be suggested, is well calculated to mislead and deceive the unwary, and all others who purchase the article without opening the box and examining the label. *Caswell et al. v. Davis*, 58 N. Y., 223.

§ 439. *Trade-marks are substantially the same, when.*

Two trade-marks are substantially the same, in legal contemplation, if the resemblance is such as to deceive an ordinary purchaser giving such attention to the same as such a purchaser usually gives, and to cause him to purchase the one supposing it to be the other. *Gorham Company v. White*, 14 Wall., 511 (PATENTS, §§ 1910-12). Suffice it to say, without entering further into details, the court is of the opinion that the first assignment of error must be overruled, and that the injunction was properly granted to prevent infringement subsequent to the filing of the bill of complaint.

§ 440. *In case of delay and acquiescence, a decree for an account and for profits and damages is erroneous.*

Suppose that is so, still the respondent contends that the court erred, as alleged in the second assignment of errors, and that the complainant is not entitled to an account, nor to a decree for gains, profits or damages. Support to that proposition is attempted to be drawn from the long delay of the complainant, and those under whom he claims, to take any legal steps to protect their alleged rights. Opposed to that, it is insisted by the complainant that no such defense is open to the respondent, as it was not set up in the answer. Nothing of the kind is directly set up in the answer; but the respondent denies all intent to injure or defraud the complainant, and avers that he has been engaged during the last twenty years in perfecting his pills, and that he had no idea that his trade-marks infringed the trade-marks of the complainant.

Proofs were taken upon both sides upon the subject; and the respondent, in his petition for rehearing filed in the court below, expressly alleges that the immediate predecessor of the complainant was perfectly familiar with the pills manufactured by the respondent, and well knew that the respondent used the labels in question; that the agent of the complainant, May 20, 1872, called on the respondent and remonstrated with him for using the label Exhibit K, and that he on the following day adopted a different label, as therein fully explained. Examined in the light of these suggestions the court is of the opinion that the

question presented in the second assignment of error is open for re-examination. *Sullivan v. Portland, etc., Railroad Co.*, 94 U. S., 806 (Conn., §§ 1629-30).

Repetition of the facts is unnecessary, as it sufficiently appears that the respondent has been engaged in preparing and selling his pills for more than forty years; that during that period, or more than half of it, he has been using labels and trade-marks corresponding more or less to those used by the predecessors of the complainant, some of whom, during all or most of that time, knew what the labels and trade-marks were which were used by the respondent, the evidence to that effect being full and decisive. Negotiations took place at one time between the respondent and one of the predecessors of the complainant for an interchange of commodities, with a view that both commodities might be sold at each of their respective places of business.

Evidence of a decisive character is exhibited in the record to show that the complainant or his predecessor knew throughout what description of labels and trade-marks the respondent was using; and it does not appear that any objection was ever made, except as heretofore stated and explained. Once the respondent was requested to insert the initials of his christian name before his surname in the label, and it appears that he immediately complied with the request. Cases frequently arise where a court of equity will refuse the prayer of the complainant for an account of gains and profits, on the ground of delay in asserting his rights, even when the facts proved render it proper to grant an injunction to prevent future infringement. *Harrison v. Taylor*, 11 Jur. (N. S.), 408; *Cox*, Trade-marks, 541.

Relief of the kind is constantly refused, even where the right of the party to an injunction is acknowledged because of an infringement, as in case of acquiescence or want of fraudulent intent. *Moet v. Couston*, 33 Beav., 578; *Edelsten v. Edelsten*, 1 De G., J. & S., 185; *Millington v. Fox*, 3 Myl. & Cr., 398; *Wyeth v. Stone*, 3 Story, 284; *Beard v. Turner*, 13 Law Times (N. S.), 747; *Estcourt v. Estcourt*, Law Rep., 10 Ch., 276; *Coddington*, Dig., 162; *High*, Injunc., 405.

Acquiescence of long standing is proved in this case, and inexcusable laches in seeking redress, which show beyond all doubt that the complainant was not entitled to an account nor to a decree for gains or profits; but infringement having been proven, showing that the injunction was properly ordered, he is entitled to the costs in the circuit court; but the decree for an account and for the supposed gains and profits being erroneous, the respondent, as appellant, is entitled to costs in this court. *Browne*, Trade-marks, sec. 497.

Decree as to the injunction and costs in the circuit court will be affirmed, but it will be reversed as to the decree for an account and as to the allowance for gains and profits, with costs in this court for the appellant; and the cause will be remanded with direction to enter a decree in conformity with the opinion of this court; and it is so ordered.

SAWYER v. HORN.

(Circuit Court for Maryland: 4 Hughes, 239-253. 1880.)

Opinion by MORRIS, J.

STATEMENT OF FACTS.—The bill alleges that the complainant, Henry Sawyer, of the city of Boston, in the state of Massachusetts, has been for about twenty years engaged in the manufacture of bluing; that his bluing has an extended and desirable reputation in the markets of the United States, and especially in Baltimore, where it has been and now is regarded as an article of great excel-

lence, and has been sold in Baltimore and elsewhere in large quantities. That in order to identify the bluing made by him and distinguish it from all others, complainant devised and adopted, as a trade-mark, certain marks, symbols and devices, and a form of package, none of which had been before at any time applied or used in connection with bluing, and which have continually, ever since, been used by him to identify his bluing. That the marks so adopted were: 1. A red disk, applied on the top of the box, which had been first used by him in 1863, and had been registered by him, according to the statutes of the United States, as a trade-mark.

2. Certain pictorial representations of his boxes, which he used as a part of the labels, applied to the outside of the packing boxes, in which the small boxes containing the blue were packed for market.

3. An allocation or combination, consisting of words printed in bronze letters on blue paper constituting the label surrounding the small boxes containing the blue. And also a new and original and peculiar form of package or box to contain the blue, consisting of a cylinder, having a top of metal, perforated with holes, sealed with red sealing-wax. Also a packing-box with certain distinctive labels before mentioned, in which the cylindrical boxes were so packed and arranged that upon being opened nothing was exposed to sight but the red tops.

And the bill charges that the respondent Horn is engaged in Baltimore in the business of manufacturing blue, and knowing the high reputation of complainant's goods as identified by his said marks and labels and peculiar appearance, has for his own profit, and to the injury of the complainant, been selling bluing put up in boxes made in imitation of complainant's trade-marks. And that said respondent Horn had wilfully and fraudulently put up his bluing in packages substantially the same in every material respect and having substantially the same general appearance as those of complainant, and had packed the same in the precise form and manner originated and used by the complainant, and had sold the same as and for the bluing of the complainant.

The bill further alleges that the respondent's imitation of the complainant's peculiar form of packages, labels and manner of packing created confusion in the market, and misled and deceived purchasers who were familiar with and desired to obtain complainant's goods, and that respondent's goods were inferior and sold at a less price than complainant's.

The bill prays for an injunction and account. These are in substance the more important allegations of the bill.

The respondent's answer admits that the complainant is a manufacturer of bluing as alleged, but denies that prior to 1878 the complainant ever claimed any of the alleged symbols, marks or form of package as his trade-mark, or that he has ever attached to his bluing anything in the nature of a trade-mark except the *fac-simile* of his signature, the dates of the patent and reissue obtained by him, and the word "crystal;" and respondent alleges that the red top of the boxes, the blue color of the label, the lettering, type, phraseology, green box, and other matters claimed by complainant in his bill, are such as belong to commerce and the public in general, and are not susceptible of exclusive appropriation by any one. Respondent further alleges that complainant had, in the year 1864, obtained a patent for the said box containing his bluing, in which it was described as a package or case which, when made with distributing holes and filled, is cemented by wax or a wafer, which patent was afterwards held to be void.

That the red top was produced by the application of Venetian red, for the purpose of stopping the perforations in the top of the package until required to be opened for use, and that the claim of the red top as a trade-mark was an afterthought of the complainant suggested as a means of continuing his monopoly after his patent was annulled. That it was not a proper subject of registration as a trade-mark, had never been used or applied as described in the certificate of registration, and was but the ordinary use of a cheap and well known red material as a cement to close the perforations of the box, and when so applied became part of the box itself and not in any sense a trade-mark.

Respondent further claims that the pictures used by him on the lids of his larger packing boxes were simply pictures free to be used by any one, and alleges that the form of package, labels and other marks claimed by complainant are not original or peculiar, but had been long used by many persons in the same trade.

The respondent admits that he does put up and sell a bluing in boxes having a resemblance in form to those sold by the complainant, but denies that he has done so fraudulently, or that he has ever done so in imitation of the complainant's bluing, or ever done anything not warranted by a fair competition in business; and denies that he has ever offered to sell any of his goods as and for the goods of the complainant, or sold any goods bearing any marks belonging exclusively to complainant, or any false representations thereon calculated to create confusion and cause his goods to be purchased as and for the goods of the complainant.

He admits that he sells his goods cheaper than the complainant, but alleges that he gives as good an article for less money.

The case now comes on for final hearing, and we have been greatly assisted by the careful and thorough manner in which the facts have been presented, and by the able arguments of counsel, and the very numerous exhibits which have been brought to our attention illustrating and explaining the facts in this controversy and also many of the subjects of controversy passed upon in the cases cited in argument. It appears that the complainant, Sawyer, in 1863, began using the present form of box as a convenient method of putting up washing blue in a dry powder, and that he began to distinguish them by using a red colored top in 1866.

He used a box, which is a small cylinder of wood, about an inch in diameter and about two inches high. The box, when filled with the blue powder, is covered by a tin top with a flange fitting over the top of the box. The tin cover is perforated with five small holes, so that when needed for use the blue powder can be sifted out as from the ordinary pepper caster or dredging box. Until needed for use, the perforations are closed by something in the nature of sealing-wax, by pricking which the perforations can be opened.

This device was supposed by the complainant to be patentable, and he did obtain therefor a patent dated January 5, 1864, reissued October 1, 1867, but by a decree of the circuit court for the southern district of New York this patent was held to be void, and that decree upon appeal to the supreme court has, since the argument of this case, been affirmed. The bluing manufactured by the complainant and offered in packages of this form obtained great favor and became well known, and has been the source of large profits. It became well known not only in Massachusetts, where complainant's place of manufacturing is, but in Baltimore, where he has sold large quantities during the year 1871.

Upon the cylindrical box of the complainant he has, since 1866, used a label of dark blue paper, printed in silver letters, which completely envelops the box, and the metal top is covered entirely by a coating of Venetian red and varnish, so that the box, when standing upright, presents nothing but the blue label and the red top. The quantity of cement used is in excess of the quantity necessary to be applied simply to cover the five small perforations in the metal top, and not only completely covers all the top, but extends nearly a quarter of an inch down the sides of the box, enveloping the whole metal covering.

The box and label and top which the respondent uses is similar in size, shape and appearance, so that, except for the words on the label and the color of the printing, which is in gold bronze instead of silver, and a hardly observable difference in the shade of the red color on the top, there is nothing to distinguish them, and unless the two are side by side and attention has been freshly called to these differences, no one can discriminate between them. They both present the appearance at a little distance of a blue cylinder with printing in gilt letters with a red top of sealing-wax.

The respondent states that he was by trade a stone-cutter, and for a while kept a grocery store, and about 1873 began putting up bluing. That from the first he used the cylindrical box and blue label, but not the red top, and that about 1876, learning that Sawyer's patent had been held void, and supposing it was the red top which had been the subject of the patent, he then began to use the red top.

The labels, when compared, show that they are precisely of the same size and color. Both are divided by vertical lines into four sections of precisely the same sizes, but the words printed on them are different.

On Sawyer's label is printed horizontally:

Sawyer's
Crystal
Blue
and
Safety box:
Patent Jan. 5th, 1864;
re-issued Oct. 1st, 1867.

Then vertically and inclosed by the vertical lines:

The Standard Blue of America. This form is the best and cheapest method of using Bluing. The quality is unexcelled.

Directions:

Pierce the prints on the top with a pin, and shake a few grains into a cup of soft water; then stir in the rinsing water.

Prepared by H. Sawyer,
Boston, Mass.
H. Sawyer.
(fac-simile of signature.)

On Horn's label is printed, with exactly the same divisions by straight lines, and in almost the same type, horizontally:

Horn's
unexcelled Sifting box
Blue.
Baltimore.
The Standard Blue of the United States.
The quality is unequalled.

Directions:

Pierce the holes on the top with a pin, and sift a few grains in a bowl of water, stir until fully dissolved, then add to the rinsing water.

Prepared by
Jas. G. Horn,
Baltimore, Md.

No one, we think, having the two labels before him, could believe that the similarities were the result of accidental coincidence. And no one having before him the two boxes, with their similar blue labels and red tops, could fail to be convinced, we think, that there was an intentional similarity in their general appearance well calculated to deceive persons exercising ordinary caution into mistaking one for the other.

The name and place of manufacture on the labels are different and many of the words; but the color, size, type and arrangements and divisions are in such exact similitude in all respects as to divert attention from the differences and to produce the impression that they are the same. The labels, if pasted upon a flat surface, could with less difficulty be distinguished from each other, but when pasted around a small cylinder in such a way that only about a fourth of the surface can be seen at one time, it becomes a matter of painstaking comparison to detect the differences.

The proof and the exhibits also show that these cylindrical boxes are packed by Sawyer by putting four dozen of them into a square, green, paper box just deep enough to contain them when standing upright, and when the lid is taken off nothing is seen of the cylindrical boxes, as they pack very close to each other, but the red tops, and the appearance is that of an almost solid, square mass of red sealing-wax. And the proof and exhibits show that the respondent packs his cylindrical boxes in precisely the same way, presenting precisely the same appearance; the large boxes of Horn's being of the same color, and having on them labels very similar in designs and color to those of the complainant.

§ 441. *Where a manufacturer puts up his goods in a peculiar manner, so that they are known to purchasers chiefly by the appearance of the package, no other person has a right to imitate such packages to such a degree that unusual care is required to distinguish one from the other. What may be used as a trade-mark.*

We are satisfied, from an inspection of the exhibits, that the general similarity between the goods of the complainant and respondent in all these respects could not have resulted from accident, but must have been the result of intention, and that the general resemblance is so great as to lead to confusion; and that a purchaser who had been in the habit of getting Sawyer's goods would have to exercise unusual and peculiar care not to take the goods of Horn if they were offered to him.

And, as matter of fact, the depositions of a large number of persons who themselves use the blue for washing purposes in Baltimore were produced, who testified that they knew of Sawyer's blue only by the appearance of the box, and, having been in the habit of using Sawyer's blue, and expecting to get it, had taken Horn's blue when offered to them by retail dealers, supposing it was what they had been in the habit of using, knowing it only by the red top and blue box. Being satisfied that these are the facts as proved by the complainant, we are now to consider the law applicable to them, and what is the remedy, if any, to which the complainant is entitled.

As to the simple question of trade-mark, we think the respondent is sustained in the position taken by him. The red top being, as to its use, a covering for the perforations in the metal top, and as to its color and material one of the most common of all the cements used to close and seal the mouths of jars, bottles, cans and similar packages, and there being impressed on it no mark or design, it cannot, we think, be said to be a trade-mark, and cannot be exclusively appropriated by the complainant; nor can the form of his box, it

having been decided not to be a patentable contrivance, be monopolized by him; nor can the color of the label, nor the allocation of words thereon, nor the type, be exclusively appropriated. The word "crystal," as applied to bluing, may be his trade-mark if he first so applied it, and the *fac-simile* of his autograph signature, but these are all; so that it does not appear, as to anything which the complainant can call technically a trade-mark, that the respondent has been guilty of piracy or imitation.

But we do find that the respondent has been guilty of improper and inequitable conduct, to the injury of the complainant, in having designedly so put up, labeled and packed his goods that purchasers for whose use they are intended are misled and deceived, and do get Horn's blue when they desire and suppose they are getting Sawyer's. And that Sawyer, the complainant, having, after many years of manufacture, established a market and demand for his goods, as known by their peculiar and distinctive appearance, which he was the first to adopt, is now deprived of profits which he would otherwise obtain, by the fact that, after he had so established a reputation and demand for his goods, the defendant, with the intention of getting the benefit of that reputation and demand, has put his goods on the market prepared with such close imitation of the complainant's that they are mistaken for his.

The respondent, while he denied (and there is no evidence whatever to the contrary) that he ever represented, or authorized any one to represent, that his goods were Sawyer's, does, in his testimony, admit that he put up his goods with the appearance they now have because it was "fashionable," and because he found that a blue box with a red top made them more salable; and as he sells his goods to the grocers at fifty cents for four dozen, while Sawyer has been accustomed to sell his for eighty-five cents, it is easy to see that the grocers prefer to give their customers Horn's goods, if they will take them, as both retail at about the same price.

It has been said that the fundamental rule applicable to such cases is that one man has no right to put off his goods for sale as the goods of a rival dealer, and that "he cannot, therefore, be allowed to use names, marks, letters or other *indicia* by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person." *Perry v. Truefitt*, 6 Beav., 66-73. And this principle has been recognized as applicable in cases which were not strictly cases of technical trade-marks by many well considered decisions.

In *Williams v. Johnson*, 2 Bosw., 1, decided in 1857, by Chief Justice Duer and Associate Judges Hoffman and Woodruff, upon appeal to the general term of the supreme court of New York, without deciding whether or not the complainant was entitled to the use of the words "Genuine Yankee Soap," which he claimed as his trade-mark, the court held that the imitations of the size, shape, style, labels and substantial appearance of the complainant's goods by the defendant was a fraud, and that he was entitled to protection, and decreed that the defendant should be enjoined from using the labels, devices and hand-bills which he had been using, and from using any other similar ones calculated to deceive the public or create the belief that the soap sold by the defendant was the soap made and sold by the complainant.

Croft v. Day, decided in 1843 (7 Beav.), 84, was not a case of trade-mark strictly, but of the use by two persons, one named Day and the other named Martin, composing a new firm of Day & Martin, of boxes and labels for putting up blacking similar to those which had been for many years used by an

old firm of Day & Martin. In giving the reasons for his decision, Lord Langdale, the master of the rolls, said: "The accusation which is made against the defendant is this: that he is selling goods under forms and symbols of such a nature and character as will induce the public to believe that he is selling the goods which are manufactured at the manufactory which belonged to the testator in the cause. I stated on a former occasion that, in my opinion, the right which any person may have to the protection of this court does not depend upon any exclusive right which he may be supposed to have to a particular name or to a particular form of words. His right is to be protected against fraud. It is truly said that if any one takes upon himself to study these two labels he will find several marks of distinction. On the other hand the colors are of the same nature, the labels exactly the same size, the letters are arranged precisely in the same mode, and the very same name appears on the face of the jars. It appears to me that there is quite sufficient to mislead the ordinary run of persons, and that the object of the defendant is to persuade the public that this new establishment is in some way or other connected with the old firm, and at the same time to get purchasers to go to 90½ Holborn Hill, and not to 97 High Holborn. I think what has been done is quite calculated to effect that purpose, and the defendant must be restrained.

"My decision does not depend on any peculiar or exclusive rights the plaintiffs have to use the names Day & Martin, but upon the fact of the defendant using those names in connection with certain circumstances, and in a manner calculated to mislead the public, and to enable the defendant to obtain, at the expense of Day's estate, a benefit for himself to which he is not in fair and honest dealing entitled."

In the case of *Holloway v. Holloway* (1850), 13 Beav., 209, the plaintiff having established a reputation for preparations known as Holloway's pills and ointment, put up in similar boxes, and with labels and wrappers similar to plaintiff's. The master of the rolls said that, although the defendant had a right to constitute himself a vendor of Holloway's pills and ointment, he had no right to do so in such a way as to deceive the public, and make them believe he was selling the plaintiff's medicines, and that he could not be allowed to perpetrate such a fraud.

In the leading case of *The Leather Cloth Co. v. American Leather Co.*, 11 Jur. (N. S.), 513, upon appeal to the house of lords the case was finally disposed of upon the ground that the alleged trade-mark was simply an advertisement of the quality of the goods, and that it was in both cases printed in very large type, in a circle more than six inches in diameter, easily read and hardly to be mistaken one for the other; and Lord Cranworth, in dismissing the case, says: "I mention this because if, instead of occupying this large space, the whole had been engraved on a stamp of the size of a shilling, so as not to be capable of being read without close examination, the case would have been different."

In the case of *Dixon Crucible Co. v. Guggenheim*, decided by Judge Paxson in 1870 (2 Brewster, 321), although there was no technical trade-mark, to the exclusive right of which the plaintiffs were entitled, the fact that the defendant's packages of stove polish were in size, shape and labels obviously a fraudulent imitation of the complainant's, induced the court to grant relief; although it was shown that the wholesale dealers generally understood the difference, and only the consumers were likely to be deceived.

And in that case, although reference is made to a Pennsylvania statute in-

tending the counterfeiting of private stamps and labels, the reasons given by the learned judge for his decision are based entirely upon the general principle adduced from the authorities cited by him.

The case of *Enoch Morgan's Sons & Co. v. Schwakhofer*, in the supreme court of the city of New York, was decided upon the same principle. The plaintiffs adopted the name of "Sapolio" as a trade-mark for their goods, and it became known by that name, and by the peculiar and distinctive style of packages, labels and wrappers in which it was put up. The defendant began manufacturing the same kind of goods and adopted the name "Sophia" as his trade-mark, and adopted the same style of package, with labels and wrappers which, as a careful inspection disclosed, were different in almost every particular, and had the defendant's own name on them, yet the court, finding that the defendant's were in appearance so close an imitation of the plaintiff's that consumers of ordinary caution did receive one for the other, and finding that the imitation was designed to mislead purchasers, enjoined the defendant.

The case of *Stonebraker v. Stonebraker*, 33 Md., 252, is also a well considered case in which an injunction was affirmed by the court of appeals of Maryland, preventing the use of labels upon medicinal preparations similar to those used by the complainant.

The case of *McLean v. Fleming*, 96 U. S., 245, October term, 1877 (§§ 431-40, *supra*), is a late and authoritative decision by the United States supreme court of questions similar to those arising in the present case, and the principles announced in that decision are, it seems to us, conclusive on the point that the right to a technical trade-mark, in the strict sense of the word, is not necessary to entitle the complainant to relief. For, although the complainants had, in that case, registered their label as a trade-mark, under the act of congress (which has been declared unconstitutional since the case now under consideration was submitted for decision), it appears that their so-called trade-mark was in fact, more strictly speaking, only a label.

In *McLean v. Fleming* the complainants for many years had been selling preparations labeled "Dr. C. McLane's Liver Pills," and had put up the pills in wooden boxes of uniform size, shape and appearance, with the name of the original inventor stamped in red wax upon the cover of each box, around which they placed a label or wrapper printed in a distinctive style. About 1855 they adopted a black label with white lettering. The defendant, whose name was J. H. McLean, and who had also for many years been making and vending the same kind of pills, in boxes similar to complainants', also adopted a black label with white lettering, very similar to complainants', on which he put the words, "Dr. J. H. McLean's Universal Pills or Vegetable Liver Pills." It did not appear that the defendant entered upon the business expecting any advantage from the similarity of names, as the manufacture was begun by both in places far apart, one in Virginia, the other in Kentucky, upwards of twenty years before the filing of the bill.

The supreme court, by Mr. Justice Clifford, delivering its unanimous decision, said: "Positive proof of fraudulent intent is not required when proof of infringement is clear, as the liability of the infringer arises from the fact that he is enabled, through unwarranted use of the trade-mark, to sell a simulated article as and for the one which is genuine. Nor is it necessary, in order to give a right to an injunction, that a specific trade-mark should be infringed, but it is sufficient that the court is satisfied that there was an intent on the part of the respondent to palm off his goods as the goods of the complainant,

and that he persists in so doing after being requested to desist. Difficulty frequently arises in determining the question of infringement, but it is clear that exact similarity is not required, as that requirement would always enable the wrong-doer to evade responsibility for his wrongful acts. Colorable imitation, which requires careful inspection to distinguish the spurious trade-mark from the genuine, is sufficient to maintain the issue; but courts of equity will not interfere when ordinary attention by the purchaser would enable him at once to discriminate the one from the other. Where the similarity is sufficient to convey a false impression to the public mind, and is of a character to mislead and deceive the ordinary purchaser, in the exercise of ordinary care and caution in such matters, it is sufficient to give the injured party a right of redress if he has been guilty of no laches. Argument to show that the name of the pills, as given in the trade-mark of the respondent, was of a character to mislead and deceive, is scarcely necessary, as they are *idem sonans* in the usual pronunciation; nor can it be doubted that the form of the box containing the pills, and the general appearance of the wrapper which surrounded it, were calculated to have the same effect. Mention may also be made of the fact that the color of the label and the wax impression on the top of the box are well suited to divert the attention of the unsuspecting buyer from any critical examination of the prepared article. Chancery protects trade-marks upon the ground that a party shall not be permitted to sell his own goods as the goods of another, and therefore he will not be allowed to use the names, marks, letters or other *indicia* of another, by which he may palm off his own goods to purchasers as the manufacture of another. Difference between the exhibits undoubtedly exists, still it is manifest that the general appearance of the package, in the respects mentioned, and others which might be suggested, is well calculated to mislead and deceive the unwary, and all others who purchase the article without opening the box and examining the label."

The decree of the circuit court was affirmed, enjoining the respondent from using his own name upon any label or wrapper for boxes or packages of pills resembling or in imitation of the labels or wrappers or trade-mark of the complainant, whether in style of engraving, printing or lettering, but the decree for account was reversed upon the ground of inexcusable laches and delay in filing the bill.

We have come to the conclusion in the case before us that the respondent should be enjoined from putting up his goods in the manner in which he has been doing, as shown by the exhibits, or in any other manner so simulating the form, color, labels and appearance given by the complainant to his goods as to mislead purchasers into mistaking one for the other. What we decide is that whether the complainant has a trade-mark or not, as he was the first to put up bluing for sale in the peculiarly shaped and labeled boxes adopted by him, and as his goods have become known to purchasers, and are bought as the goods of the complainant by reason of their peculiar shape, color and label, no person has the right to use the complainant's form of package, color or label, or any imitation thereof, in such manner as to mislead purchasers into buying his goods for those of the complainant, whether they be better or worse in quality. And finding, from the exhibits and proof in the cause, that the bluing put up by the respondent is not only well calculated so to mislead purchasers, but has actually done so, to the injury of the complainant, we are of opinion that respondent should be perpetually enjoined, and that he should account to the complainant for the damages sustained by him.

SAWYER v. KELLOGG.

(Circuit Court for New Jersey: 7 Federal Reporter, 720-723. 1881.)

Opinion by BRADLEY, J.

STATEMENT OF FACTS.—This case, with its special circumstances, seems to us to be a very clear one. The complainant's label, which he alleges that the defendant has wrongfully imitated, had been in use substantially in the same form for a dozen or more years prior to the bringing of the suit. It consists of a blue wrapper, pasted around a small bottle holding the bluing, and containing, in separate compartments, various inscriptions in letters of silver bronze. The first compartment contains the general designation of the article, in the words: "Sawyer's Crystal Blue and Safety Box." The other compartments are in finer print, and contain commendations of the quality of the article, directions for use, and the name of the party by whom it was prepared.

§ 442. *Circumstances under which an imitation of a trade-mark is held to be so far complete as to authorize an injunction against its use. All who are parties to the infringement of a trade-mark are liable.*

The label complained of, and admitted to be prepared and used by the defendant, is of the same size, color and type, and of the same general appearance, as that of the complainant, being divided into compartments corresponding with those in his label. The inscriptions, although not identical, appear very like. The general designation is in these words: "Sawin's Soluble Blue and Pepper Box." Placing the two labels side by side it is easy to distinguish them. But ordinary persons, in the habit of buying the complainant's bottles, would be very easily deceived into buying the defendant's for them, the general appearance being so similar in every respect. That the defendant's label is a designed imitation of the complainant's scarcely admits of a doubt. Such perfect similarity could hardly have been the result of chance. We do not mean to say that it would be a justification if it were accidental. But it is apparent that it was designed. Sawin is not the defendant's name; why, then, did he use Sawin's name and not his own? It was evidently done for the purpose of making a closer imitation of Sawyer's label. The defendant, it is true, alleges that he does not put up the bluing for himself, but for a firm by the name of Barron & Co., who directed him to adopt the label in question. But this is no excuse for him unless Barron & Co. were entitled to use the label. The defendant attempts to show that they had such a title by having hired from Sawin the right to use his name. This pretext is too shallow. It is shown, indeed, that Sawin did manufacture bluing, and used a label of his own, but it was wholly unlike the label in question. The use of his name by Barron & Co., in the label complained of, was evidently obtained for the purpose of making it more closely resemble Sawyer's. Sawin's bluing had no such reputation in the community as to make it an object to hire his name. As the label stands it speaks a falsehood. The article covered by it is not "Sawin's Soluble Blue," and it is not "prepared by W. E. Sawin, Jr.," as stated at the foot of the label. It evidently speaks this falsehood for a purpose, and that purpose, we are satisfied, is to obtain a closer imitation of Sawyer's label. It is no excuse for the defendant that he does this work for other persons. He is just as guilty as if he did it for himself. All who are concerned in the commission of a tort are alike amenable to the party injured.

It is suggested, however, that the label complained of is the same in all respects which the defendant had used for several years prior to its adoption by

Barron & Co., with the exception of the caption, in which Sawin's name has been introduced instead of his own. This only goes to show that the adoption of Sawin's name was regarded as important in carrying out the plan of Barron & Co. The question readily suggests itself, Why did they prefer Sawin's name to Kellogg's in the caption of the label? No sufficient reason is shown except that it enabled them more closely to imitate the complainant's. No doubt Kellogg would have been perfectly willing, and glad, to have used his own name, and then the label would, at least, have told the truth. It is unnecessary to add that the argument assumes that Kellogg's label itself was free from objection as an imitation of that of the complainant. Whether it was so or not may be a question, but one which it is not necessary now to determine.

§ 442a. *Question of acquiescence.*

It is further suggested that the complainant has lain by for several years, whilst the defendant has been publicly using his own label, and has thus acquiesced in its use. To this suggestion it may be proper to reply that the complainant had a patent for the article of bluing, which he was prosecuting and endeavoring to substantiate, but in which he finally failed. His failure to establish his patent (which would have covered all his rights) ought not to preclude him from falling back on his right to the trade-mark. No essential delay has occurred since the termination of the proceedings on the patent. But at any rate an acquiescence in Kellogg's use of his own label was no acquiescence in his use of the new and altered label having Sawin's name in the caption.

We think the case is with the complainant, and that a decree should be made in his favor. Let a decree be made accordingly.

MOORMAN v. HOGE.

(Circuit Court for California: 2 Sawyer, 78-91. 1871.)

STATEMENT OF FACTS.—Bill in equity to restrain the infringement by the defendant of plaintiff's trade-mark. The infringement consisted altogether of using barrels of the unusual size, form and dimensions of those adopted by plaintiff, and which he claimed as a component part of his trade-mark. The barrels were used to contain whisky manufactured and sold by complainants.

Opinion by SAWYER, J.

The complainants do not claim that there is any infringement upon that part of what they claim to be their trade-mark, which consists of the words and devices stamped upon the barrel. The claim is that there is an infringement by the use of the barrel only.

Is the plaintiff entitled to the exclusive use of a barrel of this peculiar form, construction and capacity, without regard to any mark or device impressed upon or connected with it? Can a barrel of this description be appropriated as a trade-mark, or substantive part of a trade-mark, so as to exclude the rest of the world from using it in the same branch of business? If so, the complainants, in my judgment, are entitled to the relief sought, otherwise not.

Complainants invoke the act of congress of July 8, 1870, entitled "An act to revise, consolidate and amend the statutes relating to patents and copyrights." 16 Stat. at L., 198. The seventy-seventh section provides, "That any person or firm domiciled in the United States, . . . and who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark

for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following requirements, to wit:" stating the conditions.

The seventy-eighth section provides that the party or firm, performing the statutory conditions, shall be entitled to use the trade-mark for thirty years, and that "no other person shall lawfully use the same trade-mark, or substantially the same, or so nearly resembling it as to be calculated to deceive, upon substantially the same description of goods." The seventy-ninth section provides a remedy for violation of the right by imitation, etc., by an action for damages and injunction. It also provides that "the commissioner of patents shall not receive and record any proposed trade-mark which is not, and cannot become, a lawful trade-mark." The eightieth section makes the certificate of the commissioner, under seal of the patent office, "evidence in any suit in which such trade-mark shall be brought into controversy."

§ 443. *The certificate of the registry of a trade-mark is not conclusive evidence that the device claimed is or can be a lawful trade-mark.*

It is not denied that the complainants have performed all the acts required by the act of congress to secure the protection contemplated, and that the certificate of the commissioner of patents was in form regularly issued. This being so, complainants insist that the court can only look to the certificate, and the act of congress, to determine the question at issue; that the act of congress confers upon the commissioner jurisdiction to examine and determine whether the proposed trade-mark is, or can become, a lawful trade-mark; whether it was first used and appropriated by the claimant, or is not identical with a trade-mark appropriated to the same class of goods, and belonging to a different party, or already registered, or received for registration; and whether it does not so nearly resemble any trade-mark registered or filed for registry, as to be likely to deceive the public; and, that having jurisdiction to determine these matters, his determination is conclusive, and the questions are not open to examination in this court. *Rubber Co. v. Goodyear*, 9 Wall., 796, and *Eureka Co. v. Bailey Co.*, 11 id., 492, are cited as sustaining the proposition.

I cannot assent to this view. The cases cited only go to the point that a patent cannot be collaterally attacked on the ground that the extension and reissue of the patents in question had been procured by fraud. It was held that, if the patents themselves were to be avoided on the ground of fraud in their issue, the patents being otherwise good, it must be done by a direct proceeding in equity to vacate them. That is an entirely different question from the one now presented. The proceeding before the commissioner to obtain protection for a trade-mark under the act of congress is purely *ex parte*. Other parties have no notice, actual or constructive. They have no opportunity to be heard, and their rights cannot be thus conclusively determined in a proceeding to which they are in no sense parties. The certificate of the commissioner of patents, I take it, can have no more conclusive effect as to the rights of third persons, than a patent issued under the patent laws by the same commissioner of patents. The commissioner in such cases is required to investigate the claim to the patent, and to determine whether the subject of the application is patentable; whether the applicant is the inventor; whether it is new, and useful, etc. While the patent is held to be *prima facie* evidence that the machine is new and useful, it is nowhere held to be conclusive on these points, or upon the point whether the machine, or device, or

article, is the proper subject of a patent. On the contrary, in every-day practice in the courts in patent cases, the very questions most frequently considered and determined are, whether the thing patented is patentable; whether it is new or useful, etc.; and, in the very cases cited to sustain complainants' position, the court determined questions as to the patentability of the articles involved in the patent. If the principle contended for could be maintained, there is not a barrel or package of any kind in use in mercantile transactions which could not be appropriated as a trade-mark, no matter how long or how generally it had been in use, if a party could, in an *ex parte* application, by any representation, fraud or other means, once procure it to be registered, and the certificate issued; for this would be conclusive upon all the world upon the points that it could become a trade-mark, and that the applicant was the first to appropriate and use it for that purpose. This point, in my judgment, must be determined against the complainants.

§ 444. *A barrel of peculiar form, dimensions and capacity cannot, without more, become a lawful trade-mark or a substantive part of such trade-mark.*

This brings us to the great and highly important question, whether a barrel of peculiar form and dimensions, without any marks, symbols or devices of any kind impressed upon or connected with it, can, in fact and in law, become a trade-mark or a substantive part of a trade-mark, so as to invest the claimant with an exclusive right to use it. It will be observed that the statute under which the claim is made does not define the term "trade-mark," or say of what it shall consist. The term is used as though its signification was already known in the law. It speaks of it as an already existing thing, and protects it as such. The thing to be protected must be an existing lawful "trade-mark," or something that may then for the first time be adopted as a lawful trade-mark independent of the statute. There must be a lawful trade-mark adopted without reference to the statute, and then by taking the prescribed steps, that trade-mark so already created and existing may receive certain further protection under the statute. This is apparent from the language of the seventy-seventh section, which speaks of parties "who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark for exclusive use," etc.; and by the seventy-ninth section, which forbids the commissioner to receive and record any proposed trade-mark which is not, and cannot become, a lawful trade-mark. It does not say what shall constitute a lawful trade-mark. We must therefore go to the law of the land, outside this statute, to ascertain what is, or what may become, a lawful trade-mark; for the statute leaves the definition of a trade-mark to the law, as it before stood. The definition of a trade-mark given by Mr. Upton is as follows, to wit: "A trade-mark is the name, symbol, figure, letter, form or device adopted and used by a manufacturer or merchant, in order to designate the goods that he manufactures or sells, and distinguish them from those manufactured or sold by another; to the end that they may be known in the market as his, and thus enable him to secure such profits as result from a reputation for superior skill, industry or enterprise." Upton on Trade-marks, p. 9.

This is a good general definition, broad enough in its terms, probably, to cover every case to be found in the books, but it would not alone, perhaps, be sufficient as a test by which every individual claim of a device, as a proper trade-mark, can be tried and determined, without looking into the cases from which the definition is compiled, to see what names, symbols, figures, letters,

forms and devices have been recognized and protected as trade-marks. The words "form" and "device," for instance, are very broad terms, and they might, in a general and comprehensive sense, embrace the form of a barrel, or package, or of the article of merchandise itself sold. But the words of definition are all used in connection with the word "mark," and the word mark, in its first and usual signification, is defined by Webster to be "a visible sign made or left upon anything; a line, point, stamp, figure, or the like, drawn or impressed, so as to attract the attention, and carry some information or intimation; a token; a trace." And some such mark used in connection with, impressed, cut or stamped upon, or attached to the article manufactured or sold in the ordinary course of trade, embraces the usual and ordinary idea of a "trade-mark." The primary and the sole object of the trade-mark is to distinguish the goods as being a particular manufacture, or as belonging to a particular party. It is cut, stamped, engraved, impressed upon, attached, or in some way appended to the goods, the vessel containing them, or the covering wrapped around the goods for this sole purpose. The object of using a barrel, box, or other package, is to contain, carry, protect and preserve the goods, or for their convenient handling; and form of some kind and dimensions are essential in a box, barrel, or package, without which it can have no existence. But the size or shape of the barrel, box, or package can scarcely be considered a mark, nor can that be the sense in which the terms "form" or "device" are used when employed as a definition of a mark, used for purposes of trade. So general is the idea that the symbol, figure, letter, form, or device used for a trade-mark must be a mark impressed, cut, engraved, stamped, cast upon, or in some way wrapped around or appended to the article or the package, as something independent of the article itself, or the package used to contain it, that it is carried into the statutes of some states, where it is, doubtless, only intended to adopt the common law definition.

Thus, in the statute of California, the language used is, "any peculiar name, letter, mark, device, figure, or other trade-mark, or name, cut, stamped, cast, or engraved upon, or in any manner attached to or connected with any article or with the covering or wrapping thereof, manufactured or sold," etc. This indicates that it was not supposed that the barrel, package, covering or wrapping itself, which is used for another purpose, could properly be used as a trade-mark, but that the trade-mark must be some mark of the kind indicated in some way, impressed, cut, cast upon, or connected with such package, covering, etc., or the article itself.

The complainants in this case, prior to the passage of the act of congress in question, filed their trade-mark in the office of the secretary of state of California, and in so doing they omitted the barrel as a part of their trade-mark, although it had long before that time been adopted and used by them in their California trade. The reason assigned for this omission by their counsel, on the argument of this cause, in answer to the suggestion that the omission constituted an abandonment of the barrel, was, that under this statute of California they could not adopt the barrel as a trade-mark, for that the trade-mark, under the act, must be cut, engraved, stamped, impressed, cast, etc., on the barrel, package, etc., and this, I apprehend, is the true idea of a trade-mark at common law with respect to this point.

I have examined with care a large number of cases involving infringements of trade-marks, including all the recent cases, which I have been able to find, so far as they bear upon the question in hand. It would be an arduous and

unprofitable task to comment upon them all, and I shall content myself with stating briefly the result of my examination.

In every case there was a trade-mark proper, such as is indicated in this opinion, embracing some name, symbol, figure, letter, form or device, cut, stamped, cast, impressed or engraved upon, blown into, or in some manner attached to or connected with the article manufactured or sold, or the package containing it, or the covering or wrapping thereof. Where the vessel containing the article was of glass, iron or other metal, whether of peculiar shape and dimensions or not, the trade-mark proper was often blown, or cast in the vessel, sometimes on a shoulder, sometimes in the body of the vessel. There were various ways of impressing upon, or connecting with the vessel, package or article the mark; but there always was a mark in fact, other than the shape or size of the vessel or package. I find no case where the vessel, box, package, or whatever contained the article, has been held to constitute a trade-mark by reason of its peculiar form or dimensions, independent of any symbol, figure or device impressed upon or connected with it for a trade-mark. I find no case where the use of a package of peculiar form and dimensions has been restrained without having imprinted upon or connected with it some other symbol, word, letter, or form, adopted as a trade-mark. There are numerous cases where the use of a bottle, or other vessel, or package, having upon it the device adopted as a trade-mark has been enjoined, but I find none restraining the use of the bottle, vessel or package without the device impressed upon or connected with it.

A manuscript copy of a recent decree rendered by the court of chancery at Louisville, Kentucky, in the case of *Wilder v. Wilder*, has been furnished me by complainants' counsel, as a case in point. But in that case the defendants were restrained from selling "any preparation or compound under the name and style of 'J. B. Wilder & Co.'s Stomach Bitters,' printed, stamped, or engraved upon the bottles, labels, wrappers, covers, boxes or packages thereof. Also from using the bottle herein exhibited marked 'B. 2,' and from imitating or causing to be imitated in any manner, either the bottle or label of the plaintiff herein marked respectively 'A. and B.'"

This case does not appear to be in any respect inconsistent with the view indicated. Here was a trade-mark proper in connection with the bottle, and, as the court restrained defendants from selling the compound in connection with the trade-mark, "printed, stamped or engraved upon the bottle," doubtless the complainants' bottles referred to as exhibits in that case had the trade-mark impressed upon or blown into the bottles; and this being so, it would be impossible to use those bottles without their having the trade-mark on them, and, therefore, also using the trade-mark itself. The trade-mark, in such cases, constitutes a part of that particular bottle. If this is not the true state of facts, then the copy of the decree furnished me does not show what the exact case is. At all events, it does not appear to be an exception to the general rule before stated. There are numerous cases where the use of a particular bottle or package has been restrained, when the bottle or package had the trade-mark impressed upon or blown into its structure, making it a part of the package itself, and it was necessary to include the particular description of bottle in order to restrain the use of the trade-mark indelibly impressed upon it. But, as before stated, I find no instance where the use of a bottle, vessel or package of a peculiar form and size has been enjoined with the trade-mark of the complainant, or colorable imitation thereof, used upon or connected with it, omitted.

Doubtless a bottle, vessel or package of a peculiar form may be used as auxiliary to the trade-mark proper, and may be of use in solving a question of intent of a party in imitating or using an evasive simulation of another's trade-mark. As, for instance, a party may adopt a trade-mark, and imprint it upon, or connect it with, the package of peculiar shape containing the article of his manufacture. Another party might make a colorable simulation of the trade-mark so used, but so different as to render it doubtful, upon a mere inspection of the simulation of such mark alone, whether it was intended to be an imitation or not, or whether it would be likely to mislead the public. But if the imitator should, in addition to this, use the peculiar shaped package adopted by the party entitled to the trade-mark, and impress upon or connect with it the simulation of the trade-mark, all doubt as to the intention and the effect would at once vanish. In this view, a peculiar package might be a valuable auxiliary to the trade-mark, although it could not, of itself alone, constitute a lawful trade-mark, or a substantive part of a lawful trade-mark. But its use would be in aiding to determine the character and effect of a colorable imitation of the trade-mark proper, and the use of the imitation, or the simulated trade-mark, or the use of the package with such simulation connected with it, would be the thing restrained. In this case there is no pretense that there is any imitation, or colorable simulation, of the marks and brands upon the package or barrel. The use of the barrel with a simulation of the complainants' trade-mark impressed upon it would doubtless be restrained. But to extend the privilege of trade-mark to the barrel in question alone, without having impressed upon, or in any way connected with, it any of the other words, symbols or devices claimed and used by the complainants as a part of their trade-mark, or any colorable imitation of it, would, in my judgment, be to go further than any case heretofore decided, and extend the privileges of trade-marks to objects not recognized by any established legal principles applicable to the subject. After a careful examination of the question, my conclusion is, that the barrel in question, without any other marks or symbols, is not, and that it cannot become, a lawful trade-mark, or a substantive or integral part of a lawful trade-mark, and that complainants have no exclusive right to its use as such.

The result is, that complainants' bill must be dismissed with costs, and it is so ordered.

BURTON *v.* STRATTON.

(Circuit Court for Michigan: 12 Federal Reporter, 696-704. 1882.)

STATEMENT OF FACTS.—Plaintiff in this case claimed the right to use a trade-mark, in connection with the manufacture of yeast, by purchase from the Strattons. It seems that the trade-mark consisted of the figures of the heads of the Stratton brothers in an oval setting, in connection with the words "Twin Brothers' Improved Dry Hop Yeast," and "Twin Brothers;" that the yeast originated with the Strattons, and that plaintiff purchased the factory from one of them, and, as he claims, the right to the trade-mark. The defendants denied that the trade-mark was sold to the plaintiff.

Opinion by BROWN, J.

We think there is a decided preponderance of testimony in favor of the plaintiff's theory that at the time his partnership with the defendant Stratton was dissolved he purchased not only his interest in the business but also his moiety of the trade-mark. Indeed, the defendant seems to have had very little

else of any value to sell. Plaintiff had put but a thousand dollars into the venture. Defendant had contributed nothing but his attention and skill. The partnership lasted but eight or nine months, and the business done was very limited. They would get a little meal and make a small quantity of yeast; then they would shut up the factory and go out and sell it, get a little more meal, and start again. After conducting the business in this way about six months the demands of their creditors became so urgent that plaintiff was obliged to advance \$300 more to continue it. Soon after an investigation of the books showed their affairs to be in such a precarious condition that defendant Stratton wanted to go out of the business, and the plaintiff bought his interest and paid him \$4,000. At the time of the sale there appears to have been no stock on hand, and the factory had been shut down for some six weeks. Under these circumstances, it seems to us quite improbable that they could have made ten or twelve thousand dollars in nine months, or that there could have been debts due the firm to the amount of \$8,000. Add to this the testimony of several witnesses who swear that defendant stated to them repeatedly, and in a regretful manner, that he had sold his interest in the trade-mark, and had nothing else to sell to the plaintiff, and his subsequent conduct after he left plaintiff's employ in commencing to sell under the name of the "Standard Yeast," we can entertain but little doubt of the fact, notwithstanding the agreement was not in writing.

§ 445. *Questions as to trade-marks settled by the authorities.*

The principal question involved in this case is whether the words "Twin Brothers" are a trade-mark of such a character as entitles the plaintiff to be protected in his monopoly of them. The point is certainly not free from difficulty. There are few classes of cases in the whole domain of the law so difficult to reconcile as those wherein the validity of a trade-mark is discussed. The following propositions, however, may be considered as settled:

§ 446. — *appropriation of label or name enjoined.*

1. That a court of equity will enjoin unlawful competition in trade by means of a simulated label, or of the appropriation of a name; as where the defendant appropriates the name of a hotel conducted by the plaintiff, or imitates his label upon preparations. *Howard v. Henriques*, 3 Sandf., 725 (Irving House Case); *Woodward v. Lazar*, 21 Cal., 448 (What-Cheer House Case); *Howe v. Searing*, 10 Abb. Pr., 264 (Howe's Bakery Case); *McCardel v. Peck*, 28 How. Pr., 120 (McCardel House Case); *Williams v. Johnson*, 2 Bosw., 1 (Genuine Yankee Soap Case); *Day v. Croft*, 2 Beav., 488 (Day & Martin Blacking Case); *Davis v. Kendall*, 2 R. L., 566 (Pain-Killer Case); *Meriden Britannia Co. v. Parker*, 39 Conn., 450. The ground of interference in this class of cases is fraud; that is, the attempt to palm off the goods of the defendant as the goods of the plaintiff.

§ 447. — *the mark used must not express a falsehood.*

2. A court of equity will not protect a person in the exclusive use of a word which expresses a falsehood; as, if the article bears the word "patented" when in fact it is not patented, or exhibits an untruth as to the place of manufacture or composition of the article. *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. of L., 531; *Brown*, Trade-marks, § 72; *Flavel v. Harrison*, 10 Hare, 467; *Partridge v. Menck*, 2 Barb. Ch., 101; *Pidding v. How*, 8 Simons, 477 (Howqua Mixture Case); *Palmer v. Harris*, 60 Pa., 156, wherein the trade-mark indicated that certain cigars were made in Havana, when in fact they were made in New York; *Fetridge v. Wells*, 13 How. Pr.,

385 (Balm of Thousand Flowers Case); Phalon *v.* Wright, 5 Phila., 464 (Night-Blooming Cereus Case); Cocks *v.* Chandler, L. R., 11 Eq., 446 (Reading Sauce Case); Conwell *v.* Reed, 128 Mass., 477 (East Indian Remedy Case).

§ 448. — *expiration of patent.*

3. That no one can extend his monopoly of a patented trade-mark. By the expiration of the patent, the public acquires the right not only to make and sell the article, but to make and sell it under the name used by the patentee. Singer Manuf'g Co. *v.* Stanage, 6 Fed. R., 279; *In re* Richardson, 3 O. G., 120; Tucker Manuf'g Co. *v.* Boyington, 9 O. G., 455.

§ 448a. — *name of place cannot be used. As to numerals or letters, and name expressive of character of article.*

4. A person cannot, by means of a trade-mark, monopolize the name of the place where the article is manufactured. Canal Co. *v.* Clark, 13 Wall., 311 (Lackawanna Coal Case); Brooklyn White Lead Co. *v.* Masury, 25 Barb., 416. Nor the ordinary numerals or letters. Manuf'g Co. *v.* Trainer, 101 U. S., 51 (A. C. A. Case); Am. Manuf'g Co. *v.* Spear, 2 Sandf., 599; Avery *v.* Meikle, 23 Alb. Law J., 443. This proposition, however, has been disputed. See Gillott *v.* Estabrook, 48 N. Y. (The 303 Case); Boardman *v.* Meriden Britannia Co., 35 Conn., 402. Nor can a person monopolize a name expressive of the character or composition of an article. Caswell *v.* Davis, 35 N. Y., 281 (Ferro-Phosphorated Elixir of Calisaya Bark Case).

§ 449. — *words expressive of quality cannot be used.*

5. So where the words used are expressive only of the name or quality of the article, and have acquired that significance in the market. Am. Manuf'g Co. *v.* Spear, 2 Sandf., 599; Manuf'g Co. *v.* Trainer, 101 U. S., 51 (§§ 464-67, *infra*); Stokes *v.* Landgraff, 17 Barb., 608; Corwin *v.* Daly, 7 Bosw., 222 (Club House Gin Case); Ferguson *v.* Davol Mills, 2 Brewster, 314; Choynski *v.* Cohen, 39 Cal., 501 (Antiquarian Book Store Case); Phalon *v.* Wright, 5 Phila., 464; Singleton *v.* Bolton, 3 Doug., 293 (Case of Dr. Johnson's Yellow Ointment); Thomson *v.* Winchester, 19 Pick., 214 (Thomsonian Medicine Case); Benninger *v.* Wattles, 24 How. Pr., 204 (Old London Dock Gin Case); Raggett *v.* Friedlater, L. R., 17 Eq., 29 (The Nourishing Stout Case).

§ 450. *Words, to be a trade-mark, must be merely arbitrary.*

In order that mere words may be upheld as a trade-mark, they must be merely arbitrary, or they must indicate the origin or ownership of the article or fabric to which they are affixed. Am. Manuf'g Co. *v.* Spear, 2 Sandf., 597; Canal Co. *v.* Clark, 13 Wall., 322 (§§ 453-56, *infra*); Falkinburg *v.* Lucy, 35 Cal., 52; Brown, Trade-marks, § 216; Durham Tobacco Case, 3 Hughes, 157 (§§ 457-59, *infra*); Wotherspoon *v.* Currie, L. R., 5 E. & I. App., 508 (The Glenfield Starch Case); Ford *v.* Foster, L. R., 7 Ch. App., 611 (Eureka Shirt Case); Hier *v.* Abrahams, 82 N. Y., 519 (Pride Tobacco Case); McAndrew *v.* Bassett, 10 Jur. (N. S.), 550; S. C., 12 Week. R., 777 (Anatoleo Case); Lee *v.* Haley, L. R., 5 Ch., 155 (Grimes Coal Co. Case); Seixo *v.* Provezende, L. R., 1 Ch., 192 (Seixo Wine Case); Braham *v.* Bustard, 1 Hem. & M., 447 (Excelsior Soap Case).

There are cases which appear to differ from those above cited, but we think most if not all of them can be distinguished from them.

The defendant takes the ground in this case that the words "Twin Brothers' Yeast" is a generic name, and indicates, not the origin or ownership of the article, but its specific quality, and that it has acquired in the market a reputation under that name. This defense appears to be somewhat of an after-

thought, and it is doubtful whether it is properly before the court, since no allusion is made to it in the answer, and it was not until the case had been at issue a year and the proofs taken that defendant made an affidavit to the effect that "Twin Brothers' Yeast" was the generic name of a specific article of merchandise, and that he was the only person who ever was or ever could be able to manufacture it. The defense, too, seems to be somewhat inconsistent with the previous testimony. Upon being called as a witness Stratton swore that he made a discovery of a yeast compound, and that he did not get it patented because he considered it of more value to him as a secret than as a patent. He had imparted the secret to the employees of the plaintiff. He had also imparted it to the Judds, who manufactured "Judd Bros." yeast according to his formula; that he had also imparted the secret to one Hopper, who made the same yeast under the name of the "National Yeast;" that while a member of the firm of A. G. Smith & Co., he manufactured and sold the same yeast under the name of the "Standard" yeast; and that he manufactured the same yeast for a firm in Toledo, who sell it under the name of the "Lion Brand."

The difficulty is in distinguishing cases where the property has acquired a generic name, as indicating the quality of the article rather than its origin or ownership. One would say at once that Congress Water was an example of a generic name, since it is universally known by that name in the market; and yet the court of appeals in New York sustained it as a trade-mark, apparently upon the ground that complainants were the exclusive owners of the spring known as the Congress Spring, and that the right to use the name was passed as appurtenant to the property. The only satisfactory rule we have been able to gather from the authorities is that in each case it is a matter for the court to determine, not alone from the mark itself, but from the testimony, whether the words have become so well known as to stand in the public eye as denoting the character and quality of the article and not its origin or ownership. Thus, if it should appear that the article had been manufactured and sold by a number of dealers under a particular name, this would be decisive that the plaintiff had no right to the exclusive use of that name. Most if not all of these generic names were at first indicative of the origin, but finally, by constant use, ceased to subserve that purpose and have become indicative of the quality. An example of this is "Fowler's Solution of Arsenic," which clearly indicates origin, but the article is nevertheless put up by druggists all over the country, and this name has become public property. We think that most if not all the cases upon this subject, when carefully examined, will be found to have turned upon the extent to which the name is used, rather than upon the name itself. Thus, in the *A. C. A. Case*, 101 U. S., 51 (§§ 464-67, *infra*), it was said by the court that it was clear, from the history of the adoption of the letters as narrated by the complainant and the device itself, that they were only intended to represent the highest quality of ticking manufactured by the plaintiff, and not its origin. It appeared that other letters were used to indicate inferior grades of the same article.

In *Stokes v. Landgraff*, 17 Barb., 608, it appeared it was a practice of manufacturers of glass to designate the several qualities by names similar to those used by the parties to the action, and not by words or figures, in terms expressing the qualities. In *Corwin v. Daly*, 7 Bosw., 222, it appeared that the words "Club House" had been applied to articles of merchandise, including gin of a special quality, for a number of years. See, also, *Ferguson v. Davol Mills*,

2 Brewster, 314; Thomson v. Winchester, 19 Pick., 214; Wollfe v. Goulard, 18 How. Pr., 64 (Scheidam Schnapps Case).

§ 451. *What is not sufficient to debar the claimant of protection to his word trade-mark.*

But if the primary object of the trade-mark be to indicate the origin or ownership, the mere fact that the article has obtained such a wide sale that the mark has also become indicative of quality is not of itself sufficient to debar the owner of protection or make it the common property of the trade. To hold otherwise would be to deprive the owner of the exclusive use of his trade-mark just at the time when it had become most valuable to him and stood most in need of protection. But if the same be suffered to come into general use without objection from the original proprietor, it becomes merely generic, or indicative of quality.

Applying these principles to the case under consideration, it is pertinent to observe that no such defense is set up in either of the answers to the original bill, which was filed in December, 1880. In the answer of Orange Judd it is expressly averred that he is manufacturing Judd Brothers' yeast; that for a number of years he manufactured yeast for the complainant of precisely the same kind as he is now manufacturing, and which said complainant sold as Twin Brothers' yeast. He admits that he is selling to said Jackson B. Stratton and Asa Judd the yeast manufactured by this defendant, which, as before stated, is precisely the same kind of yeast he before manufactured for the plaintiff. He further avers that what Stratton and Asa Judd (his brother) do with said yeast this defendant does not know except from hearsay, but he denies that he is directly or indirectly using the "Twin Brothers'" trade-mark, or any mark except that owned by himself, to wit, the trade-mark of Judd Brothers; and further, that if Stratton and Asa Judd are using complainant's trade-mark, it is upon their own responsibility and without any agency or authority from him. He further, in paragraph 6, says that he is now and has been selling to the trade large quantities of the same kind of yeast which he has been selling said defendants Stratton and Asa Judd; that all said yeast sold by him is sold under the name of "Judd Brothers' Yeast." The testimony also shows, as heretofore stated, that the same yeast was sold under the name of Standard yeast and of the Lion yeast.

§ 452. *A trade-mark indicative of origin is assignable.*

The first intimation we have of the claim now set up is contained in the affidavit of Jackson B. Stratton, filed in December, 1881. His original defense was that he did not sell his interest in the trade-mark. It is true that in several of the contracts entered into between the plaintiff and defendant Stratton the yeast is spoken of as the Twin Brothers' yeast, and sometimes of the "kind and quality" known as Twin Brothers' yeast; and so it was undoubtedly known, as between the parties themselves, as representing the yeast of the compound of which Stratton possessed the secret; but this is no answer to the fact that it was manufactured and held out to the public under different names, such as were most convenient for Stratton. Upon the whole, it does not seem to us that the words "Twin Brothers," under the testimony, can be considered as indicating to the public the quality of the yeast, though it certainly does indicate origin and ownership in the persons whose likenesses appear on the trade-mark. The question whether this trade-mark was such a one as could be the subject of assignment to the plaintiff, and lawfully used by him, is not free from difficulty. He was not one of the Twin Brothers,

nor are either of the heads in the oval figure representations of himself or of any one now connected with him in business. But the cases are numerous in which it has been held that a party may lawfully assign and sell not only a trade-mark indicative of origin in himself, but even the right to use his own name in connection with a particular business. Several of these are cited in the recent opinion of Mr. Justice Matthews in the case of *Pepper v. Labrot*, 8 Fed. R., 29 (§§ 548-49, *infra*), in which the right to use the words "Old Oscar Pepper" were held to pass to an assignee in bankruptcy of the proprietor of a distillery and premises, even as against such former proprietor himself, who had set up a separate establishment in another county. The comments of Justice Field in this connection in *Kidd v. Johnson*, 100 U. S., 617 (§ 547, *infra*), are decisive of the right of a party to sell a trade-mark used in connection with a certain business, though it be indicative of origin in himself. In the case under consideration it seems to me clear that the Strattons could lawfully transfer to the complainant, in connection with their sale to him of their interest in the business, the exclusive right to use their trade-mark. Whether such trade-mark could be assigned separate from the business to which it was appurtenant, or whether it would pass by a sale of the business alone, we are not called upon to decide. Complainant paid a valuable consideration for this trade-mark, and we think he should be protected by injunction in his right to use it.

CANAL COMPANY *v.* CLARK.

(13 Wallace, 311-328. 1871.)

APPEAL from U. S. Circuit Court, Southern District of New York.

Opinion by MR. JUSTICE STRONG.

STATEMENT OF FACTS.—The first and leading question presented by this case is whether the complainants have an exclusive right to the use of the words "Lackawanna coal," as a distinctive name or trade-mark for the coal mined by them and transported over their railroad and canal to market.

The averments of the bill are supported by no inconsiderable evidence. The complainants were undoubtedly, if not the first, among the first producers of coal from the Lackawanna Valley, and the coal sent to market by them has been generally known and designated as Lackawanna coal. Whether the name "Lackawanna coal" was devised or adopted by them as a trade-mark before it came into common use is not so clearly established. On the contrary the evidence shows that long before the complainants commenced their operations and long before they had any existence as a corporation, the region of country in which their mines were situated was called "The Lackawanna Valley;" that it is a region of large dimensions extending along the Lackawanna river to its junction with the Susquehanna, embracing within its limits great bodies of coal lands, upon a portion of which are the mines of the complainants, and upon other portions of which are the mines of the Pennsylvania Coal Company, those of the Delaware, Lackawanna & Western Railroad Company, and those of other smaller operators. The word "Lackawanna," then, was not devised by the complainants. They found it a settled and known appellative of the district in which their coal deposits and those of others were situated. At the time when they began to use it, it was a recognized description of the region, and of course of the earths and minerals in the region.

The bill alleges, however, not only that the complainants devised, adopted and appropriated the word as a name or trade-mark for their coal, but that it had never before been used or applied in combination with the word "coal," as a name or trade-mark for any kind of coal, and it is the combination of the word Lackawanna with the word coal that constitutes the trade-mark to the exclusive use of which they assert a right.

It may be observed there is no averment that the other coal of the Lackawanna valley differs at all in character or quality from that mined on the complainants' lands. On the contrary, the bill alleges that it cannot easily be distinguished therefrom by inspection. The bill is therefore an attempt to secure to the complainants the exclusive use of the name "Lackawanna coal," as applied, not to any manufacture of theirs but to that portion of the coal of the Lackawanna valley which they mine and send to market, differing neither in nature or quality from all other coal of the same region.

§ 453. *The office and use of a trade-mark.*

Undoubtedly words or devices may be adopted as trade-marks which are not original inventions of him who adopts them, and courts of equity will protect him against any fraudulent appropriation or imitation of them by others. Property in a trade-mark, or rather in the use of a trade-mark or name, has very little analogy to that which exists in copyrights or in patents for inventions. Words in common use, with some exceptions, may be adopted if, at the time of their adoption, they were not employed to designate the same or like articles of production. The office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed; or, in other words, to give notice who was the producer. This may, in many cases, be done by a name, a mark or a device well known but not previously applied to the same article.

§ 454. *The essence of a charge of invading a trade-mark is the selling one person's goods as those of another.*

But though it is not necessary that the word adopted as a trade-name should be a new creation never before known or used, there are some limits to the right of selection. This will be manifest when it is considered that in all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another; and that it is only when this false representation is directly or indirectly made that the party who appeals to a court of equity can have relief. This is the doctrine of all the authorities. *Amoskeag Manufacturing Co. v. Spear*, 2 Sandf., 599; *Boardman v. Meriden Britannia Co.*, 35 Conn., 402; *Farina v. Silverlock*, 39 Eng. L. & Eq., 514. Hence the trade-mark must, either by itself or by association, point distinctively to the origin or ownership of the article to which it is applied. The reason of this is that unless it does, neither can he who first adopted it be injured by any appropriation or imitation of it by others, nor can the public be deceived. The first appropriator of a name or device pointing to his ownership, or which, by being associated with articles of trade, has acquired an understood reference to the originator or manufacturer of the articles, is injured whenever another adopts the same name or device for similar articles, because such adoption is in effect representing falsely that the productions of the latter are those of the former. Thus the custom and advantages to which the enterprise and skill of the first appropriator had given him a just right are abstracted for another's use, and this is done by deceiving the public, by induc-

ing the public to purchase the goods and manufactures of one person supposing them to be those of another. The trade-mark must therefore be distinctive in its original signification, pointing to the origin of the article, or it must have become such by association. And there are two rules which are not to be overlooked. No one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected, for competition would be destroyed. Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients or characteristics, be employed as a trade-mark, and the exclusive use of it be entitled to legal protection. As we said in the well-considered case of *The Amoskeag Manufacturing Co. v. Spear*, 2 Sandf., 599, "the owner of an original trade-mark has an undoubted right to be protected in the exclusive use of all the marks, forms or symbols that were appropriated as designating the true origin or ownership of the article or fabric to which they are affixed; but he has no right to the exclusive use of any words, letters, figures or symbols which have no relation to the origin or ownership of the goods, but are only meant to indicate their names or quality. He has no right to appropriate a sign or a symbol, which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose." *Vide Wolfe v. Goulard*, 18 How. Pr., 64; *Fetridge v. Wells*, 4 Abb. Pr., 144; *Town v. Stetson*, 5 id. (N. S.), 218; *Phalon v. Wright*, 5 Phillips, 464; *Singleton v. Bolton*, 3 Doug., 293; *Perry v. Truefitt*, 6 Beav., 66; *Canham v. Jones*, 2 Ves. & B., 218; *Millington v. Fox*, 3 Mylne & C., 338.

§ 455. *A trade-mark cannot be made of a geographical name.*

And it is obvious that the same reasons which forbid the exclusive appropriation of generic names, or of those merely descriptive of the article manufactured and which can be employed with truth by other manufacturers, apply with equal force to the appropriation of geographical names, designating districts of country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. They point only at the place of production, not to the producer, and could they be appropriated exclusively, the appropriation would result in mischievous monopolies. Could such phrases as "Pennsylvania wheat," "Kentucky hemp," "Virginia tobacco" or "Sea Island cotton" be protected as trade-marks; could any one prevent all others from using them, or from selling articles produced in the districts they describe under those appellations, it would greatly embarrass trade, and secure exclusive rights to individuals in that which is the common right of many. It can be permitted only when the reasons that lie at the foundation of the protection given to trade-marks are entirely overlooked. It cannot be said that there is any attempt to deceive the public when one sells as Kentucky hemp, or as Lehigh coal, that which in truth is such, or that there is any attempt to appropriate the enterprise or business reputation of another who may have previously sold his goods with the same description. It is not selling one man's goods as and for those of another. Nothing is more common than that a manufacturer sends his products to market, designating them by the name of the place where they were made. But we think no case can be found in which other producers of similar products in the same place have been restrained from the use of the same name in describing their goods. It is true that in the case of *Brooklyn White Lead Com-*

pany *v. Masury*, 25 Barb., 416, where it appeared that the defendant (at first selling his product under the name "Brooklyn white lead") had added to the name the word "Company" or "Co.," which made it an imitation of the plaintiff's trade-mark, though he was not a company, he was enjoined against the use of the added word. It was a case of fraud. He had assumed a false name in imitation of a prior true one, and with the obvious design of leading the public to think his manufacture was that of the plaintiff. But the court said, as both the plaintiff and defendant dealt in the same article, and both manufactured it at Brooklyn, each had the same right to describe it as Brooklyn white lead.

We have been referred by the plaintiffs to three decisions which are supposed to justify the adoption of the name simply of a district or town, as a trade-mark. One of these is *Alvord v. Newman*. There it appeared that the complainants had been manufacturers of cement or water-lime at Akron, from beds in the neighborhood of that place, for about thirteen years, and that they had always designated and sold their products as "Akron cement" and "Akron water-lime." The defendants commenced a similar business twelve years later, and manufactured cement from quarries situated near Syracuse, in Onondaga county, and called their product "Onondaga *Akron* cement or water-lime." It was not in fact Akron cement (for Akron and Syracuse were a long distance from each other), and the purpose of calling it such was evidently to induce the public to believe that it was the article made by the plaintiffs. The act of the defendants was therefore an attempted fraud, and they were restrained from applying the word Akron to their manufacture. But the case does not rule that any other manufacturer at Akron might not have called his product "Akron cement" or "Akron water-lime." On the contrary, it substantially concedes that the plaintiffs, by their prior appropriation of the name of the town in connection with the words cement and lime, acquired no exclusive right to its use as against any one who could use it with truth.

McAndrews v. Bassett is another case cited by the complainants. The plaintiffs in that case were manufacturers of liquorice made from roots and juice imported from Anatolia and Spain, and they sent their goods to market stamped "Anatolia." Soon afterwards the defendants made to order from a sample of the plaintiffs' liquorice, other liquorice which they also stamped "Anatolia." It was a clear case of an attempt to imitate the mark previously existing, and to put upon the market the new manufacture as that of the first manufacturers. It does not appear, from the report of the case, that the juice or roots from which the defendants' article was made came from Anatolia. If not, their mark was false. Of course the lord chancellor enjoined them. In answer to the argument that the word Anatolia was in fact the geographical designation of a whole country, a word common to all, and that therefore there could be no property in it, he said: "Property in the word for all purposes cannot exist; but property in that word as applied by way of stamp upon a stick of liquorice does exist the moment a stick of liquorice goes into the market so stamped and obtains acceptance and reputation in the market." It was not merely the use of the word, but its application by way of stamp upon each stick of liquorice, that was protected. Nothing in this case determines that a right to use the name of a region of country as a trade-mark for an article may be acquired to the exclusion of others who produce or sell a similar article coming from the same region.

Nor is such a doctrine to be found in *Seixo v. Provezende*, the remaining case cited by the complainants. The case turned upon an imitation of the plaintiff's device, which was the figure of a coronet combined with the word *Seixo*, a word which can hardly be said to have been the name of a district of country. It means stony, and, although applied to two estates, it was also the name of the plaintiff. Yet nothing in the decision warrants the inference that the word *Seixo* could alone become a trade-mark for any article, much less that it could be protected as a trade-mark for any article to the exclusion of its use in describing other articles coming from the same estate.

§ 456. *It is only when the imitation of a trade-mark amounts to a false representation that there is any title to relief.*

It must then be considered as sound doctrine that no one can apply the name of a district of country to a well-known article of commerce and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district or dealing in similar articles coming from the district from truthfully using the same designation. It is only when the adoption or imitation of what is claimed to be a trade-mark amounts to a false representation, express or implied, designed or accidental, that there is any title to relief against it. True it may be that the use by a second producer, in describing truthfully his product, of a name or a combination of words already in use by another, may have the effect of causing the public to mistake as to the origin or ownership of the product; but if it is just as true in its application to his goods as it is to those of another who first applied it and who therefore claims an exclusive right to use it, there is no legal or moral wrong done. Purchasers may be mistaken, but they are not deceived, by false representations, and equity will not enjoin against telling the truth.

These principles, founded alike on reason and authority, are decisive of the present case, and they relieve us from the consideration of much that was pressed upon us in the argument. The defendant has advertised for sale, and he is selling, coal not obtained from the plaintiffs, not mined or brought to market by them, but coal which he purchased from the Pennsylvania Coal Company, or from the Delaware, Lackawanna & Western Railroad Company. He has advertised and sold it as Lackawanna coal. It is in fact coal from the Lackawanna region. It is of the same quality and of the same general appearance as that mined by the complainants. It is taken from the same veins or strata. It is truly described by the term Lackawanna coal, as is the coal of plaintiffs. The description does not point to its origin or ownership, nor indicate in the slightest degree the person, natural or artificial, who mined the coal or brought it to market. All the coal taken from that region is known and has been known for years by the trade, and rated in public statistics, as Lackawanna coal. True the Delaware, Lackawanna & Western Railroad Company have sometimes called their coal Scranton coal, and sometimes Scranton coal from the Lackawanna, and the Pennsylvania Coal Company have called theirs Pittston coal, thus referring to the parts of the region in which they mine. But the generic name, the comprehensive name for it all, is Lackawanna coal. In all the coal regions there are numerous collieries, owned and operated by different proprietors, yet the product is truly and rightfully described as Schuylkill, Lehigh or Lackawanna coal, according to the region from which it comes. We are therefore of opinion that the defendant has invaded no right to which the plaintiffs can maintain a claim. By advertising and selling coal brought from the Lackawanna valley as Lackawanna coal he

has made no false representation, and we see no evidence that he has attempted to sell his coal as and for the coal of the plaintiffs. If the public are led into mistake it is by the truth, not by any false pretense. If the complainants' sales are diminished, it is because they are not the only producers of Lackawanna coal, and not because of any fraud of the defendant. The decree of the circuit court dismissing the bill must, therefore, be affirmed. (a)

BLACKWELL & CO. v. DIBRELL & CO.

(Circuit Court for Virginia: 3 Hughes, 151-163. 1878.)

STATEMENT OF FACTS.—Morris and Wright had a tobacco factory at Durham, North Carolina. Wright sold out to Morris and left the place; Green succeeded Morris, and the plaintiffs in this action succeeded Green, who, however, before his death had adopted the trade-mark in question in this case, to wit, the word "Durham" and the figure of a short-horn bull. This trade-mark was and still is kept up by his successors. Wright claimed a like trade-mark composed of the same word and the head and neck of a bull. It was alleged that he had and used this trade-mark while in business with Morris. Its use, however, it is conceded, was abandoned by him for about eight years. After he resumed it he transferred it, together with a flavoring compound, to one Armistead, who transferred his right to Blackwell & Co. The defendants claim the right to use a trade-mark substantially the same as that used by complainants, under authority from Wright. This bill is filed for an account and a perpetual injunction. There have been several other suits concerning this trade-mark which are sufficiently referred to in the opinion of the court.

Opinion by HUGHES, J.

It is useless to review all the points relied upon by counsel on each side in their able arguments in the cause. I shall consider only those questions upon which, in my judgment, the case really turns.

§ 457. *Upon what conditions the prosecution of one suit is an estoppel.*

I shall first deal with the objection of estoppel, or *res judicata*, urged by each party against the other. In order for one suit to constitute an estoppel upon any party to another suit, four conditions must co-exist, viz.: 1st. There must be an identity of the cause of action. 2d. There must be an identity of parties to the suit. 3d. There must be an identity in the character or quality of the respective parties; and 4th. There must be an identity of the thing in question. See *Smith v. Turner*, 1 Hughes, 375.

These conditions of identity do not exist between the present case and either of the cases of *Blackwell v. Wright* or *Blackwell v. Armistead*. Those cases, therefore, do not operate as estoppels. Nor do they at all affect the one now under consideration, except so far as they are precedents of authority upon the principles which were decided by them. In *Blackwell v. Wright* the decision was upon demurrer to the complaint; and, in technical effect, it was only that Blackwell had not traced his title to his trade-mark by proper allegations from Green; while, on the merits, the decision went only so far as to determine that the allegations of the complaint did not make a case of exclusive right to the trade-mark for the plaintiff. The complaint there did not charge that Wright's use of the trade-mark was a fraud upon the public, or pray for an injunction on that ground. None of these allegations can be made of the complainants' bill in this case.

(a) Affirming *Delaware & Hudson Canal Co. v. Clark*,* 7 Blatch., 112.

In *Blackwell v. Armistead* it is true that the decision was upon the principal questions raised in the present case; but owing to the character of the pleadings it was based upon grounds narrower and more technical than those upon which I propose to found the present decision. That suit was a trade-mark case. This is more, and involves the question of the fraudulent use of a trade-mark, to the injury of the public at large, as well as of the complainants. Therefore, neither of the two cases which have been urged in estoppel governs even as precedents the present one, which I shall now proceed to consider.

Two questions arise as to the pleadings and evidence: 1st. The first is, whether the defendants have any right at all to use a label in which the word Durham is used as descriptive of smoking tobacco, and in which the figure of a short-horn bull is used as a symbol of the word Durham; their right to the exclusive use of it not being claimed. 2d. The second question is, whether the complainants have a right to the exclusive use of such a label.

In considering the first question, I shall, for the sake of brevity, speak of the defendants' right to use the label described as Wright's, inasmuch as their title to use such a label could come, under the evidence in this cause, only from Wright. Has, then, Wright, or his assignees, now, or have they at any time since 1865, had any right at all to use a label having in it the word Durham, as descriptive of smoking tobacco, and having also in it the figure of a short-horn bull, or any part of that animal, as a symbol of the word Durham? Of course their title to use the word and the symbol stands on the same basis; if it falls as to the word it falls also as to the symbol of the word.

There can be no doubt of Green's original right to the exclusive use of the full figure of a short-horn bull as a trade-mark. That is virtually conceded by Wright himself in his testimony. As to the word Durham as descriptive of smoking tobacco, the right to use it is in this cause claimed by defendants, who do business in Richmond, Va., and who advertise and sell *as* Durham smoking tobacco, tobacco which they put up in Richmond and which they obtain from any source available to them other than Durham. Such a practice necessarily deceives every purchaser who, in purchasing this Durham smoking tobacco, believes that he is purchasing the fine tobacco put up in the place of that name in North Carolina. Dibrell & Co. claim solely from Wright. What, then, is Wright's title under which this deception comes about?

He claims that he did not, in 1861, sell his right in the label used by Morris & Wright to his partner, Morris, when he sold all his interest in the business. He claims that he derived the word Durham and the device of a short-horn bull from a Durham mustard box. He pretends that neither the word nor the device, as invented and used by him, was descriptive or geographical in purport, but that they were arbitrary symbols, and that having been so at the beginning, he and his assignees have still a right to use them.

§ 458. *The right to use a trade-mark is lost by the abandonment of its use for a term of eight years.*

The objection to this pretension lies not merely in the improbability of the origin of the use of the word Durham and its symbol which Wright recounts, or in the unsatisfactory character of the evidence on which his original right to use the word and its symbol is based, or in the presumption that when he sold in 1861 he sold all his interest to Morris; but it lies also in these two facts, viz.: 1st. That whatever title Wright had to the use of the word Durham after leaving Morris, in or about the year 1861, was lost by non-use, his disuse continuing through a period of eight or nine years after he left the vicinity of

Durham; and 2d. That during this long period of disuse the brand of Durham smoking tobacco acquired a definite and peculiar meaning with dealers and consumers; the word Durham ceasing to be (even if it ever was) a mere arbitrary term, and having obtained a geographical signification as to the place — Durham, and a commercial signification as to the article of tobacco manufactured at Durham. During the interval of disuse the phrase Durham tobacco had come to indicate that portion of the product of a particular region of country which was marketed at the place called Durham's or Durham. The phrase "Durham Smoking Tobacco" had come to indicate in all markets, and among all dealers and consumers, the smoking tobacco marketed and manufactured at this place of Durham, in North Carolina.

It was not until after this signification had attached to the phrase that Wright adopted (or, as he pretends, returned to) the use of the word Durham which he had abandoned. If, as he claims, the word Durham had in fact been used by him at first as an arbitrary trade-mark, and if, in addition, he had continued the use of it without interruption down to 1866 and on to the present time, that use by him would itself have prevented the other and local signification from attaching to the brand and word; for in that case Durham smoking tobacco would have described two tobaccos: first, those marked and manufactured at Durham, and, second, those sprinkled with Wright's "Durham" juice.

But he did abandon its use; he stood by for some eight years and allowed a peculiar commercial and local signification to attach to the word Durham as descriptive of smoking tobacco, and not until after that local and commercial signification had come to identify the tobacco labeled with the word all over the country as coming from a particular region and as having a particular quality, and not until after this brand had come to be worth thousands of dollars to the manufacturers of this particular tobacco at this particular place, did he begin or resume the use of the device, which he claims to have derived from the mustard can. To put that word now on tobaccos grown elsewhere than at Durham, even though sprinkled with his "Durham" decoction, is, in the light of the evidence in this case, to pass them off as tobaccos coming from Durham, and is to deceive and defraud all who deal in and purchase the commodity as smoking tobacco from Durham. It has so come to pass from Wright's non-use for eight years, that to manufacture and sell other tobaccos at all and brand them with the word Durham is to deceive the public, no matter what liquid may be used on them. Under existing circumstances, to manufacture even Durham tobaccos elsewhere than at Durham, and to sprinkle them with a foreign liquid, is to deceive the public generally, and those who put up the genuine article at that place particularly. The manufacture of these tobaccos at that place is the best guaranty which the public and the trade can have that the commercial article labeled Durham Smoking Tobacco, and sold in all markets, is genuine, and prepared under the fewest temptations to adulteration.

That the right to use a trade-mark may be lost by abandonment or disuse is too clear to need argument or the support of authority. The law of the subject is stated in the chapter on abandonment, sections 674 to 691, of Brown on Trade-marks. It cannot be pretended that in Green's first use of his label, in 1865 or 1866, he had any intention of taking up an old label at second hand, or had any knowledge or belief that Wright, or any one else, could claim the label which he then devised as entirely novel and peculiar. The field was

open to his enterprise and invention, for establishing his business and inventing his label and trade-mark just as he did.

Green's adoption in 1865 or '66 of the word Durham, as descriptive of the best tobacco of North Carolina put up by him, and of the bull as a symbol of the word, was naturally suggested by the facts of his business. If Wright had ever had such a label, which I do not feel that the evidence warrants us to believe, it was in 1865-66 unknown in Durham; had been abandoned even then for some four years; had never signified anything but tobacco sprinkled with Wright's decoction; and had never borne the valuable and creditable commercial signification which the climate and soil and good husbandry of North Carolina and the enterprise of a Durham manufacturer were about to give it.

By the several facts, of Wright's non-user of the label for eight years; of its never having, even as claimed by him, had any but an arbitrary significance as tobacco sprinkled with a species of artificial treacle; and of its having during a long period of disuse acquired a new, wholly different, and well and widely known geographical and commercial signification, Wright lost his right of using the label altogether. His use of it now operates necessarily to mislead and deceive the public as to the source of production and quality of the article bearing the label, thereby defrauding them; and the court will therefore make a decree of perpetual injunction against the further use of it.

§ 459. *The word "Durham" and the symbol of a bull constitute a valid trade-mark.*

As to the second question, whether Blackwell & Co. have an exclusive right to the use of the label described in the pleading, I think on the evidence submitted that they have. We have no hesitation in so deciding as against the defendant in this cause, and will incorporate in the decree of the court an order for an account of profits against the defendant as prayed for in the bill.

The label and trade-mark of complainants was established in 1865 by J. R. Green. His business and that of his successors built up the insignificant and obscure place, Durham's Station, into the flourishing town "Durham." The town grew up during the first four or five years of the use of the label, and owed its growth in chief part to the business indicated by the label. In that respect the case is similar to that of the trade-mark Cocoaïne (Burnett v. Phalon, 3 Keyes, 394). In respect to the commercial article bearing the geographical name, it is similar to that of the Akron cement (Newman v. Alwood, 51 N. Y., 189). The right of the complainants in this case has the double strength of that of the proprietors of the trade-mark Cocoaïne, and of that of the Akron cement. The use of the principal characteristics of their trade-mark by manufacturers not conducting their business at Durham is a deception put upon the public, and may be enjoined on that ground alone, irrespectively of the trade-mark right. The use of the trade-mark invented by Green under which he and his successors built up his trade, and built up the town of Durham, like the use of the word Akron to the proprietors of the commercial article bearing that name, belongs exclusively to the successors of Green, and the court should secure its exclusive use to them.

I had some doubt whether, in a litigation between Blackwell & Co. on the one hand, and defendants not doing business in the town of Durham on the other, it was competent for the court to decree that Blackwell & Co. have the exclusive right to the use of the word and symbol characterizing their trade-mark; but it is certainly competent for us to render a decree responsive

to the issues made up by the allegations and denials of the bill and answer, one of which is this right of exclusive use claimed by Blackwell & Co. As between the complainants and defendants in this suit, therefore, we may so decree, even though other persons than the defendants to this record be not bound by the decree.

BOND, J., concurred in the decree.

SINGER MANUFACTURING COMPANY v. LARSEN.

(Circuit Court for Illinois: 8 Bissell, 151-154. 1878.)

Opinion by DRUMMOND, J.

STATEMENT OF FACTS.—Under the evidence in this case, I think there can be no doubt that the plaintiff cannot claim the exclusive right to manufacture the “Singer Sewing Machine.” All that it can claim is to make a machine of its own peculiar manufacture, with a device in the nature of a trade-mark. Otherwise, after a patent has expired which has established the nomenclature of a sewing machine, as the Howe patent, or the Wilson patent, the patentee might go on and have the benefit of the patent indefinitely.

§ 460. *Rights of all persons to use the name of a machine the patent of which has expired. Under what circumstances this may be done. There can be no trade-mark in the name of an expired patent. (a)*

On a machine called “The Singer Sewing Machine” there were various patents. These patents have all expired, and nothing can, therefore, be claimed under them. Other persons cannot be prevented from manufacturing a machine like the Singer sewing machine, and which may be called, to distinguish it from other machines, “Singer’s Sewing Machine.” If a sewing machine has acquired a name which designates a mechanism or a peculiar construction, parts of which are protected by patents, other persons, after the expiration of the patents, have the right to construct the machine and call it by that name, because that only expresses the kind and quality of the machine. I have read the reports of the case of the Singer Manufacturing Company v. Wilson, originally decided by the master of the rolls in England, and afterwards, on appeal, in the chancery division of the high court of justice, and again on appeal from the latter court to the house of lords (Law Rep., Ch. Div., vol. 2, 1876, 434; Law Journal Reports, 1878, N. S., 47 Ch., 481), and I do not think it is necessary to controvert the general rule there laid down, that there must be something to indicate that the thing manufactured is not the same as that of the complainant; in other words, to show it is not manufactured by the plaintiff. That is, it is a question of manufacture, not of name. A person could not claim a right to construct a peculiar form of barrel as to dimensions and capacity merely, irrespective of any marks or brands impressed upon it. That of itself could not be a lawful trade-mark. The same rule would be applicable to the construction of a wagon or carriage, which, owing to some peculiarity, might possess a particular name, as that of the original manufacturer. A man might construct a wagon or carriage precisely like it, and he would not be liable if he did not claim in some form that it was constructed by the manufacturer. The only principle upon which an action can be sustained under such circumstances, as I understand, is through a trade-mark. If there were a valid

(a) To the same effect are *Singer Manuf’g Co. v. Stanage*,* 2 McC., 512; and *Same v. Riley*,* 11 Fed. R., 706.

trade-mark called a "Singer Machine," then there would be some force in the plaintiff's claim. Here the plaintiff and the defendant have a trade-mark somewhat similar, and if there is on the machine manufactured by the plaintiff a valid trade-mark to indicate that it is of the plaintiff's manufacture, no one else ought to be permitted to put anything on his machine to show that it has been manufactured by the plaintiff; that is, to use the same trade-mark. It may be the defendant has made his machine to imitate the plaintiff's, and to induce people to believe that it is the same. But as I have said, I do not think, under the circumstances of this case, there can be a trade-mark for the name "Singer Sewing Machine."

An illustration is furnished in the opinion of the lord chancellor in the house of lords in the case already referred to. A carriage called a "brougham" had been in very general use for many years. If that were devised by a man of the same name, so that, from its peculiarity of construction, it was generally known by that name, it certainly cannot be claimed that the man who devised it, or his assignees, would have a sole right to construct a "brougham" for all time to come. If no patent existed upon it or any of its parts, any one who has the requisite skill could construct just such a "brougham" as was originally constructed. There could, in such a case, be no trade-mark which the law would protect in the name "brougham;" and I therefore do not think that the opinion of the house of lords can be construed to mean what is claimed by the counsel of the plaintiff in this case. So that, while I hold that the defendant is not prevented from constructing a "Singer Sewing Machine," still he cannot be permitted to do any act the necessary effect of which will be to intimate, or to make any one believe, that the machine which he constructs and sells is manufactured by the plaintiff. Neither has he the right to use any device which may be properly considered a trade-mark, so as to induce the public to believe that his machine has been manufactured by the plaintiff; and, therefore, I shall modify the injunction in this case by simply requiring the defendant to refrain from selling any Singer sewing machines manufactured by any person or company other than the plaintiff, without indicating in some distinct manner that the said machines were not manufactured by the Singer Manufacturing Company.

FAIRBANKS v. JACOBUS.

(Circuit Court for New York: 14 Blatchford, 337-341. 1877.)

Opinion by JOHNSON, J.

STATEMENT OF FACTS.—This motion is made for a preliminary injunction to restrain the defendant from the use of the words "Fairbanks' patent" upon platform scales, and from making or selling an imitation of Fairbanks' scales. This preliminary relief is sought substantially upon the grounds of imitation of the article made and sold by the plaintiffs, and of violation of the plaintiffs' alleged trade-mark. No question of violation of patent-right is involved, for there is no claim by the plaintiffs that the scale complained of is, either in the whole or in any part, an invasion of any existing patent owned by the plaintiffs. Indeed, it is not claimed on the part of the plaintiffs that any part of their scale alleged to be imitated is protected by any existing patent, or that any existing patent owned by them applies to their own scale, except a small and unessential, though useful, addition to the scale frame, by which the oscillation of the weighing beam is prevented under certain circumstances. This

addition, which the scale complained of does not possess, is secured by an existing patent to the plaintiffs, and bears the proper words required by statute, "patented Feb. 11, 1862," cast upon it.

§ 461. *Colors or unessential forms cannot be adopted as trade-marks.*

The alleged imitation, as claimed by the plaintiffs, consists in this: that the scale complained of, as to the iron castings entering into its structure, was made by using the corresponding parts of a scale made by the plaintiffs, to form the moulds for those castings; and that the general shape and arrangement, as well as the color and external appearance, are imitated from the plaintiffs' scale so nearly that only an expert in scales could distinguish the difference between them. While, as matter of fact, I should, after an inspection of the two scales, not think the discrimination so very difficult, yet it may be taken to be not only difficult, but impossible, to discriminate between them. That fact does not give the plaintiffs any right. Their patents, while they existed (and those concerned terminated in or about 1845), protected them in the essential structure of their invention, but exterior form, painted color, and such non-essentials, were not, and could not be, the subject of the patents, and did not, and could not, secure these to the plaintiffs. Much less could these be secured as a trade-mark, for a trade-mark is always something indicative of origin or ownership, by adoption and repute, and is something different from the article itself which the mark designates. An invention of structure a patent for the invention secures; a design is secured by a patent for that. Apart from these, any one may make anything in any form, and may copy with exactness that which another has produced, without inflicting any legal injury, unless he attributes to that which he has made a false origin, by claiming it to be the manufacture of another person. Any other doctrine is impossible to be maintained; for, otherwise, all the colors, all the unessential forms, could be monopolized as trade-marks, and exclusive rights would be created, not limited in time, as patents are, founded upon no public utility, and subject to no control but the will of the adopter. I think there is no difference in the cases on this subject. *Amoskeag Co. v. Spear*, 2 Sandf., 599; *Gillott v. Esterbrook*, 47 Barb., 455; *Newman v. Alvord*, 49 Barb., 588. I conclude, therefore, that there is no invasion of the plaintiffs' rights, in the purposed and actual identity, both of structure and appearance, in the scales in respect to which the defendant is sued, with those which the plaintiffs manufacture.

§ 462. *The words "Fairbanks' patent" do not constitute a trade-mark.*

The case does not, however, rest here. On the base of the platform of what I may call the defendant's scale are cast the words, "Fairbanks' patent," with the number indicative of size, 11, and upon the weigh beam are stamped the words "Fairbanks' patent." These are all the words which appear upon these scales, which can be the foundation of a charge of invasion of trade-mark, and, indeed, are all the words or figures upon any part of the scale. The same words appear on corresponding parts of the plaintiffs' scale, and, if they constitute a legal trade-mark, I shall assume, for the present purpose, that the defendant's scales violate it. Are these words a name of origin, or a name of quality, indicating structure? Whatever they are in the one scale, they are, also, in the other. In some of the plaintiffs' scales their origin is signified by a quite different mark: "Fairbanks' Standard, made only by E. & T. Fairbanks & Co., St. Johnsbury, Vermont." This is a valid trade-mark of the plaintiffs, but does not appear upon their scale produced in court. The

other words must be understood as claiming that the thing on which it appears is protected by a patent. Especially is it thus localized and referred to the particular parts on which it appears, when, upon another part, is found the proper patent mark, which is necessary to support an action for an infringement, in the absence of notice, under section 4900 of the Revised Statutes. This gives significance to the use of the other marks, and makes the conclusion almost irresistible, that the purpose of the other words, on the beam and the frame, are to impress upon the incautious public that the scale is the subject of a patent, and, therefore, not open to competition in manufacture or sale. I agree, on this point, with the position of the plaintiffs' counsel, in his printed points, that "it is an error to suppose that even the patentee may so stamp his articles and deceive the public after the expiration of his patent" — citing *Leather Cloth Co. v. Am. Leather Cloth Co.* (Am. Trade-Mark Cases, 688, 713). And I add, in confirmation of this view, the decision of Judge Cadwalader, in the eastern district of Pennsylvania, October 4, 1875, in *Consol. Fruit Jar Co. v. Dorflinger*, 1 N. Y. Weekly Digest, 427, upon reasons which seem to me quite satisfactory, and by which, on a motion for a preliminary injunction, I ought to be guided. It is, of course, no answer that the defendant is, at least, guilty of the same fault, or even a greater. The plaintiffs fail to make these words out to be a lawful trade-mark, and, of course, cannot maintain upon them their claim for relief.

As to the charge that the defendant threatens various supposed wrongs to the plaintiffs, in imitating their manufacture, and that he represents his scales to be of the plaintiffs' make, the allegations are not so made out as to satisfy my mind of their substantial truth. *Byam v. Bullard*, 1 Curt., 100. I doubt whether the defendant meant anything beyond the assertion of a right to use the words on the scale, which had been for many years openly used by him and his predecessors, under claim of right, and for some time at least, and to some extent, with the knowledge of the plaintiffs or their predecessors.

Certainly, if the words "Fairbanks' patent" do not mean to assert the existence of a patent securing the scales, but only that they are made in conformity with, and embody the invention of, the expired Fairbanks' patent, they are free to all the world. What is not free is, to pretend that a scale is made by one person, which is, in fact, made by another.

In trade-mark cases, it is by no means of course to grant preliminary injunctions, even where the plaintiff's case seems to be made out; and I shall, therefore, leave the further consideration of the case to the final hearing, when the questions as to the defendant's claim of right to the use of the words "Fairbanks' patent," and the other questions of fact just referred to, and the unexplained circumstances and terms of the writing claimed to have extinguished the right of Chamberlain, can, if necessary, be further considered. The motion for an injunction must be denied, and the order heretofore made, granting an injunction till the decision of the motion, must be vacated.

FILLEY v. CHILD.

(Circuit Court for New York: 16 Blatchford, 376, 377. 1879.)

Opinion by BLATCHFORD, J.

STATEMENT OF FACTS.—The bill alleges that the plaintiff, in 1851, "conceived of applying" the name of "charter oak," as a trade-mark to cooking stoves embodying certain improvements in their internal construction, which

he had invented, for the purpose (1) of securing to himself more completely and exclusively the benefits to be derived from the manufacture and sale of such cooking stoves, and (2) of giving to the same a particular name, to enable the general public and purchasers to distinguish the same from all other cooking stoves. It is not alleged in the bill that the plaintiff has ever applied the name "charter oak" to any other cooking stove than the one embodying said improvements, nor that the cooking stoves sold by the defendant, bearing upon them the name of "charter oak" embodied said improvements, nor that the said improvements were patented to the plaintiff. It is shown that said improvements were patented to the plaintiff June 14, 1853; that the patent was reissued to him December 27, 1859; and that it was extended for seven years from the 14th of June, 1867. There is no evidence that any one, prior to the plaintiff, applied the name "charter oak" to a stove containing said improvements; and it is shown that all the stoves sold by the defendant have been stoves containing said improvements, and having upon them the name "charter oak." The suit is not brought upon the patent, for a violation thereof. The bill alleges that the use of said trade-mark by the defendant "is intended and designed and well calculated to deceive the public into the belief that the stove bearing it is the genuine stove" of the plaintiff, "since by said name 'charter oak' is alone the said stove bought, sold and known." There is no evidence that any person buying one of such stoves as the defendant has so sold would believe that he was buying a stove made by the plaintiff, although he would believe that he was buying a stove containing the improvements so patented to the plaintiff.

§ 463.. *As to the right to manufacture a patented article, after the patent has expired, and call it by the name by which it has been known.*

As the patent has expired, and the defendant has a right to sell cooking stoves embodying the patented improvements, the sole question is, whether the defendant has a right to sell them with the name "charter oak" upon them. The evidence satisfactorily shows that the plaintiff, during the entire twenty-one years' duration of the patent, knew of, and acquiesced in, the manufacture and sale by M. L. Filley and those under whom he claims, of cooking stoves containing the patented improvements, with the name "charter oak" upon them. M. L. Filley made the stoves now complained of. He has built up a business through such acquiescence, in the manufacture and sale of such cooking stoves, with such name. Under such circumstances, the plaintiff cannot, after his patent has expired, and when M. L. Filley has the right to make stoves containing said improvements, prevent him from calling them by the name of "charter oak," so long as he does not represent them as being made by the plaintiff, or induce others to believe that they are made by the plaintiff.

The bill is dismissed with costs.

MANUFACTURING COMPANY v. TRAINER.

(11 Otto, 51-67. 1879.)

APPEAL from U. S. Circuit Court, Eastern District of Pennsylvania.

Opinion by Mr. JUSTICE FIELD.

STATEMENT OF FACTS.—This is a suit in equity to restrain the defendants, D. Trainer & Sons, from using, on ticking manufactured and sold by them, the letters "A. C. A." in the sequence here named, alleged by the complainant to

be its trade-mark, by which it designates ticking of a particular quality of its own manufacture; and to compel the defendants to account for the profits made by them on sales of ticking thus marked.

It appears that the complainant, the Amoskeag Manufacturing Company, a corporation created under the laws of New Hampshire, commenced the manufacture of ticking at Amoskeag Falls, in that state, some time prior to 1834, and marked its products with a label or ticket consisting of a certain device, within which were printed, in red colors, the name of the company, its place of manufacture, the words "Power Loom," and in the center the single letter "A" or "B" or "C" or "D," according to the grade of excellence of the goods, the first quality being indicated by the first letter, and the decreasing quality from that grade by subsequent letters in the alphabet. The device, apart from the words mentioned, was a fancy border in red colors, square outside and elliptical within, and the words in the upper and lower lines of the label were printed in a line corresponding with the inside curve of the border.

In the year 1834, or about that time, the company introduced an improvement in its manufacture, by which it produced a grade or quality of ticking superior to any which it had previously manufactured. For goods of this quality it used in its label or ticket, in place of the single letter "A," the three letters "A. C. A." The original device with its colored border and printed words indicating the company by which and the place where the goods were manufactured was retained; the only alteration consisting in the substitution of the three letters "A. C. A." in place of the single letter "A." Subsequently the company changed its place of manufacture from Amoskeag Falls to Manchester, in the same state, and a corresponding change was then made in the label. The three letters mentioned were placed in the label or ticket on all goods of the very highest quality manufactured by the complainant, the single letter being retained in the labels placed on other goods to indicate a lower grade or quality. The combination of the three letters was probably suggested, as is stated, by the initials of the words in the company's name,—Amoskeag Company,—with the letter "A" previously used to denote the best quality of goods it manufactured. It is contended by the complainant that the combination was adopted and used to indicate not merely the quality of the goods, but also their origin as of the manufacture of the Amoskeag Company. It is upon the correctness of this position that it chiefly relies for a reversal of the decree dismissing the bill.

On the part of the defendants the contention is that the letters were designed and are used to indicate the quality of the goods manufactured and not their origin; that it was so adjudged many years ago in a case to which the company was a party in the superior court of the city of New York, which adjudication has been generally accepted as correct, and acted upon by manufacturers of similar goods throughout the country; and that the letters, as used by the defendants on a label or ticket having their own device, and in connection with words different from those used by the complainant, do not mislead or tend to mislead any one as to the origin of the goods upon which they are placed.

§ 464. *As to the doctrine of trade-marks.*

The general doctrines of the law as to trade-marks, the symbols or signs which may be used to designate products of a particular manufacture, and the protection which the courts will afford to those who originally appropriated them, are not controverted. Every one is at liberty to affix to a product of

his own manufacture any symbol or device, not previously appropriated, which will distinguish it from articles of the same general nature manufactured or sold by others, and thus secure to himself the benefits of increased sale by reason of any peculiar excellence he may have given to it. The symbol or device thus becomes a sign to the public of the origin of the goods to which it is attached, and an assurance that they are the genuine article of the original producer. In this way it often proves to be of great value to the manufacturer in preventing the substitution and sale of an inferior and different article for his products. It becomes his trade-mark, and the courts will protect him in its exclusive use, either by the imposition of damages for its wrongful appropriation or by restraining others from applying it to their goods and compelling them to account for profits made on a sale of goods marked with it.

§ 465. *The general law of trade-marks.*

The limitations upon the use of devices as trade-marks are well defined. The object of the trade-mark is to indicate, either by its own meaning or by association, the origin or ownership of the article to which it is applied. If it did not, it would serve no useful purpose either to the manufacturer or to the public; it would afford no protection to either against the sale of a spurious in place of the genuine article. This object of the trade-mark and the consequent limitations upon its use are stated with great clearness in the case of *Canal Company v. Clark*, 13 Wall., 311 (§§ 453-56, *supra*). There the court said, speaking through Mr. Justice Strong, that "no one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected, for competition would be destroyed. Nor can a generic name or a name merely descriptive of an article of trade, of its qualities, ingredients or characteristics, be employed as a trade-mark, and the exclusive use of it be entitled to legal protection." And a citation is made from the opinion of the superior court of the city of New York in the case of the present complainant against Spear, reported in 2 Sandford, that "the owner of an original trade-mark has an undoubted right to be protected in the exclusive use of all the marks, forms or symbols that were appropriated as designating the true origin or ownership of the article or fabric to which they are affixed; but he has no right to the exclusive use of any words, letters, figures or symbols which have no relation to the origin or ownership of the goods, but are only meant to indicate their names or quality. He has no right to appropriate a sign or symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose."

Many adjudications, both in England and in this country, might be cited in illustration of the doctrine here stated. For the purpose of this case, and in support of the position that a right to the exclusive use of words, letters or symbols to indicate merely the quality of the goods to which they are affixed cannot be acquired, it will be sufficient to refer, in addition to the decisions mentioned in Wallace and Sandford, to the judgment of the vice-chancellor in *Raggett v. Findlater*, where an injunction to restrain the use by the defendants upon their trade label of the term "nourishing stout," which the plaintiff had previously used, was refused on the ground that "nourishing" was a mere English word denoting quality. Law Rep., 17 Eq., 29. Upon the same prin-

ciple, letters or figures which, by the custom of traders, or the declaration of the manufacturer of the goods to which they are attached, are only used to denote quality, are incapable of exclusive appropriation; but are open to use by any one, like the adjectives of the language.

§ 466. *A device to indicate the quality of goods is not entitled to be considered a "trade-mark."*

If, now, we apply the views thus expressed to the case at bar, we shall find the question involved to be of easy solution. It is clear from the history of the adoption of the letters "A. C. A.," as narrated by the complainant, and the device within which they are used, that they were only designed to represent the highest quality of ticking which is manufactured by the complainant, and not its origin. The device previously and subsequently used stated the name of the manufacturer, and no purpose could have been subserved by any further declaration of that fact. And besides, the letters themselves do not suggest anything, and require explanation before any meaning can be attached to them. That explanation when made is that they are placed in the device of the company when it is affixed to the finest quality of its goods, while single letters are used in the same device when it is attached to goods of an inferior quality. They are never used by themselves, but merely as part of a device containing, in addition to the border in red, several printed terms. Alone the letters convey no meaning; they are only significant as part of the general device constituting the trade-mark. Used in that device to denote only quality, and so understood, they can be used by others for a similar purpose equally with the words "superior" or "superfine," or other words or letters or figures having a like signification.

We are aware that there is in the record the testimony of several witnesses to the effect that they understood that the letters were intended to indicate the origin as well as the quality of the goods to which they were attached, but it is entirely overborne by the patent fact that the label previously disclosed the name in full of the manufacturer and by the history of the adoption of the letters, as narrated by the complainant. As it was pertinently observed in the case in Sandford, if purchasers of the ticking read the name of the company, the letters can give no additional information, even if it be admitted that they are intended to indicate the name of the company. And if they do not read the name as printed, the letters are unintelligible. If an explanation be asked of their purpose in the label, the only reasonable answer which can be given is the one which corresponds with the fact that they are designed merely to indicate the quality of the goods.

§ 467. *A label that does not mislead is not an infringement of a trade-mark, and an injunction will not be granted.*

But there is another and equally conclusive answer to the suit. The label used by the defendants is not calculated to mislead purchasers as to the origin of the goods to which it is attached. It does not resemble the device of the complainant. Its border has a different figure; it is square outside and inside. It has within it the words "Omega" and "Ring Twist," as well as the letters "A. C. A." Neither the name of the complainant, nor of the place where its goods are manufactured, nor the words "Power Loom," are upon it. The two labels are so unlike in every particular, except in having the letters "A. C. A." in their center, that it is impossible that any one can be misled in supposing the goods, to which the label of the defendants is attached, are those manufactured by the complainant. The whole structure of the case thus

falls to the ground. There is no such imposition practiced upon the public and no such fraud perpetrated upon the manufacturers, in attempting to dispose of the goods of one as those of another, as to call for the interposition of a court of equity.

Decree affirmed. (a)

MR. JUSTICE CLIFFORD dissented.

(a) The Shaw Stocking Company, of Lowell, Massachusetts, were manufacturers of hosiery, and used upon their boxes labels in the following form:

	SHAWKNIT	
Style	SEAMLESS HALF-HOSE.	Size
830.	SHAW STOCKING Co., LOWELL, MASS.	11½.

Patent. B. F. Shaw, Apr. 23, 1867; Feb. 12, 1878.

The word *Shawknit* was printed in script, with a flourish underneath, and connected with the bottom of the *t*.

The central compartment of the label was the same in every instance, without reference to the contents of the boxes. The figures at either end differed according to the style and size of the hosiery, the numerals "830" having long been used by complainant to designate seamless half-hose of a mottled-drab color, manufactured by it. Half-hose of this particular variety had been advertised by these numerals, were known to the trade as "830's," and as such had become popular as the wares of complainant.

In May, 1881, complainant commenced selling to the defendants' firm at Albany large quantities of its goods. At the request and solicitation of defendants, complainant sent them several thousand circulars or price-lists, signed by the Shaw Stocking Company, and containing the announcement that the wares manufactured by that company and described in the circular could be obtained of "Mack & Co.," who would supply them to buyers at the prices indicated. These circulars were sent by the defendants extensively to their customers throughout the state, it being generally understood that the "Shawknit" goods could be obtained as favorably at Albany as at Lowell. The statements contained in the circular, emanating as it did directly from the company, taken in connection with the fact that the defendants advertised themselves on their bill-heads as "manufacturers and manufacturers' agents," caused it to be commonly supposed that Mack & Co. were the New York agents of the complainant, or at least conveyed information from which such an inference could reasonably and properly be drawn by the commercial world. In March, 1882, the defendants having maintained this connection with the complainant for nearly a year, and having a large quantity of its hosiery undisposed of, commenced putting up and selling, without previous notice, other goods, similar in color and texture, but inferior in many respects to its productions, as complainant insists, and lighter in weight and cheaper in price, as defendants admit. These goods were sold under labels of the following form:

	SEAMLESS	Style
	HALF-HOSE	830
	DOUBLE HEELS.	
M. & Co.	MACK & Co., - - - ALBANY, N. Y.	10½.

The lettering on the ends of this label was on a shield-shaped figure, the letters "M. & Co." being in the form of a monogram, while the word *Seamless* was printed in script, with a flourish underneath connecting with the last *s*, and resembling the word *Shawknit* in plaintiff's label in general appearance.

The wares so labeled and sold were not manufactured by the defendants, but were purchased of stocking makers at Birmingham, Connecticut, the labels on the boxes being removed by the defendants and the above labels substituted, not only on the Birmingham but also on the "Shawknit" boxes.

The question in the case was as to the right of plaintiff to be protected in the use of the figures 830, and the court, COXE, J., ruled as follows:

"The question to which the attention of counsel was chiefly devoted on the argument was whether the complainant had an exclusive right to the number '830' to designate and distinguish its hose of a particular variety. Broadly defined, a trade-mark is a mark by which the wares of the owner are known in trade. Its object is twofold: *First*, to protect the party using it from competition with inferior articles; and, *second*, to protect the public from imposition. There is hardly a limit to the devices that may be thus employed; the whole material universe is open to the enterprising merchant or manufacturer. Anything which can serve to distin-

KINNEY v. ALLEN.

(Circuit Court for Virginia: 1 Hughes, 106-114. 1877.)

Opinion by HUGHES, J.

STATEMENT OF FACTS.—The complainant is a manufacturer in New York of cigarettes of several varieties, which are in very popular use. On certain classes of the packages and boxes in which he makes them up for market he places, amongst other trade-marks, an eastern fez, surrounded by rays of light; and also the numerical symbol $\frac{1}{2}$, printed in bold characters, in red color, with the bar between the two figures oblique and nearly upright; with the figure 1 elevated on the left; with the figure 2 depressed on the right; the symbol as a whole being of such size that the circumference of a circle having a radius of five-eighths of an inch will just include all of its points. This character of $\frac{1}{2}$ as just described has been used by the complainant on certain of his cigarettes since 1873, and he applied for its registration in the patent office of the United States in May, 1875.

Shortly before this last-named date, that is to say, in April, 1875, the respondents began to manufacture cigarettes in Richmond, similar to those of the complainant, and to put some classes of them up for market in packages

guish one man's productions from those of another may be used. The trade-mark brands the goods as genuine, just as the signature to a letter stamps it as authentic. The trade-mark may consist of a token, letter, sign or seal. Names, ciphers, monograms, pictures and figures may be used. Why not numerals united? What consistency is there in allowing it in a combination of letters, but denying it in a combination of figures?

"A careful examination of the authorities cited by the learned counsel for the defendants leads to the conclusion that where the courts have refused protection to alleged trade-marks composed of letters or numerals, it has been because, on the facts of each case, it was determined that the figures or letters were intended solely to indicate quality, etc., and not because figures and letters in arbitrary combination are incapable of being used as trade-marks. It is very clear that no manufacturer would have the right exclusively to appropriate the figures 1, 2, 3 and 4, or the letters A, B, C and D, to distinguish the first, second, third and fourth quality of his goods respectively. Why? Because the general signification and common use of these letters and figures are such that no man is permitted to assign a personal and private meaning to that which has by long usage and universal acceptance acquired a public and generic meaning. It is equally clear, however, that if for a long period of time he had used the same figures in combination, as '3214,' to distinguish his own goods from those of others, so that the public had come to know them by these numerals, he would be protected. The courts of last resort in Connecticut, in Massachusetts, and in New York, have distinctly held that doctrine. Boardman v. Meriden, 35 Conn., 402; Lawrence Co. v. Lowell Mills, 129 Mass., 325, and Gillott v. Esterbrook, 48 N. Y., 374,—the numerals sustained being respectively '2340,' '523' and '303.' The defendants concede this, but insist that the case of Manufacturing Co. v. Trainer, 101 U. S., 51 (§§ 464-67, *supra*), affirms a contrary doctrine, and that it should be controlling. Undoubtedly the decisions of the supreme court should be followed, but I do not understand the doctrine enunciated by the court in this case as conflicting with the general principle contended for by the complainant. The case appears to have been decided upon the theory that the letters 'A, C, A' were simply used to denote quality and not origin, and turned mainly upon the question of fact as to whether or not they were so used. Upon this question the court was divided. Mr. Justice Field, who delivered the prevailing opinion, says, at page 54: 'The object of the trade-mark is to indicate, either by its own meaning or by association, the origin or ownership of the article to which it is applied.' And at page 55: 'It is clear from the history of the adoption of the letters "A, C, A," as narrated by the complainant, and the device within which they are used, that they were only designed to represent the highest quality of ticking which is manufactured by the complainant, and not its origin;'—hence Mr. Justice Field's decision. Mr. Justice Clifford, in an able opinion, dissented, and directly antagonizing the foregoing interpretation of the evidence, says, at page 59: 'Attempt is made in argument to show that the symbol of the complainants was not adopted by them for any other purpose than to designate the grade or quality of the fabric which they manufacture and sell in the market; but it is a sufficient answer to that proposition to say that it is wholly unsupported by evidence, and is decisively overthrown by the proof introduced by the complainants;'—hence

and boxes similar to those used by the complainant, and to stamp some of the boxes and packages, amongst other devices, with this same numerical character $\frac{1}{2}$ in broad, scarlet, red color, with the dividing bar oblique and nearly upright, and of size identical with the same character as used by the complainant.

The latter complains that this is an infringement of his right to the exclusive use of this trade-mark, and files his bill praying for a perpetual injunction forbidding the use of it by the respondents. It would seem that the original idea of the complainant in using this character $\frac{1}{2}$ on certain of his wares was to indicate that the cigarettes stamped with it were made up of two kinds of tobacco, in the proportion of half-and-half. The numerical character does not *express* such an idea; it is not the term which a person accustomed to the use of accurate language would employ for the purpose of expressing it; but yet it must be admitted that it does in some sort *indicate* the idea, and is not an absolutely arbitrary symbol. It is only because of the fact that the character does *indicate* the idea of half-and-half, but does not *express* it, that any confusion attends this case. If the use by the complainant of the numerical character $\frac{1}{2}$ was absolutely arbitrary, there could be no question of his exclusive right to

Mr. Justice Clifford's dissent. Had the evidence been understood by the two justices alike, there is no reason to believe that there would have been any disagreement as to the law.

"Subsequent to the decision of the supreme court in the Trainer case, and with full knowledge thereof, the case of the Lawrence Co. v. Lowell Mills, *supra*, was decided by the supreme court of Massachusetts. There is a striking resemblance between that case and the case at bar. Rarely is there such a similarity between the facts of two cases wholly separate and distinct. The trade-mark in the Massachusetts case consisted of an eagle surmounting a wreath formed of the branches of the cotton plant. Inside the wreath, and printed in a circle, were the words 'Lawrence Manufacturing Company;' underneath it the word 'trade-mark;' and below all the figures '523.' As in the case at bar, the word 'trade-mark' does not appear to have had any connection with the numerals. It was attached to and connected with the vignette. The figures were below and separated from it. This device had been used to designate hosiery of a certain grade for many years, and was known and recognized as indicating that the goods so marked were of the plaintiff's manufacture. Other numerals, and in fact another device, had, prior thereto, been used to indicate the same grade of hosiery. The wreath and eagle, without the figures '523' or any figures, had also been used on other grades of goods. Defendants' device was an eagle surmounting a double circle or garter, on which were the printed words 'extra-finish iron frame,' and beneath were the figures '523' in the same relative position. The eagle and garter were used by defendant before the eagle and wreath were used by plaintiff, and plaintiff made no claim to them disconnected from the figures. The court, after referring to and considering the Trainer Case and other cases, proceeds to say:

" 'These considerations would be decisive, if the plaintiff here claimed the exclusive right to the numerals "523," when used only to indicate the quality, and not with reference to the origin, of the goods. But such is not the plaintiff's position. Its claim is that the purpose of using these figures in connection with the other parts of its trade-mark was to aid the buyer in distinguishing its goods from similar goods made and sold by others.'

"This is precisely the position of the complainant here, and could hardly have been stated more tersely. In that case the goods were known and described as '523's;' in this as '830's.' Again the court says:

" 'The defendant's imitation was produced by using the same figures, printed in the same style, and placed as to the other parts of the device in the same relative position as the plaintiff's. These numerals constituted one of the most prominent features in the plaintiff's design, and, when used in connection with the rest of the defendant's mark, were calculated to aid in deceiving the public. It is not necessary that the resemblance produced should be such as would mislead an expert, nor such as would not be easily detected if the original and the spurious were seen together. It is not enough that such similitude exists as would lead an ordinary purchaser to suppose that he was buying the genuine article and not an imitation.'

"I understand this case as holding distinctly that a party who has adopted an arbitrary combination of figures to designate his wares, and to distinguish them from the productions

use it stamped in any form upon his goods. But where, on the other hand, a character or word is the one in general use for describing the quality or kind of goods on which it is placed, the books are full of authorities showing that such character or word ordinarily used cannot be appropriated by any one manufacturer, and that the most he can acquire by long usage, or by statutory registration, is the right of using the character or word printed or painted in some special form not in ordinary use. The cases reported on this head are so numerous and emphatic that it is needless to cite them.

§ 468. *A part of a trade-mark not expressing but indicating the idea is not entitled to the protection of a general injunction.*

There are, therefore, but two questions arising in the present case as to this numerical character $\frac{1}{2}$.

1. The first is, its use by the complainant being in a critical sense merely arbitrary, as only *indicating* but not *expressing* the idea of half-and-half, but not absolutely arbitrary in a popular sense,—whether or not complainant has a right to an injunction prohibiting the use by others of the character *in any form* on wares similar to his own. On the general principle that exclusive

of others, is entitled to protection in the use of those figures. I am unable to see any difference in principle between it and the case at bar, and, as the latest adjudication directly upon this subject, I think it should be controlling.

“That the facts in the case at bar bring it directly within the doctrine declared in the Massachusetts case, I have no doubt. The complainant, through its officers, explicitly states that the figures were adopted to distinguish its wares from those of other manufacturers, and it is difficult to perceive why such a number, ‘830,’ was chosen, unless some such object was in view. If the design had simply been what the defendants insist it was, the figures, 1, 2, 3, etc., would have suggested a more convenient and less perplexing method than the one actually adopted.

“It was the intention of the complainant to have its goods known in the market by these numerals; they were in reality so known. Not only is the fact sworn to in the complaint, but it is admitted in the answer at folio 22; the allegation being in the following language: ‘And these defendants, further answering, severally say that they have been informed, and believe it to be true, and therefore admit, that such “Shawknit” seamless half-hose of a mottled-drab color have been more generally known, called and spoken of as “830’s” by dealers in hosiery than by any other name, and that, under that designation, such hose have some times been ordered, purchased and sold.’

“A very persuasive piece of evidence is found in an order produced by defendants, forwarded to them by their agent, in which these goods are described simply as ‘830, 2 doz.,’ and in a bill, also produced by defendants, the same goods are charged to one of their customers as ‘2 doz. hose, 830, 2.40, \$4.80.’ The right to use a trade-mark is one depending upon use, and it appears that complainant had used these numerals long enough to convey to any one versed in the nomenclature of the trade a precise understanding of what goods were intended when the numerals were used alone, disconnected from any extrinsic information.

“I must hold, then, that the complainant has a right to the exclusive use on its labels of the numerals ‘830,’ as applied to hosiery of a mottled-drab color. Regarding the word ‘Shawknit,’ printed in script letters, there is no denial of complainant’s exclusive right.

“I am therefore compelled to say, after carefully examining the evidence and the elaborate briefs submitted, that, in my judgment, there is such a simulation as will probably deceive the complainant’s customers. Great damage might result to the complainant by the continuance of defendants’ label. I fail to see, however, how the defendants can be materially injured by its disuse. They are not manufacturers of hosiery, but are simply selling the productions of others. What legitimate profits can they lose by selling the goods as they come from the manufactory with the original labels attached?

“I think an injunction should issue restraining the defendants from using the numerals ‘830’ to designate mottled-drab hose not made by complainant, and from using on their labels the word ‘seamless,’ printed in script, with the flourish underneath in imitation of the word ‘Shawknit,’ as used by complainant. Motion granted.” *Shaw Stocking Co. v. Mack*,* 12 Fed. R., 707.

privilege, in prejudice of general right, ought not to be upheld in cases of nicety and doubt, I think it most proper not to grant a general injunction.

§ 469. *A symbol with the adjuncts of form, size, color and style will be protected as a valid trade-mark.*

2. The next question is, whether the complainant has a right to the exclusive use of this trade-mark *in the form, size, color and style* in which he has used it upon his wares since 1873, and in which he registered it in 1875. Upon the authority of cases numerously reported, and upon principles well established, I decide that he has such a right, and will so decree, and will insert in the decree an imprint of the character $\frac{1}{2}$ in the form, size, color and style in which an exclusive use upon his cigarettes is affirmed to the complainant.

WILLIAM ROGERS MANUFACTURING COMPANY v. ROGERS & SPURR MANUFACTURING COMPANY.

(Circuit Court for Massachusetts: 11 Federal Reporter, 495-500. 1882.)

Opinion by LOWELL, J.

STATEMENT OF FACTS.—The plaintiffs allege that one William Rogers, of Hartford, had been a skilful manufacturer of silver-plated ware long before 1865, and had acquired a high and valuable reputation; and in that year a co-partnership was formed between one Birch and one Pierce, who agreed with William Rogers that the firm should be called the William Rogers Manufacturing Company, and agreed with him and his son William Rogers, Jr., that they might adopt and use as trade-marks, “[*representation of an anchor*] Wm. Rogers & Son,” and “1865, Wm. Rogers Mfg. Co.,” and that they were so used until 1872, when the present corporation was formed, and bought all the stock, good-will, etc., of the firm; that the two companies, successively, have used these trade-marks, from 1865 to the time of filing the bill, by stamping them upon their goods, and have taken great pains with the manufacture of the plated spoons, forks and knives which they have put upon the market, and thus their goods have become favorably and extensively known as the “Rogers” and “Rogers & Son” goods, and are inquired for by these names; that both these names are of great value and distinguishing appellations in the trade, and the spoons, forks and knives so stamped have acquired and possess a special value; that on or about January 1, 1880, Lorenzo Spurr and George W. Spurr, associated as George W. Spurr & Co., manufacturers of silverware, at Greenfield, knowing the premises, combined and confederated with David C. Rogers and George E. Rogers, a son of said David, to cheat and defraud the complainants by stamping their spoons, forks and knives with the names, “Rogers” and “Rogers & Son” and “Rogers & Son [*representation of an arrow*] Greenfield, Mass.,” and that in February, 1881, the said George W. Spurr, David C. Rogers and George E. Rogers, with others, formed the defendant corporation, with the intent to make, and that said corporation has made and sold, spoons, forks and knives stamped Rogers & Son, Greenfield, Mass. (with an arrow); that those stamps are not distinguished by ordinary purchasers, using ordinary care, from the stamps of the plaintiff company; that they make and sell inferior goods; that they adopted their pretended trade-marks in order to deceive purchasers.

The prayer of the bill is for an account; an injunction against the use of the trade-marks set out in the bill, or any other stamp having the word “Rogers”

or "Rogers & Son" as the whole or part thereof upon silver-plated forks, knives and spoons; and for general relief.

The answer denies all the allegations of the bill as to the plaintiffs' title, and charges that the complainants deceived the public by pictures, advertisements, etc., representing their wares to be the veritable manufacture of William Rogers and William Rogers, Jr.; admits the use of the trade-mark Rogers & Son (with an arrow), but denies that it can deceive the public.

The evidence on both sides proves that there were three brothers Rogers in Connecticut, who were honest and skilful silver-platers,—among the first, if not the first, in this country to adopt the electrotyping process; that they failed in business and afterwards severally gave the use of their name, for value, to two or three different companies in Connecticut, and assisted them in the manufacture for a longer or shorter time. These companies are now friendly, as I understand, and have long used trade-marks, three of which still survive, viz.: "Rogers Bros.," "Rogers & Bro.," and "Wm. Rogers & Son," with an anchor, which are used by these several manufacturers respectively; the last by the plaintiffs only. The title of the Meriden Company to use one of them was established in *Meriden Britannia Co. v. Parker*, 39 Conn., 450.

§ 470. *The right to use a trade-mark depends upon use.*

The firm called the William Rogers Manufacturing Company, predecessors of the plaintiff corporation of the same name, had an arrangement with William Rogers (one of the three brothers) and his son for the use of the name, and William Rogers was a silent partner and had charge of the plating. This connection, which was to have lasted for a long time, was terminated in two years, for reasons not necessary to be considered here. The father and son then advertised and wrote letters and circulars declaring themselves the sole owners to the trade-mark, "Wm. Rogers & Son," and were restrained by the court from continuing such publications and announcements; and the son having violated the injunction was punished. The whole record of this case is in evidence. A part of it is reported in *William Rogers Manuf'g Co. v. Rogers*, 38 Conn., 121. Since that time no one has disturbed the plaintiffs in the use of their trade-marks; and for this reason it is immaterial to enter into the merits of that controversy. The right to use a trade-mark is, above all other rights, one which depends upon use.

All those companies whose trade-marks were originally derived from the brothers Rogers have maintained a remarkably good standard of merit in their manufactures, so that all plated spoons, etc., marked "Rogers," or known as "Rogers" goods, command a superior price. The plaintiffs' goods are not known as "anchor," but as "Rogers" and "Rogers & Son" goods.

There is no doubt that George W. Spurr, a silver-plater of Greenfield, intended to obtain some of the value of the Rogers name, and that with this object he paid a royalty of five cents a dozen to D. C. Rogers & Son for the use of their trade-mark from August, 1880, to January, 1881; then he organized the defendant company, who agreed to pay D. C. Rogers and E. C. Rogers at the rate of four cents a dozen for twenty-five thousand dozen, for the use of the trade-mark, but would make no final agreement until this suit should be decided. The history of this trade-mark is that D. C. Rogers and George E. Rogers applied in February, 1879, to the patent office to register under the act of congress a trade-mark consisting of the words "Rogers & Son," with an arrow. In the sworn application or "statement and declaration" required by law, they represented themselves as doing business at Greenfield, Massachu-

setts, under the firm name of Rogers & Son, and declared that they intended to use the trade-mark upon table cutlery, knives, forks, etc. Mr. Grinnell, of Greenfield, whom D. C. Rogers consulted upon the subject, asked him the pertinent question whether he intended to use this trade-mark himself or merely to trade upon; and he answered that he intended to use it in the manufacture of goods himself; and the application to the patent office conforms to this answer. But what the father and son did was to trade upon it; they let it out to George W. Spurr & Co. for a royalty, and afterwards to the defendants for a royalty. This royalty is paid for a falsehood. The names of these Rogerses is not of the slightest value in the silver-plating business, which they never learned or practiced; nor were they ever partners, as I read the evidence, except in hiring out this trade-mark. It is impossible that this royalty can be paid for anything but the chance of purchasers supposing it to represent some other Rogerses. A court of equity cannot be expected to look with much favor upon a trade-mark thus acquired and thus used.

The name of the defendant company was undoubtedly adopted by its originator and chief stockholder, George W. Spurr, with the same purpose. His letters make this clear. If it had been his own business and reputation alone which he intended to preserve and foster, the name would have been Spurr without the ROGERS, or SPURR first and ROGERS afterwards. Speaking for myself only, I should be much inclined to say that the use of such a corporate name might well be enjoined at the suit of those who had given the Rogers name its value, as in *Holmes v. Holmes, Booth & Atwood Manuf'g Co.*, 37 Conn., 278, for reasons which I shall give presently; but Gray, C. J., in *Gilman v. Hunnewell*, 122 Mass., 139, 152, has thrown some doubt upon the decision in that case; and in *Massam v. Thorley*, L. R., 14 Ch. D., 748, 763, the lords justices, in a case very like the present, refused to enjoin the use of the name entirely, if it could be so used as not to injure the plaintiff.

The defendants insist that the plaintiffs have made false and fraudulent statements to the public, to the effect that they are still manufacturing under the direction and management of William Rogers and William Rogers, Jr. Both parties have fallen into the mistake of supposing that it was important to have a Rogers and his son to authorize them to use the trade-mark Rogers & Son. The law is not so. Any one might use that trade-mark for the first time that it was used, and if there was no Rogers in the same business no Rogers could complain. *Levy v. Walker*, L. R., 10 Ch. D., 436; *Massam v. Thurley Co.*, L. R., 14 Ch. D., 748. It was unnecessary for the plaintiffs to send round pictures of William Rogers and his son, as they have done. Such a method of advertising is more appropriate to the trade in patent medicines. But I do not quite see the injury to the public in this course of action. I think there is little doubt, upon the facts proved, that the reputation which the goods marked Rogers & Son, and Rogers & Bro., and Rogers Bros. have now acquired depends upon the conduct of those who now use those names, and not upon any supposition in the minds of the purchasers that the persons who originated the business still conduct it. Under these circumstances it does not seem to me that the plaintiffs have disentitled themselves to relief.

§ 471. *The right of a man to use his own name in business. Limitation on that right.*

A great deal was said in argument about the natural right of a man to use his own name in any business that he chooses to adopt. This, however, as I have said, is the case of a defendant corporation which has adopted a name

to suit its business; and of persons having the name, who have adopted a trade-mark to let out for hire to other people.

Even if we grant all that has been said about the freedom to use names (and I grant upon that subject much more than has been argued, for I set no limits to that freedom, excepting interference with acquired rights), the books are full of cases in which defendants have been restrained from using their own names in a way to appropriate the good-will of a business already established by others of that name. *Croft v. Day*, 7 Beav., 84; *Metzler v. Wood*, L. R., 8 Ch. D., 606; *Fallwood v. Fallwood*, L. R., 9 Ch. D., 176; *Levy v. Walker*, L. R., 10 Ch. D., 436; *Massam v. Thorley*, L. R., 14 Ch. D., 748; *McLean v. Fleming*, 96 U. S., 245 (§§ 431-40, *supra*); *Devlin v. Devlin*, 69 N. Y., 212; *Filkins v. Blackman*, 13 Blatch., 440 (§§ 552-55, *infra*); *Stonebraker v. Stonebraker*, 33 Md., 252; *Shaver v. Shaver*, 54 Iowa, 208 [S. C., 6 N. W. Rep., 188]; *Churton v. Douglas, Johns.* (Eng.), 174. See 25 Albany Law J., 203.

All these cases in equity depend upon an appropriation by one person of the reputation of another, sometimes actually fraudulent and sometimes only constructively so. "It should never be forgotten in these cases that the sole right to restrain anybody from using any name that he likes in the course of any business that he chooses to carry on is a right in the nature of a trade-mark,—that is to say, a man has a right to say, 'You must not use a name, whether fictitious or real; you must not use a description, whether true or not, which is intended to represent, or calculated to represent, to the world that your business is my business, and so, by fraudulent misstatement, deprive me of the profits of the business which would otherwise come to me.'" Per James, L. J., *Levy v. Walker*, L. R., 10 Ch. D., 447-8.

The reason why artificial trade-marks are absolutely protected, without inquiry into motives, etc., is that the defendant has no natural right to such a symbol, and has the whole world of nature from which to choose his own. The same principle, in my judgment, applies to corporate names; but here I am met by authorities hesitating to take this ground, as I have said. The defendants insist that there is no sufficient evidence that purchasers would be misled. The purpose being what it was, it would not need a great deal of evidence to prove it successfully accomplished. There is evidence that buyers at retail would be very likely to be deceived.

§ 472. *Who may enjoin the use of a name as a trade-mark.*

But the defendants say, again, "Rogers" has become a mere designation of a particular kind of ware, like Thompsonian medicines or Singer sewing machines. *Thompson v. Winchester*, 19 Pick., 214; *Singer Co. v. Larsen, Cox, Dig.*, No. 659. But the evidence does not support this defense. The Rogers name does not express a certain sort of goods, but serves as a warranty of good workmanship, because all those persons who have used it have followed faithfully the excellent example of the original Rogerses, who insisted on honest work. It is further argued that the Rogerses are so many that the court cannot find an intent to appropriate the reputation of one of them more than another; and that, if any suit will lie, it must be by all those who use any trade-mark whose distinctive feature is the name Rogers. I believe it to be true that the Greenfield Rogerses did not inquire, nor did the defendants care, whose reputation they were making available; but I am of opinion that any one of those who rightly uses the name may enjoin its interfering use by others.

Profits stand on a different footing. As at present advised, I should say that the profits made from the name Rogers belong to all those who rightly use it. It is possible, however, that the plaintiffs may be able to prove facts which will give them special profits. They are entitled to, at least, an injunction, costs, and nominal damages, and if they choose to take the burden of going to a master, I am bound to permit them. Interlocutory decree for the complainants.

ROBERTS *v.* SHELDON.

(Circuit Court for Illinois: 8 Bissell, 398-403. 1879.)

Opinion by BLODGETT, J.

STATEMENT OF FACTS.—This case comes up on application by the plaintiff for an injunction against the defendants, and on the demurrer of one of the defendants, George W. Sheldon, to the bill. The bill states in substance that the complainant is a manufacturer of needles in England, and a subject of that country, but that he is domiciled in this country, and finds here a large market for his manufactured goods; that as early as 1866 he adopted as a trade-mark the word “Parabola,” which was printed on the outside of the packages containing his needles; that his goods have acquired a wide celebrity under the name, and an extensive sale; that he has expended large sums of money in advertising and introducing his goods, and that he is entitled, by virtue of having been the first to adopt this word as a trade-mark for needles, to the exclusive use of it. He also alleges that the firm of William Clark & Sons, who are also manufacturers of needles in England, and are competitors of his in the American market, have put upon the market packages of needles in imitation of the packages of complainant’s needles, and have used and are using the said word “Parabola” to designate their needles, and are now introducing their packages, marked with complainant’s trade-mark, upon the markets of this country, and especially of the city of Chicago, whereby they are impairing the trade of the complainant, and prays for an injunction.

The defendant makes two points in the demurrer to this bill. The first is, that the word “Parabola” is a description of the peculiar quality possessed by these needles, namely: that the eye of the needle is constructed in the form of two parabolic curves brought together at their open ends; and invokes, upon this statement of fact, the well known rule in the law of trade-marks, that a person will not be allowed to use or adopt as a trade-mark any word which expresses the quality of the goods; such, for instance, as “best,” “extra” or “superfine,” or any of these adjectives. There are a large number of cases sustaining this position, and the rule, as a principle of the law of trade-marks, is undoubtedly well established.

The second objection taken to the bill by the demurrer is, that the packages put up by Clark & Sons and sold by the defendant, Sheldon, here as their agent, while they use the word “Parabola,” at the same time are not calculated to deceive the public, because they say that the needles are manufactured by William Clark & Sons, and that the public are all notified that the needles made by the defendants, Clark & Sons, and sold by Sheldon, are “William Clark & Sons’ Parabola Needles,” and not the “Roberts’ Parabola Needles;” and upon this ground it is claimed there is no danger of the public being imposed upon or deceived by reason of the defendants’ use of the word.

§ 473. *A word descriptive of the article is not a valid trade-mark; one that is not descriptive may be.*

In answer to the first point, namely, that the eye of this needle has a parabolic form, it perhaps would be enough to say that there is nothing upon the package tending to show that the word "Parabola" has any reference to the eye of the needle. It might as well be said, if the needle was a little curved, that it was a section of a parabolic curve. But I think it is answer enough to this position to say that there is nothing on the envelope or label of the package which says or tends to show that the eye of the needle is claimed to be made in the shape of a double parabola, or two parabolic curves, and when inspected under the glass it would seem to me, as a question of fact, that the eye of this needle is elliptical rather than parabolic in shape. The word "Parabola," it seems to me, is, as stated by the complainant, an arbitrary term adopted by complainant to distinguish his needles from those of other manufacturers, and he had a right to so select and apply it.

It is frequently the case that by close analysis and ingenuity, you can find in almost any trade-mark a designation of some quality connected with the goods. An analogous case to this was before this court, and heard before the learned circuit judge and myself four or five years since, in regard to what is known as the "Cream Baking Powder." The firm of Steele & Price filed a bill against one Richards and his associates, stating that Steele & Price had adopted a trade-mark to designate a certain baking powder which they manufactured, called "Cream Baking Powder." The defendant had also commenced manufacturing baking powders and was putting upon the market a commodity under the name of "Star Cream Baking Powder," and the question was there made that the word "Cream" had reference to the quality of the baking powder; that is, that it was the best in the market—the *cream* of baking powders. The position was argued very strenuously by the defendant's counsel that it was a term of quality, not an arbitrary term; but in that case, which was decided by Judge Drummond, the court held that the defendants had no right to use the word "Cream," and that any prefix or suffix they used with it would not give them the right to use it in connection with the manufacture of goods similar to those made by the complainants; that the complainants had the exclusive right to use that term to designate goods of their manufacture.

It seems to me the case was, in all respects, analogous to this. I do not recollect that the case has ever been reported. An oral opinion was delivered by Judge Drummond immediately on the close of the argument, and I presume it never got into the reports.

In regard to the last point made, that by reason of the defendants using their own name upon the wrapper or envelope, the public are not deceived, it would perhaps be enough to say that, when goods acquire a specific name, the purchaser rarely looks to see who has manufactured the goods by that name. As, for instance, if, as a matter of fact, these needles have acquired, among the trade, and among consumers or users, the designation of "Parabola," to such an extent that the purchaser would simply ask for "Parabola needles," he might be supplied with the parabola needles manufactured by Clark & Sons, instead of those manufactured by the complainant, to the direct injury of the complainant and the abridging of his trade.

Another case very analogous to this, upon this point, was also before this court. A suit was brought by Proctor & Gamble against McBride & Co., of

this city, to enjoin the use of a trade-mark, which had been adopted by Proctor & Gamble, for a certain brand of soap which they manufactured. Proctor & Gamble claimed that they had introduced to the public, under a trade-mark of their own, a brand of soap under the term and designation of "Mottled German Soap," and they had adopted as a trade-mark upon their packages, those words with a circle, with a moon and stars in the middle. The defendants, McBride & Co., who were manufacturers in this city, had put upon the market a brand of soap which they termed "S. W. McBride's German Mottled Soap," and they had marked these words upon the outside of their packages in combination with a crescent within which was a single star instead of a number of stars. That, I think, was the distinction, so that it presented a stronger case for the defendants than this, because we find upon inspection that the defendants' and complainant's labels are almost identical to the eye; that is, the reading upon them is essentially the same. In one case it is "Roberts' Parabola gold burnished sharps." Upon the other label or package, upon the same colored paper, and with the same colored ink, is printed, "William Clark & Sons' Parabola gold burnished sharps," so that there is a similar use of terms or letters, and the same use of the word "Parabola," and the only distinction is that between "Roberts" and "William Clark & Sons." Now, in the case I mentioned, the defendants had departed much more widely from the complainant's trade-mark. They had changed the arrangement of the words so, instead of its being "Mottled German Soap," it was "German Mottled Soap," and instead of a circle containing several stars, it was a crescent containing a single star, prefixed by the name of each maker; and it was argued in that case, there could be no possibility of intelligent consumers being deceived. So strong was the case made before me on an application for an injunction, that I refused the injunction; but after the proofs were taken, and the case brought to hearing before Judge Drummond, he sustained the infringement, and ordered a perpetual injunction against the defendants. It was also shown in that case that "Mottled German Soap," or "Mottled Soap," had been in common use in the trade for nearly fifty years, and that "Mottled Soap" was a commodity well known to the trade; but Judge Drummond sustained that trade-mark as the exclusive property of the complainant, and held that the defendants infringed.

In the light of that case, which has never been questioned, it seems to me that the mere fact that the defendants in this case have used the words "William Clark & Sons," so as to designate them as the manufacturers, does not defeat the complainant's right to the exclusive use of this word "Parabola," as designating his manufacture, and that there is a liability to impose upon the trade and on the public, from which the complainant has the right to be protected.

With these views, I shall order an injunction on the complainant's filing a bond in the penal sum of \$5,000, conditioned for the payment of any damages which the defendant may sustain by reason of the issuing of the injunction, and also require complainant, as a condition of the granting of the injunction, to put in his proof within thirty days after the answer in this case is filed.

WILLIAMS v. ADAMS.

(Circuit Court for Illinois: 8 Bissell, 452-456. 1879.)

STATEMENT OF FACTS.— Bill to restrain the use of the word “Yankee” as a trade-mark, complainants claiming that they adopted that word as a trade-mark for shaving soap in 1846.

Opinion by BLODGETT, J.

I am satisfied that the complainants’ case is fairly made out. The proof shows that they did enter upon the manufacture of this class of soap, as the bill alleges, and adopted this word “Yankee” as the mark or designation of their goods, and have used it from the time of its adoption to the present.

The defendants, on the contrary, claim that the complainants have abandoned the use of this word as their trade-mark; that they have allowed other manufacturers to infringe upon it by putting their soaps upon the market under the designation of “Yankee,” as, for instance, “Yankee Jim,” “Yankee Sam,” and under other labels in which the word “Yankee” is the controlling or leading term, whereby complainants’ exclusive claim of right to the use of the word “Yankee” has been infringed; and that complainants have so acquiesced in these infringements as to have abandoned their exclusive right to the use of the word “Yankee.”

§ 474. *Abandonment of a trade-mark is not established by showing numerous infringements in which the owners of the trade-mark have not acquiesced.*

I do not find this position sustained by the testimony. The complainants seem to have been diligent in prosecuting all persons who infringed upon their rights within a reasonable time after they became aware of such infringement. It is true that the proof shows that quite a large number of manufacturers are putting shaving soaps upon the market under the term or description of “Yankee,” such as “Yankee Sam Soap,” “Yankee Jim Soap,” and the “Yankee Soap,” which last is precisely like the complainants’, and there are various other imitations of the complainants’ goods, shown in the proofs. But I do not understand the rule to be, that if a party infringes upon another’s trade-mark there is any fixed time in which he must bring suit in order to save his rights. Certainly, there is no such neglect on the part of the complainants proved here, as would show an intention to abandon their trade-mark.

The other point, that the word “Yankee” cannot be adopted by any person as a trade-mark, is presented with a good deal of vigor and ingenuity by defendants’ counsel, and with a show of authority. A Mr. Browne has written a book on trade-marks, which to some extent, I think, is accepted by the profession as an authority, in which he sums up his own conclusion as to the principle decided in a certain trade-mark case, and says: “It clearly appears from the foregoing case, that words designating localities, places or persons, such as London Dock Gin, Yankee Soap, etc., cannot be adopted or used as a trade-mark.” Browne on Trade-marks, secs. 119-125, 597.

It is sufficient to say in reference to this paragraph that Mr. Browne is not a court; that he was simply enforcing his own individual views or conclusions from certain adjudged cases. Now, it seems to me by all the analogies, that a manufacturer, especially a manufacturer thirty years ago, would have had the right to adopt the term “Yankee” as applicable to some specific kind of goods, and make it a valid trade-mark.

§ 475. *The word "Yankee" is a valid trade-mark.*

We must remember that the term was not as generally applied then as it is now. At that time, certainly, the term "Yankee" was applied to the inhabitants of but a small portion of the United States—to a small portion of the New England states. For instance, in western Massachusetts they would speak of the inhabitants of the eastern part of that state, and along the coast from Boston to Portland, Maine, as "Yankees." The eastern shore people were called "Yankees" in New England. In the southern, and perhaps some of the western, states, all people in the New England states were spoken of as "Yankees," and, since our unfortunate national rebellion, it has been quite common at the south to speak of all persons who remained loyal to the federal government as "Yankees." The term has been enlarged by use, undoubtedly, very much within the last fifteen or twenty years. In 1846, the time the complainants entered upon this manufacture, the term "Yankee" was restricted, and applied solely as a nickname or epithet to the inhabitants of some parts of the New England states, but it was not a term describing a specific locality or place or person. It is not a geographical term, nor a proper name, but a designation applied by the dwellers in one locality to the dwellers in another place. It was not the name of any *certain* locality, and it seems to me complainants had the right to adopt it as their trade-mark. If it has, since that time, by a more general use and definite application, come to designate any certain locality—which is not conceded,—such subsequent events cannot defeat complainants' right. The complainants have made such a case as entitles them to an injunction perpetually restraining defendants from using the word "Yankee" in any label or mark upon their soaps, and the case will be referred to the master to take proof as to the damages which the complainants have sustained.

§ 476. *In general.*—Anything which can serve to distinguish one person's productions from those of another, as tokens, letters, figures, signs, seals, names, ciphers, monograms or pictures, may be used for a trade-mark. *Shaw Stocking Co. v. Mack*,* 12 Fed. R., 707; 28 Int. Rev. Rec., 320; 21 Blatch., 1.

§ 477. *Mark used to deceive the public.*—A court of equity will extend no aid to sustain a claim to a trade-mark of an article which is put forth with a misrepresentation to the public as to the manufacturer of the article and as to the place where it is manufactured, both of which particulars were originally circumstances to guide the purchaser of the article. So, where a manufacturer of medicine falsely states in circulars accompanying each bottle that it is manufactured by the original manufacturer at the original place of manufacture in another state, he will not be protected in the exclusive use of certain words as a trade-mark for such medicine. *Manhattan Medicine Co. v. Woods*,* 108 U. S., 218; 23 O. G., 1925.

§ 478. Equity will not lend its aid to protect a person in the use of a trade-mark which, if it has become valuable, has become so by means of the false and deceptive language used in circulars advertising the article. *Seabury v. Grosvenor*,* 14 Blatch., 262; 14 O. G., 679.

§ 479. A trade-mark calculated to convey the impression that the article to which it is applied is protected by a patent, when it is not, is calculated to deceive the public and is invalid. Mason was the patentee of an improvement in fruit jars, but his patent was declared invalid. *Held*, that the use by him of the words "Mason's patent, November 30th, 1858," or "Mason's Improved," or "The Mason Jar of 1858," as a trade-mark was calculated to deceive the public, and that such use would not be protected. *The Consolidated Fruit Jar Co. v. Dorflinger*,* 2 Cent. L. J., 721; 2 Am. L. T. Rep. (N. S.), 511.

§ 480. Equity will not protect as a trade-mark the use of a name or term which is likely to deceive the public in reference to the components or nature of the article to which it is applied. Thus the words *straight cut*, when used merely as an arbitrary trade-mark, and not truly descriptive of the tobacco to which they are applied, will not be protected. *Ginter v. Kinney Tobacco Co.*,* 12 Fed. R., 782; 22 O. G., 770; 14 Rep., 138.

§ 481. *Words and figures.*—A dealer in homeopathic medicines put up a series of homeopathic remedies named by him "Homeopathic specifics," and numbered serially from 1 to 35,

each number being adapted for certain specified diseases. *Held*, that while the words "Homeopathic specifics" could not, when standing alone, constitute a trade-mark, yet that the medicines having become known by number, the use of such numbers in connection with the words constitutes a trade-mark, and the use of the same numbers when applied by another manufacturer to remedies for the same diseases would be enjoined. *Humphreys' Specific Homeopathic Medicine Co. v. Wenz*,* 14 Fed. R., 250; 15 Rep., 70.

§ 482. A person who has adopted an arbitrary combination of figures to designate his wares, and to distinguish them from the productions of others, is entitled to protection in the use of those figures as a trade-mark, when such figures have been so long in use as to convey to any one versed in the nomenclature of the trade a precise understanding of what goods are intended when the numerals are used alone, disconnected from any extrinsic information. *Shaw Stocking Co. v. Mack*,* 12 Fed. R., 707; 28 Int. Rev. Rec., 320; 21 Blatch., 1.

§ 483. Words.—The word "Centennial" is common property, and cannot be claimed for use as an exclusive trade-mark as applied to specific objects. *Hartwell v. Viney*,* 2 Weekly Notes, 602.

§ 484. A word may be used as a trade-mark, and such use protected, notwithstanding the fact that prior to the time of its adoption it was used in a distant place upon the same article, where such use was casual, fortuitous and only continued for a short time. *Holt v. Menendez*,* 23 Fed. R., 869.

§ 485. A purely arbitrary or fanciful appellation for the first time used to distinguish an article to which it has no natural or necessary relation, by virtue of such appropriation and subsequent use becomes a trade-mark. So the word "Eureka," applied to a fertilizer, becomes by use a trade-mark, and its application to another similar fertilizer is an infringement. It is not necessary that the entire trade-mark be copied, or that the verbal or physical resemblance of the marks should be complete. It is sufficient that the essential word is taken. *Alleghany Fertilizer Co. v. Woodside*,* 1 Hughes, 115.

§ 486. Geographical name.—The plaintiff, a manufacturer of beer in St. Louis, had acquired an export trade to Panama and South America, for his beer put up in bottles and labeled "St. Louis Lager Beer." The defendant, who was a shipper of beer from New York, also labeled his bottles prepared for the same trade with the same words. *Held*, that although the plaintiff could not have an exclusive property in the words "St. Louis," or an exclusive right to designate his beer "St. Louis Lager Beer," yet as he was the only exporter from St. Louis, and his beer had acquired a reputation in the places to which it was sent, and as his use of the words was legitimate, the use of the words by the defendant, being illegitimate and calculated to deceive the public, would be enjoined, as would any attempt by the defendant to divert the plaintiff's trade by simulating his labels, or in any manner of attempting to dispose of his beer as that of the plaintiff. *Anheuser-Busch Brewing Ass'n v. Piza*,* 24 Fed. R., 149.

§ 487. Though the complainants had used for many years the name "Lackawanna Coal" for coal mined by them, the use of that word by a dealer who for many years, with the knowledge and acquiescence of the complainants, had been so designating coal mined by other parties in the same valley, will not be enjoined, for such knowledge and acquiescence amount to a license. *Delaware & Hudson Canal Co. v. Clark*,* 7 Blatch., 112. Affirmed, *Canal Co. v. Clark*, 13 Wall., 311 (§§ 453-56).

§ 488. Application to a different article.—The registration of a trade-mark for "paints" by a plaintiff who has previously acquired exclusive use of such mark for particular kinds of paint only, does not give him the exclusive right to apply such trade-mark to paints of another kind as against a person who, prior to such registration, used that mark upon such other kinds. *Smith v. Reynolds*,* 13 Blatch., 458.

§ 489. A representation of a crown applied to vessels containing paint, and printed on the labels or wrappers of such vessels, and on other printed matter relating thereto, may be a valid trade-mark. *Smith v. Reynolds*,* 10 Blatch., 100.

§ 490. A label of a single color, apart from any name, figure or device with which it may be connected, cannot be the subject of a trade-mark, so that a person adopting the same color for his label may be charged with infringement. *Fleischmann v. Starkey*,* 25 Fed. R., 127.

§ 491. A tin pail used to contain paper collars cannot be claimed as a trade-mark. *Harrington v. Libby*,* 14 Blatch., 128.

§ 492. Dealers in flour who are not manufacturers, and who had adopted a trade-mark for flour selected and classified by them, where such selection and classification required skill, judgment and expert knowledge, and added value and reputation to the flour so selected, will be protected in the use of such trade-mark. *Holt v. Menendez*,* 23 Fed. R., 869.

§ 493. A corporation may acquire a property right to use another name as a trade-mark, or as incidental to the good-will of the business, as well as an individual, and if such a right has been acquired its enjoyment will be protected. The corporation cannot be deprived of

the right by the subsequent assumption of the name by another corporation, whether assumed by the incorporators or by the legislature incorporating it. *Goodyear Rubber Co. v. Goodyear's India Rubber Glove Mfg. Co.*,* 22 Blatch., 421; 21 Fed. R., 276.

§ 494. The corporate name of a corporation is a trade-mark, and a court of equity will enjoin the use of the same name by another corporation. The intention with which such name is adopted is immaterial. Neither is it material to the jurisdiction of a court of equity that the defendant corporation is insolvent. Nor is it an objection to maintaining the suit that the right of the corporation to use the name has not been first determined at law. Such suit may be brought by a bondholder of the corporation whose name has been unlawfully appropriated, and who is likely to be affected by such unlawful appropriation, and the corporation may be made a defendant. *Newby v. Oregon Central R. Co.*, 1 Dedy, 609.

§ 495. A court of equity will not enjoin the creation of a corporation with the same name as that of a corporation existing in another state, though it is obvious that there is an intention to secure by the use of such name a part of the patronage of the foreign corporation. *Lehigh Valley Coal Co. v. Hamblen*,* 23 Fed. R., 225.

§ 496. Name used to designate business.—The Goodyear Rubber Co., a corporation, had used the name "Goodyear's Rubber Mfg. Co.," to designate their business, and afterwards another corporation, Goodyear's India Rubber Glove Manufacturing Co., used the same name. *Held*, that as that name had been first used by the former company, its use by the latter would be enjoined, notwithstanding the fact that for some years a few correspondents had, contrary to the efforts of the officers to correct the error, addressed it as Goodyear's Rubber Mfg. Co. *Goodyear Rubber Co. v. Goodyear's India Rubber Glove Mfg. Co.*,* 22 Blatch., 421; 21 Fed. R., 276.

§ 497. C., a manufacturer of machinery, and among other things of a taper-sleeve pulley, at Erie, Penn., displayed on his factory the sign, "Taper-sleeve Pulley Works." His shop and machinery being sold on execution, W. became the purchaser and afterwards became the assignee of the patent for the taper-sleeve pulley owned by C. W. sold the factory to G., together with the exclusive right under the patent for the states east of the Mississippi, with an agreement that each could sell in the territory of the other on payment of certain royalties. G. and his associates, calling their establishment the Taper-sleeve Pulley Works, built up a large business, manufacturing various mechanical devices, and stamped all their goods "Taper-sleeve Pulley Works." The assigns of W. commenced the business of the manufacture of substantially the same goods as the Erie company, including the taper-sleeve pulley, at Dubuque, Iowa, under the name of F. & Co., and did business for some time as such manufacturers under that name, but afterwards adopted as their corporate name "Taper-sleeve Pulley Works," and proceeded to issue catalogues, price-lists and labels almost exactly like those of the Erie manufacturers, and stamped the goods of their manufacture "Taper-sleeve Pulley Works of Dubuque, Iowa." *Held*, that the Dubuque corporation would be enjoined from using the trade name of the Erie manufacturers. *Gray v. Taper-sleeve Pulley Works*,* 16 Fed. R., 436.

§ 498. A name for a publication may become a trade-mark though previously used by others, if the application was to publications essentially different. *Estes v. Wilson*,* 22 Blatch., 364; 21 Fed. R., 189.

§ 499. J., in England, produced a series of books called Chatterbox, and assigned to W. the right to use that name in this country. Afterwards E. commenced to produce books so near like J.'s that purchasers were likely to be deceived into thinking that they were getting J.'s books instead of E.'s. *Held*, that the use of that name would be protected as a trade-mark in this country at the suit of W. *Ibid*.

§ 500. Name descriptive of article.—Where it appears very doubtful whether a name claimed as a trade-mark does not describe the articles themselves and indicate that they are manufactured under certain patents instead of by a particular person, and it appears also that the label describes the reputation rather than the origin of the articles, a preliminary injunction will not be granted. *Leclancha Battery Co. v. Western Electric Co.*,* 21 Fed. R., 538.

§ 501. Although the name applied by a manufacturer to an article produced by him does not afford him protection as a trade-mark, yet an imitation of the label adopted by him will be enjoined. *Leclanche Battery Co. v. Western Electric Co.*, 23 Fed. R., 276.

§ 502. Where an article is made that was theretofore unknown, it must be christened by a name by which it can be recognized and dealt in, and the name thus given to it becomes public property, and all who deal in the article have the right to designate it by the name by which alone it is recognizable; and no person, neither the inventor nor his assignee, can have a trade-mark in such designation. *Ibid*.

§ 503. A name alone is not a trade-mark when it is applied to designate, not the article of a particular maker or seller, but the kind or description of thing sold. So the word "Pile-Leclanche," the French name of the battery invented by Leclanche, is not a trade-mark when

applied to such batteries, nor is the word "Disque" when applied thereto to designate a particular style thereof. *Ibid.*

§ 504. The natural or proper designation of an article can never become a trade-mark, because any one making the article has a right to call it by its proper name. *Alleghany Fertilizer Co. v. Woodside*,* 1 Hughes, 115.

§ 505. There can be no trade-mark in a word which is descriptive of the nature and qualities of the article to which it is affixed. *Carbolic Soap Co. v. Thompson*,* 25 Fed. R., 625.

§ 506. The words "anti-washboard," as applied to soap, are suggestive rather than descriptive, and may be claimed as a trade-mark. *O'Rourke v. Central City Soap Co.*,* 26 Fed. R., 576.

§ 507. A generic term, or a name merely descriptive of the ingredients, quality or characteristics of an article of trade, cannot be the subject of a trade-mark; *e. g.*, the words *straight cut*, as descriptive of tobacco. *Ginter v. Kinney Tobacco Co.*,* 12 Fed. R., 782; 22 O. G., 770; 14 Rep., 138.

§ 508. Where a device, in part arbitrary and having no necessary connection with the article to which it is affixed, has been applied to such article for some time, so that the article has become known to the trade by that designation, the unauthorized use of such label, or of an imitation thereof calculated to deceive, will be enjoined. *Morrison v. Case*,* 9 Blatch., 548; 2 O. G., 544.

§ 509. So the use of the words "The Star Shirt," or "The * Shirt," the device having been stamped by plaintiff upon shirts manufactured by him for a number of years, and was also registered under the act of congress, was protected by injunction. *Ibid.*

§ 510. It is only the actual use of a mark, device or symbol which entitles the person using it to its protection as a trade-mark. The mere fact that his goods have acquired a particular name by the public does not entitle him to claim the exclusive use of that name as a trade-mark. *Blackwell v. Armistead*,* 3 Hughes, 163.

§ 511. The term "Worcestershire" is a name which has long been applied to a certain kind of sauce; from its long application it has become a generic term for that kind of sauce, and the fact that a party manufactures the same kind of sauce at Worcestershire, England, does not give him the sole right to the use of the name as a trade-mark. *Lea v. Deakin*,* 18 Am. L. Reg. (N. S.), 322; 7 Rep., 261; 11 Biss., 23.

§ 512. And where it appeared that plaintiff had been for many years cognizant of the fact that sauce was manufactured to which the name was applied, and took no steps to prevent its manufacture, he was held to have acquiesced in a certain sense. *Ibid.*

§ 513. And where the suit is against an agent, to enjoin him, and for an account of profits, a decree, unappealed from, in favor of his principal in England, rendered by the master of the rolls, upon the same subject-matter, is a bar. *Ibid.*

§ 514. No pseudonym can give an author any rights which he would not have under his own name. Such pseudonym cannot be applied as a trade-mark to the use of which the author can claim the exclusive right. So a publisher who has collected uncopyrighted published writings of an author may publish them as the work of the author, and may apply the author's pseudonym thereto in the same manner that he might apply the author's name. *Clemens v. Belford*,* 11 Biss., 459; 14 Fed. R., 728; 27 Alb. L. J., 293; 29 Int. Rev. Rec., 53; 15 Rep., 227.

§ 515. Expiration of patent.—After the expiration of a patent a manufacturer of the article may use the name of the article and indicate that it is manufactured according to the patents, and may use labels to that effect, provided he does not represent that it is manufactured by the original manufacturers. *Tucker Mfg. Co. v. Boyington*,* 9 O. G., 455.

§ 516. After the expiration of a patent the former proprietors of the patent are not entitled to use the word applied to the patented article as a trade-mark. So, after the expiration of the Singer sewing machine patents, the former owners of the patent were not entitled to the exclusive use of the word "Singer," as applied to sewing machines of that construction. *Singer Manuf'g Co. v. Riley*,* 11 Fed. R., 706.

§ 517. Where the exclusive right to use a device as a frame for a sewing machine, in the shape of a letter G, has rested upon a patent, the exclusive use of such device as a trade-mark cannot be sustained after the expiration of the patent. *Wilcox & Gibbs Sewing Machine Co. v. Frame*,* 21 Blatch., 431; 17 Fed. R., 623; 24 O. G., 1272.

§ 518. A manufacturer of tobacco who originally employed and obtained a patent for a colored disk of tin upon plug tobacco, showing the brand and the name of the manufacturer, may, after such patent is declared void on surrender and reissue, still use such disks as a trade-mark, and no person, whether intentionally or otherwise, will be allowed to use disks of tin of such appearance that they might readily be mistaken by the public for those of the original manufacturer. *Lorillard v. Wight*,* 15 Fed. R., 383.

§ 519. When a patented article is known in the market by any specific designation, whether

of the name of the patentee or otherwise, every person, at the expiration of the patent, has the right to manufacture and vend the same under the designation thereof by which it was known to the public. *Singer Manufacturing Co. v. Stanage*,* 2 McC., 512; 6 Fed. R., 279; 11 Rep., 611.

§ 520. After the expiration of the Singer sewing machine patent the original company continued to manufacture the machine, and imprinted on the shield and arm of the machine the words "The Singer Manufacturing Company." The defendant manufactured the same machine, placing on its arm and shield the words "The Henry Stewart's Manufacturing Co.," with another device, and advertised his machine as the "Stewart," or "Stewart-Singer." *Held*, that the word "Singer" attached to the machines was common property, and that as the devices on each machine were so distinct that the manufacture of one company would not be mistaken for that of the other, the plaintiff had no right to have the manufacture and sale of the defendant's machines enjoined. *Ibid*.

III. ADOPTION AND REGISTRATION.

SUMMARY — *Proof of filing declaration*, § 521.

§ 521. Under the laws of congress relating to trade-marks, the certificate of the commissioner of patents of the deposit for registration and the filing of the statement, of which a copy is annexed, is not conclusive evidence in the absence thereof in the certificate that such a declaration was filed as was required by law, even though the certificate states that the holder has complied with the law, and that the trade-mark will remain in force for thirty years from a given date. *Smith v. Reynolds*, § 522.

[NOTES. — See §§ 523-527.]

SMITH v. REYNOLDS.

(Circuit Court for New York: 10 Blatchford, 85-88. 1872.)

Opinion by BLATCHFORD, J.

STATEMENT OF FACTS.—This bill is founded on a statutory right to a trade-mark, claimed under the provisions of sections 77 to 84 of the act of July 8, 1870 (16 U. S. Stat. at Large, 210 to 212). Section 77 provides that any firm domiciled in the United States, "and who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following requirements." One of those requirements is, "the filing," in the patent office, "of a declaration, under the oath of . . . some member of the firm, to the effect that the party claiming protection for the trade-mark has a right to the use of the same, and that no other person, firm or corporation has the right to such use, either in the identical form, or having such near resemblance thereto as might be calculated to deceive, and that the description and *fac-similes* presented for record are true copies of the trade-mark sought to be protected." On complying with these requirements the trade-mark is to remain in force for thirty years from the date of the registration. The bill avers the filing of such declaration. The defendants, in their answer, put in issue this allegation, among others, and require proof of the same. No proof is given that such declaration was filed: A certificate is produced, signed by the commissioner of patents and under the seal of the patent office, setting forth that "J. Lee Smith & Co.," of New York (which is a firm composed of the plaintiffs), did, on the 30th of December, 1870, deposit in the patent office for registration, "a certain trade-mark for paints, of which a copy is hereto annexed; that they filed therewith the annexed statement, and, having paid into the treasury of the United States the sum of \$25, and otherwise complied with the act of congress in such case made and provided, the said trade-mark has been duly registered

and recorded in the said patent office, and will remain in force for thirty years from the 21st day of February, 1871." The statement annexed to the certificate does not contain any such declaration as that referred to. The declaration is required to be "filed." The only thing certified to have been "filed" is the "annexed statement."

§ 522. *The certificate of the commissioner of patents that an applicant for a trade-mark has filed "the annexed statement" and otherwise complied with the law is not evidence that he has filed a declaration under oath as to the right to the trade-mark, as required by the act of July 8, 1870, section 77.*

It is urged that the certificate that the parties have "otherwise complied with the act of congress in such case made and provided," and that the trade-mark "will remain in force for thirty years" from the day named, covers the point; and that, in analogy to letters patent for an invention, the certificate is evidence of a compliance with the requisite preliminary steps. But I do not think this position is a sound one. A patent, being authorized to be granted on evidence on which the commissioner of patents is to decide, the fact that he grants the patent is held to be *prima facie* evidence that the proper proofs were laid before him and were satisfactory, he being made, by the statute, the proper judge of the sufficiency and competency of the proofs. *Phil. & Trenton R. R. Co. v. Stimpson*, 14 Pet., 448, 458; *Seymour v. Osborne*, 11 Wall., 516, 540. But in respect to a trade-mark, the statute does not authorize the commissioner of patents to issue any letters patent therefor, or to issue any certificate containing a grant thereof. The only certificate he is authorized to issue in reference to the original registration of a trade-mark is that provided for by section 80, which enacts as follows: "The time of the receipt of any trade-mark at the patent office for registration shall be noted and recorded, and copies of the trade-mark, and of the date of the receipt thereof, and of the statement filed therewith, under the seal of the patent office, certified by the commissioner, shall be evidence in any suit in which such trade-mark shall be brought in controversy." A certified copy of the trade-mark, of the date of its receipt, and of the statement filed therewith (that is, a copy of everything filed and recorded, and of the memorandum of the date of the receipt thereof), is made evidence. But such copy is evidence only that what is shown by it to have been filed was filed. It is not evidence that anything required by the statute to be filed, and not shown by the certificate, or by the statement annexed to it, to have been filed, was filed. The certificate of the commissioner, that the parties "otherwise complied" with the act, cannot be substituted for the judgment which a court must pass as to whether there was a declaration filed, and one under oath, and complying, as to its contents, with the statute. The court is to judge, from the "statement," whether the requirement of recording "the class of merchandise and the particular description of goods comprised in such class, by which the trade-mark has been or is intended to be appropriated," was complied with, and whether the requirement of recording a description of the mode in which the trade-mark "has been or is intended to be applied and used," was complied with. So, it is equally for the court to judge whether the requirement as to the filing of the proper declaration was complied with. The general certificate of the commissioner cannot be taken as evidence on the subject.

The certificate that the trade-mark has been duly registered and recorded in the patent office, and will remain in force for thirty years from the day specified, adds no force to the effect of the certificate. The statute says that

the thirty years shall run from the date of the registration, that the time of the receipt for registration shall be recorded, and that the certificate shall cover a copy of the date of the receipt. The date given in the certificate, as the date from which the thirty years is to run, is to be regarded as intended for the date of registration; and the date previously named in the certificate is the date of the receipt for registration. In this view, the certificate intends to show when the trade-mark will expire; and the certificate that it has been registered and recorded, and will remain in force for thirty years from the day named, is only equivalent to saying that such day is to be taken as the date of the registration. The date given in the certificate as the date of deposit for registration is not regarded by the certificate as the date of registration and recording.

On these grounds alone, the motion for an injunction, now made, must be denied, without considering any of the other points raised.

§ 523. The registration of a trade-mark under the act of congress of March 3, 1881, is only *prima facie* evidence of the right of the party registering it to its use, and is no protection to him if it constitutes an infringement of a prior trade-mark. *Glen Cove Mfg. Co. v. Ludeling*,* 22 Fed. R., 823.

§ 524. The certificate of registration of a trade-mark is only *prima facie* and not conclusive evidence that the device is or can be a lawful trade-mark, or that it was first appropriated and used by the claimant. *Moorman v. Hoge*, 2 Saw., 78; 4 Am. L. T. (U. S.), 217; 14 Int. Rev. Rec., 155 (§§ 443-44).

§ 525. Under the act of congress of 1870, relating to the registration of trade-marks, the registration must stand or fall as a whole. So where a person had registered a crown as a trade-mark for paints, and it appeared that at the time of such registry another person had acquired the right to use the same mark on a particular kind of paint, it was held that the registration was inoperative. *Smith v. Reynolds*,* 10 Blatch., 100.

§ 526. Under the act of congress of 1870, relating to the registration of trade-marks, it is a sufficient statement of the class and description of goods to which the trade-mark is to be applied, to say that it is to be applied to paints generally, without specifying any particular description of paints. *Ibid.*

§ 527. Under section 77 of the act of congress of July 8, 1870, relating to the registration of trade-marks, it is not necessary to record the name of each individual of a firm and his place of residence; and the residence and place of business of a protected firm is sufficiently stated by giving the street and number of the place of business of the firm, and saying that it is engaged in a specified business in that city. *Ibid.*

IV. POWERS OF CONGRESS.

SUMMARY — *Act of 1870 unconstitutional*, § 528.

§ 528. The acts of congress providing for the registration of trade-marks (secs. 77-84 of the act of July 8, 1870), and punishing infringements of registered trade-marks (August 14, 1876), are unconstitutional, because power to legislate in relation to trade-marks was not conferred on congress by the constitution. *Trade-mark Cases*, §§ 529-533.

[NOTES.— See §§ 534-536.]

TRADE-MARK CASES.

UNITED STATES *v.* STEFFENS. SAME *v.* WITTEMANN. SAME *v.* JOHNSON.

(10 Otto, 82-99. 1879.)

CERTIFICATES OF DIVISION from the U. S. Circuit Court, Southern District of New York, and the U. S. Circuit Court, Southern District of Ohio.

Opinion by MR. JUSTICE MILLER.

STATEMENT OF FACTS.—The three cases whose titles stand at the head of this opinion are criminal prosecutions for violations of what is known as the trade

mark legislation of congress. The first two are indictments in the southern district of New York, and the last is an information in the southern district of Ohio. In all of them the judges of the circuit courts in which they are pending have certified to a difference of opinion on what is substantially the same question; namely, are the acts of congress on the subject of trade-marks founded on any rightful authority in the constitution of the United States?

The entire legislation of congress in regard to trade-marks is of very recent origin. It is first seen in sections 77-84, inclusive, of the act of July 8, 1870, entitled "An act to revise, consolidate and amend the statutes relating to patents and copyrights." 16 Stat., 198. The part of this act relating to trade-marks is embodied in chapter 2, title 60, sections 4937-4947, of the Revised Statutes.

It is sufficient at present to say that they provide for the registration in the patent office of any device in the nature of a trade-mark to which any person has by usage established an exclusive right, or which the person so registering intends to appropriate by that act to his exclusive use; and they make the wrongful use of a trade-mark, so registered by any other person without the owner's permission, a cause of action in a civil suit for damages. Six years later we have the act of August 14, 1876 (19 Stat., 141), punishing by fine and imprisonment the fraudulent use, sale and counterfeiting of trade-marks registered in pursuance of the statutes of the United States, on which the informations and indictments are founded in the cases before us.

The right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has been long recognized by the common law and the chancery courts of England and of this country, and by the statutes of some of the states. It is a property right for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a court of equity, with compensation for past infringement. This exclusive right was not created by the act of congress, and does not now depend upon it for its enforcement. The whole system of trade-mark property, and the civil remedies for its protection, existed long anterior to that act, and have remained in full force since its passage. These propositions are so well understood as to require neither the citation of authorities nor an elaborate argument to prove them.

§ 529. *The right in trade-marks depends on the laws of the states.*

As the property in trade-marks and the right to their exclusive use rest on the laws of the states, and, like the great body of the rights of person and of property, depend on them for security and protection, the power of congress to legislate on the subject, to establish the conditions on which these rights shall be enjoyed and exercised, the period of their duration, and the legal remedies for their enforcement, if such power exist at all, must be found in the constitution of the United States, which is the source of all the powers that congress can lawfully exercise. In the argument of these cases this seems to be conceded, and the advocates for the validity of the acts of congress on this subject point to two clauses of the constitution, in one or in both of which, as they assert, sufficient warrant may be found for this legislation.

The first of these is the eighth clause of section 8 of the first article. That section, manifestly intended to be an enumeration of the powers expressly granted to congress, and closing with the declaration of a rule for the ascertainment of such powers as are necessary, by way of implication, to carry into efficient operation those expressly given, authorizes congress, by the

clause referred to, "to promote the progress of science and useful arts by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries."

§ 530. *Trade-marks are neither inventions nor writings, and are entitled to neither patent-right nor copyright.*

As the first and only attempt by congress to regulate the *right of trade-marks* is to be found in the act of July 8, 1870, to which we have referred, entitled "An act to revise, consolidate and amend the statutes relating to *patents* and *copyrights*," terms which have long since become technical, as referring, the one to inventions and the other to the writings of authors, it is a reasonable inference that this part of the statute also was, in the opinion of congress, an exercise of the power found in that clause of the constitution. It may also be safely assumed that until a critical examination of the subject in the courts became necessary, it was mainly, if not wholly, to this clause that the advocates of the law looked for its support.

Any attempt, however, to identify the essential characteristics of a trade-mark with inventions and discoveries in the arts and sciences, or with the writings of authors, will show that the effort is surrounded with insurmountable difficulties.

The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when, under the act of congress, it is sought to establish it by registration, neither originality, invention, discovery, science nor art is in any way essential to the right conferred by that act. If we should endeavor to classify it under the head of writings of authors the objections are equally strong. In this, as in regard to inventions, originality is required. And while the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints, etc., it is only such as are *original* and are founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like. The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it. At common law the exclusive right to it grows out of its *use*, and not its mere adoption. By the act of congress this exclusive right attaches upon registration. But in neither case does it depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation. We look in vain in the statute for any other qualification or condition. If the symbol, however plain, simple, old or well known, has been first appropriated by the claimant as his distinctive trade-mark, he may, by registration, secure the right to its exclusive use. While such legislation may be a judicious aid to the common law on the subject of trade-marks, and may be within the competency of legislatures whose general powers embrace that class of subjects, we are unable to see any such power in the constitutional provision concerning authors and inventors, and their writings and discoveries.

§ 531. *The jurisdiction of congress over trade-marks cannot be supported by its authority to regulate commerce.*

The other clause of the constitution supposed to confer the requisite authority on congress is the third of the same section, which, read in connection

with the granting clause, is as follows: "The congress shall have power to regulate commerce with foreign nations, and among the several states, and with the Indian tribes."

The argument is that the use of a trade-mark — that which alone gives it any value — is to identify a particular class or quality of goods as the manufacture, produce or property of the person who puts them in the general market for sale; that the sale of the article so distinguished is commerce; that the trade-mark is, therefore, a useful and valuable aid or instrument of commerce, and its regulation by virtue of the clause belongs to congress, and that the act in question is a lawful exercise of this power.

Every species of property which is the subject of commerce, or which is used or even essential in commerce, is not brought by this clause within the control of congress. The barrels and casks, the bottles and boxes in which alone certain articles of commerce are kept for safety and by which their contents are transferred from the seller to the buyer, do not thereby become subjects of congressional legislation more than other property. *Nathan v. Louisiana*, 8 How., 73 (CONST., §§ 1035–37). In *Paul v. Virginia*, 8 Wall., 168 (CONST., §§ 1052–59), this court held that a policy of insurance made by a corporation of one state on property situated in another was not an article of commerce, and did not come within the purview of the clause we are considering. "They are not," says the court, "commodities to be shipped or forwarded from one state to another, and then put up for sale." On the other hand, in *Almy v. State of California*, 24 How., 169 (CONST., § 1465), it was held, that a stamp duty imposed by the legislature of California on bills of lading for gold and silver transported from any place in that state to another out of the state, was forbidden by the constitution of the United States, because such instruments being a necessity to the transaction of commerce, the duty was a tax upon exports.

The question, therefore, whether the trade-mark bears such a relation to commerce in general terms as to bring it within congressional control, when used or applied to the classes of commerce which fall within that control, is one which, in the present case, we propose to leave undecided. We adopt this course because when this court is called on in the course of the administration of the law to consider whether an act of congress, or of any other department of the government, is within the constitutional authority of that department, a due respect for a co-ordinate branch of the government requires that we shall decide that it has transcended its powers only when that is so plain that we cannot avoid the duty.

In such cases it is manifestly the dictate of wisdom and judicial propriety to decide no more than is necessary to the case in hand. That such has been the uniform course of this court in regard to statutes passed by congress will readily appear to any one who will consider the vast amount of argument presented to us assailing them as unconstitutional, and he will count, as he may do on his fingers, the instances in which this court has declared an act of congress void for want of constitutional power.

Governed by this view of our duty, we proceed to remark that a glance at the commerce clause of the constitution discloses at once what has been often the subject of comment in this court and out of it, that the power of regulation there conferred on congress is limited to commerce with foreign nations, commerce among the states, and commerce with the Indian tribes. While bearing in mind the liberal construction, that commerce with foreign

nations means commerce between citizens of the United States and citizens and subjects of foreign nations, and commerce among the states means commerce between the individual citizens of different states, there still remains a very large amount of commerce, perhaps the largest, which, being trade or traffic between citizens of the same state, is beyond the control of congress.

When, therefore, congress undertakes to enact a law, which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the law, or from its essential nature, that it is a regulation of commerce with foreign nations, or among the several states, or with the Indian tribes. If not so limited, it is in excess of the power of congress. If its main purpose be to establish a regulation applicable to all trade, to commerce at all points, especially if it be apparent that it is designed to govern the commerce wholly between citizens of the same state, it is obviously the exercise of a power not confided to congress.

§ 532. *Congressional legislation on trade-marks exceeding the jurisdiction of congress over commerce is void.*

We find no recognition of this principle in the chapter on trade-marks in the Revised Statutes. We would naturally look for this in the description of the class of persons who are entitled to register a trade-mark, or in reference to the goods to which it should be applied. If, for instance, the statute described persons engaged in a commerce between the different states, and related to the use of trade-marks in such commerce, it would be evident that congress believed it was acting under the clause of the constitution which authorizes it to regulate commerce among the states. So if, when the trade-mark has been registered, congress had protected its use on goods sold by a citizen of one state to another, or by a citizen of a foreign state to a citizen of the United States, it would be seen that congress was at least intending to exercise the power of regulation conferred by that clause of the constitution. But no such idea is found or suggested in this statute. Its language is: "Any person or firm domiciled in the United States, and any corporation created by the United States, or of any state or territory thereof," or any person residing in a foreign country which by treaty or convention affords similar privileges to our citizens, may by registration obtain protection for his trade-mark. Here is no requirement that such person shall be engaged in the kind of commerce which congress is authorized to regulate. It is a general declaration that anybody in the United States, and anybody in any other country which permits us to do the like, may, by registering a trade-mark, have it fully protected. So, while the person registering is required to furnish "a statement of the class of merchandise, and the particular description of the goods comprised in such class, by which the trade-mark has been or is intended to be appropriated," there is no hint that the goods are to be transported from one state to another, or between the United States and foreign countries. Section 4939 is intended to impose some restriction upon the commissioner of patents in the matter of registration, but no limitation is suggested in regard to persons or property engaged in the different classes of commerce mentioned in the constitution. The remedies provided by the act, when the right of the owner of the registered trade-mark is infringed, are not confined to the case of a trade-mark used in foreign or interstate commerce.

It is therefore manifest that no such distinction is found in the act, but that its broad purpose was to establish a universal system of trade-mark registration, for the benefit of all who had already used a trade-mark, or who wished

to adopt one in the future, without regard to the character of the trade to which it was to be applied or the residence of the owner, with the solitary exception that those who resided in foreign countries which extended no such privileges to us were excluded from them here.

It has been suggested that if congress has power to regulate trade-marks used in commerce with foreign nations and among the several states, these statutes shall be held valid in that class of cases, if no further. To this there are two objections: First, the indictments in these cases do not show that the trade-marks which are wrongfully used were trade-marks used in that kind of commerce. Secondly, while it may be true that when one part of a statute is valid and constitutional, and another part is unconstitutional and void, the court may enforce the valid part where they are distinctly separable so that each can stand alone, it is not within the judicial province to give to the words used by congress a narrower meaning than they are manifestly intended to bear in order that crimes may be punished which are not described in language that brings them within the constitutional power of that body. This precise point was decided in *United States v. Reese*, 92 U. S., 214 (CONST., §§ 1568-86). In that case congress had passed a statute punishing election officers who should refuse to any person lawfully entitled to do so the right to cast his vote at an election. This court was of the opinion that, as regarded the section of the statute then under consideration, congress could only punish such denial when it was on account of race, color or previous condition of servitude.

§ 533. *When it is not practicable to separate a part of a statute that is unconstitutional from that which is constitutional, the whole must be adjudged void.*

It was urged, however, that the general description of the offense included the more limited one, and that the section was valid where such was in fact the cause of denial. But the court said, through the chief justice: "We are not able to reject a part which is unconstitutional and retain the remainder, because it is not possible to separate that which is constitutional, if there be any such, from that which is not. The proposed effect is not to be attained by striking out or disregarding words that are in the section, but by inserting those that are not there now. Each of the sections must stand as a whole, or fall altogether. The language is plain. There is no room for construction, unless it be as to the effect of the constitution. The question, then, to be determined is whether we can introduce words of limitation into a penal statute so as to make it specific, when, as expressed, it is general only. . . . To limit this statute in the manner now asked for would be to make a new law, not to enforce an old one. This is no part of our duty." If we should, in the case before us, undertake to make, by judicial construction, a law which congress did not make, it is quite probable we should do what, if the matter were now before that body, it would be unwilling to do; namely, make a trade-mark law which is only partial in its operation, and which would complicate the rights which parties would hold, in some instances under the act of congress, and in others under state law. *Cooley, Const. Lim.*, 178, 179; *Commonwealth v. Hitchings*, 5 Gray, 482.

In what we have here said we wish to be understood as leaving untouched the whole question of the treaty-making power over trade-marks, and of the duty of congress to pass any laws necessary to carry treaties into effect.

While we have, in our references in this opinion to the trade-mark legislation of congress, had mainly in view the act of 1870, and the civil remedy which that act provides, it was because the criminal offenses described in the

act of 1876 are, by their express terms, solely referable to frauds, counterfeits, and unlawful use of trade-marks which were registered under the provisions of the former act. If that act is unconstitutional, so that the registration under it confers no lawful right, then the criminal enactment intended to protect that right falls with it.

The questions in each of these cases being an inquiry whether these statutes can be upheld, in whole or in part, as valid and constitutional, must be answered in the negative; and it will be so certified to the proper circuit courts.

§ 534. Constitutionality.—The act of congress (July 8, 1870) relating to the registration of trade-marks was unconstitutional and could not be upheld under the power of congress to legislate in favor of authors and inventors, or to regulate commerce. *Leidersdorf v. Flint*,* 8 Biss., 327; 7 Cent. L. J., 405; 18 Alb. L. J., 429; 18 Am. L. Reg. (N. S.), 37; 6 Rep., 739.

§ 535. A decree, based on common law principles, enjoining an infringement of a trade-mark, is in no way affected by the decision of the supreme court of the United States that the laws of congress relating to trade-marks are unconstitutional. *United States v. Roche*,* 1 McC., 385.

§ 536. An injunction will not be issued by a federal court to restrain the use of a trade-mark registered under the act of March 3, 1881, upon mineral water not put up for transportation to a foreign country, or for commerce with the Indian tribes, but for consumption in the same state, where the parties are citizens of that state. *Luyties v. Hollender*,* 22 Blatch., 413; 21 Fed. R., 281.

V. RIGHT TO USE OF AN ESTABLISHED TRADE-MARK.

SUMMARY—*Use by firm of which owner is a member*, § 537.—*Right to use not limited to any place*, § 538.—*Sale of establishment at which trade-mark is used*, §§ 539-541.—*Use at different places by different proprietors*, § 542.—*Right forfeited by assignor before transfer*, § 543.—*Forfeiture on account of deception*, § 544.—*Contract for use of a name*, § 545.—*Partnership*, § 546.

§ 537. The fact that the owner of a trade-mark permits the same to be used by a firm of which he is a member does not entitle the other members of the firm to any interest therein. *Kidd v. Thompson*, § 547.

§ 538. An unrestricted right to use a trade-mark is not limited to any place, city or state, but must be deemed to extend everywhere. *Ibid.*

§ 539. When a trade-mark is affixed to articles manufactured at a particular establishment, and acquires a special reputation in connection with the place of manufacture, and that establishment is transferred, either by contract or operation of law, to others, the right to use the trade-mark may be lawfully transferred with it. *Ibid.*

§ 540. When a trade-mark consists merely of the name of the establishment itself where the article is manufactured, and becomes attached to the manufactured article only as the product of that particular establishment, a sale of that establishment will carry with it to the purchaser, by operation of law, the exclusive right to use such trade-mark in connection with his own manufacture at the same place of a similar article. *Pepper v. Larbot*, §§ 548, 549.

§ 541. The complainant acquired by inheritance a distillery, operated by Oscar Pepper, his father. He commenced to manufacture whisky upon the same premises by the same process and branded his barrels "Old Oscar Pepper Distillery," and used the same term in advertisements and on letter-heads. *Held*, that this term, if a lawful trade-mark at all, was so only when applied to the distillery, and that it could not be used by the complainant, after the distillery had become the property of another, to designate whisky manufactured elsewhere; and, also, that as the words "Old Oscar Pepper Whisky" had become the known designation of whisky manufactured at that particular distillery, they could not be so used by the complainant to designate whisky manufactured elsewhere. *Ibid.*

§ 542. Trade-marks are an entirety, and are incapable of exclusive use at different places by more than one independent proprietor. *Manhattan Medicine Co. v. Wood*, §§ 550, 551.

§ 543. Persons will not be protected in the use of a trade-mark, the right to use which was forfeited by their assignors before the assignment to them. *Ibid.*

§ 544. The right to use a trade-mark may be forfeited by the licensee or assignee of the original proprietor, as when he makes it a means of deceiving the public, as by affixing it to a spurious article, or when he sells it outside the district to which he was limited by the license or assignment, or when he relinquishes it and adopts new labels and packages. *Ibid.*

§ 545. The exclusive use of the name of an inventor of certain medicine was granted by the proprietor for the term of ten years. The contract also provided that if the grantee performed the conditions of the contract he should have "all of the rights and privileges to use his (the grantor's) name in the manufacture of said medicine, without fee or reward, for fifty years." *Held*, that the grant for the fifty years additional was also exclusive. *Filkins v. Blackman*, §§ 552-555.

§ 546. When a partnership is formed in regard to the manufacture of the article to which a trade-mark is properly applied, the trade-mark of one partner, in the absence of special regulations, becomes part of the partnership property. *Ibid*.

[NOTES.— See §§ 556-564.]

KIDD v. JOHNSON.

(10 Otto, 617-620. 1879.)

APPEAL from U. S. Circuit Court, District of Louisiana.

Opinion by MR. JUSTICE FIELD.

STATEMENT OF FACTS.—The question presented in this case relates to the ownership of a trade-mark used by the complainants on packages and barrels containing whisky manufactured and sold by them in Cincinnati, and arises out of the following facts:

In 1849 one S. N. Pike, doing business in that city as a wholesale dealer in whisky, adopted as a trade-mark for his manufacture the words "S. N. Pike's Magnolia Whisky, Cincinnati, Ohio," inclosed in a circle, which he placed on packages and barrels containing the liquor. Between that date and 1863 he was in partnership with different persons doing business there under the name of S. N. Pike & Co. In 1863, having dissolved his connection with others, he took as partners two of his former clerks, Tilney and Kidd, continuing the original firm name, and soon afterwards opened a branch-house in New York city. The same trade-mark was used by the new firm as it had been by the preceding firm, without any change. At this time, and subsequently until its sale in 1868, the real property in Cincinnati, upon which the business was conducted, and the distillery, with its fixtures and appurtenances, belonged to Pike individually. In 1868 the firm removed its entire business to New York city and Pike sold the real property in Cincinnati, and the stills, tubs, engines, boilers, tubing and all apparatus in his distillery, for the consideration of \$125,000, to the firm of Mills, Johnson & Co., who were also engaged in the manufacture and sale of whisky at that place. At the same time Pike executed and delivered to the purchasers a separate instrument, stating that, having sold his premises to them, he extended to them and their successors the use of all his brands formerly used by him in his Cincinnati house.

Mills, Johnson & Co. continued for some years the manufacture and sale of whisky on the premises thus purchased, using, without objection from any one, the brands previously used by S. N. Pike & Co. They were succeeded in business by the complainants, who, it is admitted, are entitled to all the rights which they possessed in the trade-mark in question. S. N. Pike died in 1872, and his surviving partners formed a new partnership under the name of George W. Kidd & Co., which was subsequently dissolved, and to its business Kidd, the appellant in this case, succeeded.

The complainants finding that whisky bearing this trade-mark, manufactured by the firm of Tyra, Hill & Co., of St. Louis, was sold in large quantities by dealers in New Orleans, filed the present bill to enjoin the dealers from selling or trafficking in whisky contained in packages thus marked. By an amendment to the bill the defendant Kidd was made a party. He filed an

answer and cross-bill asserting title to the trade-mark as surviving partner of the firm of S. N. Pike & Co., and setting forth that Tyra, Hill & Co. were acting under a license from him.

§ 547. *The owner of a trade-mark may sell and transfer it with the establishment at which he used it.*

The principal question for determination is whether the complainants, claiming under the sale of Pike to their predecessors, or the defendant Kidd, claiming as survivor of S. N. Pike & Co., have the exclusive right to the trade-mark mentioned. The court below decided that the complainants possessed the exclusive right, and our judgment approves of the decision.

It is admitted that Pike was the owner of the trade-mark when he took two of his clerks into partnership and formed the firm of S. N. Pike & Co. He did not place his interest in the trade-mark in the concern as a part of its capital stock. He allowed the use of it on packages containing the whisky manufactured by them; but it no more became partnership property from that fact than did the realty itself, which he also owned, and on which their business was conducted. He was engaged in the same business before the partnership as afterwards, and taking his clerks into partnership changed in no respect, beyond its terms, their relation to his individual property. Their subsequent conduct, moreover, plainly shows that they claimed no interest in the trade-mark. They knew of his conveyance of its use to Mills, Johnson & Co. on the 1st of October, 1868, when they removed their own business to New York, and made no objection to the transfer. Their subsequent correspondence discloses beyond question their knowledge of the transfer and recognition of his power to make it. That transfer was plainly designed to confer whatever right Pike possessed. It, in terms, extends the use of the trade-mark to Mills, Johnson & Co. and their successors. Such use, to be of any value, must necessarily be exclusive. If others also could use it, the trade-mark would be of no service in distinguishing the whisky of the manufacture in Cincinnati; and thus the company would lose all the benefit arising from the reputation the whisky there manufactured had acquired in the market. The right to use the trade-mark is not limited to any place, city or state, and, therefore, must be deemed to extend everywhere. Such is the uniform construction of licenses to use patented inventions. If the owner imposes no limitation of place or time, the right to use is deemed co-extensive with the whole country, and perpetual.

The claim of Kidd to the trade-mark as survivor of the partners in the firm of S. N. Pike & Co. is without any merit. Pike, in his life-time, repudiated any ownership in the trade-mark after his sale, and Kidd knew that fact, and never even pretended that the firm had any such right until after Pike's death.

As to the right of Pike to dispose of his trade-mark in connection with the establishment where the liquor was manufactured, we do not think there can be any reasonable doubt. It is true, the primary object of a trade-mark is to indicate by its meaning or association the origin of the article to which it is affixed. As distinct property, separate from the article created by the original producer or manufacturer, it may not be the subject of sale. But when the trade-mark is affixed to articles manufactured at a particular establishment and acquires a special reputation in connection with the place of manufacture, and that establishment is transferred either by contract or operation of law to others, the right to the use of the trade-mark may be lawfully transferred with it. Its subsequent use by the person to whom the establishment

is transferred is considered as only indicating that the goods to which it is affixed are manufactured at the same place and are of the same character as those to which the mark was attached by its original designer. Such is the purport of the language of Lord Cranworth in the case of *Leather Cloth Company v. American Leather Cloth Company*, reported in 11th Jur. (N. S.). See, also, *Ainsworth v. Walmesley*, 44 L. J., 355, and *Hall v. Barrows*, 10 Jur. (N. S.), 55. The present case falls within this rule.

Decree affirmed.

PEPPER v. LABROT.

(Circuit Court for Kentucky: 8 Federal Reporter, 29-45. 1881.)

Opinion by MATTHEWS, J.

STATEMENT OF FACTS.—This is a bill in equity filed October 23, 1880, the complainant being a citizen of the state of New York and the defendants citizens of Kentucky.

It is alleged that both parties are, and have been, engaged in the manufacture and sale of whisky. The complainant claims to be the originator, inventor and owner of a certain trade-mark and brand for whisky made by him, consisting of the words "Old Oscar Pepper," and also of an abbreviation thereof, consisting of the letters "O. O. P." He alleges that the said words and letters were and are a fanciful and arbitrary title and trade-mark and brand intended to designate and identify whisky of his manufacture, the use of which he began in 1874, continued since by branding and marking the words on each barrel, and using the letters as an abbreviation in correspondence and contracts concerning the article; the whisky so designated having acquired that name, and being well and favorably known thereby. He says that the said words and trade-mark were made up in fact of the family name of the complainant, and embodied the name of his father, and had never before been so used. He avers that the whisky made by him, and so branded, marked and known, was very carefully manufactured, and of excellent quality, and of great reputation in the market, commanding a ready sale at profitable prices, and was identified by said trade-mark as of the complainant's make, whereby the said trade-mark has become of great value to him. He alleges that the trade-mark "Old Oscar Pepper" was used by him by burning the same upon and into the heads of barrels containing whisky made by him in a form set out as an exhibit to the bill. (a)

The same device on a smaller scale was printed upon the letter-heads and bill-heads and business cards used by him in correspondence and other business concerning his whisky; and was also attached to and pasted upon all small packages and samples of the whisky made by him, and was used to identify, and was universally recognized as identifying, the whisky made by him.

(a) [The device exhibited consisted of the following words printed within a circle, the first and last lines conforming to the curve of the circumference:

Old Oscar Pepper
Distillery.

Hand Made
Sour Mash.

Jas. E. Pepper,
Proprietor.

Woodford County, Ky.]

On November 13, 1877, the complainant procured a certificate of the registration of said trade-mark under the laws of the United States.

The bill charges that the defendants have sought to appropriate the complainant's trade-mark to their own use, and are using, upon barrels of whisky made by them, a similar device, a copy of which is exhibited. (a)

It is alleged that this is done by the defendants with the wrongful and fraudulent design to procure the custom and trade of persons who are or have been in the habit of buying, vending or using the genuine whisky made by the complainant, and of illegally and fraudulently promoting the introduction and sale of the defendants' own whisky, under the cover and reputation of the complainant's trade-mark, and of inducing unsuspecting persons to purchase the whiskies of defendants as and for the genuine "Old Oscar Pepper" whisky, manufactured by the complainant. It is charged, also, that with like intent the defendants are using the same device and trade-mark upon their letter-heads and business cards and other papers and advertisements and upon packages containing their whisky. It is also charged that this conduct of the defendants is injurious to the complainant in the sale of his whisky and in the profits thereof, and that, by reason of the inferior quality of the whisky sold by defendants under such trade-mark, the reputation of the complainant's whisky is greatly prejudiced and injured in the markets of the country, and a fraud and deception practiced upon the public, many of whom are induced to purchase the defendants' whisky, believing it to be the manufacture of the complainant.

The bill accordingly prays for an injunction and an account.

The defendants filed an answer in which they admit that they have been and are engaged in manufacturing and selling whisky, their distillery being in Woodford county, Kentucky, and long known and designated as the "Old Oscar Pepper Distillery." They deny that the complainant is the originator or owner of the trade-mark or brand for whisky made by him, as claimed, and deny that the words "Old Oscar Pepper," or the abbreviation of them, by the letters "O. O. P.," have ever been used as an arbitrary or fanciful title or trade-mark for whisky, or that they were ever so used by the complainant, and allege that they were never used by him except in connection with the word "distillery," and then only for the purpose of showing that the whisky in reference to which they were so used was manufactured at and was the product of the Old Oscar Pepper Distillery. The defendants claim that the use of the same by the complainant as a brand for their whisky, manufactured elsewhere, would be a fraud on the public, as well as on the defendants. They say that several years since the complainant became the owner of thirty-three acres of land in Woodford county, Kentucky, known as the land used by Oscar Pepper for distillery purposes, upon which there was a distillery and

(a) [The device exhibited was in the same form as the preceding, and was composed of the following words:

Old Oscar Pepper
Distillery.

—
Established
1838.

—
Hand Made Sour Mash.
Labrot & Graham,
Proprietors.
Woodford County, Ky.]

machinery, warehouse, and other improvements; that said distillery, during the life-time of Oscar Pepper, the father of the complainant, became famous because of the superior quality of the whisky there produced, which was attributed, by dealers in whisky, to the peculiar character and properties of the water used in the process of distillation; that in 1874 the complainant, in company with one E. J. Taylor, Jr., with whom he was associated in business, operated said distillery, and formally named it the "Old Oscar Pepper Distillery," and procured a large number of iron signs to be made and distributed throughout the country, containing a correct drawing of the distillery and warehouse building, and an accurate view of the Old Oscar Pepper homestead or dwelling, which drawing and view they surrounded with the words, in a circular form, above the same, "Old Oscar Pepper Distillery," and below, in a straight line, "Woodford Co., Kentucky," and thus as is claimed, fixed and determined the name of said distillery. They also procured an iron brand to be made, and with it burnt into the head of each barrel of whisky, manufactured in said distillery, the words,

Old Oscar Pepper
Distillery.
Hand-made Sour Mash.
James E. Pepper,
Proprietor.
Woodford County, Ky.,

for the purpose, as is alleged, of identifying it as the product of the Old Oscar Pepper Distillery. It is also alleged that the complainant advertised his business in a circular, as follows:

"Having put in the most thorough running order the old distillery premises of my father, the late Oscar Pepper (now owned by me), I offer to the first-class trade of this country a hand-made, sour-mash, pure copper whisky of perfect excellence. The celebrity attained by the whisky made by my father was ascribable to the excellent water used (a very superior spring), and the grain grown on the farm adjoining by himself, and to the process observed by James Crow, after his death by William F. Mitchell, his distillers. I am now running the distillery with the same distiller, the same water, the same formulas, and grain grown upon the same farm."

He also circulated a similar certificate from his distiller, Mitchell, who said:

"I am employed by James E. Pepper as distiller, and the whisky I now make is from the same formula as the celebrated Crow whisky manufactured by James Crow and myself for his father (the late Oscar Pepper), at the same place, and is of the same excellence, being identical in quality. I use the same water, the same grain, the same still."

It is also alleged that the complainant, in March, 1877, was declared a bankrupt, and that among other assets the tract of land and the distillery thereon, with all the appurtenances and fixtures, were sold by the assignee, and by mesne conveyances became vested in the defendants, who have since operated the same by the manufacture of whisky; and that the complainant in the meantime has been, and is now, operating a distillery in Fayette county, Kentucky, as the sole place of the manufacture of his whisky, and that consequently he cannot use the brand formerly used by him while operating the "Old Oscar Pepper Distillery," without making a false and fraudulent representation as to the place of manufacture:

The defendants admit that since they have owned and operated the Old

Oscar Pepper Distillery, they have used the brand set out in the pleadings, but merely for the purpose of identifying their whisky as the product of that distillery, as follows:

Old Oscar Pepper
Distillery.
Established 1838.
Hand-made Sour Mash.
Labrot & Graham,
Proprietors,
Woodford County, Kentucky.

They claim the right so to do by virtue of their ownership of the distillery, of which they say that is the proper name.

On November 23, 1880, the defendants also filed their cross-bill, setting up in substance the same facts, and claiming that they are entitled to the exclusive use as a trade-mark of the brand described in the pleadings as used by them, and praying to be protected therein by a perpetual injunction.

To this cross-bill the complainant filed his answer, insisting upon his claims to the injunction and right to the exclusive use of the trade-mark, "Old Oscar Pepper," and the abbreviation "O. O. P." as applied to whisky. He alleges that his father, during his life-time, Oscar Pepper, operated a distillery on the premises mentioned, and manufactured an article which became well and favorably known to the trade as "Crow" or "Old Crow" whisky, from the name of the distiller, and that in consequence the distillery became known as the "Old Crow Distillery;" that after his father's death, the distillery tract having come into his possession, he leased it to W. A. Gaines & Co., who continued the manufacture of whisky under the same trade-name and mark of "Crow" or "Old Crow," but that afterwards the complainant, having gone into the business himself, built on the same site an entirely new distillery, and manufactured whisky which he called by the name of "Old Oscar Pepper," and so marked and branded the packages, and thereby originated and adopted it as his trade-mark to identify and distinguish the whisky made by him, and it became well and favorably known as such. He says that in the manufacture of his whisky he used neither the same distillery building at which the "Crow" whisky was manufactured, nor the identical spring of water which had been used in connection with it, but another spring in the same vicinity of the same quality; all the springs of water in the same geological formation throughout the counties of Woodford, Fayette, Bourbon, Harrison and the blue-grass section of Kentucky being substantially alike in quality, and the whisky made from one indistinguishable from that made, with equal care and skill and by the same process, at any other.

And the complainant insists that the name "Old Oscar Pepper" was never applied to the distillery premises until after he had adopted it as the name of whisky made by him, and then only as indicating the place where he made his "Old Oscar Pepper" whisky; and that it was not the name of the distillery which was applied to designate the whisky made there, but the name of the whisky which was applied to designate the distillery at which it was made, so far as it was ever so known or called. He charges that the use by the defendants of the words "Old Oscar Pepper Distillery," as descriptive of the locality, is a subterfuge and evasion, their real intent being to use the words as describing their make of whisky, and thereby wrongfully to use complainant's trade-mark and pirate his trade.

General replications perfect the issue arising both on the original and cross-bills, and the cause has been submitted on final hearing upon the pleadings and proofs.

It is manifest that the controversy between the parties, in the first instance, is one of fact.

The construction of the complainant is, that the words "Old Oscar Pepper" and the abbreviation of them, "O. O. P.," constitute a brand or mark originally adopted by him to designate whisky as made by him, without reference to the place of manufacture; and that by use and recognition it has become associated in the minds of dealers and the public with the article manufactured by him, so as to constitute its name in the trade, whereby to distinguish it from a similar article made by any and all others.

On the other hand the defendants claim that the words in question were originally used, and their use subsequently continued, merely to designate the fact that the whisky contained in the packages so marked or spoken of in advertisements, circulars, signs, etc., on which the mark was burned or printed, was made at the distillery so designated; and that that was done because the distillery, or its predecessor on the same site, had acquired a reputation in connection with the manufacture of whisky which was sufficient to recommend any article made at the same place.

Undoubtedly the inference, from the plain meaning of the words themselves, supports strongly the claim on the part of the defendants.

The complainant's brand or mark, as claimed and used by him, is "Old Oscar Pepper Distillery, Woodford Co., Ky.," James E. Pepper, proprietor; the words "hand-made sour mash" describe the quality of the whisky; and as to the rest, the plain and unequivocal meaning is that it is the product of the "Old Oscar Pepper Distillery," of which James E. Pepper is proprietor.

The complainant in his testimony endeavors to explain his use of the word "distillery" in this connection, so as to make its use consistent with his claim that the words "Old Oscar Pepper" were intended to designate the whisky and not the distillery. He says: "In branding the ends of my barrels I put the word 'distillery' to show that the 'Old Oscar Pepper' whisky was a straight whisky made by me, and at my own distillery, and not a compounded whisky; and the use of the word 'distillery' on the heads of the barrels following the trade-mark, indicated a straight whisky as distinguished from a compounded whisky."

But the explanation does not seem sufficient. The use of the word "distillery" does, indeed, seem to advertise the fact that the whisky is distilled, and not rectified, but it does so by designating the spirits contained in the package as the product, not merely of a distillery, but of the particular distillery known as the "Old Oscar Pepper Distillery," of which James E. Pepper is proprietor.

It is true that Beecher, one of the firm of Ives, Beecher & Co., the merchants who sold the complainant's whisky in New York, testifies that the whisky acquired its reputation under the name of "Old Oscar Pepper," or "O. O. P." whisky, and known by that name, and inquired after and bought and sold by that designation. He says my firm buy whisky under the name of "Old Oscar Pepper." But he immediately explains that "we buy as 'Old Oscar Pepper,' whisky to be made at the distillery where James E. Pepper first made the whisky known to the trade by that name." (Answer to the

twenty-third interrogatory.) And in answer to the seventh cross-interrogatory he says:

“At the time my firm commenced dealing in ‘Old Oscar Pepper’ whisky that name added to the reputation and salability of the whisky, for the reason that that was the name of James E. Pepper’s father, and his father had made good whisky at that very distillery for several years previous to the making of any by James E. Pepper.”

It is beyond dispute that Ives, Beecher & Co. introduced the complainant’s manufacture of whisky to the trade under the name of Old Oscar Pepper whiskies, upon the credit of the old distillery of Oscar Pepper, and recommended them as of superior excellence because they were the product of that distillery. This was done by advertisements in circulars, containing certificates and affidavits, one from James E. Pepper himself, that he had put in the most thorough running order “the old distillery of my father, the late Oscar Pepper, now owned by me;” that “the celebrity attained by the whisky made by my father was ascribable to the excellent water used (a very superior spring) and the grain grown on the farm adjoining by himself, and to the process observed by James Crow, after his death by W. F. Mitchell, his distillers;” that “I am now running the distillery with the same distiller, the same water, the same formula, and grain grown upon the same farm, consequently my product being of the same quality and excellence.” Another certificate and affidavit so published was from his mother, in which she stated that her son, James E. Pepper, is the owner of the old distillery property situated in the county of Woodford, state of Kentucky, formerly owned by her deceased husband, Oscar Pepper, and known as the “Old Crow Distillery.”

“The buildings have been thoroughly improved. Mr. W. F. Mitchell, who distilled for the late Oscar Pepper, succeeding James Crow, is employed by my son, and the product is of the highest excellence, and recognized as fully up to the standard of the celebrated old product from the same stills.”

And the distiller, Mitchell, also certifies: “I use the same water, the same grain, and the same STILL.”

It does not avail the complainant now to repudiate these representations, or to insist that they are altogether immaterial. It may be true, as he now says, that in point of fact his distillery was altogether distinct as a building and machinery from that so long operated by his father, and that he did not use the same spring of water and the same stills; and it may be equally true that, so far as the intrinsic quality of the whisky is concerned, the circumstances referred to were altogether unimportant, for the reason that the product of equally good materials, made in the same geological region, in the best manner known to those engaged then in the manufacture, could not be distinguished from the favorite article known by the name of any particular distillery. Nevertheless it remains quite certain, from the proofs in this case, that the complainant succeeded in establishing a market for his manufacture, upon the special belief of the public that it must be like that made by his father, because made at the same locality and with all the advantages it was thought to confer. In other words, he sought and obtained for his own manufacture, by the use of the name of his father’s distillery, the reputation established by Oscar Pepper for his own.

Oscar Pepper manufactured at his distillery for many years previous to his death in 1865, probably as early as 1838, and the distillery was known in the

neighborhood, as some witnesses testify, as Oscar Pepper's distillery. This, indeed, would be most natural. Afterwards the whisky distilled there under the management of James Crow became extensively and favorably known as "Old Crow" whisky, and the distillery acquired the name of the Old Crow distillery; and that name was used after the death of Oscar Pepper, by successive lessees of the establishment, as a trade-mark to designate its production; but during that period the name of Oscar Pepper, as formerly connected with it, appeared in the brands and marks used by Gaines, Berry & Co. while they were carrying it on. They styled themselves on business cards "Lessees of Oscar Pepper's 'Old Crow' Distillery." In 1874 the trade-mark of "Old Crow" having previously, by Gaines, been transferred to the product of another distillery owned or operated by him or his firm, the complainant came into possession of his own distillery, and it became known as the "Old Oscar Pepper Distillery." The deed directly to the complainant of the distillery premises, made by a commissioner in pursuance of a decree for partition, refers to an accompanying plat in which the "Old Crow Distillery" is designated; but early in 1875 an agreement was made by the complainant with one E. H. Taylor, Jr., reciting that the former was owner of the premises upon which is situate the old distillery which was operated and run by the said Oscar Pepper in his life-time, and providing means for a thorough reparation of said old distillery, and of operating the same for the purpose of manufacturing copper whisky of the grade, character and description of that which was made by the said Oscar Pepper in his life-time, when James Crow and W. F. Mitchell were his distillers. The complainant having, upon his own petition, been declared a bankrupt, filed the required schedule of his assets and liabilities, in which he described the tract of land inherited from his brother as including the "Old Oscar Pepper Distillery;" and as such it was known at the time the title became vested in the defendants.

The clear result of the whole evidence seems, in our opinion, to be that the complainant adopted the name of "Old Oscar Pepper Distillery" as the name of his distillery in order that the whisky manufactured by him there might have the reputation and whatever other advantages were to result from that association.

That distillery having now become the property of the defendants by purchase from the complainants, can they be denied the right of using the name by which it was previously known in the prosecution of the business of operating it, and of describing the whisky made by them as its product?

Can the complainant be permitted to use the brand or mark formerly employed by him to represent whisky made by him elsewhere as the actual product of this distillery?

Both these questions, in our opinion, must be answered in the negative.

§ 548. *Principles upon which the right of trade-mark is founded. Cases cited.*

The most recent statement of the law applicable to this subject by the supreme court of the United States is found in the case of *The Amoskeag Manuf'g Co. v. Trainer*, 101 U. S., 51 (§§ 464-67, *supra*). In that case Mr. Justice Field said:

"The general doctrines of the law as to trade-marks, the symbols or signs which may be used to designate products of a particular manufacture, and the protection which the courts will afford to those who originally appropriated them, are not controverted. Every one is at liberty to affix to a product of

his own manufacture any symbol or device not previously appropriated which will distinguish it from articles of the same general nature manufactured or sold by others, and thus secure to himself the benefit of increased sales by reason of any peculiar excellence he may have given to it. The symbol or device thus becomes a sign to the public of the origin of the goods to which it is attached, and an assurance that they are the genuine article of the original producer. In this way it often proves to be of great value to the manufacturer in preventing the substitution and sale of an inferior and different article for his products. It becomes his trade-mark, and the courts will protect him in its exclusive use, either by the imposition of damages for its wrongful appropriation, or by restraining others from applying it to their goods, and compelling them to account for profits made on a sale of goods marked with it. The limitations upon the use of devices as trade-marks are well defined. The object of the trade-mark is to indicate, *either by its own meaning or by association*, the origin or ownership of the article to which it is applied. If it did not, it would serve no useful purpose either to the manufacturer or to the public. It would afford no protection to either against the sale of a spurious in place of the genuine article. This object of the trade-mark, and the consequent limitations upon its use, are stated with great clearness in the case of *Canal Co. v. Clark*, 13 Wall., 311 (§§ 453-56, *supra*). There the court said, speaking through Mr. Justice Strong, that no one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods *other than those produced or made by himself*. If he could, the public would be injured rather than protected, for competition would be destroyed. Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients or characteristics, be employed as a trade-mark, and the exclusive use of it be entitled to legal protection."

In the case of *Canal Co. v. Clark*, 13 Wall., 322 (§§ 453-56, *supra*), it is stated that the

"Office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed; or, in other words, *to give notice who was the producer.*"

And that there are some limits to the right of selection will be manifest. It is further said in that case:

"When it is considered that, in all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another; and that it is only when this false representation is directly or indirectly made that the party who appeals to a court of equity can have relief. This is the doctrine of all the authorities."

"And it is obvious that the same reasons," continues the opinion in that case, "which forbid the exclusive appropriation of generic names, or of those merely descriptive of the article manufactured, *and which can be employed with truth by other manufacturers*, apply with equal force to the appropriation of geographical names designating districts of country. Their nature is such *that they cannot point to the origin (personal origin)* or ownership of the article of trade to which they may be applied. They point *only at the place of production, not to the producer*, and could they be appropriated exclusively the appropriation would result in mischievous monopolies."

In the same opinion Mr. Justice Strong quoted, with approval, an extract

from the opinion in the case of *The Amoskeag Manuf'g Co. v. Spear*, 2 Sandford, Sup. Ct., 509, as follows:

"The owner of an original trade-mark has an undoubted right to be protected in the exclusive use of all the marks, forms or symbols that were appropriated as designating the time, origin or ownership of the article or fabric to which they are affixed; but he has no right to the exclusive use of any words, letters, figures or symbols which have no relation to the origin or ownership of the goods, but are only meant to indicate their names or quality. *He has no right to appropriate a sign or a symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose.*"

Following and applying the principle expressed in the last sentence of this extract, Mr. Justice Strong, in the opinion from which we are still quoting, says:

"It is only when the adoption or imitation of what is claimed to be a trade-mark amounts to a false representation, express or implied, designed or accidental, that there is any title to relief against it. True, it may be, that the use by a second producer, in describing truthfully his product, of a name or a combination of words already in use by another, may have the effect of causing the public to mistake as to the origin or ownership of the product; but if it is just as true in its application to his goods as it is to those of another who first applied it, and who, therefore, claims an exclusive right to use it, there is no legal or moral wrong done. Purchasers may be mistaken, but they are not deceived by false representations, and equity will not enjoin against telling the truth."

Tried by these principles, it would seem that the trade-mark claimed by the complainant cannot be sustained as a designation of whisky manufactured by him without reference to the place of its production, and that it is not, therefore, a lawful trade-mark at all, in the proper sense of that term. It is rather the trade-name of the distillery itself, of which he was at one time the proprietor, but which now is the property of the defendants. Neither by its own meaning, nor by association, does it indicate the personal origin or ownership of the article to which it is affixed. It does not seem to give notice who was the producer. It could be applied by him, with truth, to his goods only while he was the owner of the distillery named, and then only, not to all whisky of his manufacture, but only to that actually produced at that distillery. It can now be used without practicing a deception upon the public only by the defendants. It points only at the place of production, not to the produce. If a trade-mark at all, in any lawful sense, it is only in its use in connection with the article which it truthfully describes; that is, whisky which is actually manufactured at the Old Oscar Pepper Distillery, in Woodford county.

In the case of *Hall v. Barrows*, 4 De Gex, Jones & Smith, 157, there was a trade-mark altogether distinct from the name of the works, being the initials of the names of two of the original firms which owned the works, stamped upon the iron produced at the works. The question was whether, in a sale of the works and business to a surviving partner, the trade-marks should be valued as passing in the sale. The lord chancellor, Westbury, said:

"There is nothing in the answer or evidence to show that the iron marked with these initials has, or ever had, a reputation in the market because it was believed to be the actual manufacture of one of the two original firms. Now, if I adopted the distinction drawn by the master of the rolls between local

and personal trade-marks, I should be more inclined to treat this mark as incident to the possession of the Bloomfield Iron Works, for it has been used by successive owners of such works, and seems to have been used by the last partnership in no other right. In this respect the case resembles that of *Motley v. Downman*, 3 Myl. & Cr., 1.

“But it is unnecessary to pursue this further, for I am of opinion that these initial letters, surmounted by a crown, have become and are a trade-mark, properly so called — that is, a brand which has reputation and currency in the market, as a well-known sign or quality; and that as such the trade-mark is a valuable property of the partnership, as an addition to the Bloomfield Works, and may be properly sold with the works, and therefore properly included as a distinct subject of value in the valuation to the surviving partners.

“It must be recollected that the question before me is simply whether the right to use the trade-mark can be sold along with the business and iron works, so as to deprive the surviving partner of any right to use the mark in case he should set up a similar business. Nothing that I have said is intended to lead to the conclusion that the business and iron works might be put up for sale by the court in one lot, and that the right to use the trade-mark might be put up as a separate lot, and that one lot might be sold and transferred to one person, and the other lot sold and transferred to another; the case requiring only that I should decide that the exclusive right to this trade-mark belongs to the partnership as part of its property, and might be sold with the business and work and as a valuable right, and if it might be so sold, it must be included in the valuation to the surviving partner.”

It will be observed with what pains the lord chancellor guards against the conclusion that, even in such a case, the title to the trade-mark could be separated from that of the establishment upon the product of which it had always been used, even when the trade-mark was not the mere name of the place of manufacture, but a trade-mark proper, denoting the personal origin of the manufactured article.

The case of *Kidd v. Johnson*, 100 U. S., 617 (§ 547, *supra*), is to the like effect. The trade-mark in that case — “S. N. Pike’s Magnolia Whisky, Cincinnati, Ohio” — was a trade-mark proper; that is, indicated the personal origin of the manufacture, and was not the mere name of the place of manufacture. Pike sold his establishment to be carried on for the same business by his successors, and with it the right to use his brands. The court said in deciding the case (p. 620):

“As to the right of Pike to dispose of his trade-mark in connection with the establishment where the liquor was manufactured, we do not think there can be any reasonable doubt.

“It is true, the primary object of a trade-mark is to indicate by its meaning or association the origin of the article to which it is affixed. As distinct property, separate from the article created by the original producer or manufacturer, it may not be the subject of sale. But when the trade-mark is affixed to articles manufactured at a particular establishment, and acquires a special reputation in connection with the place of manufacture, and that establishment is transferred either by contract or operation of law to others, the right to the use of the trade-mark may be lawfully transferred with it.

“Its subsequent use by the person to whom the establishment is transferred is considered as only indicating that the goods to which it is affixed are manufactured at the same place, and are of the same character as those to which

the mark was attached by its original designer. Such is the purport of the language of Lord Cranworth in the case of *Leather Cloth Co. v. American Leather Cloth Co.*, reported in 11 Jur. (N. S.), 513. See, also, *Ainsworth v. Walmesley*, 44 L. J., 355, and *Hall v. Burrows*, 10 Jur. (N. S.), 55."

The observations of Lord Cranworth in the *Leather Cloth Case*, referred to in this citation, are as follows:

"But I further think that the right to a trade-mark may, in general, treating it as property, or as an accessory of property, be sold and transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser. Difficulties, however, may arise where the trade-mark consists merely of the name of the manufacturer. When he dies those who succeed him (grand-children or married daughters, for instance), though they may not bear the same name, yet ordinarily continue to use the original name as a trade-mark, and they would be protected against any infringement of the exclusive right to that mark. They would be so protected, because, according to the usages of trade, they would be understood as meaning no more by the use of their grandfather's or father's name than that they were carrying on the manufacture formerly carried on by him. Nor would the case be necessarily different if, instead of passing into other hands by devolution of law, the manufactory was sold and assigned to a purchaser.

"The question in every such case must be, whether the purchaser, in continuing the use of the original trade-mark, would, according to the ordinary usages of trade, be understood as saying more than that he was carrying on the same business as had been formerly carried on by the person whose name constituted the trade-mark. In such a case I see nothing to make it improper for the purchaser to use the old trade-mark, as the mark would, in such a case, indicate only that the goods so marked were made at the manufactory which he had purchased."

In the foregoing cases, the trade-mark consisted either in some arbitrary and fanciful name given to the product, or in the name or initials of the original producer, and it was held, even in respect to them, that the exclusive right to continue their use might pass to a purchaser of the place of production, carrying on the business of producing the same article.

§ 549. *Rule of law as to trade-marks which are descriptive of places or depend upon locality for their significance.*

It is a fair inference from these authorities that when, as in the present case, the trade-mark consists merely in the name of the establishment itself where the manufacture is carried on, and becomes attached to the manufactured article only as the product of that particular establishment, a sale of the establishment will carry with it to the purchaser the exclusive right to the use of the name it had previously acquired, in connection with his own manufacture at the same place of a similar article, by operation of law. For that proposition the case of the *Congress Spring*, Cox's *American Trade-mark Cases*, 599, is a direct authority. The court of appeal, per Folger, J., p. 630, said:

"The plaintiff purchased of the former proprietors the spring. They took the whole property in it. They thus obtained that which was the prime value of it, the exclusive right to preserve its waters in bottles, as an article of merchandise, and the exclusive right to sell it when bottled. Thus they acquired the business of their predecessors, for, the plaintiff owning the spring, no one else could carry on the business. And, under the rules above stated, they

acquired by assignment, or operation of law, the right to the trade-mark, before that time in use, to designate the article upon which this business was carried on."

It is true, as observed by counsel in argument, that in that case the article of merchandise was a natural, and not, as in the present, an artificial production. That circumstance was observed upon, in the argument of that case, as a reason for refusing the protection claimed for the trade-mark by the purchaser. The court said in reply (p. 625):

"It is true that, in most of the cases which have been the occasion of the rules laid down on this subject, the article in question has been artificial. But it will be difficult to show a reason for any of these rules which does not apply to the proprietorship of an unique product of nature, as well as to that of an unique product of art."

The following cases are cited without comment as sustaining the same proposition: *G. & H. Manuf'g Co. v. Hall*, 61 N. Y., 229; *Carmichael v. Lattimer*, 11 R. I., 407; and *Booth v. Jarrett*, 52 How. Pr., 169.

The cases cited and relied upon by counsel for complainant do not seem to us to affect the question in the view which we have taken of the facts. The only one upon which we think it important to submit a comment is that of *Wotherspoon v. Currie*, L. R., 5 Eng. & Ir. Ap., 521, and that, only because it seems to be urged as inconsistent with the view we have been compelled to adopt. In that case the controversy turned upon the exclusive right to the word "Glenfield," as applied to starch originally made at a village of that name, the manufacture of which was subsequently removed to another place, as against the defendant subsequently manufacturing at the original place — Glenfield — and claiming on that account the right to use the name in connection with the starch made by him. Lord Westbury stated the point on which the final decision in favor of the complainant was rested with clearness. He said:

"I take it to be clear from the evidence that long antecedently to the operations of the respondent the word 'Glenfield' had acquired a secondary signification or meaning in connection with a particular manufacture; in short, it had become the trade denomination of the starch made by the appellant. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which I have referred. The word 'Glenfield,' therefore, as a denomination of starch, had become the property of the appellants. It was their right and title in connection with the starch."

We do not find in the present case any state of facts corresponding with this. The words "Old Oscar Pepper Distillery" never lost their primary signification, and never acquired any secondary meaning; and, as applied to the whisky made by the complainant, the words "Old Oscar Pepper," and their abbreviation, "O. O. P.," never came to mean more than whisky that had been made at that particular distillery. They did not become a denomination of whisky as the manufacture of the complainant or of any person, but characterized it only as entitled to public favor by reason of the reputation of the particular distillery at which it purported to have been made.

For these reasons we are of opinion that the equity of the case, both upon the original and cross-bills, is with the defendants. A decree may be entered accordingly.

BARR, D. J., concurred.

MANHATTAN MEDICINE COMPANY v. WOOD.

(Circuit Court for Maine: 4 Clifford, 461-489. 1878.)

§ 550. *Ground of relief against infringement of trade-mark. Resemblance, what sufficient to constitute infringement.*

Opinion by CLIFFORD, J.

Equity gives relief for the infringement of a trade-mark, upon the ground that one man is not allowed to offer his goods for sale, representing the goods to be the manufacture of another in the same commodity. *Seixo v. Provezende*, L. R., 1 Ch., 195. What degree of resemblance is necessary to constitute an infringement is incapable of exact definition; but the rule is that no trader can adopt a trade-mark so resembling that of another as that ordinary purchasers, buying with ordinary caution, are likely to be misled. *McLean v. Fleming*, 6 Otto, 245 (§§ 431-40, *supra*). Two trade-marks are substantially the same in legal contemplation if the resemblance is such as to deceive ordinary purchasers, giving such attention to the same as such purchasers usually give, and to cause them to purchase the one manufacture supposing it to be the other. *Gorham Co. v. White*, 14 Wall., 528 (PATENTS, §§ 1910-12).

Relief is claimed in this case upon the special grounds set forth in the bill of complaint. They are, in substance and effect, as follows:

1. That the corporation complainants for a long time have been and now are the manufacturers and vendors of an article of medicine called and known as "Atwood's Vegetable Physical Jaundice Bitters," taken internally, for the cure of jaundice and other diseases; that during all the time they have been engaged in making and selling the article, it has been put up and sold in the same manner, and with the same trade-marks, labels and wrappers affixed thereto, in glass bottles, with twelve panel-shaped sides, having on five of the sides the raised words and letters, "Atwood's Genuine Physical Jaundice Bitters, Georgetown, Mass.," blown in the glass on each bottle, each bottle containing about a pint of the medicine in liquid form, labeled with a light-yellow printed label, pasted on the outside, as fully set forth in the bill of complaint.

2. That the said medicine was first invented and put up for sale about twenty-five years ago by one Dr. Moses Atwood, formerly of Georgetown, Mass., by whom, his assigns and successors, the same has been ever since made and sold by the same name, in the same manner, and with the same trade-marks and description.

3. That the complainants, long prior to the alleged infringement, became the lawful, sole and exclusive owners of the formula or recipe for making said medicine, and of the sole and exclusive right to use said name or designation therefor, together with all said trade-marks, labels, and good-will of the business of making and selling said medicine.

4. That the respondents, prior to the filing of the bill of complaint, at Portland, and at divers other places unknown to the complainants, have manufactured and sold, and are still manufacturing and selling, large quantities of medicine, of an inferior quality, in imitation of the article manufactured and sold by the complainants, and without their consent.

5. That during all that time the respondents have made, put up and sold, and still make, put up and sell, their said imitation and counterfeit article as and for the genuine article of the complainants, so put up, marked and labeled, that it is very difficult to be distinguished from the complainants' genuine article.

6. Based on these allegations, the complainants pray for an account and for an injunction, restraining the respondents from affixing or applying to any article of medicine manufactured, sold, shipped or supplied by them, or to the bottles or packages in which the same is put up, the complainants' trade-mark words, to wit, "Atwood's Vegetable Physical Jaundice Bitters," or either of said words, or any imitation thereof.

Service was made, and the respondents appeared and filed an answer, setting up several defenses to the following effect:

1. They admit that complainants purchased all the right, which the parties named in the answer owned, to prepare the Atwood Bitters, but they deny that those parties held or possessed the exclusive right to manufacture the same, or any exclusive right whatever to the same, or any exclusive right to any trade-mark, label or wrapper, consisting of a glass bottle with panel-shaped sides, and with the raised words and letters, "Atwood's Genuine Physical Jaundice Bitters, Georgetown, Mass.," blown in the glass; nor did they possess any exclusive right to the preparation of the medicine in a liquid form, or to the light-yellow printed label pasted to said bottle, upon which were the words, "Atwood's Vegetable Physical Jaundice Bitters." Nor did they possess any exclusive right to the residue of what is printed upon the label, and set forth in the bill of complaint.

2. That the twelve-panel bottle, the yellow label, the words "Atwood's Bitters," together with the other words alleged to be printed on said label, were in public and common use by a large number of manufacturers.

3. That the complainants did not purchase and do not now own the exclusive right, nor the entire right, to said bottle, label and words, or either of them, as alleged, because their said assignors were not the exclusive proprietors of the same, and therefore could not sell and dispose of what they did not own.

4. They deny that Moses Atwood first invented and put up the said medicine for sale, and allege that it was first put up by Moses F. Atwood, of Georgetown, Mass., in connection with L. H. Bateman, not in a paneled bottle, but in a smooth, round bottle, without panels; that the round bottle used by Bateman had no words blown in the glass, and that the bottles which contained words blown in the glass were rectangular in form and without panels, and that Moses Atwood first used a white label and a round bottle having no panels or blown letters.

5. That Moses F. Atwood, and not Moses Atwood, first obtained the formula for the medicine from some physician to these respondents unknown, and prepared the same according to the formula, and not according to any invention of himself or of said Moses Atwood; and that subsequently thereto the medicine put up by him and Batemen began to be called "Atwood's Bitters."

6. That the respondent first named in May, 1861, purchased the recipe for the medicine, and the right of using the bottle and label, that he has a right to use the same, and that no person has ever pretended to interrupt him in such use prior to the present suit.

7. That L. F. Atwood, the brother of Moses Atwood, also had a right to use the said label and bottle, and that he sold such a right to H. H. Hay, of Portland, who uses the same on the bottles containing the medicine.

8. That they have been in the practice of preparing the medicine under the recipe bought of Moses F. Atwood, for the period of fourteen years, and that they have spent large sums of money in advertising the medicine and in creating a market for the same.

Proofs were taken on both sides and the evidence is voluminous and somewhat conflicting. Any discussion of the legal questions arising in the case would not be of much advantage until the facts are ascertained, which will be best accomplished by distinct findings.

Pursuant to that view the court finds as follows:

1. That Moses Atwood, Georgetown, Mass., commenced preparing the medicine in question nearly forty years ago; that for a time the formula of the ingredients was a secret, and that he soon began to designate the preparation as his medicine more frequently than otherwise, designating it as Moses Atwood's Bitters or as Moses Atwood's Jaundice Bitters, and sometimes as Atwood's Vegetable Jaundice Bitters. There is no direct proof that he ever adopted any distinct trade-mark, but the evidence of use is such as to warrant the conclusion that he considered the latter designation as representing the article which he manufactured and put up for sale. For a time no other person had any interest in the business, and throughout all that period he put the article up in round, smooth bottles without panels or raised words or letters of any kind. Others subsequently acquired an interest in the business with him, among whom were his brother and L. H. Bateman, and the person who subsequently joined with him in the conveyance to Carter and Dodge. His son, Moses F. Atwood, had worked with him and Bateman at Georgetown in preparing the medicine under the recipe and knew the ingredients of which it was compounded. He, the son, went to work with Bateman in 1860, and he states that they used a fluted bottle containing the name of the medicine and that of his father and his place of residence blown into it.

2. That large rights in respect to the business remained in Moses Atwood, notwithstanding the interest in the same acquired by others; that January 1, 1848, he entered into a written contract with Moses Carter by which he sold to the latter bills against local agents in many places in Massachusetts, Rhode Island, Connecticut and New York, and the right to sell the medicine in those places under the terms and conditions following: that he, the manufacturer, should not sell the medicine in those places so long as the other party supplied customers there; that he, the proprietor, agreed to make the bitters during ten years for \$17 per barrel, to be delivered in the state where the same were made, three-quarters of the money to be advanced by the other contracting party.

3. Carter and Benjamin S. Dodge, February 2, 1852, formed a copartnership, which, of course, consisted of two parts; but they subsequently took into the firm C. L. Carter, and by interlineations made the articles consist of three parts. They formed the copartnership for making and vending Atwood's vegetable medicines and essences. Enough appears to afford an inference that a prior agreement between Moses Carter and Dodge of the one part and Moses Atwood of the other had been made, as the record shows that Atwood and Bingham and Carter and Dodge, September 29, 1852, entered into a contract to settle doubts and supply omissions in the supposed antecedent agreement, which was not introduced in evidence.

4. By the contract introduced Moses Atwood and his partner conveyed to Carter & Dodge the right to use said Atwood's name on the labels and circulars, and to manufacture and sell "Atwood's Vegetable Jaundice Bitters," and certain other articles, on the ground hereinafter described, and not to sell by themselves or their agents in any other portion of the world, or sell to others to sell, except on the ground hereinafter described. Massachusetts is named,

with numerous excepted towns and parts of towns. Towns and places are also excepted from New York. Seven towns are also excepted from New Hampshire; and all of the state of Maine except the towns of Kittery, South Berwick and Lebanon. Other exceptions are made in the same instrument, not necessary to be noticed in this investigation. Attempt was made to prove by parol the prior agreement referred to in the contract, and with that view reference was made in argument to the cross-examination of Luther F. Carter, who states that there were papers executed to Carter & Dodge, giving them the right to manufacture the bitters, using Moses Atwood's name, but that he knew nothing about the bottle. When asked if those papers came into his possession he answered that he didn't know that they ever did. He was then asked, "If they were ever in your hands, to whom did you deliver them?" and his answer was, "If they were ever in my hands I delivered them to Eli B. Johnson," the record showing that the person named was the agent of the complainants. Taken as a whole, the court is of the opinion that the evidence was not sufficient to admit parol testimony of the contents of the instrument, nor would it benefit the complainants if the rule was otherwise, as the witness states that he does not know that the paper or papers conveyed anything more to Carter & Dodge than the right to put up the medicine and use Atwood's name; nor does the record contain any evidence tending to show that the original proprietor ever gave them the right to sell the medicines in any of the places excepted out of the contract introduced in evidence.

5. That parol evidence was introduced, tending to show that Carter & Dodge owned, at the time of their dissolution of copartnership, all the right in Atwood's Bitters to manufacture and sell the same, except what Atwood had reserved; but there is no evidence that he ever conveyed to them any right to put up or sell the same in the places reserved, nor is there any evidence tending to show how, if ever, he acquired the interest in the same at one time held by his brother and Bateman.

6. Suggestions were made in argument that Moses Atwood, in the year 1855, conveyed to Carter & Dodge, or Carter, Dodge & Co., his entire interest in the business, except his right to sell the medicine beyond Illinois. What a party does not own of course he cannot sell, and that is a sufficient answer to the proposition, so far as respects the interests which had become vested in others; but the supposed sale might apply to some of the excepted places, not to all, as the same witness admits that Carter & Dodge did not own what Mr. Atwood had reserved, but he says that he once saw the agreement last referred to, and, when asked if he had made search for it, stated that he had made diligent search for it among his father's old papers. It was about the time that Carter, Dodge & Co. brought the suit against Bateman that he saw the paper, and he says he has not seen it since that time. According to his statement the paper was from Moses Atwood to Carter, Dodge & Co. Carter & Dodge sued Bateman for putting up and selling the medicine and using the trade-mark, and he prevailed in the suit; and yet no search was made among the papers of Mr. Dodge. For aught that appears to the contrary, it may be among his papers, or in the hands of the attorneys in that suit, or in the files of the clerk's office.

Two objections are taken to the evidence, both of which may be sustained:

First. That sufficient search is not shown to admit it.

Second. That, if it is admitted, it has no tendency to show that the convey-

ance included Maine, or any other of the excepted places; nor does it appear that the grantor re-acquired the interests previously vested in other persons.

Localities almost without number were excepted out of the general grant, and the uncontradicted proof is that the original proprietor made reservations in favor of his father, Levi Atwood, and his brother, Levi F. Atwood, of Maine and part of New Hampshire.

7. Viewed in the light of these suggestions, the court finds that Carter & Dodge never acquired the right to put up and sell the medicine in Maine, or in any of the places excepted out of the grant from the original proprietor, nor did they ever acquire the right or title to any of the same reservations in favor of other parties. Trade-marks are an entirety, and are incapable of exclusive use at different places by more than one independent proprietor, for the reason that the party seeking redress, in order to establish an exclusive right to the trade-mark, must show that he had an exclusive right in the commodity to which it is attached. Upton, Trade-marks, 24; *Canham v. Jones*, 2 Ves. & B., 218. Throughout the largest portion of the period since 1842, Bateman, or his son, who succeeded him, put up and sold Atwood's Bitters in the same town with the original proprietor, and the proofs show that he put the medicine up in half-pint glass bottles, with the words "Atwood's Jaundice Bitters, Moses Atwood, Georgetown, Mass.," blown upon the bottles; that when the proprietor removed, in 1855, he left with Bateman his original recipe for the manufacture of Atwood's Bitters, with all the medicines which he manufactured and sold. Little or nothing was made in the business during the life-time of Bateman, and when he died his son succeeded to and continued in the business until the heirs transferred the same to the complainants. For a few years Carter & Dodge put up and sold the medicine in accordance with the course pursued by the original proprietor, when they took into the firm the son of the senior partner, C. L. Carter, and continued to transact the business, under the name of Carter, Dodge & Co., two or three years longer. When they dissolved and Dodge went out, the new firm, called Carter & Son, consisting of Moses Carter and C. L. Carter, took control of the business, and they continued the same for about five years. Subsequently another son of the senior partner joined the firm, and they continued the business for two or three years under the firm name of Carter & Sons. Lastly the father and the elder son went out, and Luther F. Carter took the firm name of Carter & Son, and continued the business until he sold to the complainants. After Carter & Dodge dissolved in 1855, Dodge went to Rowley, and put up and sold the medicine there for five years, using the Atwood labels. On the 4th of September, 1867, he sold and conveyed the right to manufacture and sell Atwood's Bitters to William B. Dorman for the term of five years from the date of the agreement, with the right to use the trade-marks he had previously used in the sale of the same. Before that period expired the same party sold the same right to Noyes & Manning, now of Mystic, Conn., with authority to use the same labels.

8. That Carter & Son had two kinds of labels used on the bottles which they put up for sale. On the top of one of the labels the words "Carter's are the only genuine" were printed, and below the directions the words "Manufactured by M. Carter & Son, successors to Moses Atwood, Georgetown, Mass.," were also printed. At the bottom of the label were also printed the words "Caution.—Observe that our name is blown in the bottle and on the

revenue stamp. None others are genuine." The label also bore the words "Atwood's Vegetable Physical Jaundice Bitters." Two kinds of bitters were put up at their place. One kind, under the label described, which was the genuine "Atwood's Vegetable Physical Jaundice Bitters," sold in the market at wholesale for \$27 per gross; the other kind was an inferior article, an imitation of the genuine, sold in the market at \$15 per gross, bearing the genuine original label of Atwood's Bitters, with the "e" left out in the word "the," preceding the words "United States." Carter's traveling agents never sold any but the genuine article, the imitation being disposed of by Carter alone. In most instances the two kinds were retailed at the same price; but when both kinds were known the genuine brought a higher price.

9. That Bateman had the original recipe, and that Moses F. Atwood, the son of the original proprietor, when in the employment of Bateman as a selling agent, sold the recipe for compounding and preparing the Atwood Bitters in the state of Maine to Nathan Wood, in 1861. When asked whether the conveyance was in writing, he said it was, and that each party had a copy, and that he sold to the respondent the right to manufacture the bitters and sell the same in the state of Maine and elsewhere. Proof that the grantor had authority from the actual proprietor to execute the conveyance is not shown in the record; but it is shown that the purchaser, with his partner, has continued to prepare, put up and sell the medicine from the date of the purchase of the recipe to the date of the bill of complaint, without hindrance or interruption, with the exception of the two instances mentioned in the second answer, since the organization of the complainant corporation. None of the grantors of the complainants ever disputed their right to compound, put up and sell the bitters in question, nor is there any evidence tending to show that the bitters which they sold were not the genuine Atwood Bitters. Their grantor possessed the genuine recipe, and the proofs are full to the point that it was the genuine recipe which he sold to the respondent, Nathan Wood. Beyond all doubt the respondent, Nathan Wood, acquired the recipe, which, not being the subject of a patent, might lawfully be used by any one who possessed the secret; and it is equally certain that he supposed that he had acquired the right to use the labels, as he purchased the right to use the same of the son of the original proprietor, and of the selling agent of Bateman, whose title to put up the medicine and use the labels was subsequently established by judicial determination.

10. Unlike what is usual in controversies respecting trade-marks, the complainants in this case, instead of using a trade-mark of their own adoption, allege and attempt to prove that the trade-mark in question was adopted by the original proprietor of the medicine, and that they have acquired the title to the same by certain mesne conveyances set forth in the record; and the court finds upon that subject as follows:

1. That they, or their predecessors, January 1, 1875, acquired, by assignment, whatever right in the same belonged to the heirs and representatives of L. H. Bateman.

2. Also, March 18th, in the same year, whatever right belonged to the firm of Noyes & Manning.

3. Also, March 30th, in the same year, whatever right belonged to Benjamin C. Dodge.

4. Also, March 30th, in the same year, whatever right belonged to William B. Dorman.

5. Also, April 12th and 19th, in the same year, whatever right belonged to the Carters in the said trade-mark.

None of these instruments of conveyance, however, convey, or profess to convey, any greater rights to the complainants than those which were previously held by Carter & Dodge; and it is clear that Carter & Dodge never acquired from the original proprietor any right to put up or sell the medicine in Maine, or to use the labels of the original proprietor in that state, out of the three towns specified in the written agreement, which constitutes the evidence of their title.

§ 551. *Conclusions from the findings.*

Nothing remains to be done in the case of much importance, except to state the conclusions of law and fact resulting from the findings of the court:

1. Examined in the light of the findings, as the case must be, it is clear to a demonstration that the complainants have no exclusive right to put up and sell the medicine, nor any exclusive right or title to the labels, which belonged to the original proprietor.

2. That all they claim in respect either to the medicine or the labels is the right to the same which was held by Carter & Dodge, who never possessed the right to put up the medicine or to use the labels in any part of Maine, except the three towns named in the said written agreement.

3. That the rights of certain of the assignors of the complainants, if any they ever had, were forfeited long before the supposed transfer under which the complainants claim, by the use of the trade-mark as a means of misrepresentation and deception to the public, by putting up a spurious article, and using the genuine trade-mark to promote the sale of the spurious article. Misrepresentation and deceit of the kind divest the guilty party of all title to the same, and it follows that a party who has forfeited his property in the same cannot convey any title to another. *Phalon v. Wright*, Am. Tr. Cas., 311; *Same Case*, 5 Phil., 464; *Perry v. Truefitt*, 6 Beav., 66; *Pidding v. How*, 8 Sim., 477; *Hobbs v. Francais*, 19 How. Pr., 567; *Partridge v. Menck*, 1 How. App. Cas., 547; *Fetridge v. Wells*, 4 Abb. Pr., 144; *Flavell v. Harrison*, 19 Eng. L. & Eq., 15. Equity will not decree for an account of past gains and profits where there has been laches in bringing the suit and long acquiescence in the use of the trade-mark by others, and especially not where the acquiescence covers a period of fourteen years. *McLean v. Fleming*, 6 Otto, 245 (§§ 431-40, *supra*); *Harrison v. Taylor*, 11 Jur. (N. S.), 408; *Moet v. Couston*, 10 L. T. R. (N. S.); *Edelsten v. Edelsten*, 1 De G., J. & S., 185; *Estcourt v. Estcourt*, 1 L. R., 10 Ch., 276.

4. That the assignors of the complainants forfeited all their property, if any, in the trade-mark belonging to the original proprietor, by a disregard, among themselves, of their several allotted districts, after the grant or license from the original proprietor, by trespassing upon each other, and misuse of the trade-mark.

5. That the grantees or licensees of the original proprietor, and their successors, forfeited the right to the original trade-mark of their grantor or licensor by the voluntary relinquishment of the bottle, label and directions, which he used before the transfer, and by the adoption of new and different labels, etc., of their own substitution, one or more of whom put up and sold a spurious article of medicine under the genuine label, and used a different label of his own invention on bottles containing the genuine medicine. Cases arise where the title is complete, when a party, though not entitled to a decree for

an account, may still be entitled to a decree to prevent future infringements; but the difficulty in the way of the complainants in this case is incurable, as the evidence shows that the respondents have the genuine recipe, which is not protected by any patent, and the complainants have not any exclusive right to the use of the label, and no right at all to the use of it in the state of Maine. Bill of complaint dismissed, with costs.

FILKINS *v.* BLACKMAN.

(Circuit Court for Connecticut: 13 Blatchford, 440-447. 1876.)

Opinion by SHIPMAN, J.

STATEMENT OF FACTS.—In the bill in equity which was originally filed by the plaintiffs, they averred that they were residents of the city of Albany, and citizens of the state of New York, and were, as copartners, manufacturers and dealers in proprietary medicines; that they had long manufactured and sold a well-known article of medicine, called “Dr. J. Blackman’s Genuine Healing Balsam,” which had gone into extensive use, and obtained a high reputation; that they had acquired an exclusive right to the use of that name as a trade-mark, and had also a right to the use of certain labels, which had been devised by one of the plaintiffs, upon the bottles containing the medicine; and that the defendant, a resident and citizen of Danbury, in Connecticut, was using upon bottles of medicine of his own manufacture, said trade-mark, and labels which were close imitations of the plaintiffs’ labels. The bill prayed for an injunction. Upon the hearing of a motion for preliminary injunction, the plaintiffs asked and obtained leave to amend their bill, by the averment that, on October 14, 1875, they deposited in the patent office, for registration, a label, of which the following is the title, viz., “Dr. J. Blackman’s Genuine Healing Balsam,” the right to the use of which they claimed as sole proprietors, and that said trade-mark was then duly registered in the patent office, and a certificate thereof was duly issued to the plaintiffs. The motion was tried upon the affidavits which were presented by the parties, no answer having been filed at the time of said hearing. The affidavits of the defendant deny the right of the plaintiffs to any exclusive use of such name or title, and assert the right of the defendant to manufacture said medicine, and to use said name, and assert that the plaintiffs do not manufacture the medicine according to the original formula, and have abandoned the use of the name “J. Blackman” in their trade-mark.

From the affidavits which are on file, it appears that Jonas Blackman is the father-in-law of Morgan L. Filkins, one of the plaintiffs, and was, about the year 1840, the inventor of the article which was called, at the time of the discovery, “Dr. J. Blackman’s Genuine Healing Balsam.” It was at first sold under said name from house to house, until Dr. Filkins made a contract with Dr. Blackman, by which the former obtained a right to manufacture, or assist in the manufacture and sale of, said medicine. He subsequently entered into the business somewhat extensively, and placed the medicine upon the market. Two or three contracts were made between these parties, which expired by lapse of time or by mutual agreement. The final contract was as follows: “This agreement made and entered into this 28th day of November, A. D. 1865, between Jonas Blackman, of the town of Brookfield, and county of Fairfield, state of Connecticut, of the first part, and Morgan L. Filkins, of the city and county of Albany, and state of New York, of the second part, wit-

nesseth, that, in consideration of the covenants and agreements hereinafter contained, to be performed by the party of the second part, the said party of the first part hereby sells and conveys unto the said party of the second part, his heirs or assigns, the exclusive right to use his name in the manufacture, putting up and sale of certain medicines, known as Dr. J. Blackman's Genuine Healing Balsam, Dr. J. Blackman's Valuable Red Salve, and Dr. J. Blackman's Valuable Strengthening Plasters, for the term of ten years from the 1st day of January, A. D. 1866; and the party of the first part hereby agrees not to manufacture, or cause to be manufactured, either himself or by his agents, or authorize any other person or persons to use his name in the manufacture of, said medicines, or any other medicine recommended to cure diseases said medicines are said to cure; and the party of the second part agrees, in consideration of the covenants and agreements hereinbefore stated, to pay unto the party of the first part, or his assigns, the sum of \$365 annually, lawful money, at Brookfield, in the state of Connecticut, in manner following, to wit: \$91.25 on the first day of each of the following months of April, July, October and January of each year, up to and including the 1st day of January, A. D. 1876; and it is further agreed by the party of the first part, provided always that the party of the second part does well and truly perform the covenants and agreements to be by him kept and performed for the full term of ten years from the 1st day of January, A. D. 1866, thereafter the party of the first part gives and grants to the party of the second part all of the rights and privileges to use his name in the manufacture, putting up and sale of said medicines, without fee or reward to the party of the first part, his heirs or assigns, for the full term of fifty years or more; and it is mutually agreed by and between the parties to these presents, that in case either party shall fail to perform the covenants and agreements by such party to be kept and performed, the party so failing to perform shall pay unto the other party the sum of \$50,000, which sum of \$50,000 the parties hereto have agreed to fix and liquidate as the damages in case of non-performance."

The medicine has become well known, mainly through the efforts of Dr. Filkins to introduce it to the public, has quite a large sale among druggists, and has been a source of profit. It is now made by the plaintiffs substantially according to the original formula which was furnished by Dr. Blackman, and the plaintiffs have never abandoned the use of the original name. The name of the inventor, "J. Blackman," is the distinctive part of the name or title of the medicine, and gives to the title its peculiar value. Newton M. Blackman, who is the son of Jonas Blackman, has engaged in the manufacture of the same medicine, which is put up in bottles encircled with labels closely resembling those which are used by the plaintiffs, and containing the same title or name—"Dr. J. Blackman's Genuine Healing Balsam." The defendant states, in his affidavit, that his father has sold him the formula, and the right to manufacture the medicine, and to use the father's name.

The question in the case is, whether or not the plaintiffs now have a clear and exclusive continuing right, under the contract which was entered into between Jonas Blackman and Morgan L. Filkins, to the use of the name which was originally given to the medicine by the inventor, and whether or not, therefore, the plaintiffs held the right, at the time of the registration of the trade-mark, to its exclusive use after January 1, 1876.

§ 552. *General principles as to assignment of trade-marks.*

The following general principles in regard to the assignment of the exclu-

sive use of trade-marks are applicable to this case. The name "Dr. J. Blackman's Genuine Healing Balsam," which was originally given to the medicine by the inventor, "points out distinctly the origin or ownership of the article to which it is affixed," and the words "were appropriated as designating the true origin or ownership of the article or fabric to which they are attached." *Canal Co. v. Clark*, 13 Wall., 311 (§§ 453-56, *supra*). The name, as a whole, was his trade-mark, which he had the exclusive right to use, and the exclusive use of which would pass by assignment to any one who had lawfully obtained from the inventor the exclusive right, also, to manufacture and sell, and who did sell, that particular article compounded according to the original formula. "The property or right to a trade-mark may pass, by an assignment, or by operation of law, to any one who takes, at the same time, the right to manufacture or sell the particular merchandise to which said trade-mark has been attached. As a mere abstract right, having no reference to any particular person or property, it is conceded that it cannot exist, and so cannot pass by an assignment or descend to a man's legal representatives." *Dixon Crucible Co. v. Guggenheim*, Am. Trade-mark Cases, 559. If the assignee should make a different article he would not derive, by purchase from Jonas Blackman, a right, which a court of equity would enforce, to use the name which the inventor had given to his own article, because such a use of the name would deceive the public. The right to the use of a trade-mark cannot be so enjoyed by an assignee that he shall have the right to affix the mark to goods differing in character or species from the article to which it was originally attached. It is not, however, necessary that an article to which a trade-mark, personal in its inception, was originally affixed, should always be manufactured at the same place where it was originally made. This particular trade-mark, being the name of the inventor, was personal to Dr. Blackman in its inception, but has been permitted by him to be applied and to be appropriated to the same article when manufactured by Filkins Bros.

§ 553. *The rights of an assignee, and upon what they are founded.*

Under the circumstances in which the medicine has been manufactured and sold, the use of the trade-mark does not imply that the medicine was manufactured by Jonas Blackman, but that it is the same article which he originally invented and manufactured. *Bury v. Bedford*, 10 Jurist (N. S.), part 1, 503; *Leather Cloth Co. v. American Cloth Co.*, 11 Jurist (N. S.), part 1, 513. It is also to be noticed, that an assignee of a trade-mark does not obtain a right to restrain copyists of his mark, merely by virtue of his assignment, but he must also show that it has actually been used and applied upon an article, so that the public have come to understand that "the article to which it is attached is the manufacture or production which is generally known in market under that denomination." *Walton v. Crowley*, 3 Blatch., 440.

§ 554. *Construction of an agreement for the use of a trade-mark.*

In this case, an agreement was made on November 28, 1865, between Jonas Blackman and Morgan L. Filkins, by which, in consideration of the agreement of the latter to pay specified royalties, Blackman sold and conveyed to Filkins, his heirs or assigns, the exclusive right to use the name of the inventor, in the manufacture and sale of certain medicines, for the term of ten years from January 1, 1866. Blackman further agreed not to manufacture, or cause to be manufactured, and not to authorize any person to use his name in the manufacture of, said medicines; and, in case the said Filkins performed his

covenants for the term of ten years, Blackman further granted "all of the rights and privileges to use his name in the manufacture, putting up and sale of said medicines, without fee or reward, for the term of fifty years or more." There is no question that an exclusive right was granted for the ten years ending January 1, 1876; but it is claimed that thereafter a bare right or privilege was granted, in common with Jonas Blackman, to use his name and to manufacture said medicines. The determination of this question depends upon the construction which shall be given to the grant of "all of the rights and privileges to use my name." An exclusive right had been given for ten years, upon the payment of royalty, and thereafter, "all of the rights and privileges" to use the name of the grantor were given, without royalty, for the term of fifty years. The terms "an exclusive privilege," and "all of the rights and privileges," as used in this contract, are synonymous, and by the words "all of the rights and privileges" are meant all the rights, or the entire right, which the grantor had at the expiration of the term of ten years. Each word in the phrase "all of the rights" is to have the force which naturally belongs to such word, and by construing the words to mean a conveyance of a bare right, the same effect is given to the language as if it had been "I convey the right, or a right, to use my name," which construction leaves the word "all" without any significance. If the grantor retained the right in common with Filkins to use the name of the inventor, he did not convey all of his rights, but retained as much as he granted. The grantor intended to convey, in a certain contingency, all the rights, for fifty years, which he had previously conveyed for the term of ten years. If the same language which is used in this entire contract had been used in an assignment of a patent or of a copyright, although it is true that "property in a trade-mark, or in the use of a trade-mark, has very little analogy to that which exists in copyrights or in patents for inventions" (Canal Co. v. Clark, 13 Wall., 311), the assignment would, it is believed, convey the exclusive right for a specified term. The grant is unlike a grant of an easement, for there the title to the land is retained, and in this case the grantor parts with his entire right to the thing which is the subject-matter of the conveyance — the use of the trade-mark. I am of opinion that Filkins obtained, by the contract, an exclusive right to use this name in the manufacture of the medicine, for the term of fifty years from January 1, 1876.

§ 555. *The trade-mark of one partner used in the partnership business becomes part of the partnership property.*

The contract was made by Blackman with Morgan L. Filkins alone, and it is suggested that, inasmuch as the bill is brought by Filkins Brothers, and as Welcome L. Filkins was not a party to the contract, or to the grant, the firm has no legal right to the use of the mark. When a partnership is formed in regard to the manufacture of the article to which the trade-mark is properly applied, "the trade-mark of one partner, in the absence of special regulations, becomes part of the partnership property." *Bury v. Bedford*, 10 Jurist (N. S.), part 1, 503.

In regard to the propriety of granting a preliminary injunction, it is obvious that the plaintiffs have expended a good deal of money in advertising and in bringing this medicine into public use. They have made its manufacture profitable, and have invested their property in the business. The defendant has but recently, and not extensively, engaged in the manufacture, but is seeking to take advantage of the reputation which the efforts of others have given

to the article. The contest between the parties is plainly the result of a family quarrel, in which, I think, the defendant is seeking to obtain a position to which the previous contract and business relations between his father and brother-in-law have given him no right.

Let a preliminary injunction issue restraining the defendant from the use of the trade-mark "Dr. J. Blackman's Genuine Healing Balsam," and from the use of any label containing that name, or the name of Dr. J. Blackman.

§ 556. *Non-user*.—The right to use a trade-mark may be lost by a non-user for eight or nine years, and when lost it cannot be resumed if in the meantime another person has acquired the right to use it. *Blackwell v. Dibrell*, 3 Hughes, 151; 17 Am. L. Rep. (N. S.), 516 (§§ 457-459).

§ 557. *Assignee*.—To entitle a purchaser or assignee of a trade-mark to be protected he must, in the use thereof, indicate that he is such assignee or purchaser. *Stachelberg v. Ponce*,* 23 Fed. R., 430.

§ 558. *Abandonment by original owner*.—A person who improperly appropriates the trade-mark of another does not get a title to such trade-mark and an exclusive right to use the same on its abandonment by the original proprietor, and this may be set up by a third party in defense of a suit by the appropriator for an infringement. *O'Rourke v. Central City Soap Co.*,* 26 Fed. R., 576.

§ 559. *No written assignment*.—Persons who have used a trade-mark for many years are entitled to an injunction as against a person wrongfully using such trade-mark, though no written assignment to them by the original proprietor, who was formerly their partner, is shown. *Hostetter v. Vowinkle*,* 1 Dill., 329.

§ 560. *Partners*.—In the absence of express stipulation at the time of the dissolution of a partnership each partner may continue to use the trade-mark of the firm. The right does not pass inferentially under a general assignment, but, like a person's skill in any pursuit, remains in him. *Young v. Jones*,* 3 Hughes, 274.

§ 561. Where a name of an article has been adopted by two persons who are engaged in the business of making and selling it, that name, when they dissolve their business connection, may be used by each; and the fact that one, without the knowledge of the other, has procured the name to be registered as a trade-mark, representing that no one else had any interest therein, gives him no exclusive right. *Taylor v. Bothin*,* 5 Saw., 584; 8 Rep., 516.

§ 562. *Sale of business*.—A person may lawfully assign and sell not only a trade-mark indicative of origin in himself, but even the right to use his own name in connection with a particular business, and the assignee will thereby become entitled to the exclusive use of the trade-mark, even as against the assignor. So the assignee of the business of manufacturing a certain kind of yeast and trade-mark of "Twin Brothers" may use that trade-mark exclusively, even as against one of the Twin Brothers who sought to use the term in connection with his own yeast. *Burton v. Stratton*, 12 Fed. R., 696; 28 Int. Rev. Rec., 321; 14 Rep., 421 (§§ 445-52).

§ 563. The firm of Probasco & Oakes, manufacturers of candies, adopted the name "Excelsior" for their candies, but finding that name unsuitable used the word "Oakes," calling their candies "Oakes' Candies." Oakes sold out the business, including the right to use the name, to his partner, who devised a trade-mark for his candies consisting of two oaks and certain words. Probasco sold to H., who in turn sold to S. *He'd*, that as the word Oakes was not adopted because the candies were made by Oakes, and was not understood by the public as indicating that Oakes was the manufacturer, its use by other persons was not calculated to deceive the public, and, consequently, it might be transferred to and used by Probasco and his successors. *Oakes v. Tousmierre*,* 4 Woods, 547.

§ 564. The right to the exclusive use of a word or symbol as a trade-mark is inseparable from the right to make and sell the commodity which it has been appropriated to designate as the production or article of the proprietor. It may be abandoned if the business of the proprietor is abandoned. It may become identified with the establishment where the article is manufactured or sold, to which it has been applied so as to designate and characterize the article as the production of that place or establishment rather than of the proprietor. Such a trade-mark would seem to be an incident to the business of the establishment to which it owes its origin, and without which it can have no independent existence, and will be deemed to pass with the transfer of the business, because such an implication is consistent with the character of the transaction and the presumed intent of the parties. So the word "Champion," which was applied to a brand of flour produced at a certain mill, by the originator and successive owners of the same mill, was held to be entitled to protection as the trade-mark of the owner of the mill, though he held no written assignment of the right to use such word from the originator. *Atlantic Milling Co. v. Robinson*,* 20 Fed. R., 217.

VI. INFRINGEMENT.

§ 565. **Intent.**—It seems that an infringement of a trade-mark will be restrained though there is no fraudulent intent on the part of the infringer. *Coffeen v. Brunton*,* 4 McL., 516; 7 West. L. J., 59.

§ 566. Positive proof of a fraudulent intent is not required where the proof of the infringement is clear, in order to entitle the proprietor of a trade-mark to relief. *McLean v. Fleming*, 6 Otto, 245; 10 Ch. Leg. N., 252 (§§ 431-40).

§ 567. **In cases of nicety and doubt** as regards the use of a device as a trade-mark, the alleged infringement will not be enjoined. *Kinney v. Allen*, 1 Hughes, 106; 4 Am. L. T. (N. S.), 258 (§§ 468-69).

§ 568. **Who liable.**—If goods are put up by a manufacturer in such a way as to infringe a trade-mark, the fact that they are thus put up according to orders of the persons for whom they are manufactured will not relieve him from liability for the infringement. *Sawyer v. Kellogg*, 7 Fed. R., 720; 19 O. G., 1627; 12 Rep., 228 (§ 442).

§ 569. One who prepares and puts up an article for another, in such a manner as to infringe an established trade-mark, is liable to the proprietor of the trade-mark, and will be compelled to account for the profits and damages. *Sawyer v. Kellogg*,* 9 Fed. R., 601.

§ 570. **Wrappers and labels.**—Upon a consideration of the evidence, it was held that a certain wrapper for stove-polish, in use by the complainant, was afterwards imitated and used by the defendant, and such use was enjoined and an accounting decreed, the only question in the case being as to priority in the use of the wrapper in question. *Joseph Dixon Crucible Co. v. Benham*,* 4 Fed. R., 527.

§ 571. Where a particular form and character of label has become known and recognized by dealers and the public as designating articles produced by a given person, the use of a label by another person, which is hardly distinguishable from the other, unless they are placed side by side, and which is calculated to lead the public and purchasers to suppose they are getting the articles produced by the first person, will be enjoined. *Landreth v. Landreth*,* 22 Fed. R., 41.

§ 572. Similarity of style and color of label, and of size, shape and color of packages, and the notice and directions for use, does not constitute an infringement when the article is naturally packed in such a shape, and the packages contain the quantity usually purchased, and the label contains printed matter entirely and distinctly different. *Frese v. Bachoff*,* 13 Blatch., 234.

§ 573. Although a package and label do not technically constitute a trade-mark, their use or imitation by another, in such a way as to mislead purchasers, will be enjoined, and the infringer will be required to respond in damages. *Sawyer v. Horn*,* 1 Fed. R., 24.

§ 574. The use of a label for goods will be enjoined when it appears that such label is calculated to lead purchasers to suppose that they are buying a known article upon which a similar and well-known label has for some time previously been used. *Shaw Stocking Co. v. Mack*,* 12 Fed. R., 707; 28 Int. Rev. Rec., 320; 21 Blatch., 1.

§ 575. A person will be enjoined from putting up a medicine of a particular kind, with bottles and labels in imitation of those of an established and well known manufacturer, if such imitation is such that an ordinary observer or purchaser would be deceived. *Hostetter v. Adams*,* 10 Fed. R., 838; 20 Blatch., 326; 22 O. G., 943; 13 Rep., 454.

§ 576. The use of labels, directions, advertisements or hand-bills, or parts thereof, by means of which it is represented to the public that a certain liniment is equal to another liniment of established reputation, and which leads the public to suppose that it contains the same ingredients as the other, will be enjoined. *Coffeen v. Brunton*,* 4 McL., 516; 7 West. L. J., 59.

§ 577. The distinguishing and prominent part of a label of smoking tobacco cannot be adopted by another manufacturer and applied either to smoking tobacco or cigarettes, though the rest of the label is different. *Carroll v. Ertheiler*,* 1 Fed. R., 688; 28 Int. Rev. Rec., 133; 9 Rep., 737.

§ 578. Where a manufacturer has employed a peculiar and distinctive label to designate his goods, and has so used it that his goods are identified by it, a court of equity will restrain another party from adopting and using one so similar that its use is likely to lead to confusion by purchasers exercising the ordinary degree of caution which purchasers are in the habit of exercising with respect to such goods. *Anheuser-Busch Brewing Ass'n v. Clarke*,* 26 Fed. R., 410.

§ 579. The printing and selling of labels in imitation of a valid trade-mark, with the intention to enable others to palm off their goods on the public by the use of such labels as those of the owners of the trade-mark, will be enjoined. *De Kuyper v. Witteman*,* 23 Fed. R., 871.

§ 580. Equity will enjoin the use of a label upon spurious medicine which is calculated to

deceive the public to the injury of the owner of the genuine medicine. *Scoville v. Toland*,* 6 West. L. J., 84.

§ 581. Though a complainant may not be entitled to a trade-mark in a name applied by him to a compound manufactured by him, yet he will be protected from the imitation of his packages so far as they are peculiarly designed and shaped for the purpose of distinguishing his goods, and from the imitation in color, design, style and lettering combined, of the labels of such packages. *Carbolic Soap Co. v. Thompson*,* 25 Fed. R., 625.

§ 582. A firm had for a long time been accustomed to put up a certain compound in packages of a peculiar shape, and with labels of such colors and styles that their compound became known by such form and labels, and another person used the same form and labels for the same compound put up by him. He afterwards discontinued the use of the firm name and location, and substituted his own, but made no further changes. *Held*, that he was liable for an infringement of the trade-mark of the firm. *Frese v. Bachof*,* 14 Blatch., 432.

§ 583. Imitations calculated to deceive.—A person has no right to imitate the trade-mark of another by copying from it prominent and distinguishing words which are well calculated to deceive even the cautious and careful purchaser. *United States v. Roche*,* 1 McC., 385.

§ 584. A court of equity will, at the suit of the owner of a trade-mark, enjoin the use of a device which has such a similarity to the trade-mark as would deceive the ordinary purchaser. Actual intention to deceive purchasers is not necessary, but will be inferred from the fact of similarity. *Liggett, etc., Tobacco Co. v. Hynes*,* 20 Fed. R., 883.

§ 585. A device which is not calculated to mislead purchasers as to the origin of the goods to which it is attached is not an infringement of a trade-mark. *Manufacturing Co. v. Trainer*, 11 Otto, 51 (§§ 464-67).

§ 586. No person can adopt or use a trade-mark so resembling that of another that ordinary purchasers buying with ordinary caution would be likely to be misled. *Manhattan Medicine Co. v. Wood*, 4 Cliff., 461; 14 O. G., 519 (§§ 550-51).

§ 587. It is not necessary, in order to constitute an infringement of a trade-mark, that it be copied in every particular. It is sufficient if it is copied to an extent calculated to deceive purchasers. *Atlantic Milling Co. v. Robinson*,* 20 Fed. R., 217.

§ 588. If, by representation, an article be so assimilated as to be taken in market for an article of established manufacture, or compound of another, the injured person is entitled to an injunction. *Coffeen v. Brunton*,* 5 McL., 256.

§ 589. To enable the proprietor of a trade-mark to relief against an illegal appropriation, it is not necessary that the imitation be so close as to deceive persons seeing the two marks side by side. It is sufficient if there is such a degree of resemblance that ordinary purchasers using ordinary caution are likely to be deceived. But the question whether the defendant has colorably imitated the complainant's trade-mark is not to be solved by merely considering the resemblance between the words themselves, and where the defendant has artfully garbed and draped the word used by him, and bearing a close resemblance to the complainant's word, so that the difference is rendered less distinguishable, that fact will be considered. *Glen Cove Mfg. Co. v. Ludeling*,* 22 Fed. R., 823.

§ 590. Exact similitude is not required to constitute an infringement of a trade-mark. If the form, marks, contents, words, or the special arrangement of the same, or the general appearance of the alleged infringer's device, is such as would be likely to mislead one in the ordinary course of purchasing the goods and induce him to believe that he was purchasing the genuine article, then there is an infringement. *McLean v. Fleming*, 6 Otto, 245; 10 Ch. Leg. N., 252 (§§ 431-40).

§ 591. In order to constitute an infringement of a trade-mark it is not necessary that the imitation should amount to a forgery or be so close as to deceive a wholesale dealer. It is sufficient if it is calculated to deceive the unpracticed and unwary customer. *Blackwell v. Armistead*,* 3 Hughes, 163.

§ 592. The imitation of an established trade-mark will be enjoined though it is not exactly copied in every particular. It is enough that the representations employed bear such a resemblance to the genuine as to be calculated to deceive the public and make the articles to which it is affixed pass for the genuine. *Walton v. Crowley*,* 3 Blatch., 440.

§ 593. To entitle the proprietor of a trade-mark to relief, or to establish a case of infringement, it is not necessary to show that the imitation is exact in all particulars. If the resemblance is such as not only to plainly suggest an intention to deceive, but is calculated to mislead the public and thus injure the sale of the goods of the proprietor of the original device, the injured party is entitled to redress. So where a dealer in medicines put up and sold medicines called "Humphreys' Homeopathic Specifics," and numbered serially from 1 to 35, each number being designated as for use in a certain class of diseases, and the medicines came to be known and ordered by number, it was held to be an infringement for another dealer to put up medicines in similarly shaped bottles labeled Reeve's Improved Homeopathic Specifics,

and numbered serially from 1 to 40, so far as the numbers used by the latter to indicate remedies for certain diseases corresponded with the numbers used by the former for the same diseases. *Humphrey's Specific Homeopathic Medicine Co. v. Wenz*,* 14 Fed. R., 250; 15 Rep., 70.

§ 594. **Instances of infringement.**—The use of “Holsteter & Smythe” in place of “Hostetter & Smith,” and a substitution of Pittsburg for New York as the place of manufacture, retaining an exact imitation of label, devices, bottles and mode of packing, *held* an infringement. *Hostetter v. Vowinkle*,* 1 Dill., 329.

§ 595. Though the words “Coral Baking Powder” are not in themselves an infringement of the words “Royal Baking Powder,” yet their use in connection with cans and labels of the same general appearance as those used by the manufacturers of the latter article will be enjoined. *Carbolic Soap Co. v. Thompson*,* 26 Fed. R., 293.

§ 596. A trade-mark exclusively applied to dry white oxide of zinc is not infringed by the manufacture and sale of a paint containing white oxide of zinc ground in oil, though it is falsely represented that the oxide used is that made by the proprietor of the trade-mark. *La Société, etc., v. Baxter*,* 14 Blatch., 261.

§ 597. The plaintiff's trade-mark, consisting of the words “Lone Jack” in connection with other words and devices, and used on smoking tobacco, *held* infringed by the application of the words “Lone Jack” to packages of cigarettes, though the accompanying devices were different. *Carroll v. Ertheiler*,* 1 Fed. R., 688; 28 Int. Rev. Rec., 133; 9 Rep., 737.

§ 598. The use on packages of Hamburg tea of the name “J. C. Frese & Co.,” and the trade-mark or label “J. C. Frese & Co., Hopfensack, 6, Hamburg,” enjoined. *Frese v. Bachof*,* 13 Blatch., 234.

§ 599. Where a trade-mark consists of a combination of a picture, a monogram and certain words, there is no infringement unless the whole combination is used. *Tucker Mfg. Co. v. Boyington*,* 9 O. G., 455.

§ 600. A registered trade-mark for plug tobacco, consisting of a line printed or stamped on the plug, dividing it longitudinally into two equal parts, with lines crossing it at right angles at equal distances, as guides for cutting or dividing it into equal pieces, is not infringed by stamping a series of Greek crosses along the center of the plugs, with a series of half crosses along the margin opposite as guides for dividing it, as every manufacturer has a right to indicate on his goods suitable points or lines of division. *Dousman, etc., Tobacco Co. v. Ruffner*,* 15 O. G., 559.

§ 601. The use on labels and bottles of the word “Appolinis,” in connection with a bow and arrow and anchor, was restrained on account of their similarity to the word “Apollinaris” and the representation of an anchor, previously used by the plaintiffs, and because it appeared designed and calculated to deceive the purchasers and consumers of the waters thus marked into the belief that they were buying the waters of the plaintiff. But the allowance of such injunction was made conditional upon the plaintiff's executing a bond to the defendant to pay all damages sustained by the defendant if it should finally be determined that the plaintiff was not entitled to the injunction. *Actien-Gesellschaft Apollinaris Brunnen v. Somborn*,* 14 Blatch., 380.

§ 602. The complainant, who had used for some years the word “Maiziena,” and a representation of Indians cultivating corn and preparing flour, as a label for packages of corn flour put up by him for sale, registered the same under the act of congress of March 3, 1881. The defendants afterward adopted the word “Maizharina,” accompanied by a picture of a man carrying a quantity of maize in his arms, and registered them. The form, size, color and other characteristics of the packages put up by the defendants were the same as those put up by the complainant, and it appeared that the defendants colorably imitated the label and style of the packages of the complainant to such an extent as to be likely to deceive purchasers. *Held*, that the use by the defendants of the complainant's trade-mark would be enjoined. *Glen Cove Mfg. Co. v. Ludeling*,* 22 Fed. R., 823.

§ 603. A manufacturer of plug tobacco had used a star impressed on each plug as a trade-mark. *Held*, that the use of a somewhat similar though not identical device by another party on plug tobacco made in the same shape and size, and of the same appearance, would be enjoined where such device so used was calculated to deceive a purchaser of such tobacco into the belief that he was buying the genuine. *Liggett, etc., Tobacco Co. v. Hynes*,* 20 Fed. R., 883.

§ 604. Landreth & Co. adopted the name “Landreth's Extra Early Peas” for certain peas sold by them. The defendant, by the same name, afterwards commenced to sell what he called “Landreth's Extra Early Peas.” *Held*, that it did not appear that he had not the right to use the same words, provided he did so in such a manner as to inform the public that the peas to which he affixed such label were his own growth and production. But the use of a label substantially the same as the plaintiffs', and calculated to deceive purchasers into the

belief that they were buying the plaintiffs' peas, was enjoined. *Landreth v. Landreth*,* 23 Fed. R., 41.

§ 605. The plaintiffs, who possessed the exclusive right to use the words "Dr. J. Hostetter's Stomach Bitters" in connection with certain bottles, labels and devices, alleged that the defendants were making and selling an extract which would produce an imitation of their bitters, which they were disposing of to persons who would put the compound into the plaintiffs' bottles and sell it as genuine. *Held*, that, as it did not appear that the defendants were doing more than selling the extract with directions for its use, such sale would not be enjoined. *Hostetter v. Fries*,* 21 Blatch., 339; 17 Fed. R., 620; 16 Rep., 6.

VII. SUITS FOR INFRINGEMENT.

§ 606. **Jurisdiction.**—Where the parties are citizens of the same state a federal court has no jurisdiction of a suit for an infringement of a trade-mark, unless such trade-mark is used by the defendants in foreign commerce. *Schumacher v. Schwencke*,* 26 Fed. R., 818.

§ 607. Courts of the United States have jurisdiction to enjoin the unauthorized use of trade-marks registered according to the act of congress of July 8, 1870, irrespective of the citizenship of the parties. *Duwel v. Bohmer*,* 14 O. G., 270.

§ 608. **Parties.**—Where a suit for an infringement of a copyright is brought in a firm name by a person representing himself to be sole partner, and it appears that there is another member, he may be brought in by amendment if the suit is a meritorious one. *Frese v. Bachof*,* 14 Blatch., 432.

§ 609. The person for whom goods are manufactured has the same legal right to affix and maintain a special trade-mark as the manufacturer himself, and he need not join the manufacturer in a suit against an infringer. *Walton v. Crowley*,* 3 Blatch., 440.

§ 610. **Evidence.**—In an action to recover damages for the unlawful use of a trade-mark, evidence may be given of the sales of goods bearing such trade-mark on any day under a count charging such sales on a certain day and on divers days between that time and the commencement of the action. *Taylor v. Carpenter*,* 2 Woodb. & M., 1; 10 Law Rep., 35.

§ 611. **Question of title.**—In a suit for the infringement of a trade-mark, the question whether the complainant is the original inventor and proprietor of the article in question, or whether the article sold by the respondent is equal to that sold by the complainant, is immaterial. *McLean v. Fleming*, 6 Otto, 245; 10 Ch. Leg. N., 252 (§§ 431-40).

§ 612. **Delay in suing.**—There is no fixed time within which the owner of a trade-mark must proceed against a party infringing it, where there is no such delay as would show an intention to abandon it. *Williams v. Adams*, 8 Biss., 452 (§§ 474-75).

§ 613. Where there has been an unreasonable delay in bringing a suit for an unauthorized use of a trade-mark, an injunction will be allowed, but an accounting will not be decreed. *Holt v. Menendez*,* 23 Fed. R., 869.

§ 614. A long lapse of time will not deprive the owner of a trade-mark of an injunction against an infringer, but reasonable diligence is required, or an accounting of the rents and profits will not be decreed. Acquiescence must be after knowledge of the infringement. *Sawyer v. Kellogg*,* 9 Fed. Rep., 601.

§ 615. The use of an infringing trade-mark will be enjoined, though, owing to the delay in bringing suit, an accounting will not be decreed. *McLean v. Fleming*, 6 Otto, 245; 10 Ch. Leg. N., 252 (§§ 431-40).

§ 616. Equity will not decree for an account of past gains and profits where there has been laches in bringing the suit and long acquiescence in the use of a trade-mark by others. *Manhattan Medicine Co. v. Wood*, 4 Cliff., 461; 14 O. G., 519 (§§ 550-51).

§ 617. Where the delay of the owner of a trade-mark to prosecute infringers has been of a tendency to mislead the public, or the defendant sought to be enjoined, into a false security, and a sudden injunction would result injuriously, it will not be granted summarily, but the complainant will be left to his relief on the final hearing. So where the extensive use of a trade-mark by others, with the implied acquiescence of the owner, has contributed to give a reputation and create a demand for the article to which it has been applied which it would not otherwise have acquired, equity will not by any stringent intervention assist the owner to secure these fruits. *Estes v. Worthington*,* 22 Fed. R., 822.

§ 618. **Injunction.**—It is not necessary, in order to give a party a right to an injunction, that a specific trade-mark should be infringed, but it is sufficient that the court is satisfied that there was an intent on the part of the respondent to palm off his goods as the goods of the complainant, and that he persists in doing so after being requested to desist. *McLean v. Fleming*, 6 Otto, 245; 10 Ch. Leg. N., 252 (§§ 431-40).

§ 619. Equity will enjoin an infringement of an established trade-mark. *Frese v. Bachoff*,* 13 Blatch., 234.

§ 620. The granting of an injunction in a trade-mark suit is a matter in the discretion of the court. *Tucker Mfg. Co. v. Boyington*,* 9 O. G., 455.

§ 621. The right of a party whose trade-mark has been infringed to an injunction is not affected by the fact that the appropriation has been a limited one merely. *Atlantic Milling Co. v. Robinson*,* 20 Fed. R., 217.

§ 622. A court of equity refused to interfere by injunction in a trade-mark case, because the right was doubtful, before the plaintiff had made out his title at law. *Hartwell v. Viney*,* 2 Weekly Notes, 602.

§ 623. A complainant who has refused to recognize the rights of a foreign proprietor of a trade-mark until it appeared to him that it would be more profitable to purchase his rights in this country and obtain a monopoly of such trade-mark here will be left to his rights, as against an infringer, until final hearing, and an injunction will be refused. *Estes v. Worthington*,* 22 Fed. R., 822.

§ 624. Where the right to manufacture an article is contested between the parties, chancery will not interfere and enjoin a party from using labels or marks to recommend his article, though it may, to some extent, be substituted for that of the plaintiff. *Coffeen v. Brunton*,* 5 McL., 256.

§ 625. In trade-mark cases, it is by no means of course to grant preliminary injunctions, even where the plaintiff's case seems to be made out. *Fairbanks v. Jacobus*, 14 Blatch., 337 (§§ 461, 462).

§ 626. The complainant in a trade-mark suit is entitled to an injunction when it appears that the mark used by the defendants sufficiently resembles the complainant's to be mistaken for it, and that the defendants adopted such mark for the purpose of selling their goods as those of the complainant, or for the purpose of enabling retailers to do so, and that the complainant has been or is likely to be injured thereby. *Southern White Lead Co. v. Cary*,* 25 Fed. R., 125.

§ 627. **Quality of article sold.**—An action will lie to recover damages for an unauthorized use of a trade-mark, though the article sold by the defendant was not inferior to that sold by the plaintiff. *Taylor v. Carpenter*,* 2 Woodb. & M., 1; 10 Law Rep., 35.

§ 628. **Costs.**—In trade-mark case a decree of infringement and for an injunction carries the costs. *Sawyer v. Kellogg*,* 9 Fed. R., 601.

§ 629. **Damages.**—An infringer is liable to the person whose trade-mark he has infringed, and the damage will ordinarily be the loss of profits caused by the infringements. Where the sales of the genuine article have fallen off in a certain place to a greater extent than the sales of the spurious in the same time, the measure of damages will be the profits on the quantity of the spurious article sold there. *Hostetter v. Vowinkle*,* 1 Dill., 329.

§ 630. The damages for the unlawful use of a trade-mark are measured by the extent to which the unlawful use of the trade-mark has interfered with the sale of the genuine article. *Atlantic Milling Co. v. Robinson*,* 20 Fed. R., 217.

§ 631. An action to recover damages for an unauthorized use of a trade-mark was held not to be a case for punitive or vindictive damages. *Taylor v. Carpenter*,* 2 Woodb. & M., 1; 10 Law Rep., 35.

TABLE OF CASES.

(COPYRIGHT AND TRADE-MARKS.)

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*Prepared by A. L. SANBORN, Esq., of Madison, Wisconsin.

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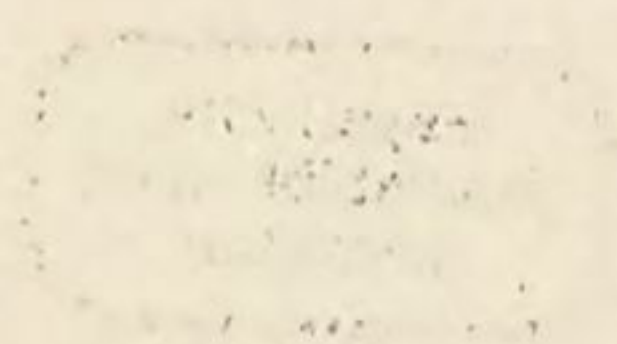
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